

OBLIGATORY TRADE MARK USE  
and CASE-LAW

Publications of the Faculty of Law, Canon Law and Administration  
of the John Paul II Catholic University of Lublin

Volume 2

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OBLIGATORY TRADE MARK USE  
and CASE-LAW  
Community and Polish Case-Law Studies

Wydawnictwo KUL  
Lublin 2010

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This book has been published with the financial assistance of:  
the Faculty of Law, Canon Law and Administration  
of the John Paul II Catholic University of Lublin  
and  
the Educational Foundation



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ISBN 978-83-7702-120-0

PUBLISHER  
Wydawnictwo KUL  
ul. Zbożowa 61, 20-827 Lublin  
tel. 81 740-93-40, fax 81 740-93-50  
e-mail: [wydawnictwo@kul.lublin.pl](mailto:wydawnictwo@kul.lublin.pl)  
<http://wydawnictwo.kul.lublin.pl>

PRINTING AND BINDING  
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08-110 Siedlce  
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## ABBREVIATIONS

BoA	Board of Appeals (OHIM's)
CFI	Court of First Instance
CTMR	Community Trade Mark Regulation
EPS	Europejski Przegląd Sądowy (European Court Review)
ECJ	European Court of Justice
Mon.Pr.	Monitor Prawniczy (Polish Law Journal)
KO	Polish Patent's Office Appeals Division
NSA	Naczelny Sąd Administracyjny (Supreme Administrative Court in Warsaw)
OHIM	Office for Harmonization in the Internal Market
OSP	Orzecznictwo Sądów Polskich (Polish Court's Review)
PO	Polish Patent Office
PWP	Prawo własności przemysłowej (Industrial Property Act)
SN	Sąd Najwyższy (Supreme Court)
WSA	Wojewódzki Sąd Administracyjny w Warszawie (Voivodship Administrative Court in Warsaw)



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34. Decision of June 24, 2005, case no. Sp. 210/04, "Moon";
35. Decision of October 19, 2005, case no. Sp. 98/04, "HandBud";
36. Decision of October 26, 2005, case no. Sp. 151/04, "Delikatny";
37. Decision of November 4, 2005, case no. Sp. 344/04, "Sierżant Kozak";
38. Decision of November 23, 2005, case no. Sp. 018/02, "Cracovia";
39. Decision of November 28, 2005, case no. Sp. 16/04, "Cleanic";
40. Decision of November 30, 2005, case no. Sp. 26/05, "Atut";
41. Decision of November 30, 2005, case no. Sp. 199/04, "Red Bull";
42. Decision of December 9, 2005, case no. Sp. 339/04, "Etno";
43. Decision of January 4, 2006, case no. Sp. 0129/01 and Sp. 0159/01, "Faberge";
44. Decision of January 6, 2006, case no. Sp. 73/05, "Wellner";
45. Decision of January 6, 2006, case no. Sp. 220/05, "Scalextric";
46. Decision of January 9, 2006, case no. Sp. 85/05, "500 Wódka produkowana ze spirytusu Polmosu";
47. Decision of January 12, 2006, case no. Sp. 30/05, "Lerros Collection";
48. Decision of January 30, 2006, case no. Sp. 112/05, "Botox";
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## INTRODUCTION

In comparison with other issues of trade mark law, the aspects of obligatory trademark use have a relatively short history due to the young genealogy of legal regulations concerning obligatory use. This is with relevance to both the laws of old EU member states, including the community law itself, as well as Polish law and other new EU member states' laws.<sup>1</sup>

This short genesis of the issues of obligatory use is well evident through the jurisdiction of community and domestic organs. The subject of obligatory trade mark use found its permanent place in the community jurisdiction only since 2003. At this time, the European Court of Justice (ECJ) handed down its decision in the "Ansul" case. This judgment was based on the regulations of the Directive on trade marks, whose goal is to approximate the laws of the Member States in this area of trade marks.<sup>2</sup> Until that time, the subject of obligatory use was only visible in the decisions of the

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<sup>1</sup> See further M. Trzebiatowski, *Obowiązek używania znaku towarowego. Studium z prawa polskiego na tle prawnoporównawczym*. Warszawa 2007, s. 1-38.

<sup>2</sup> Directive 2008/95/EC of the European Parliament and of the Council of October 22, 2008 to approximate the law of the Member States relating to trademarks (OJ L 299, 8.11.2008, p. 25-33), formerly directive no. 89/104/EEC, further as the Directive. See more on the meaning of the "new" directive: E. Jaroszyńska-Kozłowska, M. Trzebiatowski, *Dyrektywa o znakach towarowych po "liftingu"*, Mon. Pr. 2009/1, p. 32-35.

Office for Harmonization in the Internal Market (OHIM) and its Board of Appeals (BoA), not taking into account the sporadic cases that were handled by the Court of First Instance (CFI). Since the time of the *Ansul* judgment, it can also be noticed that more attention is paid with regard to the subject of obligatory trade mark use by the businessmen themselves and their legal advisors. This results in a growing number of judgments by the above mentioned organs and courts. These judgments are now more often based on the regulations of Community Trademark Regulation<sup>3</sup> and supplement the achievements of the judiciary based on the rules of the Directive. The regulations with regard to obligatory trade mark use are included in both of the mentioned legal acts and are closely related and fundamentally overlap each other. This is ascertained by OHIM's guidelines with reference to proof of trade mark use.<sup>4</sup> These guidelines embrace the rules developed by the ECJ, the CFI, OHIM's BoA and the OHIM itself, based simultaneously on the Directive and CTMR. These guidelines are also a certificate of "the young age" of the pertinent subject matter. Their first official version is dated on March 2004, even though the OHIM's guidelines have been published since 1996.

The situation of this pertinent subject-matter presents itself similarly in the Polish jurisdiction. The first substantial decisions of the PO concerning obligatory trade mark use were made in 2002, and the first court judgments date two and three years later. These judgments were still made based on the regulation of the "old" Trademark Act,<sup>5</sup> even though in most cases the nor-

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<sup>3</sup> Council Regulation (EC) No 207/2009 of February 26, 2009 on the Community trade mark (OJ L 78, 24.3.2009, p. 1-42), formerly as Regulation No. 40/94, further as CTMR.

<sup>4</sup> OHIM's Opposition Guidelines, Part 6. *Proof of use*. (Final version: November 2007), see [www.oami.europa.eu/ows/rw/resource/documents/CTM/guidelines/opposition\\_proof\\_of\\_use\\_en.pdf](http://www.oami.europa.eu/ows/rw/resource/documents/CTM/guidelines/opposition_proof_of_use_en.pdf)

<sup>5</sup> Act of January 31, 1985 on Trademark (Dz. U. (Official Journal) No 5, pos. 17 with further amendments) hereby as UZT.



mative background for the considered matters were already the regulations of the Industrial Property Act.<sup>6</sup> This specific transition from the hitherto existing to the new regulation was reflected in the content of judgments, especially with regard to issues that were regulated differently or were completely opposite. A significant example of this was the issue of the consequences of a revocation decision due to non-use of a trademark. The courts and the PO needed seven years, by way of the "Red Bull" case, to finally come to the conclusion, in the judgment of seven judges of the Supreme Administrative Court, that it is admissible to accept in this particular decision the retroactive effect with regard to the day of the filing of the motion for revocation.

One ought, however, to admit that the problems of obligatory trademark use hide yet many complicated or even enigmatic issues. This is apparent against the background of both the ECJ's and Polish administrative courts judicatures. The issue of the forms of trade mark use satisfy the requirements of use, particularly the use of a trade mark and its advertising function or the function of the trademark to indicate the commercial origin (name of the enterprise). Lately, one can add the issue of obligatory trade mark use on the Internet to these problems. Another such problem is the issue of justification of non-use. Still yet another matter is its use by authorized third parties, or use of different forms of a registered trade mark. Still current and baffling are the issues of extent of use of a trade mark, including the types of such use, as well as using the trade mark for goods or services for which the mark is registered. The matter of obligatory trade mark use by non-profit organizations is new. Besides these issues, strictly procedural matters are continuously discussed, concerning the legal interest of entities to file for the revocation of trade marks, or the time-frames in which the obligatory use was to take place, and the burden of

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<sup>6</sup> Act of June 30, 2000 – Industrial Property Act (Dz. U. (Official Journal) of 2003, No. 119, pos. 1117 with further amendments) hereby as PWP.

proof of use or the criteria for exhaustive revocation due to non-use or trademark revocation with a retroactive effect.

The present study contains a compilation of the thesis included in the most important community and national judgments concerning the above mentioned problems. However, it mainly concentrates on the material aspects of these legal matters. Taking into consideration the procedural issues at hand, it mainly discusses the mentioned notions of proof and time-frames. This compilation has been achieved by the analysis of 130 judgments and decisions of the ECJ and CFI and the decisions of OHIM's BoA and OHIM and by the equal number of judgments and resolutions by the NSA and the WSA and the decisions of the PO, not taking into account the single judgments of the SN and the decisions of the PO's Opposition Division. This study is mainly based on the materials prepared for a two-part training held for patent attorneys of the Mazovian District of the Polish Patent Attorneys Association, which took place in January and March 2009. The author, expressing his gratitude to the authorities of the mentioned Association, would like for this publication to leave a permanent mark in literature. However, it must be explained that this study, in comparison to the training material, has been enriched by a dozen or so additional, new judgments, both from community and national practices. Therefore, it has been up-dated. Further updated versions of these materials should be expected. These updates might additionally be supplemented by new commentaries to the cited judgments, with regard to specific issues. Hoping for such future publications, the Author together with the Publisher would like to present this publication to its Readers (especially to patent attorneys, legal advisers, barristers, judges and members of the PO's organs), counting on their positive acceptance of its usefulness in their professional work.

Warsaw, April 2009

## CHAPTER 1.

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# THE CONCEPT OF OBLIGATORY TRADE MARK USE

### 1.1. Trade Mark Use, Intention and Preparations to Use

#### 1.1.1. Community Practice

The Community's organs and courts have pointed out that while assessing obligatory trade mark use it is necessary to separate the notion of the intent to use from genuine use. Such a distinction is legitimate, since it allows to identify a mutual contraposition of the two mentioned notions. It clearly shows that as long as trade mark use stays within the intent to use, and the intent has not yet occurred, there cannot be any mention about any "genuine" use of a mark. This means that intent alone is not sufficient to declare such use. Therefore, it cannot be considered alone while assessing obligatory use. If such an occurrence would take place then the five-year-period to fulfill this requirement of genuine use would have little or no meaning.<sup>1</sup>

Preparations for genuine use are linked directly to the intent of trade mark use. Such actions are treated as an indication of such intentions. Therefore, it is also necessary to distinguish such pre-

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<sup>1</sup> OHIM's decision of March 28, 2000, No. C 000053447/1 in the case of "Trilium".

parations, just as in the case of intent, from genuine trade mark use. This also means that such actions alone cannot replace genuine trade mark use. However, they should be taken under consideration while assessing the obligatory use of a trade mark. This is, however, only true when such actions are conducted outside the undertaking. For example, in the case of pharmaceuticals, the fact of initiating proceedings for the authorization of the price of state-reimbursed medicine is considered such an action.<sup>2</sup> Hence, in general, preparations for the sale of any type of goods to customers, particularly in the form of advertising campaigns, is considered such a relevant action.<sup>3</sup>

### 1.1.2. Polish Practice

Polish jurisdiction also points out the necessity to separate the notions of intent to use and preparations for use from genuine trade mark use. It has also been stated that intent and preparations to use are not sufficient to acknowledge that either the use itself has actually occurred or if there are any proper reasons for non-use. Also, these two matters must be clearly demarcated. Consequently, if the trade mark proprietor wants to refer to the lack of the possibility to use a trade mark, he must show that in spite of the fact that he had a direct intent to use the trade mark and in spite of the fact that he had made preparations to use it, there came into being a proper reason causing non-use of the trade mark.<sup>4</sup>

As in the community practice, in the domestic practice, the preparations for use also have only an auxiliary effect when assess-

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<sup>2</sup> BoA's decision of September 16, 2005, No. R 878/2004-1, in the case of "Dinaxil".

<sup>3</sup> ECJ's judgment of March 11, 2003, C-40/01, in the case of "Ansul".

<sup>4</sup> WSA's judgment of December 13, 2007, case No. VI SA/Wa 1515/07 "Eucerin".

ing the obligatory use of a trade mark. Actions such as signing of a license agreement, taking steps to set-up a business undertaking on the territory of Poland or already setting-up such an undertaking are considered to be such preparatory actions. These mentioned actions are, however, conditional. They are only taken into consideration if future genuine trade mark use can be proved to be highly probable. This increased probability has to refer to the actual possibility in the future for the customers to use the offer for the sale of goods, which were previously part of the preparations. This means that these actions have to stay functionally and periodically connected with trade mark use for the goods currently on the market.<sup>5</sup>

It can be stated that the domestic practice has been mostly interested in preparatory actions to use when it comes to pharmaceuticals. Such actions in particular account for preclinical and clinical testing and filing the necessary documentation with the appropriate authorities for the registration of a pharmaceutical. Also, in this situation, the signing of a license agreement is considered to be a preparatory action to use, especially if it is an exclusive license to use the trade mark on the territory of Poland and if an authorization agreement by a licensee in Poland has been signed. The mentioned authorization agreement is to enable the licensee to file the documentation not only to register a said pharmaceutical but also to enable its commercialization on the territory of Poland.<sup>6</sup>

The domestic practice also further explains the problem of the reality of genuine trade mark use after preparations for use have taken place, also underlining the difference between these two occurrences, especially in the pharmaceutical sector. It has been

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<sup>5</sup> WSA's judgments of October 13, 2004, case No. 6 II SA 4027/03 – "Paradies" (II) and of September 30, 2008, case No. VI SA/Wa 1042/08 – "Apetito" and NSA's judgment of October 9, 2007, case No. II GSK 149/07 – "Paradies".

<sup>6</sup> PO's decision from December 11, 2003, case no. Sp. 024/02 – "Alerid".

maintained that actions prior to the sale of a pharmaceutical can amount to such actions as: creating the concept of early projects, printout editing and the production of materials for production and advertising purposes, such as folders for doctors, leaflets for patients, catalogues for chemists, pharmaceutical standards, educational posters and ads, logos on pens, calendars and newspaper ads and production materials in the form of cardboard packaging and labels on packaging. These materials indicate only the desire of the proprietor to possibly commercialize the said pharmaceutical on the market. Hence, they indicate that only preparations to introduce a product on the market have taken place. Such actions include in particular ad campaigns, which are usually accompanied by the introduction of some samples of the product. These actions are however conditional, since it is first and foremost obligatory to have had obtained the necessary permits from the proper authorities to introduce the given products on to the market. If such permits have not been given, such actions will not be effective and the product will not be available on the market. This implies that essential preparatory actions are to obtain the necessary permits to market the pharmaceutical under the given trade mark or to start the registration process for the trade mark under which the pharmaceutical is to be marketed. If in a given situation there exist real possibilities of the introduction of the pharmaceutical on the market, the proprietor, exercising ordinary diligence, has the obligation to provide suitable evidence. If no such evidence is delivered, it is then implied that the proprietor has no means to commercialize the product in the specified time-limit.<sup>7</sup>

The above restriction, with regard to the type and the range of preparatory actions, demonstrates that their (auxiliary) significance, while assessing the obligatory use of a trade mark, is determined by an actual impact, in other words, the actual possibility that

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<sup>7</sup> PO's decision of December 9, 2003, case no. Sp. 037/02 – "Spectrum".

these actions will result in the future in a factual commercialization of goods or services with the trade mark. This matter demands further research with regard to the specific conditions of a definite market section. At the same time, it needs to be determined if the preparations have any external effect, which would additionally resonate with future customers of the goods or services under the given trade mark. Therefore, it has been maintained that with regard to the alcohol industry, activities such as establishing contacts with the proper authorities for this market and industry, establishing business contacts and starting to exchange correspondence about future trade ventures, ordering graphic projects of packaging and signing adequate agreements in that regard are not considered to be effective preparatory actions with regard to the assessment of genuine use. These mentioned activities testify only as to the intent to use the trade mark for alcohol, and for such products at-large, but not as the intent to use a given trade mark for a given type of alcohol. Besides, they take place within the framework of the relations between the proprietor and the appropriate authorities or his contracting parties upon whose decisions or activities depends the future marketing of alcohol on the market. Instead, activities with regard to the alcohol industry that would evoke the intention to use a particular trade mark and that would also be recognizable by the consumers of those goods as such could constitute effective preparatory actions. These activities could include then, for example, the placing of the given trade mark in vodka ads, which would be available on the domestic market or in export, displaying the vodka or its packaging with the trade mark or placing the trade mark on invoices with regard to the vodka which is being sent to the purchasing party.<sup>8</sup>

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<sup>8</sup> WSA's judgments of February 5, 2008, cases No. VI SA/Wa 2019/07 and 2020/07 – "Lech-Pol" and "Mariusz Lech".

Taking into consideration the above assumptions, it can be affirmed that with regard to, for example non-metal roof tiles, not only such activities as commercial offers or print ads can be considered as preparations for use of a trade mark. These can also amount to placing information or announcements on the proprietor's Internet site or printing out catalogues showing the future sale of mentioned tiles with the given sign. They can be also proven by specific lab tests, market research, and especially the obtainment of certificates, approvals and permits or even specific applications filed with the proper authorities to that effect.<sup>9</sup>

## **1.2. Trade Mark Use and Conducting Business Activity**

In the Polish jurisdiction, the problem of the connection between the obligatory trade mark use and ceasing the activities of an undertaking have also been analyzed. It has been stated that the lack of, i.e. ceasing or even temporarily stopping the conducting of a real undertaking with regard to the goods covered by a registration, also under the revocation procedure, due to the liquidation or re-branding of the proprietor's undertaking is equivalent to the non-use of a trade mark.<sup>10</sup> This given situation means that the proprietor of the trade mark, who has ceased to conduct his business activities or who has not even started to do so will not use the trade mark. Hence, he has exposed himself to the revocation of his rights from registration due to the non-use of a trade mark. This means that if the proprietor of the trade mark ceases to conduct business activity due to its liquidation, and there are no

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<sup>9</sup> PO's decision of June 20, 2005, case no. Sp. 050/02 and 051/02 – "Ondura".

<sup>10</sup> PO's decision of February 20, 2002, case no. Sp. 024/01 – "Wega" and of October 20, 2004, case no, Sp. 0151/01 – "Tele Top".



legal successors, this determines the non-use of the trade mark from the day of the liquidation of the proprietor.<sup>11</sup>

The proprietor's bankruptcy is qualified in the same way. It has been maintained that the beginning of the bankruptcy proceedings amounts to ceasing further debiting of the undertaking and what is more important, capitalizing the company's assets and their distribution among creditors. Those assets include rights that can be assigned and personalized, so that they become objects of turnover. Let us assume that in a particular situation the syndic of the undertaking in bankruptcy confirmed that the right to the contested trade mark has not been assigned to another party, even though the rights to another trade mark have been assigned. Furthermore, the proprietor's bankruptcy resulted in his being deleted from the register of companies just short of a year after applying for the trade mark's registration. These circumstances permit implying that the trade mark was not used at least from the date of the declaration of bankruptcy.<sup>12</sup> It is worth adding that this opinion seems to be even more general in the PO's practice, since it has been accepted that the use of a trade mark, whose rights have been assigned to another entity, can be proven by the successor in title of the previous proprietor.<sup>13</sup>

One ought, however, to remember that the quoted position of the PO evolved during a period when Article 169 par. 1 of the PWP was being amended by the introduction of point 4. This point includes that one of the conditions for the revocation of trade mark rights is also the fact that the proprietor of the trade mark has been deleted from the Register of companies. This regulation clearly states that the condition to revoke the proprietor's trade

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<sup>11</sup> PO's decision of June 23, 2004, case no. Sp. 24/04 – "Polovat" and from September 1, 2004, case no. Sp. 235/03 – "Mister".

<sup>12</sup> PO's decision of September 23, 2004, case no. Sp. 182/04 – "Augusta".

<sup>13</sup> PO's decision of January 6, 2006, case no. Sp. 73/05 – "Wellner".

mark rights is not only met when the activities of the undertaking were ceased or did not start at all but also when the proprietor has been deleted from the Register of companies. Furthermore, this regulation indicates that the mentioned above condition is separate from the notion of non-use, which is being discussed in point 1 of Article 169, par. 1 of the PWP. Hence, it can be argued if the presented above position is fully current or whether at all correct. What is most import is the mutual relationship between the two conditions for the revocation of trade mark rights. These doubts become even stronger when taking into consideration contradictory opinions, expressed at the same time of the quoted above position. According to those opinions, the PO authority in relation to the adversarial stage of the registration proceedings has been precisely enumerated in Article 255 of the PWP. Among the motions indicated in this provision, for which the PO is the appropriate examining organ, the motion to revoke trade mark rights due to the closure of business activity has not been enumerated. The instances of granting the revocation of a trade mark was defined precisely in point 3 of the mentioned regulation, limiting them to circumstances enumerated in Article 169 of the PWP. At the same time, the PO, due to the explicit provision of point 3 of Article 261 of the PWP, conducts its activity in the adversarial stage of proceedings within the range defined by the PWP. In the light of such precisely defined authority of the PO, it has no legal means to widen the interpretation of Article 255 point 3 of the PWP. Therefore, there are no grounds to assume that this provision includes other cases, which have not been enumerated in Article 169 of the PWP, which could provide a condition for the revocation of a trade mark, eg. due to the closure of business activity by the proprietor. This position, that legislators wanted to restrict the authority of the PO with regard to such provisions, is also supported by the provisions in Article 255 point 1 of the PWP with regard to the revocation procedure of patents. In this regulation, legislators did not institute any restrictions for the

examination of such a motion. At the same time, in the present matter, Article 315 par. 1 and 2 can not be applied. This is because this article refers to the assessment of the trade mark registrability and the rights conferred by registration and not to the authorization of the administrative body examining the motion. It can be concluded then that the legislator consciously eliminated from the competence of the PO during the adversarial stage of proceedings the authority to examine motions of revocations of trade marks due to the cessation of business activity by the proprietor. No such competence was given, bearing in mind the provisions of Article 19 and 20 of the civil proceedings act (KPC) which are to be applied in such a case based on the provisions of Article 256 of the PWP. These regulations provide that public administrative bodies *ex officio* comply with their territorial and material jurisdiction and that the material jurisdiction of the administrative body is determined based on the provisions concerning its functioning. This leads to the conclusion that the PO during the adversarial stage does not have the authority to examine a motion to revoke a trade mark's rights, which is based on conditions not enumerated precisely by the realm of its authority (not stated in the PWP).<sup>14</sup>

### **1.3. Genuine Trade Mark Use**

#### **1.3.1. Community Practice**

Within the framework of the notion of genuine use, the community courts, already in their first judgments with regard to obligatory trade mark use, have explained the relation between the notions of "genuine" and "serious" trade mark use. Such clarification was necessary due to the differences in translations

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<sup>14</sup> PO's decision of September 5, 2002, case no. Sp. 039/01 – "Relax".

of the community directive and regulation in connection to the mentioned obligation.<sup>15</sup> It was believed that these notions cannot be contradictory to each other.<sup>16</sup> "Serious" use has to be understood within the meaning of "genuine" use, in compliance with the terminology accepted in the 8<sup>th</sup> recital of the Directive.<sup>17</sup> This interpretation should also establish some standard rules (and directions) for the interpretation of all related notions, which appear in this area in national legislations. Equating with each other "genuine" and "serious" use means that obligatory trade mark use consists of actual use. This entails that the use can not be symbolic, aiming only at maintaining the rights conferred by registration. Such use must instead assure that the trade mark fulfills its essential function, which is to guarantee the identity of the origin of goods or services to the consumer by enabling him, to distinguish the product or service from other entities. Hence, such exploitation of the trade mark should take place on the market, and such use should not alone consist of internal use by a given undertaking. It also must coincide with the general aim of a trade mark which is to create or preserve an outlet for the goods or services. It should consist of affixing the trade mark on goods or services which are to be distributed (sold), which can also be preceded by direct trade mark use in ad campaigns to gain new customers and increase such sales.<sup>18</sup>

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<sup>15</sup> See further M. Trzebiatowski, *Obowiązek używania znaku towarowego. Studium...*, pgs. 69-70.

<sup>16</sup> CFI's judgment of March 12, 2003, case No. T-174/01 – "Cocoon".

<sup>17</sup> Previously the ninth recital of Directive No. 89/104.

<sup>18</sup> ECJ's judgment in the case of "Ansul", previously cited and the ECJ's judgment of January 27, 2004, case C-259/02 – "La Mer (I)", see further M. Trzebiatowski, *Komentarz do postanowienia 17 w sprawie C-259/02 LaMer*, [w:] *Własność przemysłowa. Orzecznictwo Trybunału Sprawiedliwości Wspólnot Europejskich, Sądu Pierwszej Instancji i Urzędu Harmonizacji Rynku Wewnętrznego z komentarzami*, red. R. Skubisz, Kraków 2008, pgs. 291-302.

The interdependency of the above notions has led to the establishment of the position that genuine trade mark use occurs when the use is objectively factual, consistent in time and stable in form. Only such use allows the customer to perceive the trade mark as an indicator of the origin of goods or services. Such use embodies in contrast a use that is inconsiderable, illusive and only aims at maintaining the rights conferred by a trade mark's registration. Genuine use implies most of all that the sign is present in the essential part of the area of its protection in a way that allows the fulfillment of its original function. It assumes therefore the use of a trade mark that takes place in public, externally, including also outside the proprietor's undertaking, his distributors, his sale network and agents, which can all be under the proprietor's control. Genuine use in its final effect has to result in grabbing the attention of potential customers onto the goods or services bearing the sign, which are effectively offered on the market.<sup>19</sup> It ought to be mentioned that with regard to the considered here notion, the use is to happen within the course of trade, as understood in Article 5 of the Directive. This is confirmed by the opinion according to which the use of a sign takes place in the context of commercial activity with a view to economic advantage and not as a private matter.<sup>20</sup> It is also explained that the above mentioned

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<sup>19</sup> CFI's judgments in "Cocoon" case as cited previously and of December 12th, 2002, case T-39/01 – "Hiwatt", of July 9, 2003, case T-156/01 – "Giorgio Armani", of July 8 2004, case T-203/02 – "Vitafruit"; of July 8, 2004, case T-334/01 – "Hipoviton", of October 6, 2004, case T-356/02 – "Vitakraft"; of June 7, 2005, case T-303/03 – "Solevita"; of February 23, 2006, case T-194/03 – "Bainbridge", of September 27, 2007, case T-418/03 – "La Mer" (II), of April 30, 2008, case T-131/06 – "Sonia Rykiel", of September 10, 2008, case T-325/06 – "Capiro" and of December 18, 2008, case T-86/07 – "Deitech".

<sup>20</sup> ECJ's judgment of December 12th, 2002, case C-206/01 – "Arsenal", of January 25, 2007, case C-48/05 – "Opel", of September 11, 2007, case C-17/06 – "Celine" and of March 20, 2007, case C-325/06 P – "Galileo", and also CFI's judgments of April 10, 2003, case T-195/00 – "Travelex" and of December 16, 2008, case T-225/06, 255/06, 257/06 and 309/06 – "Bud".

use and the connected economic advantage can not only be tied to payment. It can also occur when there are annotations on invoices, indicating that goods were delivered free of payment. This is because even gratuitous delivery can target the obtainment of an economic advantage which for example can amount to acquiring new markets.<sup>21</sup>

The above notion of "genuine" use understood as "serious" use has to lead to the development of an outlet for goods or services for which the trade mark is intended. Such use needs to therefore result in creating and preserving an adequate market position for the trade mark. In this sense, serious use is to be considered as an element of normal (typical) business activity in a given business sector, that is normal in terms of range and frequency of using the sign.<sup>22</sup>

### 1.3.2. Polish Practice

Polish jurisdiction is very much in-line with the above stated position. This is evident by numerous referrals to this view and especially to the judgment in the *Ansul* case.<sup>23</sup> Based on these referrals, it has been maintained that there is no legal definition of "use". This results in the necessity of the interpretation of this notion in compliance with its generally accepted understanding. However, it has been pointed out that with regard to obligatory

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<sup>21</sup> CFI's judgment in the "Bud" case as previously cited.

<sup>22</sup> ECJ's judgment in the "Ansul" case as previously cited, and ECJ judgment of May 11, 2006, case C-416/04 P – "Vitafruit" and CFI judgments in the "Hipoviton" case as previously cited, of July 10, 2006, case T-323/03 – "La Baronne", and BoA's decision of May 19, 2003, case R 450/2001-2 – "Rio/Rio Bravo", and of September 19, 2003, case R 867/2000-2 – "Hexacan/Cekacan" and of January 26, 2004, case R 225/2003-1 – "Nevadent/Novodent".

<sup>23</sup> Among many for example, WSA's judgment of February 6, 2008, case no. VI SA/Wa 1418/07 – "Twój Styl" and the PO's decision of September 12, 2007, case no. Sp. 398/06 – "Aveda".

trade mark use, this interpretation should be properly oriented. Therefore, it has been asserted that this obligation is only fulfilled when the use of the trade mark occurs only with regard to goods or services. The function of the trade mark is manifested in the relationship between the sign and the good or service that is imprinted in the consciousness of the public. It is necessary therefore to allow the average consumer on the market, through the use of the trade mark, to connect the given good or service with the used sign.<sup>24</sup> Such use therefore has to be of a clear character, which means that it has to be assured, that the sign is used at least in its essential function.<sup>25</sup>

The above mentioned views lead to the conclusion that "genuine" use is connected with the function of the trade mark. This consists of indentifying the goods based on their origin and can occur only when the trade mark is affixed on the good, and the goods are available to the customers. The sign fulfils its role when the good affixed with that sign is commercialized. The trade mark is therefore available in the course of trade and used, in accordance with law (Art. 154 PWP) only if, there occurs an actual contact between the trade mark and the customers.<sup>26</sup> Such contact is achieved as a result of the undertaking's repeated activities, which amount to the legally defined aspects of trade mark use and concern its use in the course of trade. Hence, these activities have to be connected to the identification of the trade mark by customers.<sup>27</sup>

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<sup>24</sup> WSA's judgments of February 19, 2004, case No. 6 II SA 2490/02 – "Helios" and of March 21, 2006, case No. VI SA/Wa 1653/05 – "Co jest grane".

<sup>25</sup> WSA's judgment of October 17, 2006 – case No. VI SA/Wa 1279/06 – "Czach"

<sup>26</sup> WSA's judgment in the "Eucerin" and "Twoj Styl" cases, as previously cited, and of February 7, 2008, case No. VI SA/Wa 1456/07 – "Cardinal". On the inseparable connection between obligatory use and the function of a trade mark achieved on the market, also NSA's judgment of February 8, 2007, case No. II GSK 252/06 – "Moon".

<sup>27</sup> SN's judgment of February 17, 2005, case No I CK 626/04 – "Ale kino" and NSA's judgment of May 24, 2006, case No. II GSK 70/06 – "Naomi".

This ascertainment implies specific conditions for genuine use. Such use has to stay in agreement with the scope of proprietor's economic activity and the use needs to happen in the course of trade.<sup>28</sup> At the same time, this use has to stay physically and conceptually connected to the good or service. This implies the necessity to put the sign on the good and to commercialize such demarked good onto the market.<sup>29</sup>

From the issues discussed above, it can be concluded that in case of genuine trade mark use only the use in the course of trade, that is outside the undertaking's seat, has any real meaning. At the same time, this use has to have some economic weight. Only through such use a trade mark can be recognized by customers and even by other business entities. For such recognition to occur, the activities surrounding use cannot be isolated or sporadic. These activities have to be characterized as certain and constant.<sup>30</sup> For example, to present only one invoice concerning the sale of the good with the trade mark implies a singular transaction from which genuine use of a trade mark cannot be ensued.<sup>31</sup> As it has been stated above, genuine use has to involve repeated activities in the course of trade with the use of the trade mark.

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<sup>28</sup> NSA's judgment of October 10, 2006, case No. II GSK 173/06 – "Eska" and NSA's judgment of February 7, 2006, case No. VI SA/Wa 1749/05 – "Eska" and in the "Twój Styl" case, as previously cited.

<sup>29</sup> NSA's judgment in the "Naomi" case as previously cited.

<sup>30</sup> SN's judgment in the "Ale kino" case as previously cited and NSA's judgment in the "Naomi" case as previously cited.

<sup>31</sup> PO's decision of October 27, 2004, case No. 174/03 – "Kronos".



## **1.4. Genuine Trade Mark Use and the Commercialization of the Affixed Good on the Market**

### **1.4.1. Community Practice**

From the presented interpretation of the notion of genuine trade mark use, it can be concluded that such use cannot occur if the goods with the trade mark have not been commercialized. Hence, the question can arise: at what moment does the actual commercialization occur? This question has been answered so far only by OHIM. However, this answer can be rather controversial. It is the Office's opinion that to fulfill the requirement of genuine ("serious") use, it is sufficient to have sent the goods affixed by the trade mark from the country of origin, impose duty on them and for the goods to be received by an undertaking which is to introduce them into the market. It is insignificant if the delivered goods were actually commercialized and offered to customers. In this situation it is enough simply to assume that such actions have taken place.<sup>32</sup>

### **1.4.2. Polish Practice**

The position of the domestic jurisdiction on this issue can raise some doubts. As previously in the case of domestic jurisdiction, so far only the PO has given its position on this issue. It can be deduced then that the issue of genuine use and the commercialization of goods affixed with a given trade mark have to be treated on a case by case basis. For example, to recognize that a trade mark was used for pharmaceuticals, it is of no significance that the products are not available at drug stores. Just the sale, including

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<sup>32</sup> BoA's decision of December 10, 2002, No. R 554/2001-1 – "Rossi/Roxy".

export of such products to specialized pharmaceutical wholesale companies is enough.<sup>33</sup>

### 1.5. Genuine Trade Mark Use and Non-Profit Organizations

This problem has so far only been the subject of consideration under community practice. Hence, it has been stated that the circumstance, that goods or services with a sign that are being offered non-profit, is not conclusive for the evaluation of genuine trade mark use. Non-profit activities, such as charities, do not exclude the fact that an entity having such a goal, as for example an association, can create and preserve an outlet for its goods or services. Registered trade marks in the name of such entities can be protected from the possible use of identical or similar marks by third persons in the course of trade. Therefore, if such an entity uses their registered trade marks to identify and promote goods or services for which these trade marks are intended, then such use is genuine. However, it has been stressed that such use must occur in relations with customers. In such circumstances such use should aim at least at announcing some organized festivities, e.g. collection drives or allocating donations. This use should also consist of placing the trade marks on company paper or marketing materials and badges worn by the members of such entities during the said festivities. If, however, these trade marks were used by such associations only during private functions, only among its members, or only for the purpose of sole announcement or advertisement of such functions then the use could only be qualified as internal use. Such activity then could not be qualified as genuine use.<sup>34</sup>

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<sup>33</sup> NSA's judgment of December 12, 2007, case No. II GSK 252/07 – "Botox".

<sup>34</sup> ECJ's judgment of December 9, 2008, case C-422/07 – "Radetzky". See further M. Trzebiatowski, *Używanie znaku towarowego przez stowarzyszenie non profit – glosa do wyroku ETS z 9.12.2008 r. w sprawie C-442/07 Radetzky*, EPS 9/2009, pgs. 41-46..

## **1.6. Genuine Trade Mark Use and Reputation or Well-Known Trade Marks**

### **1.6.1. Community Practice**

It is difficult to find a distinct opinion on this matter in community practice. However, OHIM affirms that for the evaluation of genuine trade mark use, particularly if the form of the trade mark has been slightly altered, the degree of recognition of the trade mark bears no significance.<sup>35</sup>

### **1.6.2. Polish Practice**

In this particular matter, the Polish courts have presented a clear and definite position. They maintain that the reputation of a trade mark is not to be taken under consideration while assessing its obligatory use. In proceedings to revoke a trade mark's rights due to its non-use, only the formal conditions for revocation are taken under consideration.<sup>36</sup>

A similar opinion was already expressed by the PO. It came to the conclusion that in compliance with the content of legal regulations, the institution of revocation of a trade mark's rights due to its non-use does not preclude trade marks with a reputation or well-known marks to be revoked due to non-use. The legislator has conveyed the requirement of use placed on the proprietor of the trade mark for goods covered by the trade mark regardless of the character of the trade mark. Simultaneously, he created the possibility by revoking the rights of registration to eliminate such trade marks that are not used in the course of trade. Therefore, the

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<sup>35</sup> BoA's decision from April 23, 2001, decision No. R 89/2000-1 – "El Capitan Pescanova/Capitan".

<sup>36</sup> NSA's judgment of March 20, 2007, case No. II GSK 364/06 – "Red Bull" (I) and of September 11, 2008, case No. II GSK 138/07 – "Red Bull" (II).

condition that allows the trade mark to be revoked is the non-use of the trade mark and not the character of the trade mark itself – the degree of recognition of the trade mark or its reputation.<sup>37</sup>

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<sup>37</sup> PO's decision of January 4, 2006, case no. Sp. 0129/01 and 0159/01 – "Faberge".

## CHAPTER 2.

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# THE FORMS OF OBLIGATORY TRADE MARK USE

### 2.1. Use of a Mark Indicating Company's Name

#### 2.1.1. The Community Practice

The matter of the admissibility of the used form of the trade mark as an indication of a company's name has been discussed for a long time only by OHIM. The Office has admitted that it can not exclude that the use of the given mark as an indication of a brand name can satisfy the requirement of obligatory trade mark use. This is, however, conditioned by the requirement that such use of this mark should identify the offered goods or services as such. This condition is not fulfilled if the mark is used as the name of a shop<sup>1</sup> or is placed on the back cover of a catalogue<sup>2</sup> or on a back-label.<sup>3</sup> Genuine use of a mark can constitute the placing of the mark (name) of the company in the upper heading of orders or invoices. However, this is admitted exceptionally, depending on the manner of the placing of this mark on said documents.<sup>4</sup> In principle, genuine trade mark use has to consist of the use of a mark as a trade mark. Therefore, using the mark or its essential

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<sup>1</sup> OHIM's decision of March 29, 1999, "Fixella" case, No. 137/1999.

<sup>2</sup> OHIM's decision of May 25, 1999, "Apomedica" case, No. 298/1999.

<sup>3</sup> OHIM's decision of August 3, 1999, "Aka" case, No. 586/1999.

<sup>4</sup> OHIM's decision of April 25, 2001, "Anastasia" case, No. 1063/2001.

part in the capacity of a company's name is not considered genuine trade mark use.<sup>5</sup>

This issue has been lately the subject of discussion by the CFI. The CFI has noticed that whether the mark is used as a trade mark or else as a brand name or its element should be determined by a general assessment of the pertinent trade mark use. However, one ought to take into consideration the existing manner of the extent of trade mark use, both in relation to the similar as well as other products covered by this mark. The sound of the proprietor's name and the form of its presentation in the course of trade, including the packaging of the products, should be taken into consideration in such assessment. It is also necessary to consider if the (sign "®", indicating a trade mark's registration, has been placed close to the mark. It is also essential to assess the pertinent issue in connection with the context of current regulations with regard to specific requirements placed on specialized products, e.g. cosmetics or medications. It can also be vital, especially in exceptional cases, to compare the extent of use of a trade mark before and after the request for proof of use has been filed. Such is the situation when the proprietor's company name is changed by the inclusion of the sign. If this comparison results in establishing that within the period before the mentioned date to which this motion refers the name was not or was not always presented in companionship or together with the mark, this means that the mark, used as described above in this period of time, could not be treated as an element of the name, which it has become nowadays. Besides, the sole fact that the mark was incorporated into the proprietor's company name does not cause that its use, in spite that it is part of the company's name, is an admissible form of use as a trade mark.<sup>6</sup>

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<sup>5</sup> BoA's decision of December 13, 2001, "Carlisle" case, No. R-791/2000-1.

<sup>6</sup> CFI's judgment in "La Mer" (II) case, cited above.

### 2.1.2 Polish Practice

Polish jurisdiction holds the same position. However, it discusses this issue considering a broader perspective. It has been stated that the forms of obligatory trade mark use are equated with the general rules of trade mark protection implementation.<sup>7</sup> However, the sum of attributes of obligatory trade mark use, i.e. genuine use and unambiguous character, have essential meaning in light of Article 154 of the PWP.<sup>8</sup> It has been pointed out that obligatory trade mark use is satisfied when the trade mark is used in connection with the good or service. Therefore, not every form generally defined as a form of trade mark protection implementation satisfies the fulfillment of obligatory trade mark use and allows the maintenance of the right derived from the registration.<sup>9</sup>

One comes to the conclusion that use, and all the more genuine use, can not be satisfied by the sole sale of goods at a commercial stand under the company name which is the same or similar to the trade mark. The essential function of a trade mark is to identify the goods of a specific business entity. If this is the case then the use of a trade mark should consist of placing the trade mark on goods or on their packaging, and not only using the trade mark for the identification of a business entity itself.<sup>10</sup>

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<sup>7</sup> SN's judgment in the "Ale kino" case, cited above and the judgments of the WSA in the "Twój Styl", "Eucerin", and "Cardinal" cases, all cited above, and the judgment of November 4, 2004, case no. 6 II SA 4086/03 in the "Ava-Mustela" case, and before the decision of KO of October 22, 1993, case no. Odw. 1266/93, "Aro".

<sup>8</sup> WSA's judgment in the "Czach" case, cited above.

<sup>9</sup> WSA's judgment of June 16, 2004, case no. 6 II SA 811/03 – "Rainbow".

<sup>10</sup> NSA's judgment of May 24, 2007, case no. II GSK 13/07 – "Świat Kawy i Herbaty".

## 2.2. Trade Mark Use as the Name of Product Type

This issue revolves around the relationship of obligatory trade mark use and the use of a trade mark as such. To illustrate the difficulty in assessing this type of use, it will be best done by one of the case-studies in the Polish practice. This case-study is about the "Solar" trade mark for goods in class 3, i.e. sun care products and cosmetics. This sign was to be used by a licensee, based on a proper license agreement. It was also used for the suntan oil "Solar", containing the Solar base which was written up as a definite technical symbol. The registered trade mark was written in a usual font, universally used for writing purposes with simple styling and no ornaments. Also, this mark was placed on the bottle into which the oil was poured. The mark for Solar oil with the information that it contained the Solar base was visible on the packaging. In this situation, it was considered that placing the Solar mark on the packaging only caused that the oil sold was marked with the pertinent trade mark. This is also ascertained by the mentioned license agreement, from which it could be derived that the licensee was obliged to use only the Solar base for all of his oil-products in class 3, with UV protection, affixed with the word "Solar" trade mark. If one was to reason *a contrario* one can say that if the packaging of oil was affixed with the name "Solar" – the SOLAR mark, then this oil contained the Solar base. Therefore, the name Solar should be interpreted in compliance with its purpose, i.e. it should be read as a sign – the trade mark "Solar". Based on this situation, the trade mark proprietor could then identify the use by the licensee of the mark Solar for oil with the name Solar as the use of the trade mark "Solar".<sup>11</sup>

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<sup>11</sup> PO's decision of April 15, 2003, case no. Sp. 031/01 – "Solar".



### **2.3. Trade Mark Use in Correspondence and Other Documents (Orders, Catalogues, Invoices, Official Documents)**

#### **2.3.1. Community Practice**

The OHIM's opinion in this matter has been concise, but clear enough. It stated that if goods were offered for sale by the means of a catalogue with mail-orders, and the mark was used as the title of this catalogue and it referred generally to all the mentioned goods, then this could not constitute genuine use.<sup>12</sup>

#### **2.3.2. Polish Practice**

The PO generally accepts that genuine use as a rule consists of affixing the mark on goods and putting those goods on the market or using the mark on business documents in relation with the proprietors business or advertising these goods.<sup>13</sup> However, the administrative courts have argued that to satisfy an obligatory trade mark it is necessary to affix the trade mark on the good or on its packaging and putting the good on the market. This means that sole business correspondence or advertisement of a given good is not enough to oblige the requirement for its use.<sup>14</sup> In order to avoid the loss of protection rights due to non-use, the trade mark should be used in physical or content sense with regard to the given good or service. Consequently, the use of the mark in correspondence with possible contracting parties, placing the mark in catalogues or the single display of the good with the mark at trade fairs can constitute a form of use, but only when it is accom-

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<sup>12</sup> OHIM's decision of December 18, 2000, case no. 3086/2000 – "Kaleidoscope".

<sup>13</sup> PO's decision of February 14, 2006, case no. Sp. 125/05 – "Lord".

<sup>14</sup> NSA's judgment in "Naomi" case and the WSA's judgment in the "Helios" case, both cited previously.

panied by an actual introduction of the goods with the trade mark onto the market or by actual rendering of services. This activity is taken under consideration as an element of the actual state of affairs, being the base for the assessment if the proprietor's use of the trade mark was genuine.<sup>15</sup>

Applying for the registration of industrial designs containing the trade mark has no particular meaning taking into account the above. Such actions do not testify for the factual use of the trade mark in the course of trade.<sup>16</sup>

## **2.4. Trade Mark Use in Advertisement or Promotional Events**

### **2.4.1. Community Practice**

The opinion of community organs and courts is such that there is no doubt that the requirement of trade mark use cannot be satisfied through the use of the mark during promotional events. In particular, the OHIM has accepted in its practice that genuine use of a trade mark for drinks does not consist in affixing the given trade mark on marketing materials, such as T-shirts and baseball caps and distributing them during promotional events for those drinks.<sup>17</sup>

This position has been lately confirmed by the ECJ, with an even larger justification. The Court of Justice explains that, when taking into consideration the number of registered trade marks and the possible conflicts that might develop between them, it is necessary to evaluate genuine trade mark use with regard to each class of goods for which the trade mark has been registered. It is at

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<sup>15</sup> WSA's judgments of February 12, 2004, case no. II SA 2095/02 – "Agnes" and of December 15, 2004 – case no. II SA 3166/03 – "Scalextric" and the PO's decision of January 6, 2006, case no. Sp. 220/05 – "Scalextric".

<sup>16</sup> PO's decision of September 4, 2006, case no. Sp. 307/04 – "Broadway" (I).

<sup>17</sup> OHIM's decision of February 14, 2001, case no. 374/2001 – "Malibu".

the same time necessary to make dependent the maintenance of trade mark protection right with regard to a particular class of goods or services upon the use of the mark on the market of the goods and services belonging to that class. The conditions of further protection derived from the above mentioned dependency are not met by a mark that is used for articles that are offered as a "compensation" for purchasing other goods. Such actions are considered to be aimed only at advertising those products. In these types of situations the mentioned articles (promotional) are not distributed through the normal channels of distribution that would allow for the penetration of the market of goods that belong to their same class. In such circumstances the trade mark affixed on those articles does not contribute to the creation of a share in the market for those goods, nor even, does it in the interest of the consumer help them to identify them from identical or similar goods of other undertakings. As a consequence, if the proprietor of the trade mark puts the mark on items that are offered to customers for his other goods free of charge, then that mark is not put to genuine use with regard to the protected class of goods to which those items belong.<sup>18</sup>

#### 2.4.2. Polish Practice

A similar opinion was lately presented by the administrative courts. They stated that autonomous advertisements with the use of the registered trade mark, for example for sweets, by the way of affixing the mark on the packaging (boxes) of candy and on the candy itself and then distributing them among business partners or clientele in a form of present during various occasions does not

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<sup>18</sup> ECJ's judgment of January 15, 2009, case no. C-495/07 – "Silberquelle". See further M. Trzebiatowski, *Obowiązek używania znaku towarowego a nieodpłatne oferowanie upominków promocyjnych – glosa do wyroku ETS z 15.01.2009 r. w sprawie C-495/07 Silberquelle*, Mon.Pr. 14/2009 pgs. 791-796.

fulfill the requirement of use.<sup>19</sup> Thus, the administrative courts confirmed the PO's earlier decision, according to which the trade mark does not satisfy obligatory use when it is placed on, for example T-shirts, which are distributed free of charge for advertisement and promotional purposes, and they are practically used in the course of trade.<sup>20</sup>

The above position has been justified by the fact that an advertisement alone, especially if it involves the distribution of a given number of bags or ad-pads or the occasional use of other gadgets with the mark, is not sufficient to uphold this right. If the trade mark is not actually used, then it cannot block the revocation of the right to a trade mark. The goods whose introduction onto the market was in some way announced in the advertisement must be then available for sale. This is in accordance with Article 169 (5) in connection with Article 154 (3) of PWP, which states that the use of a trade mark in the good's advertisement that is not available on the domestic market or is not produced in the country concerned with export does not constitute genuine use.<sup>21</sup>

With regard to this opinion, there are other examples of actions given that do not deserve the recognition as a form of actual trade mark use. These are such actions as the use of the mark only for advertisement and promotional purposes, for example, in magazines, information print-outs, in competition and promotional activities and not for the purpose of identifying the goods of a given undertaking and therefore guaranteeing for the customer the origin of the given good.<sup>22</sup> The use of the mark in calendars, ads in white pages, on company labels, certificates or letters of recom-

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<sup>19</sup> NSA's judgment in the "Red Bull" (II) case, cited previously and the WSA's judgment of September 7, 2006, case no. VI SA/Wa 557/06 and 558/06 – "Red Bull" (II) and the PO's decision of November 30, 2005, case no. Sp. 199/04 – "Red Bull".

<sup>20</sup> PO's decision of March 11, 2004, case no. Sp. 052/02 – "York".

<sup>21</sup> NSA's judgment in the "Naomi" case, cited previously.

<sup>22</sup> WSA's judgment in the "Twoj Styl" case, cited previously, upheld by the NSA's judgment of March 12, 2009, case no. II GSK 762/08.

mentation is also considered such a type of action. Such action does not constitute using the trade mark in the course of trade but shows that the mark was used only to individualize and advertise only the undertaking of the proprietor.<sup>23</sup>

## **2.5. Trade Mark Use in Agreements and Other Similar Trade Contracts**

Poland's practice has resolved the issue of obligatory trade mark use with regard to the use of a trade mark in agreements, including agreements between the proprietor and his clients, and also in other trade contacts or activities of the proprietor. It has been stated that the use of a mark in, for example, assignment of rights agreements or lease agreements, or in legal extracts or correspondence with clients is not evidence for the use of the trade mark in the course of trade.<sup>24</sup> Also, in particular, the sole mention of the trade mark in a license agreement does not constitute the use of the mark either by the licensor nor the licensee. All the same, it does not terminate the five-year period for putting the trade mark into genuine use.<sup>25</sup>

## **2.6. Trade Mark Use in Trading Activity**

Poland's jurisdiction has explained how obligatory trade mark use should appear with regard to a trade mark registered for trading activity. It has assumed that the form of obligatory trade mark use has to be in accordance with the substantial nature of the

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<sup>23</sup> PO's decision of August 16, 2004, case no. Sp. 35/03 – "Rand".

<sup>24</sup> PO's decision in "Rand" case, as cited previously.

<sup>25</sup> WSA's judgment in the "Eucerin" case, as cited previously and the PO's decision of March 2, 2007, case no. Sp. 476/05 – "Cardinal".

trade mark. If, then, a given trade mark is intended for the sale of cosmetics and not its production or confection, then the requirement for use will not be fulfilled when the mark will be affixed on those cosmetics or the packaging but only when it is placed on promo bags in which the cosmetics are sold. In other circumstances the regulations of the Unfair Competition Act would be infringed upon.<sup>26</sup> The placement of the trade mark on the goods themselves could bring about the wrongful impression that the trade mark proprietor is the producer of those cosmetics.<sup>27</sup>

It has been pointed out that trading activity does not involve production of goods. Therefore, the marks cannot be placed on the goods. The use of a trade mark in this form of activity consists of the placement of the mark on the bags in which the products are sold (for example plastic bags), on store logos, personnel attire, advertising materials, business cards and invoices.<sup>28</sup>

## 2.7. Trade Mark Use in Services

Poland's jurisdiction has also separately treated the issue of obligatory trade mark use in trade marks registered for services. It has been assumed that such use consists of the actual rendering of services, for example, transport or tourism services. However, sponsoring trips which are an award or a motivation for better work with regard to the distribution of a said product does not constitute such a service. These types of activities are a derivative of the main activity which is the sale of goods and are a part of the system of sales. They do not, however, constitute an independent form of activity in a way of rendering tourism services. Therefore,

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<sup>26</sup> Unfair Competition Act of April 16, 1993 (consolidated text: Journal of Law of 2003, No. 153, pos. 1503 further amended), hereby as UZNK.

<sup>27</sup> WSA's judgment in the "Agnes" case, as cited previously.

<sup>28</sup> PO's decision of May 17, 2007, case no. Sp. 299/05 – "Maraton".

in this case the mark is functioning with regard to the sale of goods. This is also the case when the trade mark shows up with regard to a trip which is an award that does not satisfy use with regard to those winnings. The same entails for hotel reservations. Every undertaking has the right to such an activity, even those that do not conduct tourism services. If the proprietor of the trade mark does not have the proper certificates to organize tourist tours or events, this also testifies against the fulfillment of use with regard to tourism services.<sup>29</sup>

It has been underlined that the requirement for genuine rendering of services under a given trade mark should be treated very rigorously. This requirement is not met if the trade mark is registered for publishing services and the proprietor is providing services in the area of education, culture, entertainment and sport or if he is conducting publishing services but they consist of printing activity associated with printing a newspaper. In such situations, the mark is not identifying and not individualizing the service in the sense that it makes it different from other such services. At the same time it does not create in the consciousness of the customer the relation between the mark and the publishing service.<sup>30</sup> Therefore, publishing services include, for example, the publishing of a newspaper, book, brochure or other printing materials and rendering professional services with regard to publishing activity under the contract of third persons, that is external entities, for example, an author, office or educational institution, that are not able to publish them on their own. Another publishing house could also be such a third person. But the publishing house can not render for themselves publishing services.<sup>31</sup>

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<sup>29</sup> WSA's judgment in the "Rainbow" case, cited previously.

<sup>30</sup> WSA's judgment in the "Co jest grane", cited previously.

<sup>31</sup> NSA's judgment of February 14, 2007, case no. II GSK 209/06 – "Co jest grane".

This rule of very rigorous application of the requirement of genuine use with regard to services leads to further conclusions. In particular, for example, it has been pointed out that the requirement of genuine use is not met when Polish customers have access to information about hotel services under a given mark rendered by the proprietor of the trade mark by way of descriptions available on the Internet, tour guides or information brochures. In these cases, these services are not being actually rendered on the territory of Poland and therefore the requirement of genuine use is not satisfied.<sup>32</sup>

Notwithstanding this rule, it has been pointed out that only in a few instances can the service be supplied through a material medium, such as a bill, check or credit card in connection to banking services, or luggage tags in connection with transport services. A trade mark for services is usually used in advertising or business correspondence.<sup>33</sup> With regard to agency services or trade information, a typical method of using a trade mark is to use it on receipts and in particular in business letters.<sup>34</sup>

## 2.8. Trade Mark Use on the Internet

### 2.8.1. Community Practice

The OHIM has stated in its decisions that the mere presence of the mark on a website shows nothing more than that the website is accessible. Such use is not sufficient to determine genuine use of the trade mark.<sup>35</sup> Only when it has been proven that this site was visited by a given number of clients and that those visits lead to

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<sup>32</sup> PO's decision of June 18, 2004, case no. Sp. 41/03 – "Regent".

<sup>33</sup> WSA's judgement in the "Co jest grane" case, cited previously.

<sup>34</sup> PO's decision of February 3, 2004, case no. Sp. 0169/01, – "znak Sowy".

<sup>35</sup> OHIM's decision of October 31, 2001, case no. 2621/2001 – "Advance" and of January 30, 2001, case no. 209/2001 – "Crittles".



certain orders in a relevant time period, then in those circumstance genuine use is determined.<sup>36</sup>

### 2.8.2. Polish Practice

The PO has only made some general remarks with regard to this issue. It has stated that neither a method nor a medium through which the good is offered on the market can have an effect on the assessment of genuine use of a trade mark. Therefore, sale through the Internet is an equal channel of distribution, comparable with sale through a store or a salon. Thus, it is not of the same nature as the use of a trade mark solely through advertisement. It is irrelevant for this type of assessment that the client does not have physical contact with the good at the time of its purchase.<sup>37</sup>

The PO has said at the same time that trade mark use on the Internet as a rule serves informational and advertisement purposes and therefore is usually in the form of an offer.<sup>38</sup>

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<sup>36</sup> OHIM's decision of December 17, 1999, case no. 1513/1999 – "Terol".

<sup>37</sup> PO's decision in the "Aveda" case, cited previously.

<sup>38</sup> PO's decision of December 1, 2004, case no. Sp. 162/03 – "Apetito".



## **CHAPTER 3.**

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# **EXTENT OF TRADE MARK USE**

### **3.1. Criteria for the Evaluation of the Significant Extent of Trade Mark Use**

#### **3.1.1. Community Practice**

In this regard, community judicature indicates that the evaluation of genuine use has to in particular take into account the market situation with regard to the commercial position and at the same time the extent of use of the trade mark in a particular matter. This will result in the correct evaluation if genuine and at the same time serious use has taken place. The factors that are taken under consideration are first of all the type of goods or services for which the trade mark is registered and used. The requirement of genuine use has to be, therefore, also related to the nature of goods and services for which the trade mark is registered. The second factor is the characteristics of the particular industry or trade concerned. The third factor is the commercial value, the duration period and the frequency of all acts of use. It is not, however, required that the use has to occur on the entire market, nor even on a significant part of the protection territory. The territorial extent of trade mark use is just one of the many factors taken under consideration. Fourth of all, the manner in which the trade mark is used in a relevant industry

is taken under consideration. In a particular industry a certain manner can be considered correct or not for the enlargement or maintenance of the shares on the market with regard to relevant goods or services. It is significant to consider if the trade mark is used for all or just some of the identical products sold by the proprietor's undertaking. The fifth factor is the volume of business, its production capacity and the degree of diversification of the undertaking.<sup>1</sup>

However, it has been underlined that while assessing the extent of use, extraordinary circumstances such as the current or previous financial situation of the trade mark proprietor, as for example his financial difficulties, including bankruptcy, are of no significant meaning. These special circumstances can only be considered as justifications of non-use. But they cannot influence lowering the standards that have to be met with regard to obligatory trade mark use.<sup>2</sup> On the other hand, it has been stated that it is not that important for this assessment if the trade mark was used continuously during the five year period during which genuine use is evaluated. It is sufficient if the trade mark was used only during a part of that period, especially at the very beginning or end of it, provided that this use was genuine.<sup>3</sup> This opinion can then be later modified as a more precise analysis occurs (see further). The above mentioned value of the duration of the time of use

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<sup>1</sup> ECJ's judgments in the "Ansul" case and in the "Vitafruit" case, as cited previously, and ECJ's decision in the "La Mer" (I) case, as cited previously. Similarly, CFI's judgments in the "Vitafruit" case, "Hipoviton" case, "Solevita" case, "La Baronnie" case, "La Mer" (II) case, "Capio" case and "Deitech" case, all cited previously. See further M. Trzebiatowski, *Komentarz do postanowienia ...*, ditto, pgs. 293-296.

<sup>2</sup> CFI's judgment in the "Giorgio Aire" case, as cited previously.

<sup>3</sup> CFI's judgments in the "Deitech" case, cited previously, of October 4, 2006, case no. T-96/05 – "Valle della Luna" and of November 8, 2007, case no. T-169/06 – "Charlot" and BoA's decisions of July 19, 2000, case no. R 362/1999-1 – "Hervalia/Herbapura", of March 21, 2001, case no. R 821/1999-3 – "Rentolin/Renolin" and of April 3, 2001, case no. R 786/2000-1 – "Paraboot/Parawet".

(the cycle) and the frequency and regularity of use is without a doubt very significant.<sup>4</sup> It is very important to mention here that the evaluation of genuine use cannot lead to the evaluation of the commercial success of the trade mark or the commercial strategy of the proprietor. It cannot also depend on the commercial volume of the exploitation of the mark.<sup>5</sup>

A starting point in determining genuine use is to establish if the use of a given trade mark was not minimal. Hence, such use is considered when in a period of five years, different types of wine are sold for the price of 24,000 Euro.<sup>6</sup> Also, in the case of juices and concentrates, their production and sale of 3.5 thousand for the amount of roughly 5000 Euro, and only during a period of one year out of the five year period is considered sufficient use.<sup>7</sup> It is also sufficient to sell 2000 furry toy animals in the high-priced market sector.<sup>8</sup>

However, to determine genuine use, it is insufficient to sell 450 packages of pet food<sup>9</sup> or 100 electrical toothbrushes in one year.<sup>10</sup> It is also insufficient to sell 180 pairs of shoes based on one invoice<sup>11</sup> or 40 packages of sherry upon the submission of one bill of

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<sup>4</sup> CFI's judgments in the "Vitafruit" case, "Hipoviton" case, "La Mer" (II) case, "Sonia Rykiel" case, "Charlot" case, "Capiro" case, "Deitech" case, all cited previously and of December 14, 2006, case no. T-392/04 – "Manu" and of December 10, 2008, case no. T-101/07 – "Dada".

<sup>5</sup> CFI's judgments in the "Vitafruit" case, "Hipoviton" case, "Solevita" case, "La Mer" (II) case, "Sonia Rykiel" case, "Capiro" case, "Dada" case and "Deitech" case, all cited previously.

<sup>6</sup> BoA's decision of September 15, 2005, case no. R 850/2004-1 – "Alamos/lamo".

<sup>7</sup> ECJ's and CFI's judgments in the "Vitafruit" cases, both cited previously.

<sup>8</sup> OHIM's decision of January 26, 2001, case no. 129/2001 – "Treff".

<sup>9</sup> BoA's decision of September 26, 2001, case no. R 578/2000-4 – "Hipoviton/Hippovit".

<sup>10</sup> BoA's decision in the "Nevadent/Novodent" case, as cited previously.

<sup>11</sup> OHIM's decision of June 21, 1999, case no. 391/1999 – "Oregon".

loading.<sup>12</sup> Also, the sale of 122 items of clothing based on two invoices is insufficient to prove genuine use.<sup>13</sup>

Services are treated with special attention when it comes to the assessment of the extent of use. As an example, for services in the area of car and motorcycle shows, the organization during the two (out of five) years of car shows with the participation of three large auto producers, and half a million visitors was considered sufficient to prove genuine use.<sup>14</sup>

### 3.1.2. Polish Practice

In this regard, Poland's judicature is following, at least in principle, the community practice. This is especially evident in those judgments that refer to the ECJ judgment especially in "La Mer" (I) and "Vitafruit".<sup>15</sup> This does not, however, mean that while looking at this issue on a case-by-case basis there are some discrepancies between the domestic and community practices.

This discrepancy can be evident by the opinion of the Patent Office with regard to the time duration in which a trade mark should be exploited so that genuine (serious) use can be determined. According to regulations, it can be assumed that the proprietor is not obliged to use the trade mark continuously in the five-year period, prior to the start of the revocation procedures.

If genuine use of a trade mark is to begin right before the date of the filing of the motion for revocation of the trade mark rights then those rights can not be revoked. A different stance in this situation is possible only when the circumstances mentioned in Article 170 (2) PWP occur. This occurs when the proprietor of

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<sup>12</sup> BoA's decision of April 30, 2001, case no. R 378/2000-1 – "Renacimiento/Rinascimento".

<sup>13</sup> OHIM's decision of January 30, 2001, case no. 208/2001 – "Lynx".

<sup>14</sup> BoA's decision of December 2, 2002, case no. R 970/2000-2 – "Motor Show".

<sup>15</sup> For example, PO's decision in "Aveda" case, cited previously.

the trade mark has found out three months before the filing of this motion that such a motion could be filed.<sup>16</sup>

The Polish administrative courts believe that to determine the genuine use of a trade mark, an objective assessment of the actual size of sale of goods with the trade mark has to be made. This assessment is to be conducted based on sale invoices. However, the size of sale is to be confronted with other criteria for evaluating the extent of use. These criteria include, among others, volume of the business, nature of products, or sale volume of the same or similar products under different brands by the same proprietor.<sup>17</sup>

The Patent Office has stated in its practice that the evaluation of genuine use needs to consider the objective and subjective factors. The extent of use needs to be evaluated taking into account the situation of the proprietor. This premise indicates the volume of the trade mark but in a commercial context. Therefore, it should be evaluated particularly with regard to the value, that is the high price of the products within the trade mark. Hence, if a given product is a luxury item, then even if it is of common nature, i.e., shoes, then genuine use is sufficient, even if only singular sales of the given shoes are proven. This is even more so if these shoes are available only in two stores in one town. This circumstance is also a factor in evaluating extent of use.<sup>18</sup>

Taking into account the above position, it has been recognized that quantity and volume factors should determine if the use was genuine and serious. This is mostly with regard to the quantity of clients or the size of the area where the product with the trade mark is available. These factors need to be evaluated even further taking into consideration yet more specific aspects. These aspects are primarily the characteristics of the goods or services, such as

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<sup>16</sup> PO's decision of March 31, 2004, case no. Sp. 021/02 – "Bioton".

<sup>17</sup> WSA's judgment of June 26, 2008, case no. VI SA/Wa 283/08 – "Perrier".

<sup>18</sup> PO's decision in the "Lord" case, cited previously.

their price or nature. Also, the evaluation should take into account the type of clients that are going to buy these products. One should also bear in mind the characteristics of the trade or industry concerned and of the volume and frequency of trade mark use, including channels of distributions of the goods or services within the trade mark. If the goods are expensive luxury items and require a more demanding and rich clientele, then to declare genuine use it is not necessary to bring those goods for mass consumption and through many channels of distribution onto the market. In such circumstances even sale through the Internet would be sufficient.<sup>19</sup> The case is similar with regard to alcohol with specific qualities or taste. In such a situation, demand would be limited in an already saturated market. The proprietor of the trade mark for alcohol of a certain type does not have to have a large production, especially production "for storage" – meaning more than the market can take. Such actions would be economically irrational.<sup>20</sup>

It can be deduced from the Patent Office's decisions that too high expectations as to the volume of sales are also not required from everyday-use products. For example, the sale of a few thousand kilograms of washing-powder is not considered minimal.<sup>21</sup> On the other hand, the sale of 1,184 blouses in the period of two years is not sufficient to constitute genuine use. The evaluated product was directed for mass sale. It is by its nature commonly available on the market and is usually offered in thousand of hundreds of pieces annually. This means that, with regard to the above situation, the blouses were sold in minimal quantity.<sup>22</sup>

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<sup>19</sup> PO's decision in the "Aveda" case, cited previously.

<sup>20</sup> PO's decision of February 27, 2002, case no. Sp. 010/01 – "Poznańska Gorzka" and WSA's judgment of April 15, 2004, case no. 6 II SA 1885/02 – "Poznańska Gorzka".

<sup>21</sup> KO's decision in the "Aro" case, cited previously.

<sup>22</sup> PO's decision in the "Broadway" (I) case, cited previously.



## 3.2. The Relevance of the Volume of Sales or Turnover

### 3.2.1. Community Practice

The above analysis has shown that the basic effect that the volume of sales has on the assessment of extent of use does not mean that each time the volume has to be significant. The given assessment has to take into consideration all of the relevant factors described above. It should also be overall and consider the interdependence that exists between these factors, and specifically between these factors and the volume of sales. Hence, a small volume of sales might be offset by the fact that the mark was used regularly, extensively and long-term. The consideration of the volume of turnover can not become absolute. Therefore, while assessing genuine use through the volume of sales, one has to also evaluate such factors as production capacity and area of sale. This entails that even if the volume of turnover is not significant, the use itself might be sufficient to determine genuine use. It is adequate that such inconsiderable use in a considered industry will allow for the preservation or creation of an outlet for those goods and services with that trade mark. If that can not be proven, then the insignificant volume of turnover should be considered as actions aiming for the sole maintenance of trade mark registration and defense against revocation.<sup>23</sup>

As there are no absolute rules as to the volume of turnover when considering this factor, one has to also bear in mind the relation between the sale of the good with the mark and the proprietor's volume of sales of all his goods in a relevant time-frame. Only when this ratio shows a symbolic sales volume, espe-

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<sup>23</sup> ECJ's judgment in the "Ansul" and "Vitafruit" cases and the ECJ's decision in the "La Mer" (I) case, all cited previously. Similarly, CFI's judgments in the "Vitafruit" case, "Hipoviton" case, "Solevita" case, "La Mer" (II) case, "Sonia Rykiel" case, "Capio" case, "Charlot" case and "Dada" case, all cited previously.

cially when it is a percentage fraction, then can it be assumed that the extent of use was not sufficient to constitute genuine use. However, this volume accounted in such a way can not be the decisive criteria. It has to relate to the size of the proprietor's undertaking and its production capacity. It should also be evaluated from the perspective of not only the good itself but also of its price. The volume of sale has a lesser meaning with regard to the proprietor's volume of turnover if the given good in comparison to other of the proprietor's goods is much cheaper. Therefore, the rule which states that minimal volume of sales and turnover for inexpensive goods is not sufficient to constitute the genuine rule should only be treated as a starting rule. The mentioned quantity and volume, while assessing the extent of use, have to be each time considered separately baring in mind all the other relevant factors.<sup>24</sup>

This is well evident in the "Sonia Rykiel" case. With regard to this trade mark it was established that it was used in a stable manner only for 13 months. At the same time, the time of the actual use practically involved three consecutive months each year and two more months in another year, whose period themselves were separated almost by a year. The trade mark was affixed in total on 85 pairs of female underwear and slips for the total amount of around 430 Euro. The proprietor's explanations that the good was of a very high quality and very innovative design (style) were irrelevant. Those types of products, taking everything into account, are not luxury products, expensive and sold in limited numbers on selective markets. On the contrary, they are items for everyday use, which on the considered domestic market were in high demand. Besides, their offering price was very reasonable. It also needs to be considered that the proprietor offered a very large number of goods of the same type, but among them those

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<sup>24</sup> CFI's judgments in the "Hipoviton" and "La Baronnie" cases, all cited previously.

with the trade mark in question were sold only in the given numbers. It is also important to mention that the given number of sales was due to nine transactions for which invoices were provided. The fact that the community courts accept minimal volume of sales to determine genuine use can not be a justification in this case, although those cases also show a low number of invoices. However, these invoices indicated the time of use for several dozen months and not like in the "Sonia Rykiel" case a period of two or three months. Therefore, these examples are not adequate in the "Sonia Rykiel" case.<sup>25</sup>

In examining the nature of a good as a factor in this type of assessment, ecological bread is a good example. This is a type of product which is more expansive and usually sold locally. In case of such products, a lower volume of sales might be expected. From the point of view of obligatory use, it is satisfactory when the volume of sales amount to 60-70 kilos annually.<sup>26</sup> The sale of one laser machine for precise cutting in the amount of 550 thousand francs is also sufficient to satisfy obligatory use. The nature of this product, its marker and its high price has to be taken into consideration in this case.<sup>27</sup> The case is analogical with the sale of fiber oxygenerators with a detachable hard-shell reservoir. Keeping in mind that the above apparatus is highly specialized, the sale of about 120 of them in the period of three years for the amount of around 20,000 Euro is clearly sufficient to declare that the trade mark affixed on those goods was put to genuine use.<sup>28</sup> Also, computer services are treated specifically, especially services related to computer programming and software. This sector of the market is considered to be one of constant growth and development with a high degree of competitiveness and big difficulties in

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<sup>25</sup> CFI's judgment in the "Sonia Rykiel" case, cited previously.

<sup>26</sup> BoA's decision of September 7, 2005, case no. R 662/2004-4 – "Bio Sonne/Öko-Sonne".

<sup>27</sup> OHIM's decision of June 18, 2001, case no. 1390/2001 – "Focus".

<sup>28</sup> CFI's judgment in the "Capio" case, cited previously.

maintaining and establishing a significant position. In such a specific market, undertakings which are small or medium can only provide services on a limited territory and in very specialized areas. This is especially the case when those services include creating computer software for specialized undertakings, which encompasses a long period of time focused on one service. The conclusion is such that this type of market can not be treated as a primary market where the services rendered are common but as a market that is highly diversified. This means that the requirements as to the time-spent and the number of transactions with regard to those services should be lowered accordingly.<sup>29</sup> Furthermore, taking the above into consideration, it has been stated that, for example, ten invoices for cosmetics, including soap and bath accessories, for the period of 33 months in connection to different types of products from the evaluated group of products encompassing serial numbers, that are far away from each other (i.e. 22 214, 24 085, 24 135 and 31 348) and in addition amounting each to over 200 Euro is sufficient to show that use of the trade mark for those goods was genuine.<sup>30</sup>

It is noticed that tolerable compliance with the quoted opinion with regard to the assessment of genuine use and the exploitation of the trade mark in the five year time period is applied here. In some of the judgments, it is said that the exploitation of the trade mark is not necessary during the entire five year period. Hence, if a trade mark was used in two consecutive time periods, i.e. for two and a half years and then for a year and a half, then the one year break that occurred in the trade mark use cannot lead to the revocation of a trade mark due to non-use.<sup>31</sup> In other judgments, it has been said that the volume of sales for the entire five year period in which the trade mark is to be exploited should be ac-

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<sup>29</sup> CFI's judgment in the "Dada" case, cited previously.

<sup>30</sup> CFI's judgment in the "La Mer" (II) case, cited previously.

<sup>31</sup> CFI's judgment in the "Valle della Luna" case, cited previously.

counted for. At the same time, these volumes should be relatively significant for each year of that period. For example, a trade mark for air fresheners was used for four of the five years but its annual sale first amounted to about 24 pieces but then it jumped up to 2500 pieces and then went down to a mere 300 pieces. This was not considered to constitute genuine use.<sup>32</sup>

Hence, IT has stated that a *de minimis* rule cannot be laid down to establish at what point the volume of turnover guarantees genuine use of the trade mark. Use of the mark by a single client which imports the products to an EU country can be considered genuine use. This is only the case when these transactions have a commercial justification for the proprietor. This means that it is irrelevant that the use has always been made with the same customer.<sup>33</sup>

It is also worth mentioning that it is possible to determine genuine use of a trade mark without practically any evidence that would indicate the volume of sales or turnover of goods with the given trade mark. Genuine use can be established based on all the other evidence in a specific case. As an example, in the case of a Portuguese trade mark for clothing, evidence included numerous and various documentation such as: sale receipts of jackets, clothes tags, pictures of shop-windows with trade marks pasted on them, press information about the store, including change of the store's address, customer's publicized opinions about the bridal wear offered by the store, a web page of the proprietor with a Portuguese domain and printouts of orders maybe through the web site, clothing magazines and catalogues with seasonal collections and price catalogues for neck ties, coat, evening-gowns and other costumes with the trade mark, confirmations and pictures about attendance in fair trades where the trade mark was used,

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<sup>32</sup> CFI's judgment in the "Giorgio Aire" case, cited previously.

<sup>33</sup> ECJ's decision in the "La Mer" (I) case, and ECJ's judgment in the "Vitafruit" case, both cited previously.

certificates and photographs from fashion shows and fairs in Lisbon where their goods with the trade mark were offered including such goods, besides clothing, as stands or mannequins exposing the trade mark. All this evidence allowed determining that the trade mark was used in order to assure the adequate position of the goods on the market and not only to maintain the trade mark registration.<sup>34</sup>

### 3.2.2. Polish Practice

Bering in mind all the above factors with regard to use and volume of sales, it has also been acknowledged in the domestic judicature that the volume of sales, for example of candy, is not always that important. It is sufficient that the invoices show that the sale of the products with the trade mark was constant and stable. Such evidence allows determining that the trade mark was put to use genuinely, according to its function, which allows it to affix the trade mark on the good and bring it into the market.<sup>35</sup>

However, it has been recognized that a relevant volume of sales is the basis for evaluation if the trade mark use was genuine. This volume enables evaluating its weight in the proprietor's business activity. Only such an evaluation allows determining if the use of a trade mark had a genuine impact on the commercial situation of the proprietor with regard to his goods with the said trade mark. If then from the evidence it can be deduced that the sale of cosmetics with the mark was conducted in the period of two years and amounted to the total of 15,000 PLN, meaning about 7,500 PLN annually, then if the price of one piece costs 3 PLN, then this comes out to 2,500 pieces sold annually or 7 pieces daily. Such a sales volume indicates a miniscule production of the cosmetics

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<sup>34</sup> CFI's judgment in the "Charlot" case, cited previously.

<sup>35</sup> PO's decision in the "Cardinal" case and WSA's judgment in the "Cardinal" case, both cited previously.

with the mark, which is not sufficient to conclude genuine and serious use of a trade mark.<sup>36</sup> Even more so, the sale of about 30 pieces of cosmetics in one year, and then only distribution in the following year more than a dozen sample products (testers) can not attest for genuine use of the trade mark in the course of trade. Such evidence only shows that those goods with the trade mark were only a sample or promotional products, having been put on the market only to test it.<sup>37</sup>

It has been pointed out that the evaluation of genuine use requires the establishment of the range of this activity from a commercial point of view, keeping in mind, among others, the undertaking's position in the concerned industry, the characteristics of that industry, the time of use, type and nature of the good, the price of goods and channels of its distribution. The quantity of sold packages with the sign and the continuity of such sale testifies to this type of use.

Particularly in the case of medical goods, when there are invoices that show that in the first year 150 pieces were sold, in 2002 about 1,000 pieces, in 2003 – 500 pieces and in 2004 over 1,000 pieces, then these invoices show that this use was not illusive. They also show that the goods with the mark were not intended for customers in the form a free sample or one time sale. It is also worth mentioning that these goods were not only sold to the company headquartered in Poland.<sup>38</sup>

Similar deductions were made based on four invoices. They showed that in a short period of time, over 16,548 pieces of trousers and blouses were put on the market. This shows genuine use even more so, since after the time that the motion for proof of use was filed, those goods were being sold in similar numbers.<sup>39</sup>

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<sup>36</sup> PO's decision of January 27, 2005, case no. Sp. 09/02 – "Lady".

<sup>37</sup> PO's decision of December 12, 2003, case no. Sp. 0176/01 – "Joy of Amber".

<sup>38</sup> PO's decision of January 30, 2006, case no. Sp. 112/05 – "Botox".

<sup>39</sup> PO's decision of February 3, 2004, case no. Sp. 190/01 and Sp. 191/01 – "Cross".





## CHAPTER 4.

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# GOODS OR SERVICES AND OBLIGATORY TRADE MARK USE

### 4.1. Community Practice

Much attention has been paid by the community courts and organs with regard to goods or services for which the requirement of use has to be satisfied. This problem mainly evolves around the issue of the use of a trade mark in relation to part of the goods and services for which the trade mark has been registered. This issue is related in Article 13 of the Directive, which states that this concept of genuine use in relation to some of the goods aims to eliminate the monopolization of the trade mark for those categories of goods or services for which the mark is not used. However, this concept cannot cause the proprietor to lose his protection with respect to goods (services) that are not identical with the goods (services) for which the trade mark has been genuinely put to use but which do not specifically differ from those goods (services). The loss of this right would be without merit in those circumstances, even more so if the goods (services) covered by trade mark registration and the goods (services) covered by trade mark use belonged to the one and the same category, especially if within that category it would be impossible to normally include those comparable goods (services) into two separate and independent sub-categories. "Part of the goods or services" which is at stake here can not be understood as any commercial form of the given type of product or service. It

should be understood as goods (services) that are sufficiently different from one another and that can constitute mutually coherent categories and sub-categories. It is necessary to mention that in determining these differences, the concept of similarity of goods and services is not a valid consideration.<sup>1</sup> Hence, it has been stated that it is even more difficult to reference the use of a trade mark for even more different goods or services from the relevant class, similar to those for which the trade mark was genuinely used.<sup>2</sup>

In solving this problem, the following rules are meant to be of help. It has been assumed that the category of goods or services that has been covered by the trade mark registration has to be from the perspective of the requirement of use evaluated with reference to the goods and services for which the trade mark is genuinely used. Nevertheless, it should be also taken into consideration how general were the headings used to describe this category of goods or services. Hence, two occurrences should be mentioned. In the first circumstance the category of goods (services) from the classification is formulated very generally and it allows for the distinction of several sub-categories of goods (services), which can be treated separately. Hence, the use of the trade mark for goods (services) from of the independent sub-categories will be considered as having been used only for those goods (service). However, in the second circumstance, when the category has been clearly defined in the classification, there is no possibility to distinguish separate sub-groups within it. This time, if the trade mark was used for part of the goods (services) from that category, then the mark will be considered used for all of the goods (services) from that category.<sup>3</sup>

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<sup>1</sup> CFI's judgment of July 14, 2005, case no. T-126/03 – "Aladin" and of February 13, 2007, case no. T-256/04 – "Respicur".

<sup>2</sup> OHIM's decision of November 17, 1999, case no. 1153/1999 – "Vitalift".

<sup>3</sup> CFI's judgment in the "Aladin" case, cited previously.

Bearing in mind those guidelines, it has been accepted, for example, that the use of a mark for ready-to-eat pizzas and pasta meals does not constitute use for preparations made of cereals. Even though these goods can be considered to be similar, there is still no fulfillment of obligatory use.<sup>4</sup> A similar example is the relation between, on one the hand, dessert toppings that are strawberry, caramel and chocolate flavored and on the other hand, preserved, dried and cooked fruits and vegetables; concentrated citrus fruit and fruit extracts, preserves; sugars, biscuits, cakes, pasty and confectionary.<sup>5</sup> Similarly, the use of the mark for auto-body wax can not be established through the use of mark for industrial, hydraulic and auto oils and anti-corrosion greases and liquids.<sup>6</sup>

As goods that cannot fulfill each other's requirements of use, we can enumerate cleaning products and detergents against cosmetics, and associated with them pharmaceutical products. A general rule has to be kept in mind that while assessing the types of goods for which the trade mark is used, one has to remember that some of the products have many functions and are not to be included in several of the classification categories.

The nature of the good should decide about its type and character. This is with relation to, for example, cosmetics and with regard to soap or bath accessories. They are not always cleansing products. They can function as cosmetics if their goal is to beautify the skin or when they contain perfume. The same rule applies to products that are usually considered to be pharmaceuticals. The mere fact that the product is to be used orally does not mean that it should be always considered a pharmaceutical. Products contained in vials or phials that are to be swallowed can not be classified as

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<sup>4</sup> OHIM's decision of 2001, case no. 1196/2001 – "Pizza del Arte" (this decision has been mentioned in OHIM's guidelines, however, it was impossible to find in the OHIM case law data base).

<sup>5</sup> BoA's decision of May 3, 2004, case no. R 68/2003-2 – "Sweetie/Sweety".

<sup>6</sup> BoA's decision in the "Rentolin/Renolin" case, cited previously.

nutritional supplements, included in class 5, that aim at weight loss, appetite control and skin care. In both of the mentioned cases, the use of the trade mark for such products constitutes the use of this trade mark for cosmetics.<sup>7</sup>

In reference to the category of pharmaceutical products, much attention has been paid to the necessity in establishing the correct headings for the given products from this category. Hence, for example, for medicines that contain calcium, if evidence proves the use of the trade mark for that specific type of product then the right from registration may be maintained only in respect to those specific goods.<sup>8</sup> Analogically, the use of the trade mark for diapers does not protect against the loss of registration right for pharmaceutical, veterinary products and disinfectants. This is so, even though all of those products could be sold in pharmacies.<sup>9</sup> It can be derived from the above examples that the evaluation of goods for which the mark was used involves a large dose of accuracy and insight. This refers especially to goods of special use, like medicines. The proof of use for pharmaceuticals should then very precisely designate the type of pharmaceutical with the trade mark and not only refer to the medicine itself.<sup>10</sup>

This rule can also be used with regard to services, including pharmaceutical services. The use of the mark for organizing conferences in the field of pharmaceuticals is treated as the use with respect to only informational services and trade-fair services in this area. Such use will not constitute use for the publication of books, brochures and organization of training courses in a conventional and multimedia manner.<sup>11</sup> All the same, the use of the trade mark

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<sup>7</sup> CFI's judgment in the "La Mer" (II) case, cited previously.

<sup>8</sup> CFI's judgment of October 17, 2006, case no. T-483/04 – "Galzin".

<sup>9</sup> OHIM's decision of May 26, 2000, case no. 1088/2000 – "Demar".

<sup>10</sup> BoA's decision of March 8, 2005, case no. R 124/2003-4 – "Vertex/Vertel".

<sup>11</sup> BoA's decision of September 19, 2001, case no. R 307/2000-3 – "Cifarma/Difarma".

for entertainment services does not constitute use for educational services.<sup>12</sup>

The genuine use of a trade mark for goods that are no longer available on the market is a very particular issue. Such use has been accepted. In such an instance, genuine use may be satisfied by the use of the good's integral parts or after-sales services (such as necessary equipment, accessories, related parts, or the supply of maintenance and repair services). However, if this use is to fulfill the requirement of use of the entire good, it has to be of a considerable volume. Even more, it has been stated that the mark might have been put to genuine use with respect to new products covered by registration if the mark was affixed on old products that were previously available on the market as individual products and now make-up the integral parts of the new product or are integrally connected with its use (i.e. maintenance or repair). Such use can also occur when the mark was affixed on products directly connected with those older products which were designated for after-sales services.<sup>13</sup>

## 4.2. Domestic Practice

The position of Poland's courts and organs in reference to this issue is also firm. It has been pointed out that for the purpose of the evaluation of the fulfillment of obligatory trade mark use, it is necessary to concentrate on the evaluation of the use of the mark with respect to the goods covered by registration and not any other goods. If, for example, the trade mark was registered for shoes, then evidence with regard to shoe accessories should not be evaluated. If that were the case, then the proceedings would involve the evaluation of goods that were not registered.<sup>14</sup>

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<sup>12</sup> OHIM's decision of November 25, 2002, case no. 3412/2002 – "Kay".

<sup>13</sup> ECJ's judgment in the "Ansul" case, cited previously.

<sup>14</sup> WSA's judgment of July 28, 2004, case no. II SA 1715/03 – "Lord".

This strict evaluation of the fulfillment of obligatory trade mark use with respect to goods or services is justified by the fact that the provided proof of use of a mark for only part of the registered goods or services results in partial revocation of the trade mark's protection rights. This is especially the case when the trade mark is registered for goods in class 25: clothing, underclothes, head gear, shoes including sport shoes and socks and for goods in class 28: sporting accessories, including golf gloves, fencing, boxing and baseball gloves and the trade mark is used for gloves. This partial use of the trade mark by a sporting manufacturer cannot constitute the use of the trade mark for the above mentioned goods in class 25. First of all, all sporting gloves have been classified in class 28 as sporting accessories. This means that those goods are different from the gloves (mittens) that could be included in class 25 for this trade mark. Second, in this list of goods, gloves were not included in class 25, which decisively proves that the trade mark was not intended to be used for gloves (mittens) but for gloves as sporting accessories.<sup>15</sup>

Hence it has been argued that obligatory trade mark use has to refer to all the goods for which the trade mark was registered and which are grounds for revocation due to non-use. When the evidence, in a specific case, where the trade mark was registered for goods in class 16, 25, 35 and 42 shows that the trade mark was put to genuine use with respect to goods or services from class 16, 35 and 42, that is for publishing services, organization of competitions and the advertising and promotion of fashion, excluding goods from class 25, then this evidence does not prove genuine use of this mark for goods in class 25, i.e. clothing and shoes.<sup>16</sup> Publishing a magazine on fashion cannot constitute the use of a trade mark in respect to such goods as clothing, shoes or clothes made of leather.

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<sup>15</sup> PO's decision in the "York" case, cited previously.

<sup>16</sup> WSA's judgment in the "Twój Styl" case, cited previously.

In order to prove the use of the mark for these goods, one has to show that the mark was affixed onto those goods.<sup>17</sup>

This opinion is a consequence of the nature of the publishing services. It has been explained that a publishing service consists of editing the text that was submitted for publishing and rendering commissioned actions such as composition, corrections, graphic design, layout, preparation of the index, acquisition of an ISBN number. Hence, this service does not include data acquisition, preparation of announcements, ads and other texts (also apart from the author's), processing, adaptation, evaluation and approval of materials for print, and such which lead to the creation of a project, for example a newspaper supplement. Those services undertaken by the editor's board and its coworkers are part of the job performance (creative) in the interest of the publishing house, and they consist of the typical editorial actions that are an element of the publishing process and the creation of newspapers or books. In the case of a newspaper editor, these types of actions include, for example, evaluation of the reader's market, creation of the concept of the newspaper by determining its size, type of text and possible periodical supplements, definition of the layout, manner of illustration and graphic design and the like. They also include registration of the title, employment of journalists and graphic designers, print with in-house machines or on order by another printing press and distribution of the newspaper. A newspaper prepared in such a manner is a good that is included in class 16. This also refers to the newspaper supplements, which if prepared in the manner described above is a typical element of the publishing of a newspaper. All of the above mentioned activities are undertaken by that particular publishing house and in their own name. They constitute, therefore, the creation of that good, that is a publishing activity, and not a publishing service. All of this activity, and not service, includes the publishing of any print-

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<sup>17</sup> PO's decision of September 18, 2008, case no. Sp. 332/07 – "Vogue".

ing materials that were not commissioned outside. The reader is the commissioner or the customer of those materials. He is the buyer of those goods. Therefore, the creation of the good includes, among others, the publishing of a newspaper supplement when the publishing house on its own publishes such a supplement with its own newspaper. This does not, however, happen when the supplement itself has been inserted into the newspaper in the name of an outside institution. It is all the same when a book is published by order of the author, but the author himself was commissioned to write a certain piece by that publishing house and was reimbursed for it.<sup>18</sup>

This position has been supported by other findings. Hence, an informational brochure can not be considered as proof of genuine use of a trade mark for goods in class 16 such as newspapers or magazines. First of all, it was a pilot issue, hence the trade mark was not put to genuine use. Second, newspapers can be defined as a periodical publication of an informative character and magazines could be defined as a continuous publication, that is published regularly in constant time intervals (for example, daily, weekly, bi-weekly, monthly or quarterly). Therefore, the mentioned evidence cannot be considered either as a newspaper or a magazine. Third, the presented brochure does not include any characteristic markings for periodicals, such as the frequency of the issues, the number of the issue and especially the date of the issue. Also, other press-clippings cannot be considered as evidence in this case and therefore were not taken under consideration. They are not evidence for the use of a mark as an identification of goods for which the mark was registered but only testify that a mark was used for various types of publications by completely other undertakings.<sup>19</sup>

The qualification of the above actions also leads to the conclusion that by submitting as proof an issue of a magazine and maps,

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<sup>18</sup> NSA's judgment in the "Co jest grane" case, cited previously.

<sup>19</sup> PO's decision in the "Tele Top" case, as cited previously.



business cards of the editors' board, invoices for the printing of the newspaper, company letterheads and business cards all affixed with that trade mark, that these indicates the use of the mark for goods in class 16, which include paper goods, encompassing paper, carton, stationery and office materials.<sup>20</sup>

A strict approach to this issue is evident in more examples. In particular, if a trade mark is registered for goods in class 17 and 20 (materials for packaging of synthetic substances, packaging made out of synthetic, synthetic in pressed form, foil made from synthetics, semi-processed synthetic materials, decoration made of synthetics, furniture made of synthetics) and it is used only for pots and flower-boxes made of synthetics and colorants (semi-processed synthetics in a form of granulate which make up synthetic substances and colorants) then the right of registration of that mark is maintained in respect to materials made of synthetics, packaging made of synthetics and semi-processed synthetics.<sup>21</sup>

All the same, the use of a trade mark for fruit wine is not equivalent to the use of a mark for alcoholic beverages. Wine is included in the medium percentage alcohol and as a heading for goods is in class 33 among alcoholic beverages, which is clearly differentiated from other alcohols, meaning high percentage alcohols. If then the trade mark was registered only for alcoholic beverages, excluding wine, that means that wine is not a part of alcoholic beverages for which the mark is registered.<sup>22</sup>

Similarly, the introduction of tissues, cosmetics pads and wet-wipes with a cosmetic product (cream or lotion as a hydrating substance) into the market, instead of the cosmetic itself which is also included in class 3, cannot constitute use of this cosmetic product. This situation involves a revocation procedure based on cosmetic

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<sup>20</sup> PO's decision of February 14, 2003, case no. Sp. 072/01 – "Focus".

<sup>21</sup> PO's decision of June 23, 2005, case no. Sp. 282/03 – "Interplast".

<sup>22</sup> Two WSA judgments in the "Lech-Pol" and "Mariusz Lech" cases, both cited previously.

products, excluding wet-tissues, cosmetics pads, wipes and cotton buds for cosmetic purposes and cotton balls for cosmetic purposes, with the trade mark being registered for goods in class 3, generally named as cosmetic products and cleaning sanitary products. In such a situation it is necessary to establish if the materials submitted in the case can be considered proof for the use of goods on which the revocation was based, that is cosmetic products that are not wet-tissues, cosmetics pads, wipes and cotton buds for cosmetic purposes and cotton balls for cosmetic purposes. The evidence submitted includes the following types of goods: cotton buds, cosmetic pads, pads, wet-tissues with oil, refreshing wipes, wet-wipes, make-up removal wipes, personal care wipes and cleansing wipes. Hence, it has to be stated explicitly that the submitted evidence does not show the use of the given trade mark for products or other cosmetics goods that are not part of the revocation. On the contrary, they provide evidence for the use of the contested trade mark for goods that are not the justification for the revocation. The argument that introduction onto the market of wipes that include the relevant cosmetics such as creams or hydrating lotions should be considered as the introduction onto the market of those cosmetic lotions, meaning that cosmetic products are without merit. According to the binding version of the Nice classification (8<sup>th</sup> edition), class 3 goods have been classified separately as wet-wipes. Creams and goods or cosmetics products in the form of liquids, such as after-shave lotions, cosmetic milks and tonics have been classified as a separate heading. Hence, this classification has divided these goods based on their type and not based on their effect (such as skin hydration). The PWP regulations have not defined the concept indirect use or use by other mediums. Hence, it should be embraced that genuine use of a mark has to refer to the specific goods that the mark was registered for.<sup>23</sup>

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<sup>23</sup> PO's decision of November 28, 2005, case no. Sp. 16/04 – "Cleanic" and WSA's judgment of October 16, 2006, case no. VI SA/Wa 770/06 – "Cleanic".

It is worth mentioning here the opinion of the judicature in connection with the role of the classification of goods and services. It has been explained that the classification is not conclusive as to the affiliation of specific goods to a given category. The classification is only a tool that is to help the Patent Office in creating lists of goods for applied trade marks. The classification arranges goods and services according to their nature. To establish that the goods of contested trade marks are similar is not sufficient for them to be classified in the same class of goods and services. This classification was only created for the purpose of trade mark registration, to introduce a common system of ranking for those goods (services). Goods (services) that are included in one class can be goods of a different type and vice versa – goods from different classes can be considered similar. Hence, the classification is not a strict standard to find goods similar, and thus can be only an aiding tool in this endeavor. The classification is also of no special importance in the trade mark revocation proceedings with regard to the revocation of the part in respect to part of the goods. The manner in which the proprietor of the trade mark has filled in the application the list of goods which the trade mark will cover and which was then accepted in the registration decision is of technical and not substantive importance. Therefore, during the trade mark revocation procedures, due to non-use with respect to part of the goods, the Office has the obligation to evaluate the actual affiliation of the contested goods to a given category, and the manner in which the list of goods was created is indifferent.<sup>24</sup>

It should be mentioned that the list of goods (services) arranged into the given classes are usually large compilations from which the registration rights for trade marks are derived. If so, then the protection rights for trade marks used for the identification of goods in a given class should be particularized according to Article 171 of the PWP. According to this article, if the revocation

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<sup>24</sup> NSA's judgment of February 3, 2009, case no. II GSK 698/08 – "Amber".

of a trade mark is directed only towards some of the goods, then the revocation shall cover only those goods.<sup>25</sup>

Also, in case of uncertainty as to the nature of the goods for which the mark is used, it is allowed to clear up those doubts with presumption of doubt. This is especially the case with regard to medicinal preparations. That a medical preparation with a trade mark will be used as medicine and not as a cosmetic is evident by the fact that it has been put on the official list of pharmaceuticals that are allowed to be put on the market in Poland and that this good has been included in the "Handbook of Medicine". The included there description of this product unambiguously indicates the medicinal nature of the good and that is equivalent to the goods, for which the trade mark was intended. Another fact that without a doubt clears the nature of this product is that this product is used in treatments that are never conducted in beauty salons. However, it is indifferent to the case that this preparation with the given mark is used also for cosmetic purposes, which is evident by one of the brochures on the preparation. The above information with regard to the nature of the given product as well as the volume of goods brought into Poland are sufficient to conclude that this specimen is for medical purposes.<sup>26</sup>

This opinion is also justified by the fact that the PO is very cautious in allowing a broader evaluation of trade mark use in connection with the nature of mark. It has been stated that when submitted catalogues and price lists identify the given good, on which the trade mark was affixed, as a polishing agent for precious steel, then those documents also testify that the mark was used for goods in class 3 that are described as detergents, polishing and scrubbing agents. However, the ingredients of this agent, describ-

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<sup>25</sup> NSA's judgment of January 11, 2006, case no. III GSK 306/05 – "Columbus" and WSA's judgment of October 20, 2006, case no. VI SA 604/06 – "Columbus" (II).

<sup>26</sup> PO's decision in the "Botox" case, cited previously.

ed in the catalogue indicate that it include surfactants. It also mentions that it can be used for pots. In light of those circumstances it can be judged that this agent sold under the mark can also be used for washing. Those goods are also included in class 3 and described as washing agents. The evidence produce does not, however, show that this mark was used for goods described as disinfectants. Even if it appeared from the price list that the good with the mark is a professional specialized agent, then the use of the mark as a "specialized, luxurious" agent should not result in the maintenance of the registration right for all the goods. However, according to the doctrine of the member states of the Association, adapted based on Article 5 (C) (1-2) of the Paris Convention, the use of a trade mark exclusively for specialized and luxurious products is effective in maintaining the protection right for a trade mark which is registered for a category of goods that include that specialized product, such use is also sufficient for other goods from that category. This is true if it is possible to accept that detergents, polishing and scrubbing agents and other washing agents belong to the same category but this is impossible to determine for disinfectants which belong to class 5.<sup>27</sup>

In regard to this issue, there are other matters that relate to the problem of the nature of the good. This is the issue of the correctness or consistency of use of the good with the mark by the customer in regard to the trade mark nature. It has been agreed that this consistency is indifferent with regard to the evaluation of the fulfillment of obligatory trade mark use. This sphere of use is beyond the control of the trade mark proprietor.<sup>28</sup>

In practice, the PO has pointed out that the use of a mark for given goods or services shall be in respect to not only all the goods if such a requirement results from revocation. At the same time, if

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<sup>27</sup> PO's decision of January 30, 2006, case no. Sp. 226/04 – "Helios".

<sup>28</sup> NSA's judgment in "Botox" case, cited previously.

there is no authorized distributor or agent then the use has to be done by the proprietor himself. If then a mark was registered for services in class 36, that is, for renting, managing and administrating of real-estate, exchange offices, banking services, customs and insurance services and the motion for revocation covers some of those goods, the proof of use needs to be submitted only for that part of goods. The proprietor showed that he uses the trade mark for renting, managing and administrating real estate. He did not show that he renders services with respect to exchange office, banking services, customs and insurance services. It is indifferent that the proprietor rents business space to such undertakings as banks or insurance companies or exchange offices. Those undertaking conduct those activities in their own name. The activity of the proprietor evolves only around the service of renting. It is therefore insufficient to constitute genuine use with respect to banking, exchange office, insurance or customs. Such an understanding of genuine rendering of services with regard to the concept of genuine trade mark use is incorrect.<sup>29</sup>

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<sup>29</sup> PO's decision of October 7, 2003, case no. Sp. 052/02 – "ETC".

## CHAPTER 5.

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# THE PLACE OF OBLIGATORY TRADE MARK USE

### 5.1. Community Practice

The specific characteristic of the community trade mark can not be disregarded with regard to this issue. This is evident in the basic rule that a trade mark used in one of the member states of the EU is used on the entire territory of the EU. Such use is not only needed for its protection in a given state, but also to fulfill the requirement of use of a community trade mark as such. The circumstance if it is used in other EU member states is not relevant with regard to the obligatory use of the given trade mark.<sup>1</sup>

It is worth mentioning the special characteristics of the community trade mark, because there are analogical problems in relevance to the national trade marks. In relation to the national trade marks, it is established that the concept of use nationally does not require for the trade mark to be used on the entire territory of that country. It also does not mean that the trade mark should be used in a considerable part of that territory. It is enough for the goods or services with the trade mark to be generally present on that territory. The rest is the problem of the extent of use.<sup>2</sup> This view

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<sup>1</sup> ECJ's judgment in the "Vitafruit" case, as cited previously.

<sup>2</sup> ECJ's judgment in the "Vitafruit" case, as cited previously and the CFI's judgment in the "Capio" case, as cited previously.

corresponds with the opinion in regard to the extent of use, as it has been shown that the trade mark is to be indeed used on a considerable part of the protected territory and at the same time it has to be used on a considerable part of the market for the goods or services for which it registered. It does not have to be used on the entire market or even on the larger part of the territory covered by trade mark protection. The territorial extent of trade mark use is only one of the elements taken under consideration when assessing the extent of use.<sup>3</sup>

However, it has been brought forward that in the period of trade globalization, the designation by the proprietor of his company's headquarters as situated in a given country is not enough to consider that the trade mark has been actually used on the territory of that given country. This is conclusive with the regulation, according to which genuine use is presumed when the goods or its packaging are affixed with the trade mark in a country (or the EU) exclusively for export purposes.<sup>4</sup> With reference to the use of a trade mark on a relevant market, it must be shown that the goods or services with the given trade mark were present in a given geographical area. Therefore, taking into consideration the actual state of a given situation, the evidence that the goods were imported to such an area could be enough.<sup>5</sup>

Service trade marks have been treated particularly with regard to this issue. For example, a trade mark which is designated for organizing music events and promoting music, including giving out awards, is considered to be used in Spain, if in that country broadcasting, license, promotional or other agreements have been signed and also other agreements associated with the maintenance of the "Grammy Awards" show broadcasted on Spanish TV. It is therefore of no relevance that the show itself takes place in the

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<sup>3</sup> See footnotes no. 19 in Chapter 1 and 1 in Chapter 3.

<sup>4</sup> OHIM's decision of April 27, 2000, case no. 827/2000 – "Marca".

<sup>5</sup> OHIM's decision of September 23, 1999, case no. 802/1999 – "Miles".



United States, meaning outside the territory of Spain. It is only relevant that the show is broadcasted to the Spanish audience.<sup>6</sup>

## 5.2. Polish Practice

Poland's jurisprudence has also tried to solve the problem of obligatory trade mark use in case when the trade mark is used for goods destined only for export. It has been acknowledged that such type of use is qualified only if the trade mark is affixed to that export good (packaging) in the territory of Poland. Even if the export itself is conducted by another company, it has to be, however, organizationally connected to the proprietor.<sup>7</sup> This fact of affixing the trade mark on the exported good (its packaging) has to be derived from very concrete evidence for trade mark use, such as license agreements or delivery note.<sup>8</sup> Therefore, the authorized by a license agreement use of a trade mark through the placing of the trade mark on the packaging of goods for export, which are at the same time advertised in a mass communications medium in Poland (i.e. the Internet) equals to the use of the trade mark in Poland.<sup>9</sup>

However, it has been at the same time argued that for trade mark use in Poland, the entity using the mark is not relevant when, for example a licensee has its branch or agency in Poland. It is important that the licensee uses the trade mark in its business activity with business partners in Poland. This also pertains to contacts that would include activities with entities active outside of Poland.<sup>10</sup>

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<sup>6</sup> BoA's decision of August 18, 2005, case no. R 1062/2000-4 – "Grammy".

<sup>7</sup> WSA's judgment of October 29, 2004, case no. 6 II SA 3904/03 – "Tudor" and PO's decision of March 6, 2006, case no. Sp. 221/05 – "Tudor".

<sup>8</sup> WSA's judgment of January 26, 2005, case no. VI SA/Wa 285/04 – "Krokus".

<sup>9</sup> PO's decision of December 11, 2003, case no. Sp. 0147/01 – "Krokus".

<sup>10</sup> PO's decision in the "znak Sowy" case, as cited above

On the other hand, it has been stated that in the case of Internet sale, a trade mark could be considered to be used in Poland only if the Internet store has its seat in Poland, meaning the place where it conducts its activity. To be more precise, this Internet store should be run by a business company that has its seat in Poland. Simultaneously, the proof of use can only pertain to the territory of Poland, meaning specifically proving that the goods affixed with the trade mark were brought to the Internet store's magazine in Poland. This opinion is based on the community and national regulations with regard to services and trade on the Internet.<sup>11</sup>

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<sup>11</sup> PO's decision in the "Aveda" case, as cited previously.

## CHAPTER 6.

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# THE PERSON FULFILLING OBLIGATORY TRADE MARK USE

### 6.1. Community Practice

With regard to this issue, the community practice states that neither a license agreement, nor an official entry of the licensee into a trade mark register is necessary to fulfill the requirements of obligatory trade mark use by a subsidiary mandate.<sup>1</sup>

It is required, however, that while assessing trade mark use by third parties in connection to the type of use and submitted proof of use, to find out in particular if authorization for the use of the trade mark was given beforehand, that is before the third party started using the mark.<sup>2</sup>

It has also been pointed out that the requirement for genuine use of a trade mark is not only directed to the current trade mark proprietor. It also pertains to the previous proprietor of the given trade mark.<sup>3</sup>

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<sup>1</sup> BoA's decision of April 9, 2002, case no. R 294/2001-1 – "Marie Claire".

<sup>2</sup> BoA's decisions of September 19, 2000, case no. R 733/1999-1 – "Affinage/Affinite" and of November 8, 2000, case no. R 756/1999-3 – "Doc&Tors/Doctors".

<sup>3</sup> OHIM's decision of December 10, 1999, case no. Nr 1426/1999 – "Ventozelo".

## 6.2. Polish Practice

There seems to be a difference of opinion between the administrative courts and the PO in Poland's jurisprudence. This discrepancy seems to relate to the relation between a foreign trade mark proprietor and a third person who uses the trade mark in a given country.

In the opinion of the courts and also the PO, in the light of the regulation with regard to obligatory trade mark use, it is most important for the final consumer to connect the given good to the mark. Therefore, the relation between the trade mark proprietor and the person using the trade mark is not that important. It is enough for the good affixed with the trade mark to be present in the course of trade in a given country and for the trade mark to identify the goods and connect them with the producer. It can be a license agreement, a distribution agreement or any other type that associates the proprietor with the user of the trade mark. The type of agreement is not important. It can not also be required that an agreement, other than a license agreement, be made in any special form or include any specific content. None of the regulations with regard to trade marks qualifies that the proprietor's authorization for the use of a trade mark be made in any specific written agreement. It can therefore be assumed that such an authorization can be verbal or in the form of an "implied agreement". Such an agreement, for example, could be in the form of a statement from a director-general of the proprietor that a given domestic company is the main distributor of its goods affixed with the contested trade mark. It can also be in a form a statement given by this company that it has been selling car accessories affixed with this trade mark on the Polish market for the past 10 years. It can be also a statement from the owner that is has been the proprietor's official distributor. Also, based an exemplary correspondence or a catalogue in which it has been stated that this company is an importer and a distributor of the said accessories affixed with the

trade mark on the territory of Poland, it can be explicitly derived that the given goods have been distributed by the said company with the knowledge and the authorization of the proprietor on the territory of Poland. It should also be maintained that even if there is no type of agreement between the proprietor and the user, it can only lead to the application of general rules with regard to the commercialization of the good, including trade mark exhaustion. The lack of such an agreement does not cause the trade mark proprietor to lose all his rights to the trade mark. All the same, it does not result in the non-use of a trade mark with regard to those aspects of the law that do not cover exhaustion. If a third person uses the trade mark as authorized, not infringing upon the rights of the trade mark proprietor, then even if it they were to do it on their behalf, it is not possible to declare the non-use of a trade mark and to revoke the trade mark. In this situation, one should also take into account the function of the trade mark. The trade mark has to identify the goods, protect its association with the good and to prevent the likelihood of confusion as to the origin of the goods. The interpretation that requires a formal association between the proprietor and the trade mark user would lead the preclusion of implementation of the said trade mark functions. It would also allow for the revocation of the trade mark that is functioning on the market and that is associated by the consumers with a given producer.<sup>4</sup>

However, the Patent Office has a different opinion with regard to the above issue.

On the one hand, according to the PO, even if between the domestic distributor and the proprietor there is no specific form of association resulting from, for example, an agency relation or a license agreement, then the content of the agreement with the distributor certifies about the proprietor's knowledge and authori-

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<sup>4</sup> PO's decision of July 24, 2003, case no. Sp. 0110/01 – "Carpoint" and WSA's judgment of October 28, 2004, case no. 6 II SA 3752/03 – "Carpoint".

zation for the sale of goods on the territory of Poland. Such an agreement clearly designates Poland to be the territory of the distribution for the goods of the proprietor. The lack of an appendix, which would identify the list of goods for distribution, can be replaced by invoices that evidence the sale of goods affixed with the proprietor's trade mark. The regulations of the PWP do not require proof of formal relations between the proprietor and the entity which actually sells the goods on the territory of Poland. Therefore, the view that the lack of a distribution agreement means that the trade mark was used in Poland by the buyer and only in his name is incorrect. The trade mark was used in Poland both by the proprietor commercializing the good through export and by the buyer who further sold the good to other buyers in Poland. Both used the trade mark within their rights and in this particular situation it was not necessary to prove that the buyer used the trade mark on behalf of the proprietor. Even if the buyer used the trade mark in its own name, a motion for the revocation of the trade mark would be untitled. Therefore, it can not be derived that the trade mark was not used by a third person, especially since trade mark use according to Article 154 of PWP could also consist of the export or import of goods affixed by a trade mark.<sup>5</sup>

However, on the other hand, the PO is of the opinion that the sole fact of buying goods with the trade mark from a proprietor's licensee abroad and then reselling those good in the country of the buyer but without the authorization of the proprietor or the licensee and without any agreement with them can not consist of use of the trade mark by the proprietor or the licensee in the given country.<sup>6</sup> The courts themselves believe that to declare trade mark use by a third person with the authorization of the proprietor it is not enough for there to be only the agreement itself (for example a license agreement) between these persons. It is necessary to

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<sup>5</sup> PO's decision in the case of "Botox", as cited previously.

<sup>6</sup> PO's decision of October 28, 2004, case no. Sp. 0125/01 – "Reporter".

prove genuine use, and that is the genuine use of the licensed trade mark. In addition, use by the licensee, meaning the use of the trade mark has to have an effect on the proprietor.<sup>7</sup>

It should also be noted that the administrative courts have a different position than the community organs with regard to the issue of the person fulfilling the requirements for use. They believe that the circumstances with regard to the use of a trade mark by a previous proprietor and the assignment of trade mark rights should not be evaluated during the procedures for the revocation of a trade mark due to non-use. The rules regulating such a revocation of rights are directed to the non-use of the current proprietor and not towards his predecessors.<sup>8</sup>

This view of the PO seems to be consolidated in their practice. Their practice comes from the assumption that trade mark registration is a defining element of the right to a trade mark and it qualifies the scope of given protection both objectively and subjectively, meaning with regard to the trade mark itself as well as to the proprietor. Therefore, both invalidation and revocation applies to the rights derived from trade mark registration, which should be understood as the right resulting from legally valid judgments (decrees, decisions) which determine the current status of the registration. If then, in a given state of affairs, the Patent Office has established that the proprietor of a given right is a civil law partnership, and not its legal predecessor, here one of the partners of this entity who also conducts individual business activity, then the revocations proceedings can be directed only towards that given civil law partnership. The mentioned partnership has submitted evidence for the proof of use and this evidence is enough to determine the use of a trade mark just prior to the period in which the applicant has applied for registration. However, the applicant

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<sup>7</sup> WSA's judgment of December 21, 2005, case no. VI SA/Wa 1315/05 – "Montana" and NSA's judgment of June 6, 2006, case no. II GSK 83/06 – "Montana".

<sup>8</sup> NSA's judgment of January 7, 2005, case no. GSK 940/04 – "Jubiler".

did not contest that evidence, since it is not derived from the proprietor of the trade mark. In the light of the above, the circumstances brought about by the applicant are of no relevance. They are with regard to the non-use of trade mark by an entity due to its nonexistence in the essential for the case period of time in which this entity was already not entitled to the trade mark. The circumstances with regard to granting protection to a nonexistent entity in the date of trade mark registration can, however, be of relevance during the trade invalidation procedure.<sup>9</sup>

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<sup>9</sup> PO's decision of November 13, 2002, case no. Sp. 032/01 – "Italpol", citing the general rule given for example in the SN's judgment of July 21, 1994, case no. I PRN 46/94 – "Las", OSP 1995/5, pos. 40.



## CHAPTER 7.

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# THE FORM OF THE MARK AND OBLIGATORY TRADE MARK USE

### 7.1. Insignificant and Significant Variations of the Form of the Trade Mark

#### 7.1.1. Community Practice

Community courts and organs have explained that when the trade mark used varies in form from the registered trade mark, then the requirement of trade mark use is satisfied if the trade mark used and the registered trade mark can be considered as one and the same. This sameness can only be considered when the used form of the trade mark does not exceed beyond the insignificant variations of the registered form of the trade mark. The assessment of this relation is only possible by a comparison of the forms of the marks.<sup>1</sup>

The following rules are used when comparing the pertinent marks:

1) The alterations done to letters and words or to its elements in word and word-figurative trade marks lead to the alteration of the distinctive character of the sign.<sup>2</sup> However, if the changes

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<sup>1</sup> BoA's decision in the "El Capitan Pescanova/Capitan" case, as cited previously.

<sup>2</sup> Compare OHIM's decision of March 31, 1999, case no. 165/1999 – "Warriors" with the decision of December 8, 2000, case no. 2996/2000 – "Bonoli".

consist of adding or omitting some word elements, then the outcome of this assessment might differ.<sup>3</sup>

2) Insignificant alterations include change in the composition of words in a multi-word (for example two-word) trade mark, such as placing them in a single line, next to each other instead of in several lines (for example two lines), one under the other.<sup>4</sup>

3) Font variations or size and style variations of the font, including the switch from an elegant to a typical style are of no essential importance. It is also of small importance if a part of the word element has been underlined or if it has been placed on a specifically shaped or contoured background.<sup>5</sup>

4) Also, changes from small to capital letters are not an indication of originality and therefore they can not alter the distinctive character of the sign. However, this is up to the point where the modified in this way letter or letters are not perceived as being separate from the word which it is a part of and which is the main element of the sign.<sup>6</sup>

5) Consequently, the addition, omission or modification of a graphic element, especially in a word-figurative trade mark, as a rule does not alter the distinctive character of the sign.<sup>7</sup> This is especially the case when that graphic element is descriptive in

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<sup>3</sup> Compare BoA's decision in the "El Capitan Pescanova/Capitan" case, as cited previously with the decision of November 3, 2004, case no. R 930/2001-2 – "Cannon/ITT Cannon" and the decision of December 3, 2003, case no. R 1000/2001-2 – "Budweiser/Budweiser Budvar" and the OHIM's decision of May 10, 1999, case no. 237/1999 – "Maxor".

<sup>4</sup> BoA's decision of November 17, 2004, case no. R 620/2003-1 – "Rossi/Sergio Rossi".

<sup>5</sup> Compare BoA's decision of December 3, 2002, case no. R 1018/2000-3 – "Tiffany/Tifany", of December 14, 2004, case no. R 518/2003-2 – "Tiffany&Co./Tifany" and of December 14, 2004, case no. R 519/2003-2 – "Tiffany&Co.(3D)/Tifany".

<sup>6</sup> CFI's judgment of January 12, 2006, case no. T-147/03 – "Quantieme".

<sup>7</sup> Compare BoA's decisions in the "Tiffany/Tifany" case, in the "Tiffany&Co./Tifany" case, and in the "Tiffany&Co.(3D)/Tifany" case, all cited pre-

connection with the goods or services covered by that trade mark.<sup>8</sup>

6) Exceptions to the above rule are the circumstances when the graphic element is dominant in the overall presentation of the trade mark. In these circumstances, an alteration and specifically the addition or omission of such an element can alter the distinctive character of the sign. This is even the case when the word element of that sign has not been changed.<sup>9</sup> As a rule, therefore, when a graphic element is specific and very characteristic and when it is separate from the goods covered by the trade mark, then its omission can alter the distinctive character of the sign.<sup>10</sup>

7) The same rules apply to figurative trade marks with color. In particular, registered colors or their combinations can be used in different combinations or proportions only if such a combination or proportion has not been registered itself. However, the use of a color sign in its black and white version does not constitute genuine use.<sup>11</sup> It is insignificant if the background and letter coloring have been flipped.<sup>12</sup> Alterations in the form of shading of a 2-dimensional sign, which give the impression of

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viously and OHIM's decision of August 6, 1999, case no. 609/1999 – "Compu-tervision".

<sup>8</sup> OHIM's decisions of June 21, 2000, case no. 1308/2000 – "Weekend" and of March 16, 2001, case No. 682/2001 – "Fildor".

<sup>9</sup> CFI's judgment in the "Giorgio Aire" case, as cited previously and the decision of BoA's of September 30, 2002, case no. R 73/2000-1, in the "Nike" case and OHIM'S decision of May 21, 1999, case no. 295/1999 – "Tack", of February 14, 2000, case no. 206/2000 – "Lusan" and of February 27, 2001, case no. 484/2001 – "Orbi-val".


<sup>10</sup> BoA's decision of November 22, 2001, case no. R 150/2000- 1 – "RA-BA".

<sup>11</sup> OHIM's decision of February 21, 2000, case no. 242/2000 – "Silver" and of May 23, 2000, case no. 1044/2000 – "Criollo".

<sup>12</sup> Compare the BoA's decisions in the "Tiffany/Tifany" case, in the "Tiffa-ny&Co./Tifany" case and in the "Tiffany&Co.(3D)/Tifany" case, all cited pre-viously.

a 3-D sign, are also considered minimal and routine. It is also of no importance if one letter in a word has been highlighted in color.<sup>13</sup> However, if more than one letter or the entire word has been colored, and if in addition that colored word has been added to another word element, which is used yet in another color, this can as a rule lead to the alteration of the distinctive character of the sign.<sup>14</sup>

8) The assessment of the effect of the variation of the mark on the distinctive character of the registered trade mark is subject to the general rules under the assessment of the distinctive character of the sign.<sup>15</sup> These rules can be demonstrated by the chart below, showing the results of the comparison between used signs and their registered versions:

Variations altering the distinctive character		Variations not altering the distinctive character	
Registered form	Actual use	Registered form	Actual use
THE WARRIORS	WARRIORBELL	BUDWEISER	BUDWEISER BUDVAR
BONOLI	BONOLIVA	COMPUTERVISION	
EL CAPITAN PESCANOVA	CAPITAN	FLEX	REVLON FLEX NEW TRIPLE ACTION
CANNON	ITT CANNON	BIT	BITTE EIN BIT

<sup>13</sup> BoA's decision of October 2, 2001, case no. R 812/2000-1 – "Biotek/Biotex".

<sup>14</sup> OHIM's decision of November 29, 2002, case no. 3484/2002 – "Cargobull".

<sup>15</sup> CFI's judgment in the "Quantieme" case, as cited previously.

BIO DANONE		BIO DANONE	
<i>J. Giorgi</i>		<i>tiffany</i>	TIFANY
tack			QUANTIEME
	NIKE	<b>SERGIO ROSSI</b>	sergio rossi
		<b>WEEK END</b>	<i>Week End</i>
	<b>Lusan</b>		
			
			

Among the mentioned rules, much emphasis is put on the relation between those elements of the trade mark that have been altered and the goods or services which the trade mark covers. To be more precise, if, for example, in a trade mark the style of its letter "Q" creates a specific clock-face or even an alarm clock then if that trade mark is to cover clocks and related items from class 14 then such a stylization is not distinctive. Thus, it does not alter the distinctive character of the trade mark.<sup>16</sup>

The type of goods (services) which the trade mark covers, is of significance when the trade mark used is a combination of several signs (symbols) which are used in the proprietor's business activity. This factor is sometimes more important than the degree of recognition of the elements used in that trade mark or the appearance or the resonance of that sign. This is not always the outcome of the pertinent assessment, whose result in a certain discrepancy as to the community practice, especially since this discrepancy occurs between the OHIM's and community courts.

The case of the "Minuto" trade mark is a well-known example of the dependency that exists between the type of goods and the possibility of the fulfillment of the requirements of trade mark use by a variation of the registered mark. The trade mark was used as "Dubois Minuto", where the sign "Dubois" was a separate mark, used for a longer time and therefore better known. This element was frequently used with other elements as it identified the producer. It was therefore assessed that such a variation – "Dubois Minuto", used for wines, could not satisfy the requirement for use of the "Minuto" trade mark. It was further argued that it is very common to use such elements to identify a winery (in this case: Dubois) and the name of the product (in this case: Minuto).

The "Dubois Minuto" trade mark is therefore not equivalent to the "Minuto" trade mark. In the case of the first trade mark, the consumer, in this example of wines, treats the word "Minuto" as

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<sup>16</sup> CFI's judgment in the "Quantieme" case, as cited above.

information about the good that is identified with the "Dubois" winery and associates it with the line of products of that winery. In the case of the second trade mark, the word "Minuto" does not bring about such associations. It is treated as a separate mark.<sup>17</sup>

The case of the "Cristal" trade mark is, however, a contradictory example. This trade mark was also registered for wines. It was also used with an accompanying producer's name of "Louis Roederer" and other additional word-graphic elements, including the initials "LR". Hence, it was decided that such a variation did not alter the distinctive character of the trade mark. It was noticed that the word "Cristal" was present several times on the top and bottom labels and that it was very visible. It was also argued that the top label leaves a certain distance from other word and graphic elements and besides that, the word "Cristal" was also present on carton packaging. Therefore, the mark "Louis Roederer" and the "LR" initials are not able to have any effect on the alteration of the distinctive character of the used with them "Cristal" trade mark. They are association with many wine products that belong to the same line of products and they do not change the identification function of the "Cristal" trade mark.<sup>18</sup>

The second solution seems to be more dominant in the OHIM's judgments. This can also be noticed in the "Portale" case, also in relation to wines.<sup>19</sup> Furthermore, the OHIM has accepted specifically that in the case of the cosmetics industry, it is also customary to identify goods by a specific mark that is used for a given type of product. Therefore, the use of the "Revlon Flex New Triple Action" mark constitutes use of the "Flex" trade mark. In this specific mark, the sign "Revlon" is a "house" mark. It identifies the producer, not the good. It identifies a given undertaking or a brand name or even a group of products. While the "New Triple Action"

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<sup>17</sup> BoA's decision of September 12, 2001, case no. R 206/2000-3 – "Minuto".

<sup>18</sup> CFI's judgment of December 8, 2005, case no. T-29/04, – "Cristal".

<sup>19</sup> OHIM's decision of November 28, 2002, case no. 3477/2002 – "Portale".

formula is descriptive,<sup>20</sup> in such a type of trade mark, which besides the given trade mark is composed of "house" mark, it should then be assumed that two independent trade marks are used.<sup>21</sup>

It has been pointed out that in cases in which a given trade mark a mark with a dominant nature has been added, then the first mark can become a mere decorative element. It is doubtful if such a combination constitutes genuine use.<sup>22</sup> This is even more the case when in a trade mark combined of more than one mark the different elements appear as a "unitary whole". This issue, as usual, needs to be treated on a case-by-case basis. The customs in a specific market sector might play a very significant role in such an assessment.<sup>23</sup> A similar situation might occur with regard to a combined trade mark, where one of the elements is a company name, especially if the company is known, for example "Danone".<sup>24</sup>

A specific type of trade mark alteration is the use of the trade mark in the form of a slogan, including an advertising slogan. However, in this example it is necessary to assess the case on its own merits and take into consideration the customers' customs and habits. For example, the use in Germany of the slogan "Bitte ein Bit" constitutes the use of the "Bit" trade mark, registered for beers. The preposition "Bitte ein" in this slogan cannot alter the distinctive character of the given trade mark. This preposition is customary for ordering beer in a German bar. Therefore, it is

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<sup>20</sup> BoA's decision of October 17, 2005, case no. R 806/2002-4 – "Flex/Flexi Touch".

<sup>21</sup> OHIM's decision in the "Miles" case, as cited previously and of May 31, 2001, case no. 1378/2001 – "Terry".

<sup>22</sup> BoA's decision in the "Nike" case, as cited previously.

<sup>23</sup> For example, OHIM's decisions in the "Cargobull" and "Portale" cases, as cited previously.

<sup>24</sup> Compare contradictory findings in OHIM's decision of March 1, 2001, case no. 616/2001 – "Bio garantie" and of June 6, 2001, case no. 1391/2001 – "Io Bio" (the first decision was made after an earlier decision was cancelled by OHIM's BoA).



descriptive. The customer, while identifying the beer with regard to its origin, does not concentrate on the form of the order but on what it orders. Therefore, this formula cannot alter the distinctive character of the "Bit" trade mark.<sup>25</sup>

### 7.1.2. Polish Practice

The domestic practice has not developed so many and so various cases as the community practice has with regard to the fulfillment of the requirement of trade mark use by the use of a variation of a trade mark. This is especially the case with regard to the general rules of this issue. However, there are some judgments of the administrative courts and the Patent Office that allow establishing the position that has been developed by them with regard to the assessment of the fulfillment of the requirement of use by such a use.

In the light of the regulations with regard to this issue, it is allowed to use a trade mark in a varied form, which could only insignificantly differ from the registered form of the trade mark. For example, the use of the "Cross" mark differs insignificantly from the registered "Cros" trade mark, which does not effect the distinctive character of the trade mark.<sup>26</sup> In case of the addition of new elements to the used form of the trade mark, the case is similar. It is enough that this new form still combines the dominant form of the registered trade mark. In such circumstances, the used form only insignificantly varies from the registered form of the trade mark.<sup>27</sup>

However, on the other hand, a label which it to be the proof of use, which combines the mark with word elements, significantly

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<sup>25</sup> BoA's decision of July 22, 2004, case no. R 447/2002-2 – "American Bud/Bit".

<sup>26</sup> Two PO's decisions in the "Cross" cases, as cited previously.

<sup>27</sup> WSA's judgment in the "Poznańska Gorzka" case, as cited previously.

varies from a registered trade mark which does not include those elements.<sup>28</sup> Even more, the use of the "Tiffany & Broadway" mark cannot constitute the use of the "Broadway" trade mark.<sup>29</sup>

The case of the "Radio 73.2 FM ESKA" trade mark is a good example to assess the meaning of the types of variations that fulfill the requirement of trade mark use. This trade mark was used with different number elements for the radio frequency. But the variation included the words "ESKA" or "Radio ESKA". The word "ESKA" decided about the strength of the trade mark. This word and not the graphic-number elements were the dominant element of the mark. Therefore the mentioned and used form of the trade mark kept the distinctive character of the registered trade mark.<sup>30</sup>

## **7.2. Special Circumstances, Including the Use of Another, but also Registered Form of a Trade Mark**

### **7.2.1. Community Practice**

In order to correctly assess if the used variation of the trade mark fulfills the requirement of use, it is necessary to established if that used form is also registered. Only general remarks about this issue can be found in OHIM's decisions, according to which within the framework of the mentioned assessment it should be taken under consideration if the given element, used with a given mark but not present in the registered trade mark is an independent trade mark. In such circumstances it should be evaluated in what manner this trade mark is used and how well it is known.<sup>31</sup>

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<sup>28</sup> PO's decision of November 4, 2005, case no. Sp. 344/04 – "Sierżant Kozak".

<sup>29</sup> PO's decision in the "Broadway" (I) case, as cited previously.

<sup>30</sup> NSA's judgment in the "Eska" case, and the WSA's judgment in the "Eska" case, both cited previously.

<sup>31</sup> BoA's decision in the "Minuto" case, as cited previously.

On the other hand, the community courts have a clear stance on this issue. The possibility to satisfy the requirement of use by a variation of the trade mark is limited only to the used forms of the mark. It does not include the circumstances when the used mark is a registered trade mark. Therefore, one cannot free themselves from the requirement of use of a registered trade mark by using a similar trade mark which is separately registered. This rule is even more applied to "family trade marks", where each of the trade marks has extended protection.<sup>32</sup>

### 7.2.2. Polish Practice

The presented above position of the community courts has been applied in the newest judgments in Poland. It was referred to in the judgment with regard to the "Bainbridge" case.<sup>33</sup>

However, in earlier court judgments, but also in the PO's decisions, one can find many examples with regard to the above issue. It has been argued that Article 169 (4) (1) PWP is distinctive in nature and should be interpreted as such. Otherwise, a registered trade mark, maintained because of its use in a varied form, could illegitimately limit the competitors conduct of their business activity. Such a solution is clearly not compatible with the function of a registered trade mark. This is especially the case when, for example, a used trade mark "Ava Mustela" is a compilation of two registered trade marks: word-figurative "Ava" trade mark and the word "Mustela", which is a part of another word trade mark "Ava-Mustela".<sup>34</sup>

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<sup>32</sup> CFI's judgment in the "Bainbridge" case, cited previously and the ECJ's judgment of September 13, 2007, case no. C-234/06 P – "Bainbridge". See further M. Trzebiatowski, *Używanie znaku towarowego w postaci odmiennej od zarejestrowanej jako przesłanka ochrony znaku – glosa do wyroku Sądu Pierwszej Instancji WE z 23.02.2006 r. w sprawie T-194/03 Bainbridge*, EPS 10/2006, pgs. 49-54.

<sup>33</sup> WSA's judgment in the "Perrier" case, as cited previously.

<sup>34</sup> WSA's judgment in the "Ava-Mustela" case, cited previously.

A similar situation occurs when the proprietor has two similar registered trade marks: "Dziecko" and "Twoje Dziecko". The use of the first trade mark can not constitute simultaneously the use of the second one. If two trade marks have been registered, then the requirement of use is separate for both of them. This is necessary even if the two trade marks are similar. Otherwise, the registration of one of them would make no sense. The regulations on this issue do not include the situation when the changed form of the mark is registered as a separate trade mark. From this regulation and from the definition of a trade mark, it follows that if a varied form of a trade mark is registered, that means that it has its own distinctive character. Registered trade marks, as a rule of thumb, are not similar to each other. If there was similarity between two trade marks, this would create a negative basis for registration for one of them. Each registered trade mark has to be able to independently identify the goods. In its form, it is separately protected, which includes the protection of an acceptable varied form of the earlier registered trade mark. If this were not the case, a proprietor could have registered two very similar trade marks and used them interchangeably.<sup>35</sup>

Analogically, this can be argued in the case of the "Naomi" and "Naomi Campbel" trade mark cases. If these two trade marks were registered separately, then they exist separately. Thus, each of them has their own rights and benefits for its own protection. Therefore, both of these trade mark should be used in the course of trade.<sup>36</sup> The same applies when there are two "Toni-Dress" trade marks. The use of one of them does not constitute the use

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<sup>35</sup> NSA's judgment of October 25, 2006, case no. II GSK 190/06 – "Twoje Dziecko" and the WSA's judgment of March 17, 2006, case no. VI SA/Wa 2320/05 – "Twoje Dziecko". See also WSA's judgment of December 9, 2004, case no. VI SA/Wa 10/04 – the same matter.

<sup>36</sup> NSA's judgment in the "Naomi" case, as cited previously.

of the other. This is the case even though the trade marks are phonetically similar.<sup>37</sup>

One can then conclude that the legal rule set in the above mentioned Article is with regard to the situation where a non-registered trade mark different from the registered trade mark in elements which do not alter its distinctive character is used. This rule does not apply when the varied form is separately protected, meaning registered as a separate trade mark.<sup>38</sup>

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<sup>37</sup> PO's decision of May 10, 2005, case no. Sp. 458/05 and Sp. 459/05 – "Toni-Dress".

<sup>38</sup> NSA's judgment in the "Twoje Dziecko" case, and two WSA's judgments in Warsaw in the "Twoje Dziecko" cases, all cited previously. See further M. Trzebiatowski, *Używanie znaku towarowego w postaci odmiennej ...*, pgs. 54-56.



## CHAPTER 8.

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# TIME AND OBLIGATORY TRADE MARK USE

### 8.1. Community Practice

This problem deals with two issues. The first regards the date from which the five-year period begins its run to commence genuine (serious) use of a trade mark. It has been acknowledged that this date depends on the national laws and regulations. However, it has been assumed that this occurs no earlier than after the relative grounds for refusal of registration have been checked.<sup>1</sup>

The second issue is the practical time-frame of the five-year period. It has been stated that while assessing the genuine use of a trade mark, only the circumstances that occurred up to the date of the termination of the five-year period, meaning up to the date when the motion for revocation was filled, are taken into consideration. However, it has also been pointed out that Article 12 of the Directive does not exclude the possibility that circumstances that have occurred after such a motion was filed can be taken under consideration. Such a prolongation of the relevant time-frame for this type of assessment could allow a better judgment as to the extent of use in the five-year time frame and a better determination

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<sup>1</sup> ECJ's judgment of June 14, 2007, case no. C-246/05 – "Häupl". Further on this subject see M. Trzebiatowski, *Obowiązek używania znaku towarowego – glosa do wyroku ETS z 14.06.2007 r. w sprawie C-246/05 Häupl*, EPS 11/2007, pgs. 37-40.

of the actual intent to use. Only under those conditions the said circumstances can be taken under consideration.<sup>2</sup>

It should be explained, however, that the community courts categorically negate the theory that the sole fact of having proof of use, and in large quantity, but for a significantly distant time after the time-frame period for genuine use is without merit. Such a fact cannot determine that in the relevant time-frame a trade mark was used seriously. It also cannot give significant information about the extent of its use in the relevant time-frame.<sup>3</sup>

## 8.2. Polish Practice

The first of the above described issues is also the subject of Polish judicature. It has been stated that the time-frame needed to grant a revocation decision due to the non-use of a trade mark can not start earlier than from the date of trade mark registration, the date when one's rights derived from registration come into force. This period begins then from the moment that the trade mark has been registered.<sup>4</sup> It has been highlighted that based on the regulations of the UZT as well as the PWP, judicial doctrine and judicature have been united in the opinion that the date when obligatory trade mark use starts is the date of trade mark registration and not its application. The regulations clearly state that the

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<sup>2</sup> ECJ's decision in the "La Mer" (I) case, as cited previously and BoA's decision of September 14, 2004, case no, R 644/2002-2 – "Protel/Rotel", and lately CFI's judgment in the "Capio" case, as cited previously. See further M. Trzebiatowski, *Komentarz do postanowienia...*, pgs. 294-297.

<sup>3</sup> CFI's judgment in the "Sonia Rykiel" case, cited previously.

<sup>4</sup> NSA's judgment of July 20, 2005, case no, II GSK 71/05 – "Leo", WSA's judgments in the "Czach" case, cited previously and of June 16, 2005, case no. VI SA/Wa 1326/04 – "Trybuna Ludu" and the PO's decisions of February 20, 2006, case no. Sp. 153/05 – "Czach" and of November 23, 2005, case no. Sp. 018/02 – "Cracovia".



five-year period of non-use refers to a registered trade mark and not to an applied trade mark. The argument that the five-year period should start from the date of application for registration has no support in the judicial doctrine nor the judgments of the courts, including the administrative courts or of the Patent Office.<sup>5</sup>

The second issue examined by the administrative courts and the Patent Office is the date of the termination of the five-year period. It has been established that this date is the date when the proceedings with regard to the revocation of the trade mark due to its non-use begin, meaning the date when the motion for revocation is received by the PO.<sup>6</sup> This receipt date of the mentioned motion sets the time-frame for the assessment of trade mark use. During this date the reasons for the effective revocation of the trade mark had to occur.<sup>7</sup>

It has also been brought up that the evaluated period should encompass the five consecutive years before the motion has been filed, meaning that this period should be counted five years back from the date of the motion for trade mark revocation.<sup>8</sup> At the same time, this motion should be filed after the period of non-use of the trade mark but before the trade mark has started to be used again.<sup>9</sup>

The vast majority of the judgments assume that the revocation of a trade mark due to non-use is possible only after the full five-year time period has been terminated. However, it has to be stress-

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<sup>5</sup> PO's decision of February 23, 2006, case no. Sp.161/05 – "Atlas".

<sup>6</sup> NSA's judgment in the "Red Bull" (I) case, as cited previously and WSA's judgment of June 13, 2006, case no. VI SA/Wa 2180/05 – "Red Bull" (I).

<sup>7</sup> NSA's judgment in the "Leo" case, and WSA's judgment in the "Cardinal" case, both cited previously.

<sup>8</sup> NSA's judgment in the "Leo" case and WSA's judgment in the "Lord" case, both cited previously and PO's decision of March 7, 2002, case no. Sp. 02/01 – "Sensor".

<sup>9</sup> WSA's judgment in the "Poznańska Gorzka" case, as cited previously and of March 25, 2005, case no. VI SA/Wa 1077/04 – "Cross" and two PO's decisions in the "Cross" cases, cited previously.

ed that there is a possibility that such a decision can be made before that time period has passed. This possibility has been made available with regard to pharmaceuticals. It has been established that if the period of non-use for five-years has not yet passed, then there are no grounds to revoke the trade mark. These grounds emerge when the proprietor can not prove that in the period from which the revocation proceedings have started he will introduce into the Polish market, based on an adequate permit, the pharmaceutical product with the said trade mark. This is if he was to prove the circumstances that would lead to believe that the trade mark will be genuinely used for goods covered by the registration. If, however, such a circumstance was not proven, then there is no evidence to believe that a trade mark will be genuinely used in the relevant time-frame.<sup>10</sup>

Definitively now, but after some debate, the theory that the motion for revocation due to non-use could be only possible when the right to the trade mark still exists, has been discarded. This has not been accepted when the trade mark right was revoked *ex officio*, that is, when the period of protection ended, the motion to revoke the trade mark due to non-use is without merit. Even if the only goal of that motion was to cancel the waiting period after the *ex officio* revocation, it has to be stressed that the decision for trade mark revocation due to non-use specifically marks the date of non-use that caused that revocation. This decision in the light of PWP regulations may be established *a posteriori*. It can date to the end of the five-year period in which the proprietor has stopped to genuinely use the trade mark or did not resumed to use the trade mark (see further). This means that the date of filling the motion for trade mark revocation is not important in establishing the revocation date itself. The motion is only an activity that starts the administrative proceedings by request of the opponent. It will be all the fact-findings during the revocation proceedings that will deter-

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<sup>10</sup> PO's decision in the "Spectrum" case, as cited previously.

mine if the right can be revoked and at what date. This also applies to the revocation of the trade mark due to the termination of the five-year period in which the proprietor ended or did not resumed the use of the trade mark. This procedure is by its nature applied when the trade mark right is still in existence. However, it can also be applied when the five-year non use period has been terminated before the usual end of the protection period.<sup>11</sup>

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<sup>11</sup> NSA's judgment of January 21, 2009, case no. II GSK 668/08 – "Chokella", canceling a contradictory judgment of the WSA of December 12, 2007, case no. VI SA/Wa 791/07 on this matter.



## CHAPTER 9.

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# JUSTIFICATIONS OF NON-USE OF A TRADE MARK

### 9.1. Community Practice

This issue is one of the more important in the aspects of obligatory trade mark use. While conducting an analysis of this issue, one should initially bare in mind that Article 12 of the Directive which deals with this issue should be interpreted in light of Article 19 of the TRIPS Agreement. This article helps in establishing boundaries of justifiable reasons for non-use, which are mentioned in the Directive. As a consequence, these reasons might be considered to be bureaucratic difficulties (governmental requirements). They are independent of the will of the trade mark proprietor. At the same time, they might be impossible to overcome. They have to also directly effect the use of the trade mark. The premises for these reasons are met when, in particular, their use is dependent upon a specific administrative procedures, for example inspection of food in connection with its sell-by date. There is a lack of such dependency when, for example, there are complications and delays in obtaining permits for building of a supermarket and the trade mark could be use with the assistance of other sellers. Even more, there could be no talk of justifiable reasons for non-use with regard to strategic considerations of the undertaking. Such an obstacle is clearly within the sphere of control of the undertaking – the trade mark proprietor. In case of need, an economic strategy

of the undertaking should be adjusted to current economic conditions. Hence, trade mark non-use can not be justified by the need to uphold an earlier adopted plan of action. Otherwise, a much broader interpretation of the justifiable reasons for non-use would take place. And such an interpretation is unacceptable. However, it is not completely possible to eliminate such situations in which a reason describe above could be treated as justifiable due to its nature. It is understood in the sense that the given obstacle will not make it impossible to use the mark but will create a big threat to a proper, and economically rational exploitation of the trade mark. As an example, that will be the case if a given obstacle would force the trade mark proprietor, who would otherwise be selling the goods through his own sales network, to sell those goods through his competitors.<sup>1</sup>

With regard to the interpretation of the justifiable reasons for non-use of a trademark, according to Article 19 of the TRIPS Agreement, the reasons are circumstances arising independently from the will of the trade mark proprietor and which constitute an obstacle to the use of the trade mark. The economic (financial) difficulties that are encountered by the trade mark proprietor are not among these reasons. These circumstance are a part of the proprietor's own business risks.<sup>2</sup> Therefore, the proprietor's financial problems due to an economic recession or insolvency proceedings or temporary stoppage of production and trading activities are not considered to constitute proper reasons for non-use. They are a natural part of running a business.<sup>3</sup>

According to Article 19 of the TRIPS Agreement, such circumstance as import restrictions or other government requirements for goods or services protected by the trade mark are recognized as

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<sup>1</sup> ECJ's judgment in the "Häupl" case, cited previously. M. Trzebiatowski, *Obowiązek używania znaku towarowego – glosa ...*, pgs. 40-44.

<sup>2</sup> CFI's judgment in the "Giorgio Aire" case, cited previously.

<sup>3</sup> OHIM's decision of January 24, 2001, case no. 120/2001 – "Ercros".

justifiable reasons for non-use. In particular they amount to such government requirements as State monopolies or State prohibitions of the sale of goods for reasons of health or national defense. Other regulatory procedures which the owner has to pass before offering the relevant goods and services on the market are typical cases in this respect.<sup>4</sup>

Nevertheless, it has been pointed out that the time period in which a justifiable reason for non-use occurs shall be significant. If such obstacles only existed during a part of the five-year-period, this may not always be considered as justifiable reasons for non-use.<sup>5</sup>

## 9.2. Polish Practice

The significance of this issue has also been acknowledged by the Polish judiciary. Much emphasis has been put on this issue, which is evident in the long and elaborate reasons for judgments and decisions of the PO. It has been declared that proper reasons for non-use of a trade mark, which protect the trade mark from revocation, include most of all circumstances of an extraordinary character (nature), external, impossible to overcome, and also cases of *force majeure*. They can also include circumstance with regard to the situation of the trade mark proprietor. However, such circumstances every time have to arise independently of the will of the trade mark proprietors and have to objectively justify the use of a given mark. They include, for example, economic barriers with regard to a specific home industry. They do not, however, include such circumstances as conducting market research, which is to estimate the most profitable value of sales for the goods with the mark, and hence the resulting decision which is to be rationed by

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<sup>4</sup> OHIM's decision of June 27, 2001, case no. 1507/2001 – "Viadur".

<sup>5</sup> OHIM's decision of July 1, 1999, case no. 421/1999 – "Cerezyme".

economical reasons and a decision which suggests the time of the introduction of the good on the market should be delayed, so that the profit will be greatest.<sup>6</sup>

Based on those assumptions, it has been stated that the objective obstacle of lack of demand, which has been caused by higher production costs of the good than the manufacturing costs in the country of origin of the trade mark owner do not constitute proper reasons for non-use. To recognize such an obstacle as a justifiable reason for non-use, it is necessary for the trade mark proprietor to take actions to overcome such an obstacle. These have to especially include precautionary actions. A justifiable reason for non-use will suffice for the maintenance of the right from registration regardless of the non-use if all the actions, beyond any doubt, intended to commence the use of the trade mark in the required time period.<sup>7</sup>

It has been pointed out that an entrepreneur who applies for trade mark registration should be aware of the negative consequences of trade mark non-use in the period mentioned in the Law. He should have a precise plan with regard to the introduction of the good on the market. A lack of a valid reason for the commencement of this plan such as, for example, blockage of State boarders, must result in genuine use of the mark. This means that if such obstacles exist, the entrepreneur should be aware of them and should not apply for registration. However, if he applied for the registration in such circumstances, this suggests that he anticipated the fact that he will not introduce the good with the mark on the market in the required time period. Such a situation can not exonerate a rationally acting entrepreneur.<sup>8</sup>

In this respect, natural disasters or *force majeure* cases are sometimes negatively qualified with regard to justifications of non-

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<sup>6</sup> WSA's judgment in the "Eucerin" case, cited previously.

<sup>7</sup> WSA's judgment of August 10, 2004, case no. 6 II SA 1650/03 – "Paradies" (I) and PO's decision of March 2, 2006, case no. Sp. 124/05 – "Paradies".

<sup>8</sup> WSA's judgment in the "Apetito" case, cited previously.



use. This is especially the case with regard to fires in buildings. Against recognizing such circumstances as proper reasons for non-use not only is the meaning of the significance of the trade mark application date but also the fact that the proprietor was using different trade marks in the course of trade during the period covered by the revocation. First of all, based on the date of trade mark application, the proprietor could effortlessly evaluate the production capacity of the plant (building). The application occurred two years after the circumstance in question. Second, trade mark non-use was not caused by the simultaneous stoppage of business activity. According to the evidence submitted, the proprietor was still producing cigarettes affixed with different trade marks. Third, the use of the contested trade mark did not occur at that time period, after the trade mark registration, that is five years after the fire. Even if the intention for the trade mark application existed before the burning down of the plant, it is of no significance to the pertinent case outcome. Knowing the production capabilities of the plant at that time, the proprietor could have delayed the trade mark application, and hence avoid the results of the revocation of the trade mark's protection rights.<sup>9</sup>

Further expanding on this issue, it has been stated that the obstacles are usually associated with preparatory activities and result directly from them. Taking up such activities could justify non-use. It has been pointed out that these preparatory activities are only directed toward the commencement of use in the required time period. They are time consuming and do not bring any effects at the beginning. Therefore, not all such activities, taken from the perspective of time, can be sufficient to justify non-use. In particular, such actions as business correspondence with regard to offers of cooperation or participation in trade fairs in the country concerned, if this is not accompanied by intensified advertising in all available informational mediums or other activities which intend

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<sup>9</sup> PO's decision of November 30, 2005, case no. Sp. 26/05 – "Atut".

to "publicize" trade mark recognition, are not sufficient. In this case, obstacles such as extended negotiations or the lack of customers due to the high price of the goods, which prevents quick introduction of the good on the market, are not sufficient reasons. At the same time, it has been underlined that the obstacle of lack of demand cannot be a proper reason for non-use.<sup>10</sup>

Hence, a thesis has been formulated that regardless of the type of the proper reason for non-use, such a circumstance has to arise independently of the will of the trade mark proprietor every time. Circumstance that account for business risks do not constitute such obstacles. Such risks include, in particular, the failure of finding a co-producer of a particular good. The same applies to a fiasco in negotiations with sales chains. Business risks also involve a situation in which the market for the sale of vodka gets to be more and more competitive for alcohol producers. Such a circumstance has to be known to those producers. Besides this, new salesmen of new types of vodka still surface on the market. This proves that there is still room for new producers on this market.<sup>11</sup> Hence, the reasoning that the trade mark proprietor has financial difficulties in the alcohol industry due to the rise of excise taxes is even more so not a proper justification. Such a change and the encountered difficulties are directed towards all of the alcohol producers in Poland. At the same time, such rise in excise tax should mobilize those producers to embark on new and appropriate marketing activities. In such circumstances, these producers have to conduct their business activity in such a way as to diminish the effects of the unfavorable for them taxing decisions and they need to adapt to the changing market conditions. The lack of such actions is a subjective issue that is dependable on the proprietor himself.<sup>12</sup>

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<sup>10</sup> WSA's judgment in the "Scalextric" case, cited previously.

<sup>11</sup> Two WSA judgments in the "Lech-Pol" and "Mariusz Lech" cases, both cited previously.

<sup>12</sup> PO's decision of March 10, 2006, case no. Sp. 190/05 – "Sarmata".

Continuing in this direction, the specifics of the cosmetics industry, which entails a constant introduction of new cosmetics to satisfy the needs of the customers, are not proper reasons for non-use. This is so because those obstacles effect all of the cosmetic producers and result from the rules of the market which also impact all of them.<sup>13</sup>

The issues of justifiable reasons for non-use that have to be caused by extraordinary, unpredictable circumstances which can not be included in business risks have been very precisely explained. It has been stated that the mentioned circumstances can not be associated with a typical market reality and in particular with the existing market competition. Hence, as an example, price wars or the fall of consumption on the cigarettes market can not be considered such a circumstance. The existence of a black market, which involves the illegal import, and more precisely smuggling of cigarettes on the domestic market is also not considered such a circumstance. Those circumstances constitute subjective obstacles.<sup>14</sup>

Continuing this analysis, it has been stated that a justifiable reason for non-use of a mark for clothing can not include problems with regard to its import, such as customs fees, taxes or unreliable business partners.<sup>15</sup> However, they can include difficulties in acquiring required materials or credits. They can even include reasons that are the result of the proprietor's actions. All of those reasons have to be without guilt, including negligence. They are therefore taken into consideration if they were made by a reasonable entrepreneur. This type of circumstance occurs when, for example, due to extraordinary conditions there is a lack of materials that allow for the production of the good without the need to lower its existing high quality which is additionally justi-

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<sup>13</sup> PO's decision in the "Lady" case, cited previously.

<sup>14</sup> PO's decision of June 24, 2005, case no. Sp. 210/04 – "Moon" and of December 9, 2005, case no. Sp. 339/04 – "Etno".

<sup>15</sup> PO's decision of October 19, 2005, case no. Sp. 98/04 – "HandBud".

fied by the fact that such actions would diminish the reputation of the trade mark for this product.<sup>16</sup> A proper reason of non-use of a trade mark for goods in class 25 includes the conversion of an individually controlled undertaking into a capital partnership which takes several years and during which the entrepreneur is suffering financial difficulties due to a recession on the domestic clothing market and the announcement of import restrictions especially with regard to second-hand clothing. This is because these circumstances effect the condition of the business and its possibility to secure bank credits.<sup>17</sup>

An important justifiable reason for non-use of a trade mark is, for example, the change of radio frequency that is used in the trade mark, which is the effect of technical requirements, independent of the proprietor.<sup>18</sup>

Those obstacles do not however include long-term legislative works which effect the status of a given type of a trade mark. This is even more so not a proper reason for non-use if it was not proven that there is a connection between the given legislative works and the laws that are being amended and the current status of the protection right. This is especially the case when the regulation in question was not finally amended.<sup>19</sup>

Looking more precisely into the issue of subjective justifiable reasons for non-use of the trade mark, one can also find such obstacles as legal disputes with regard to patent invalidation. This is especially the case with regard to a legal dispute about a chemical substance which is the main ingredient of a pharmaceutical, where the name of that pharmaceutical will make up the trade mark. It is hence indifferent that the dispute does not regard the

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<sup>16</sup> NSA's judgment of June 15, 2005, case no. II GSK 84/05 – "Roxy Life".

<sup>17</sup> PO's decision of March 13, 2003, case no. Sp. 077/01 – "Diamond".

<sup>18</sup> NSA's and WSA's judgment in the "Eska" cases, both cited previously.

<sup>19</sup> PO's decision of January 9, 2006, case no. Sp. 85/05 – "500 Wódka produkowana ze spirytusu Polmosu".

trade mark itself. It is enough that the dispute is strictly connected to the issue of trade mark use. In this circumstance, the delay of the proprietor as to the use of the trade mark is justifiable because it is not due to his fault. A possible defeat in the dispute with regard to patent invalidation could make the introduction of that pharmaceutical with the mark economically without merit.<sup>20</sup> An analogical justification occurs when there is an ongoing dispute between the trade mark proprietor and its competitor with regard to the rights of the trade mark. It is then reasonable to delay the use of the mark.<sup>21</sup> However, the mere fact the rights of the proprietor have been infringed upon by a third person that is using the trade mark without the proprietor's authority is not a sufficient explanation.<sup>22</sup>

What is more, the change of the proprietor is not a proper reason for non-use. The revocation is directed toward the registration and not the proprietor. Furthermore, the assignment of rights from registration does not interrupt the non-use period. If that were the case, then each time there would be a change of the proprietor the right to the non-use period would begin from the day of the assignment of rights. It would make it impossible then to revoke a trade mark whose proprietors change frequently.<sup>23</sup> This means that the circumstance with regard to the assignment of registration rights cannot constitute justifiable reasons for non-use. This is because they are not independent of the will of the proprietor.<sup>24</sup>

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<sup>20</sup> PO's decision in the "Alerid" case, cited previously

<sup>21</sup> NSA's judgment of September 20, 2007, case no. II GSK 127/07 – "Cafe Pele", judgment of December 11, 2006, case no. VI SA/Wa 1571/06 – "Cafe Pele" and PO's decision of March 8, 2006, case no. Sp. 98/05 – "Cafe Pele".

<sup>22</sup> PO's decision in the "Cracovia" case, cited previously.

<sup>23</sup> NSA's judgment in "Roxy Life" case, cited previously. Similarly, the PO's decision in the "Etno" case, cited previously.

<sup>24</sup> PO's decision in the "Tele Top" case, cited previously.

The undertaking's insolvency does not, or at least not always, constitute justifiable reasons for non-use. This is the case when the proprietor did not submit documentation that would allow assessing from what date the given undertaking was going through insolvency proceedings. This is especially the case when from the documents of the case it could be concluded that in the beginning of the period when the commencement of the trade mark should happen the current proprietor has already signed assignment agreements for the sale of his undertaking. Even then the trade mark was not commenced into use. In such situations, there are grounds for the revocation of the trade mark protection rights.<sup>25</sup>

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<sup>25</sup> PO's decision of October 26, 2005, case no. Sp. 151/04 – "Delikatny".

## CHAPTER 10.

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# SANCTIONS FOR NON-USE OF A TRADE MARK

### 10.1. Community Practice

Taking into consideration the nature of the Directive regulations and also the content of those regulations with regard to obligatory trade mark use, the community courts confirm the rule that sanctions for non-use of a trade mark are dependable on the national laws and regulations. It has been pointed out that those sanctions can be complemented by the sanctions available on the basis of the unfair competition and civil laws' regulations.<sup>1</sup>

### 10.2. Polish Practice

With regard to sanctions for non-use, the domestic jurisprudence concentrates its attention on the effects of trade mark revocation due to non-use and especially the time extent of that effect. A rule has been formulated that the revocation of the trade mark occurs on the date of the decision of the trade mark registration, but the effects of that revocation might be established *a posteriori* from the date of the filing of the motion for revocation. It is required that on that day, and more precisely, up to the day of the revocation

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<sup>1</sup> ECJ's judgment of November 26, 1996, case no. C-313/94 – "Cotonelle".

decision, that the grounds for trade mark revocation have to exist. Hence, the decision of the revocation of trade mark rights has a *ex tunc* effect (see below).<sup>2</sup> The PO does not have the freedom to establish the revocation date. Only the applicant for revocation can effect the date of the revocation, since he can motion for revocation on the earliest date on which he has grounds for revocation.<sup>3</sup> Nevertheless, discontinuation of use is not an autonomous basis for revocation.<sup>4</sup>

It has been pointed out that the revocation should take effect from the date when the motion was filled, but the applicant can demand that it will be established even earlier. This can be at the furthest, the last date of the five-year-period counted from the beginning date of trade mark non-use. This means that a decision on this matter has a declaratory effect. The mere discontinuation of use is grounds for the loss of the right from registration. The revocation decision only confirms those circumstances, establishing the date of its occurrence.<sup>5</sup>

As a consequence, if a trade mark is not used for more than five years, then the five-year-period of non-use should not be counted back from the day of the motion of revocation. It should be counted from the actual date of discontinuation of use of the trade mark in the course of trade. And the end date of that five-year period is established by the revocation decision.<sup>6</sup>

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<sup>2</sup> WSA's judgment in the "Trybuna Ludu" case, cited previously.

<sup>3</sup> PO's decision in the "Sensor" case, cited previously.

<sup>4</sup> WSA's judgment in the "Red Bull" (I) case, and the NSA's judgment in the "Red Bull" (I) case, also the WSA's judgment in the "Poznańska Gorzka" case, all cited previously.

<sup>5</sup> Resolution of seven NSA judges of April 23, 2008, case no. II GPS 1/08 – the "Red Bull" (II) case and NSA's judgment in the "Chokella" case, cited previously. In part critically on the subject in: R. Skubisz, M. Trzebiatowski, *Glosa do uchwały Siedmiu Sędziów Naczelnego Sądu Administracyjnego z dnia 23 kwietnia 2008 r., II GPS 1/08*, OSP 1/2009, pos. 3.

<sup>6</sup> PO's decision in the "Vogue" case, cited previously and of September 12, 2008, case no. Sp. 220/08 – "Tornado".



## CHAPTER 11.

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# MEANS OF EVIDENCE IN NON-USE TRADE MARK CASES

### 11.1. Community Practice

This issue is widely commented in the community judicature with regard to the entire problem of obligatory trade mark use. The core assumption of this issue is that the evidence shall, in principle, be confined to the submission of supporting documents and material evidence. Those include: packages, labels, price lists, catalogues, invoices, photographs and newspaper advertisements. In addition, they can also include statements in writings, or sworn or affirmed statements or other statements that have a similar effect according to the law of the State in which they have been drawn up. This is understood as an authenticated promise made under a penal sanction for committing fraudulent declarations or false testimony. However, such a declaration can not be submitted as sole evidence. It should be affirmed by other "material" evidence. If the submitted statements are drawn up by the interested parties, they are generally considered as weak evidence. Such evidence is then not sufficient. This is also the case when such statements are accompanied by similar evidence, such as for example data about the use of the trade mark drawn up by the interested party itself.<sup>1</sup>

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<sup>1</sup> BoA's decision in the "Alamos/lamo" case, in the "Cifarma/Difarma" case and in the "Tiffany/Tifany" case, all cited previously.

Hence, such statements (declarations) as evidence are very thoroughly evaluated with regard to their probative value. They should be evaluated under the following criteria: their origin, drawn up circumstances, addressee and the logic and authenticity of their content.<sup>2</sup> Statements that do not contain any actual circumstance of trade mark use should be given no probative value. This specifically concerns the extent and frequency of use, volume of turnover or share of the market of the goods or services with the trade mark, which can be evaluated through the scope of advertising activities and the volume of expenses committed to promotional activities.<sup>3</sup> As a consequence, declarations can only be treated as supportive evidence or as affirmation of other submitted documentation, which include the manner, time, place and extent of genuine trade mark use. Otherwise it is only a mere declaration that needs to be substituted by authentic evidence.<sup>4</sup>

A sworn statement is not sufficient proof for the obligatory use of a trade mark, especially if it is to testify about the time and place of use and if it is to be the lone evidence for those circumstances, since it is impossible to determine any type of time or place of use of the goods with the mark from the additional documentation such as labels, price lists or catalogues.<sup>5</sup> This implies that any information provided in a statement needs to be verified by additional objective evidence. If a statement indicated that the use of the mark took place continuously for every year of the five-year-time period and the other evidence showed that the use took place

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<sup>2</sup> CFI's judgments in the "Solevita", "Manu", "Charlot" and "Capiro" cases, all cited previously and the judgment of December 15, 2005, case no. T-262/04 – "Bic".

<sup>3</sup> BoA's decision of June 17, 2004, case no. R 16/2004-1 – "Reporter".

<sup>4</sup> BoA's decision in the "Rossi/Sergio Rossi" case, cited previously.

<sup>5</sup> BoA's decision in the "Carlisle" case, cited previously, decision of July 29, 2002, case no. R 267/2000-2 – "Merc/Marc", of November 10, 2003, case no. R 951/2002-1 – "Sic/Sick", of January 29, 2003, case no. R 643/2000-1 – "Boss/Buss" and of February 28, 2003, case no. R 834/2000-1 – "Columbus".

in three and not succeeding years of the five-year-time period, then the shorter period of time should be regarded as time of use.<sup>6</sup>

Invoices have been acknowledged as the most significant, independent evidence for the proof of obligatory trade mark use. It has also been recognized that photos of goods, stickers, or badges as proof of genuine use are not usually sufficient. In particular circumstances, catalogues or price lists are sometimes sufficient to determine such use. However, in evaluating the probative value of such evidence, as with other materials, it is necessary to bear in mind the realistic relations that govern the industry or part of the market concerned, where the goods or services with the mark are offered. Hence, this evaluation has to occur from the level of expectancy of a well-informed, observant and reasonable consumer. Such an evaluation has to take into account all the circumstantial evidence, including the form of the goods or services and especially the place and method of offering. This indicates with regard to the mentioned catalogues, ad prospects or photographs that it is necessary to determine the date in which they were made or which they connote.<sup>7</sup>

It has been emphasized that evidence for the proof of genuine trade mark use should be very precise and solid. Such use should be proved by circumstances that are not only objective by also tangible. The evaluation of those circumstances should then be very comprehensive and free of any probabilities or assumptions.<sup>8</sup>

Obligatory trade mark use has not been satisfied, if for example, for a trade mark which is designated to identify the sale of cars,

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<sup>6</sup> CFI's judgment in "Deitech" case, cited previously.

<sup>7</sup> BoA's decision in the "Doc&Tors/Doctors" and "Merc/Marc" cases, cited previously, decision of February 27, 2002, case no. R 1164/2000-3 – "Thermal Vision/Thermovision", of March 6, 2002, case no. R 601/2001-3 – "It's a Wonderful Life/Life" and of November 27, 2002, case no. R 498/2001-3 – "TravelCard/Air Travel Card".

<sup>8</sup> CFI's judgments in the "Hiwatt", "Vitakraft", "Solevita", "La Mer" (II), "Sonia Rykiel" and "Deitech" cases, all cited previously.

the proof submitted are invoices, but none of them refers to the sale of cars but to expenses made for their advertisements and proposal prospects.<sup>9</sup> Similarly, it is not sufficient to prove obligatory trade mark use for a trade mark designated for almonds, by invoices submitted that show the sale of dried fruits in general under the given trade mark. This is even the case if those invoices are accompanied by packages which show the almonds and also their sale-by-date that is within the range of the five-year-period. The packaging with the date alone is not enough to prove that the good was put on the market.<sup>10</sup> Even more, shipping or customs documentation in which the trade mark has been mentioned but the name of the good which the trade mark indicates is not considered sufficient evidence.<sup>11</sup>

Even so, there is room left for some presumptions. As a rule, however, this is with regard to some very specific situations, when the facts of the case are gathered based on accumulation of several circumstances in connection to these facts and are documented by separate evidence. For example, it has been stated that the absence of the trade mark on the invoices cannot always deprive those invoices of their probative value as proof of genuine trade mark use. It is sufficient, for example, that instead of the given trade mark which is to identify the issuer, a "house" trade mark be placed, which is similar to that trade mark or includes that trade mark on those invoices. Since it is considered natural that the "house" trade mark identifies the issuer, the invoice only includes the names of the products which identify the goods themselves. Nonetheless, in such situations it is necessary to support those invoices by evidence that proves that those products on their packaging had the trade mark on them in the course of trade. Only with such evidence, accompanied by an invoice, is it possi-

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<sup>9</sup> OHIM's decision of November 30, 1999, case no. 1269/1999 – "Lupo".

<sup>10</sup> BoA's decision in the "Rio/Rio Bravo" case, cited previously.

<sup>11</sup> BoA's decision in the "Nevadent/Novodent" case, cited previously.

ble to determine that the good mentioned in the invoice was put on the market with that trade mark visible on the packaging in a given date, place, volume and by the issuer concerned.<sup>12</sup>

Furthermore, it is believed that placing information in the native language of the country where the good is to be sold and about the fact that the good was produced in that country on the packaging of that good implies that the good is directed for that domestic market.<sup>13</sup> Such an implication can also be made with regard to the information given in the native language in promotion brochures and catalogues. To allow such evidence, it is necessary to prove that such brochures or catalogues were made to convey the purpose of their distribution and not solely for advertisement.<sup>14</sup> It needs to be pointed out that such materials do not have to be necessary in the country's official language. Particularly, if the goods have special characteristic, then materials in foreign languages can be valuable in assessing their indication for the market of a country concerned. This is especially the case with respect to professional medical equipment. We must keep in mind that this type of equipment is handled by highly-professional medical staff, especially hospital staff who specializes in cardiology and that the English language is fundamental and dominant in that area of medicine, especially with regard to highly-advanced technically medical equipment. Furthermore, it should be understood that materials prepared in English were also intended for distribution in Finland. This is even more the case, considering that English is commonly known in Finland.<sup>15</sup>

However, it has been indicated that when in doubt, the pertinent presumption is without merit. This is exemplified in the following case. A trade mark was to be used in Austria and the

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<sup>12</sup> CFI's judgment in the "La Mer" (II) case, cited previously.

<sup>13</sup> BoA's decision in the "Hexacan/Cekacan" case, cited previously and of January 16, 2004, case no. R 196/2002-4 – "Tazza D'Oro/Piazza D'Oro".

<sup>14</sup> BoA's decision of July 16, 2003, case no. R 539/2002-1 – "Boss/Bos".

<sup>15</sup> CFI's judgment in the "Capiro" case, cited previously.

promotional materials and press-clippings were all in German but from all the other evidence, for instance, the trade mark's presence in fair trade was in Germany, so it was determined that the trade mark was only used on the German market.<sup>16</sup> All the more so, if a catalogue was prepared in another language at that time spoken by the pertinent consumers and the address of the producer and all other contact information was in foreign countries, then it should be determined that the good was not distributed among the domestic consumers.<sup>17</sup>

It is also believed that a catalogue alone only allows certain assumptions. It can authenticate the actual affixing of the good or service with the trade mark but it can not be considered proof for the actual fact of that affixation. Therefore, it can not be the only means of evidence for the proof of trade mark use. Such a catalogue does not indicate that the presented good was the subject of authentic distribution among the customers on the given market. It especially does not indicate that the good was sold on that market. The catalogue or the ad prospect alone does not even prove that it alone was distributed among the customers on the given market.<sup>18</sup>

Also, labels are not considered sufficient means of evidence with regard to genuine trade mark use. This is even the case when the information included on that label includes a probable time frame and place of use. Such information is not sufficient. The label alone does not provide any evidence of the extent of use.<sup>19</sup> For the same reason, photographs are also considered not to be

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<sup>16</sup> BoA's decision of June 18, 2003, case no. R 552/2001-2 – "Cryopak/Cryovac".

<sup>17</sup> CFI's judgment in the "Hiwatt" case, cited previously.

<sup>18</sup> CFI's judgments in the "Vitakraft" and "Deitech" cases, both cited previously and the BoA's decision of June 28, 2005, case no. R 641/2000-4 – "Silk Cocoon/Cocoon", of November 28, 2005, case no. R 434/2004-2 – "Direct Line/Linea Directa" and of December 15, 2004, case no. R 429/2004-1 – "Chicken Bag/Chicken-gar".

<sup>19</sup> CFI's judgment in the "Ba Baronnie" case, cited previously.

sufficient as proof of use. This is even the case if they are accompanied by additional documentation which shows the place of use, for example, trade fairs shown on the photographs.<sup>20</sup>

## 11.2. Polish Practice

Similar ideas have been expressed in Poland's practices. It has been stated that the fact of use has to be proven beyond any doubt. It has also been underlined that the burden of proof cannot be reversible. In particular, this is with regard to those circumstances when the applicant is required to clear up the evidence submitted by the trade mark proprietor.<sup>21</sup>

It has been argued that the trade mark proprietor can submit any type of means of evidence that will prove his use. He is not limited, for example, to submitting only official documentation.<sup>22</sup>

This does not change the rule that proof for genuine use has to be stable and clear. Three Xerox copies of documents that are not sworn and translated into Polish and further have no essential significance are not considered sufficient evidence. This is especially so if the photograph of the store is not legible, and it cannot be determined where it is from and what it is to prove. Furthermore, the additional press clippings in English only mention about the intent of the proprietor or persons that are associated with him to introduce the goods on the Polish market. Such documentation cannot be considered sufficient means of evidence to prove trade mark use.<sup>23</sup>

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<sup>20</sup> BoA's decision in the "Cryopak/Cryovac" case, cited previously.

<sup>21</sup> The WSA's and NSA's judgments in the "Montana" case, cited previously.

<sup>22</sup> NSA's judgment in the "Columbus" case, cited previously, WSA's judgment of May 13, 2005, case no. VI SA/Wa 2132/04 – "Columbus" (I) and PO's decision of September 3, 2004, case no. Sp. 253/03 – "Columbus".

<sup>23</sup> PO's decision of September 5, 2002, case no. Sp. 019/01 – "Gap".

Also, in this regard, it has been argued that the evidence should indicate genuine and serious trade mark use on the territory of Poland, hence press articles from foreign magazines cannot be considered sufficient evidence in such a case.<sup>24</sup>

Moreover, proof of use has to be objectively sufficient. An employee's statement which is not aided by any trade documentation cannot be considered objective evidence.<sup>25</sup> Even more the statements of the governing organs of the proprietor's undertaking, which are not supported by any invoices that show the volume of sales which is discussed in those statements is also not considered sufficient evidence.<sup>26</sup>

Hence, it has been indicated that some documents can not be at all considered as means of evidence for genuine trade mark use. This is with regard to, for example, health quality certificates of cosmetics. Such certificates only prove that the given cosmetics of a declared content, nature and way of use does not create a health hazard. They do not prove that the given cosmetic product was introduced on the market.<sup>27</sup>

Such an opinion is derived from the assumption that the proof of use has to be clear. It has to identify the good for which use is to be determined. If the evidence only presents the mark itself without the clear identification of the good, this is not sufficient to prove obligatory trade mark use.<sup>28</sup> For the same reasons, brochures or ad posters cannot be considered sufficient evidence.<sup>29</sup>

A folder or a catalogue without a clear publication date is also without merit with regard to the assessment of genuine trade mark

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<sup>24</sup> WSA's judgment in the "Apetito" case, cited previously.

<sup>25</sup> PO's decision in the "Toni-Dress" case, cited previously.

<sup>26</sup> WSA's judgment in the "Perrier" case, cited previously.

<sup>27</sup> PO's decision in the "Cleanic" case, and WSA's judgment in the "Cleanic" case, both cited previously.

<sup>28</sup> WSA's judgment in the "Helios" case, cited previously.

<sup>29</sup> PO's decisions of January 16, 2007, cases no. Sp. 551/05 and Sp. 552/05 – "Broadway" (II).



use. Such a publication date is necessary to determine when the good presented in those materials could be available on the market.<sup>30</sup> This is the same with regard to labels that do not show the date of use, placed on, for example, wine bottles.<sup>31</sup>

Hence, one comes to the conclusion that even an invoice-receipt for the sold good is only considered sufficient evidence when it includes data that allows for the identification of the good, its volume and date or time period in which it was sold.<sup>32</sup> If, for example, the invoice only indicated the trade mark by its name and it does not show the graphics in a word-figurative trade mark, then it cannot be considered sufficient evidence. This is especially the case when other submitted documentation such as sale offers, ad printouts or sales records do not even show the graphics of that trade mark.<sup>33</sup>

At the same time, it has been noticed that, for example, in case of a trade mark of a bottle for mineral water and non-alcoholic beverages, printouts from professional magazines that show pictures of store shelves with non-identifiable bottles, which also do not include any data about the volume of sales of that good cannot be considered as sufficient evidence. Neither can applications for contests directed towards restaurant businesses be regarded as sufficient evidence, if there is a lack of evidence that those businesses and the contest organizer have actually sold the goods with the given trade mark.<sup>34</sup>

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<sup>30</sup> PO's decision of March 30, 2007, case no. Sp. 548/06 – "Tartufo".

<sup>31</sup> PO's decision in the "Sierżant Kozak" case, cited previously.

<sup>32</sup> NSA's judgment in the "Columbus" case, cited previously, WSA's judgment in the "Columbus" (I) and "Cross" cases, both cited previously. Most favorably for the sufficiency of lone invoices in NSA's judgment in the "Botox" case, cited previously, rather favorably for such sufficiency in PO's decision of March 10, 2006, case no. Sp. 191/05 – "Ziemiańska".

<sup>33</sup> Two PO's decisions in the "Ondura" case, cited previously.

<sup>34</sup> WSA's judgment in the "Perrier" case, cited previously.

With regard to the rules described above, it can be deduced that means of evidence for the proof of genuine (actual) trade mark use have to be so precise and comprehensive that they allow for the evaluation of all circumstances that need to be taken into consideration while assessing genuine trade mark use. At the same time, an overall assessment of the evidence is necessary, also bearing in mind their interdependence with reference to all the necessary circumstances that have to be evaluated. Hence, in particular, genuine use cannot be determined if the submitted orders do not include the good which the trade mark covers. Also, it cannot be determined that a trade has been put to genuine use if the license agreement does not clearly indicate on which territory it is effective and to which goods it pertains. Moreover, a license agreement alone cannot constitute sufficient evidence for proof of use. Also, it is indifferent in such a situation that a statement has been made by an exclusive distributor of the goods indicating that the goods are available on the market. Such a statement cannot be evidence for the use of the trade mark. Ads in professional magazines play a similar role. They only indicate that marketing activities have taken place. They do not prove the volume of turnover of those goods. Furthermore, they refer to jewelry goods, not articles made of precious metals, designed for smokers on which the revocation was based. Also, the submitted picture of the good with the mark is of no importance with regard to the case at hand. Taking into account the nature of the goods, which include humidors, cigarette cases, snuff-boxes, mouthpieces and ashtrays made of precious metals and the nature of the market for those types of goods, the confrontation of the photograph with witness depositions can unequivocally determine that not a single good was sold on the territory of Poland during the contested period of time. Hence, the notion that there is no sufficient evidence proving trade mark use is valid. The notion is even more correct taking into consideration the fact that the humidor to which all the submitted evidence pertains is only one of the goods covered

by the revocation. Meanwhile, the proprietor of the trade mark did not show any other evidence for the proof of use with reference to the other goods.<sup>35</sup>

The requirement for precise assessment of evidence for the proof of trade mark use is demonstrated in the following examples. In particular, as one case shows, printouts from the Internet which indicate the number of products together with consumer comments with regard to only make-up remover wipes, refreshing wipes or wipes for personal hygiene do not constitute sufficient evidence to prove the use of cosmetics accessories on which the revocation was based. Hence, they cannot be included as evidence for the proof of use of the contested trade mark. Also, those printouts were from a later date than the time-period in question. Only the consumer comments were from the proper time-period. But they were with regard to moistening and refreshing wipes and wipes for children, and those goods were not covered by the revocation.<sup>36</sup>

In another example, after the analysis of evidence, it was determined that the proof was only with reference to shoes and not to clothing. Meanwhile, the revocation was based on a larger category of goods not only included in class 25 but also in class 3 and 18. Therefore, non-use constituted for the mentioned goods in class 2, 8 and 25. At the same time, it was established that only with reference to shoes the trade mark was put to genuine use. The gathered documentation, in particular including invoices and contractor's statements, printouts of the picture of the shoes affixed with the mark and advertisement materials, print ads in a quarterly magazine dedicated to leather goods, promo bags with the mark printed on them, when looked at as a whole, showed that the contested trade mark was put to use in the pertinent time-period with regard to shoes. The invoices, even though they

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<sup>35</sup> Two PO decisions in the "Faberge" case, cited previously.

<sup>36</sup> PO decision in the "Cleanic" case, cited previously.

did not have the trade mark on them, constituted sufficient proof. This was because the evidence also included statements of those entrepreneurs' whose signatures appeared on the invoices. These invoices raised no doubts and confirmed that the bought goods were affixed with the contested and not other mark.<sup>37</sup>

The method of genuine trade mark assessment is very well illustrated by the case of "Lerros Collection". In this case, invoices made up the core of the evidence. The trade mark in question was placed in the heading of the invoices and not on the list of the goods. Nevertheless, the PO did not agree with the opinion that on those invoices the mark was not used in accordance with its function but as a name of the program that was used for creating the invoices. The placing of the mark in the heading of the invoice and not on the list of the products does not change the fact that the invoice is also with regard to those products. It should be assumed that due to technical reasons and the general practice of invoicing, the mark was not placed directly next to the good. This fact is also supported by other submitted evidence. These include labels, price tags and other tags with the trade mark used to identify clothing goods. They do not directly include information about the production date but in practice such information is not placed on any type of tags. At the same time, the production date was determined through the statements of the tags' producers. They confirmed that in the time in question they delivered such types of products to the proprietor, so that he could place them on the clothing. This is also affirmed by orders made that indicate the number of seals and paper labels. It should be mentioned that the labels, tags, bags, hangers, and seals alone used for clothing goods or photographs of stores are sometimes not sufficient to prove the use of a trade mark. This is because they alone can not demonstrate the extent of use. However, by assessing all of the evidence gathered based on common sense and knowledge, one should assume that they constitute sufficient

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<sup>37</sup> PO's decision in the "Broadway" (I) case, cited previously.

evidence that shows that the clothing goods were introduced onto the Polish market. This is because it would be hard to believe that any entrepreneur would buy such accessories as labels, tags, hangers, bags and seal made for clothing goods for any other reason than to put them on the market with the clothing in question. The evidence of a woman's two-piece suit produced by the proprietor and affixed with those tags and labels was very significant in this case. Even if it was a fact that the suit originated with the proprietor and was not contested during the proceedings. It was noticed that this suit even if submitted in larger volumes did not prove that the contested mark was put to genuine and actual use. It is hard to agree with such a statement, especially in the light of the submitted proprietor's financial documentation. It includes more than a dozen invoices that prove that those pieces of clothing were used in the course of trade. The submitted one suit was to be an example of that product and the manner in which the labels and tags with the mark were affixed on it. Therefore, there was no need to show several hundred pieces of clothing that would prove the volume of turnover. The submitted invoices unequivocally prove that the clothing with the mark was used in a course of trade in a continuous manner and sold in a sufficient volume. It is worth mentioning that to constitute that the mark was put to genuine and actual use it is not necessary to establish the total number of the produced and introduced by the proprietor pieces of the good (i.e. 400). These mentioned means of evidence support the general thesis introduced in the judicial doctrine that only the correct combination of various means of evidence submitted by the proprietor can constitute genuine use of a mark. The evidence gather in this case, even if only partially assessed, allows to constitute that the contested mark was put to genuine use.<sup>38</sup>

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<sup>38</sup> PO's decision of January 12, 2006, case no. Sp. 30/05 – "Lerros Collection" and WSA's judgment of November 16, 2006, case no. VI SA/Wa 1195/06 – "Lerros Collection", not that categorically this time.



## CONCLUSIONS

The presented case-studies most of all illustrate the complexity of the issues with regard to obligatory trade mark use. Even if this presentation was limited to the most essential part of the problem at hand (see Introduction), it should be stated that the number of issues involved is significant. This is due to the fact that the major topics, such as the concept of obligatory trade mark use, forms of use and the extent of use necessary to fulfill the requirement of use enclose several separate issues.

The listed community and Polish judgments also show that many of the issues with regard to obligatory trade mark use cause difficulties in establishing conclusive findings. As a rule, with regard to these issues, the administrative organs are left some room for their own interpretations. This is particularly with regard to the proper extent of use of a trade mark, the issue of goods (or services) for which the trade mark is to be used or the required form of the mark used and also with regard to the justifiable reasons for non-use. It should be mentioned that those difficulties also arise with regard to other issues, equally essential as those mentioned above. This is with regard to the forms of obligatory trade mark use and more precisely concerning the nature of use. This is clearly evident in the newest judgments of the ECJ, including the "Radetzky" and "Silberquelle" cases. These judgments have, in a sense, started a new discussion about the

topic of obligatory trade mark use. This is because they have attempted for the first time to tackle issues that so far have been discussed in the area of general trade mark law and are hence of essential importance, and now have been analyzed with regard to obligatory trade mark use. This is also visible in the domestic practice. This is evident not only through the Supreme Administrative Court judgment in the "Red Bull" case but also in the judgment in the "Chockella" case. Even if those judgments tackle issues that address both material and procedural aspects of obligatory trade mark use, in this regard all of those judgments show that most of the interpretation difficulties with regard to the issue at hand arise from the elementary problems of trade mark law.

It should also be noticed that many aspects of the problem at hand have not been yet clarified. This is especially the case with regard to the domestic practice. And this is not solely the issue of aspects that have not been discussed in judgments, but it is with regard to those issues that have been discussed in judgments but their findings were not complete or final.

The aspect of "repeated" trade marks, meaning a trade mark that has been again applied for registration when the same trade mark is already registered only to maintain the registration of that trade mark since it is being or it will be revoked due to non-use, is the first group of such issues. This is because it is not clear if such an application and precisely under what conditions it would be deemed effective and free of bad faith. Similar doubts can be directed towards the possibility of revoking an (earlier) trade mark due to non-use, where that trade mark is already the basis for the revocation of another (later) trade mark also due to non-use.

The possibility of bringing up such claims against infringement charges and invalidity of procedures can be derived from the regulations of the PWP. Even more, the notion of bring up such claims if the five-time-year period has not yet terminated before the infringement charges or invalidity procedures were brought up but termination during these proceedings is very debatable. This



issue has not been covered by the PWP's regulations. Up until this moment there have been no cases that would allow for a clear explanation of the premises for the maintenance of registration rights which are included in Article 170 of the PWP. Hence, it is unclear, how to understand this, keeping in mind the concept of preparations for use of a trade mark and also the concept of "acquiring" knowledge by the proprietor about the possibility of filing the notion of revocation against his trade mark.<sup>1</sup>

The second group of aspects specifically includes the possibility of satisfying the requirements of use by the use of the trade mark on the Internet. The judgments that have been given in this regard are so far of a very initial and general nature. Same situation applies with regard to fulfilling the requirement of use through service trade marks. Another aspect is the effects of retroactive decisions with regard to the date of revocation of rights. With that regard, it can not be stated definitively if it is the Patent Office that automatically makes that decision when non-use was determined before the contested five-year period. Furthermore, it has not been decided if such a request should be precise and final and included in the motion for revocation. Most of all, it is unclear if such a retroactive effect can be with regard to any earlier and continuous five-year period, meaning also a period after which the trade mark was put to genuine use and then again the use was terminated for another five years.<sup>2</sup>

It seems that the issue of satisfying the requirements of trade mark use by the use of well-known trade marks or trade marks with reputation has also been not fully or finally resolved. Similarly, the aspects of fulfilling obligatory use by the use of a mark by third persons on behalf of the proprietor also have to be further

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<sup>1</sup> Further on those aspects see M. Trzebiatowski, *Obowiązek używania znaku towarowego. Studium...*, previously cited, pgs. 350, 351-358, 435-437, 442-443, 497-498 and 521-525.

<sup>2</sup> More precisely on this subject R. Skubisz, M. Trzebiatowski, *Glosa do uchwały...*, previously cited.

discussed and determined. A certain discrepancy in the opinions of the courts can be noticed in this regard. At the same time, these opinions do not discuss the necessity of an express consent of the proprietor for the use, where the use should be explicit within the norms of the consent. The situation is similar with regard to the criteria for introducing the good with the mark to the market. Also, in these cases, there is a lack of coherency in the findings of the courts, including the community courts. Similar discrepancies could be found in other specific aspects of the problem at hand. Among these are questions with regard to the length of the time-period within the five-year time period that allows the fulfillment of the requirement of use. The question of use which the product has to occur in each year of the five-year time period, within most of those years or is one year enough. Also, those type of specific problems can be very significant with regard to the concept of genuine (serious) trade mark use.<sup>3</sup>

Keeping in mind the above-mentioned status of judicature with regard to the scope and degree of complicity of these issues, it can be anticipated that this case-law will be developing surely and steadily but with some probable difficulty. Hence, it seems necessary to comprehensively assemble the findings of the courts with regard to obligatory trade mark use, including a comparison between Polish and community findings. This was the notion that motivated this compilation at hand. Such compilations should also be continuously updated and supplemented by new commentaries also taking into consideration the findings of the courts of other EU member states.

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<sup>3</sup> Further on these aspects see M. Trzebiatowski, *Obowiązek używania znaku towarowego. Studium...*, cited previously, pgs. 60-63, 141-145, 151-157, 255-268 and 345-347.

# APPENDIX

## ACTS of LAW

### PART I. Community Law

1. Directive to Approximate the Laws of the Member States  
Relating to Trade Marks (2008/95)

#### Point 5 of the Preamble

In order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation. It is necessary to provide that a trade mark cannot be invalidated on the basis of the existence of a non-used earlier trade mark, while the Member States should remain free to apply the same principle in respect of the registration of a trade mark or to provide that a trade mark may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the trade mark could be revoked. In all these cases it is up to the Member States to establish the applicable rules of procedure.

#### Article 5 (3)

The following, inter alia, may be prohibited under paragraphs 1 and 2:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under the sign;
- (d) using the sign on business papers and in advertising.

### Article 10

#### *Use of trade marks*

1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the sanctions provided for in this Directive, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first subparagraph:

(a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

(b) affixing of the trade mark to goods or to the packaging thereof in the Member State concerned solely for export purposes.

2. Use of the trade mark with the consent of the proprietor or by any person who has authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor.

3. In relation to trade marks registered before the date of entry into force in the Member State concerned of the provisions necessary to comply with Directive 89/104/EEC:

(a) where a provision in force prior to that date attached sanctions to non-use of a trade mark during an uninterrupted period, the relevant period of five years mentioned in the first subparagraph of paragraph 1 shall be deemed to have begun to run at the same time as any period of non-use which is already running at that date;

(b) where there was no use provision in force prior to that date, the periods of five years mentioned in the first subparagraph of paragraph 1 shall be deemed to run from that date at the earliest.

### Article 11

#### *Sanctions for non-use of a trade mark in legal or administrative proceedings*

1. A trade mark may not be declared invalid on the ground that there is an earlier conflicting trade mark if the latter does not fulfil the requirements of use set out in Article 10(1) and (2), or in Article 10(3), as the case may be.

2. Any Member State may provide that registration of a trade mark may not be refused on the ground that there is an earlier conflicting trade mark if the latter does not fulfil the requirements of use set out in Article 10(1) and (2) or in Article 10(3), as the case may be.

3. Without prejudice to the application of Article 12, where a counter-claim for revocation is made, any Member State may provide that a trade mark may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the trade mark could be revoked pursuant to Article 12(1).

4. If the earlier trade mark has been used in relation to part only of the goods or services for which it is registered, it shall, for purposes of applying paragraphs 1, 2 and 3, be deemed to be registered in respect only of that part of the goods or services.

### Article 12 (1)

#### *Grounds for revocation*

1. A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

However, no person may claim that the proprietor's rights in a trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trade mark has been started or resumed.

The commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the continuous period of five years of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.

Article 13

Grounds for refusal or revocation or invalidity relating to only some of the goods or services

Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

2. Regulation on the Community Trade Mark (207/2009)

Motive 10 of the Preamble

There is no justification for protecting Community trade marks or, as against them, any trade mark which has been registered before them, except where the trade marks are actually used

Title II. THE LAW RELATING TO TRADE MARKS

Section 2. Effects of Community Trade Marks

Article 9 (2)

The following, inter alia, may be prohibited under paragraph 1:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under that sign;
- (d) using the sign on business papers and in advertising.

Section 3. Use of Community Trade Marks

Article 15

Use of Community trade marks

1. If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which

it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first subparagraph:

(a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

(b) affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes.

2. Use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

#### TITLE IV. REGISTRATION PROCEDURE

##### Section 4. Observations by Third Parties and Opposition

###### Article 42 (2), (3) and (5)

2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

5. If examination of the opposition reveals that the trade mark may not be registered in respect of some or all of the goods or services for

which the Community trade mark application has been made, the application shall be refused in respect of those goods or services. Otherwise the opposition shall be rejected.

## Title VI. SURRENDER, REVOCATION AND INVALIDITY

### Section 2. Grounds for Revocation

#### Article 51 (1)(a) and (2)

1. The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;

2. Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.

### Section 4. Consequences of Revocation and Invalidity

#### Article 55 (1)

The Community trade mark shall be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in this Regulation, to the extent that the rights of the



proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

#### Section 5. Proceedings in the Office in Relation to Revocation or Invalidity

##### Article 57 (2), (3) and (5)

2. If the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been registered for not less than five years, the proprietor of the earlier Community trade mark shall furnish proof that, in addition, the conditions contained in Article 42(2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

5. If the examination of the application for revocation of rights or for a declaration of invalidity reveals that the trade mark should not have been registered in respect of some or all of the goods or services for which it is registered, the rights of the proprietor of the Community trade mark shall be revoked or it shall be declared invalid in respect of those goods or services. Otherwise the application for revocation of rights or for a declaration of invalidity shall be rejected.

## PART II. International Law

### 1. Paris Convention for the Protection of Industrial Property (1883)

#### Article 5 (C) (1) and (2)

(1) If, in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.

(2) Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.

### 2. AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (1994)

#### Art. 19

##### *Requirement of Use*

1. If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions or other government requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use.

2. When subject to the control of its owner, use of a trademark by another person shall be recognized as use of the trademark for the purpose of maintaining the registration.

### **PART III. Polish Law**

#### Industrial Property Law (2000)

#### Title III. Trademarks, Geographical Indications

#### Part I. Trademarks and Rights of Protection

#### Chapter 5. Rights of Protection for Trademarks

##### Article 154

The use of a trademark shall consist of:

(i) affixing the trademark to the goods covered by the registration or to the packaging thereof and offering and putting the goods on the market, importing or exporting them and storing them in order to offer them and putting them on the market and also offering or rendering services designated by the trademark.

(ii) using the trademark on business documents handled in putting the goods on the market or in rendering services,

(iii) using the trademark in advertising.

##### Article 157

The proprietor of a trademark registration shall not be entitled to prohibit a third party from using that mark or a mark similar thereto in the course of trade, if he has refrained from using that mark within the meaning of Article 169(1)(i), (4) and (5).

#### Chapter 6.

#### Invalidation and Revocation of The Right of Protection for a Trademark

##### Article 166

1. The right of protection for a trademark may not be invalidated on a sole ground that the trademark is similar to an earlier trademark, where the latter has not been used within the meaning of Article 169(1)(i), (4) and (5).

2. In the case referred to in paragraph (1), an exception of non-use of the trademark may only be raised when accompanied by a request for declaring the right of protection to be revoked. The exception shall be liable to examination jointly with the request for invalidation.

Article 169 (1)(1) and (3-6)

The right of protection for a trademark shall be revoked:

(i) on failure to put to genuine use of the registered trademark for the goods covered by the registration for a period of five successive years after the date of the decision on granting registration, unless serious reasons of non-use thereof exist,

[...]

3. The General Public Prosecutor of the Republic of Poland or the President of the Patent Office may, in the public interest, request that a right of protection for a trademark be revoked or may intervene in an action already pending.

4. Use of a trademark within the meaning of paragraph (1) shall also mean the use of a mark:

(i) in a form varying in elements which do not alter the distinctive character of the mark in the form for which the right of protection has been granted,

(ii) by affixing the mark to goods or the packaging thereof solely for export purposes,

(iii) by a third party with the proprietor's consent,

(iv) by a party authorized to use the collective trademark or the collective guarantee trademark.

5. Use of a trademark in advertising of the product, which is neither available on the market nor is manufactured in the country for export purposes shall not be deemed to constitute genuine use.

6. Where a proceeding for declaring the right of protection to be revoked is initiated, the burden of proof that the trademark has been used or that serious reasons for non-use of the trademark exist shall be on the proprietor of the right of protection.

Article 170(1-3)

1. Subject to paragraph (2), the Patent Office shall dismiss a request for declaring the right of protection revoked in the case referred to in

Article 169(1)(i), if before the submission of the request genuine use of the mark has started or has been resumed.

2. Start or resumption of the use of the trademark after the expiration of an uninterrupted period of five successive years of non-use and within a period of three months preceding the submission of the request for declaring the right of protection revoked, shall be disregarded, if preparations for the start or resumption of the use have been undertaken immediately after the proprietor became aware of possible submission of such request

3. Paragraphs (1) and (2) shall apply accordingly in the cases referred to in Article 169(7).

#### Article 171

Where the reason for the revocation of the right of protection for a trademark involves only certain goods, the revocation of the right shall be effective only in respect to these goods.

#### Article 172

Subject to Article 170, a right of protection for a trademark shall be revoked at a date of the occurrence of the event, which is considered under this Law as giving rise to the revocation of the right of protection. The date of the revocation of the right of protection shall be confirmed in a decision.

