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PROTECTION OF A REPUTED TRADEMARK
NOTES IN LIGHT OF THE JUDGEMENT I CSK 778/15
OF THE SUPREME COURT

In the judgement addressed by the presented gloss, the Supreme Court made an interpretation of two crucial issues connected with the protection of the Community trademarks¹ and the scope of their protection. The first one concerns the scope of protection of a trademark consisting of a colour *per se*. The other issue concerns the difference between the content of art. 296 para. 2 point 3 of the Polish Industrial Property Law² and Article 9(1), point (c)³ of Regulation 207/2009⁴ regarding

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¹ Currently, the Community trademark is subject to Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trademark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trademark, and repealing Commission Regulation (EC) No 2868/95 on the fees payable to the Office for Harmonization in the Internal Market (trademarks and designs).

² Act of 30 June 2000 (Industrial Property Law), Journal of Laws of 2017, item 776 [hereafter IPL].

³ Article 9 was amended by Article 1, point (11) of Regulation (EU) 2015/2424 of 16 December, 2015, OJ L 342, 24.12.2015, p. 21, amending the regulation on March 23, 2016; now it has been superseded by Article 9(2), point (c).

⁴ Currently, this is Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trademark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trademark, and repealing Commission Regulation (EC) No 2868/95 on the fees payable to the Office for Harmonization in the Internal Market (trademarks and designs). The question at hand is regulated by Article 9(2), point (c).

protection of reputed trademarks. The gloss will discuss the second issue since it underscores differences between the Polish and the EU legal system and has a great deal of relevance for proceedings concerning infringement of reputed trademarks, especially the scope and possibility of adducing evidence.

The issue considered by the Supreme Court involved the difference between the content of art. 296 para. 2 point 3 IPL and Article 9(1), point (c) of Regulation 207/2009, both dealing with the protection of reputed trademarks. First, we need to indicate the scope of protection attributed to reputed trademarks. Under Polish legislation, these marks have a shorter history than those under French law, for example, because the creation of this sign has been typical for states which have had a free market economy.⁵ The question of defining the notion of reputed trademarks has often been addressed by the EU law.⁶ It is argued that when a good reputation is beneficial, it can be taken advantage of by a third party who attempts to operate on the coat-tails of the mark with a repute, exploiting its power of attraction, reputation and prestige. It is debatable whether the notion of a reputed trademark should be identified with prestige, quality and luxury,⁷ since it is claimed that reputation stems from a bundle of “positive ideas customers have about products and services associated with a particular entity,”⁸ or whether a reputed trademark constitutes an equivalent of a sign known only to a section of the public but distributed over a major part of a territory.⁹ If we look at dictionary definitions of the notion “reputed”, we see that the idea of good name is emphasised to indicated something which

⁵ M. BOHACZEWSKI, “Pojęcie znaku towarowego powszechnie znanego oraz renomowanego na tle code de la propriété intellectuelle oraz ustawy – Prawo własności przemysłowej,” *Przegląd Prawa Handlowego* 11 (2012): 38.

⁶ Judgement of the European Court of Justice dated June 18, 2008 (L’Oréal SA et al.), case C-487/07, Reports of Cases 2009 I-5185; see also M. NAMYSŁOWSKA, *Glosa do wyroku TS z dnia 18 czerwca 2009 r., C-487*, LEX; M. KULIKOWSKA, “Ochrona renomowanego znaku towarowego w prawie wspólnotowym – na podstawie orzecznictwa ETS,” *Glosa* 2 (2009): 99.

⁷ See, for example, a judgement of the Supreme Court dated February 19, 2009, file ref. no. II CSK 541/08, LEX no. 500147; a judgement of the Supreme Court dated March 7, 2007, file ref. no. II CSK 428/06, LEX no. 278685; a judgement of the Supreme Administrative Court dated February 27, 2008, file ref. no. II GSK 359/07, retrieved from www.orzeczenia.nsa.gov.pl; BOHACZEWSKI, *Pojęcie znaku*, 33; W. KATNER, “Komentarz do art. 551,” in *Kodeks Cywilny. Część Ogólna*, ed. M. Pyziak-Szafnicka and P. Księżak (Warsaw: Wydawnictwo C.H. Beck, 2014), 587.

⁸ J. MARCINKOWSKA and S. STANISŁAWSKA-KLOC, “Ochrona oznaczeń indywidualizujących wykorzystywanych w adresach internetowych – wybrane zagadnienia,” in *Internet 2000. Prawo – Ekonomia – Kultura*, ed. R. Skubisz (Lublin: Verba, 2000), 25.

⁹ See a judgement of the European Court of Justice dated September 14, 1999 (CHEVY), case C-375/97, Reports of Cases 1999 I-5421, point 25; R. SKUBISZ, “Kolizja późniejszego znaku towarowego z wcześniejszym renomowanym znakiem towarowym. Glosa do wyroku TS z dnia 27 listopada 2008r., C-252/07,” *Europejski Przegląd Sądowy* 2 (2009): 33–38.

is “established thanks to its good name, praised, famous,”¹⁰ “renown, popularity, fame,”¹¹ “known from the good side, popular,”¹² “recognized and successful,”¹³ “branded, recognized.”¹⁴

A reputed trademark is becoming a sign of a symbol or quality identified with specific prestige.¹⁵ At present, a valid tendency is demonstrated in the Polish literature of the subject¹⁶ and partially in jurisprudence¹⁷ that reputed trademarks should not be identified with luxury goods. This approach is an essential consideration when the reputation of a trademark and the degree of its infringement is appraised. “Renown, reputation, trust in the trademark is a value in itself.”¹⁸ “A trademark with a repute is one which symbolises proven quality of a product. The circle of buyers in whose opinion the trademark has gained a good reputation for this reason is not a decisive factor.”¹⁹ It is also an indisputable fact that reputation constitutes a personal right of an undertaking, just like the good name of a natural person, so it can serve as an intangible asset.²⁰ In J. Piotrowska’s view, an appraisal of a trademark’s reputation entails

¹⁰ Pol. *ustalony dobrym imieniem, chwalony, sławny*, as defined by M. ARCT, *Słownik wyrazów obcych* (Warsaw: M. Arct, 1913), 855.

¹¹ Pol. *rozgłos, wziętość, sława*, as defined by W. DOROSZEWSKI, *Słownik Poprawnej Polszczyzny* (Warsaw: Państwowe Wydawnictwo Naukowe, 1980), 631.

¹² Pol. *znany z dobrej strony, wzięty*, as defined by J. TOKARSKI, *Słownik Wyrazów Obcych PWN* (Warsaw: Państwowe Wydawnictwo Naukowe, 1980), 640.

¹³ Pol. *cieszący się uznaniem, powodzeniem*, as defined by W. GŁUCH, *Słownik Wyrazów Obcych* (Wrocław: Europa, 2002), 508.

¹⁴ Pol. *markowy, uznany*, as defined by *Słownik Synonimów* (Warsaw: Państwowe Wydawnictwo Naukowe, 2007), 282; M. SZYMCZAK, *Słownik Języka Polskiego* (Warsaw: Państwowe Wydawnictwo Naukowe, 1989), 3:44.

¹⁵ R. SKUBISZ, “Naruszenie prawa z rejestracji renomowanych znaków towarowych (w świetle dyrektywy o znakach towarowych),” in *Współczesne wyzwana europejskiej przestrzeni prawnej. Księga pamiątkowa dla uczczenia 70. urodzin Profesora Eugeniusza Pionka*, ed. A. ŁAZOWSKI and R. OSTRIHANSKY (Kraków: Zakamycze, 2005), 429.

¹⁶ IDEM, “Glosa do wyroku Naczelnego Sądu Administracyjnego z dnia 27 lutego 2008 r., II GSK 359/07,” *Przegląd Sądowy* 4 (2009): 143; M. KUBIAK, “Komentarz do art. 296,” in *Prawo własności przemysłowej. Komentarz*, ed. A. Michałak (Warsaw: Wydawnictwo C.H. Beck, 2016), 821; A. TISCHNER, “Komentarz do art. 296,” in *Prawo własności przemysłowej. Komentarz*, ed. Piotr Kostański, 1397–1427 (Warsaw: Wydawnictwo C.H. Beck, 2014), 1419.

¹⁷ Judgement of the Supreme Court dated March 4, 2009, file ref. no. IV CSK 335/08, OSNC-ZD 2009, no. 3, item 85. A different interpretation can be found in a judgement of the Supreme Court dated February 10, 2011, file ref. no. IV CSK 393/10, OSN 2011, no. 11, item 127.

¹⁸ J. PIOTROWSKA, “Renomowany znak towarowy. Analiza pojęcia, formy naruszenia interesu uprawnionego, ochrona w prawie polskim,” in *Naruszenia praw na dobrach niematerialnych*, ed. T. Szymanek (Warsaw: Polska Izba Rzeczników Patentowych, 2001), 115.

¹⁹ A. SZEWC, “Przedmioty własności przemysłowej (przedmioty ochrony),” in *Prawo własności przemysłowej*, by A. SZEWC and G. Jyż (Warsaw: Wydawnictwo C.H. Beck, 2011), 124–25.

²⁰ J. DOMINOWSKA, “Naruszenie renomy przedsiębiorcy przez nieuprawnione korzystanie z jego oznaczeń indywidualizujących,” *Państwo i Prawo* 7 (2013): 68.

analysis of several aspects: market share, scope and durability of an advertisement of products marked with a particular sign; area and duration of trademark use; licences granted for the use of a trademark; quality of marked goods; value of a particular marking in the opinions of independent financial institutions; distribution of outlays made with respect to the promotion of a trademark; price relation to substitute goods; and whether (and to what extent) a trademark is used by third parties.²¹

As regards a reputed trademark, it is particularly important that apart from the traditional functions of a trademark, such as an advertising or distinguishing role or one signifying quality, it is emphasised that a reputed trademark also has an “investment” function. In a judgement of the European Court of Justice dated September 14, 1999, it is argued that an appraisal of repute should also take into account the “scale of investments made by an undertaking for its promotion.”²² The market position of reputed trademarks is special – they “stimulate the high sales of goods or services particularly well. Besides information that is inherent in every trademark, it conveys all kinds of signals and provokes emotions and associations that are beneficial for goods bearing this designation. For this reason, the market value of such goods can sometimes be very high.”²³ A trademark acquires its repute as a result of long-term efforts and investments made by the owner.²⁴ Reference to the protection of reputed trademarks is made by both art. 296 para. 2 point 3 IPL and Article 9(1), points (b) and (c), as well as Article 9(2), point (c) of Council Regulation (EC) No 207/2009, amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council.

Pursuant to art. 296 para. 2 point 3 IPL, an infringement of the right of protection for a trademark involves an unlawful use of an identical sign or a sign which is similar to the reputed trademark registered for any kind of goods, if such use can bring undue advantage to the user or be detrimental to the distinctive character or the repute of the earlier trademark. This article is applied for “«attacks» on registered trademarks going beyond the scope of product similarity.”²⁵ As underscored in the doctrine, this article takes into account the very likelihood of a real threat occurring, but a demonstration of the result is not necessary.²⁶ The degree of simi-

²¹ J. PIOTROWSKA, *Renomowane znaki towarowe i ich ochrona* (Warsaw: Wydawnictwo C.H. Beck, 2001), 74.

²² Case C-375/97, ECLI:EU:C:1999:408.

²³ R. SKUBISZ, “Czerpanie nienależnych korzyści z charakteru odróżniającego lub renomy znaku towarowego,” in *Abiit, non obiit. Księga poświęcona pamięci Księdza Profesora Antoniego Kościa SVD*, ed. A. Dębiński, T. Barankiewicz, and W. Sz. Staszewski (Lublin: Wydawnictwo KUL, 2013), 1287.

²⁴ Judgement of the General Court (Fourth Chamber) of 22 May 2012, Case T-570/10, ECLI:EU:T:2012:250.

²⁵ TISCHNER, “Komentarz do art. 296,” 1418.

²⁶ KUBIAK, “Komentarz do art. 296,” 820.

larity between trademarks referred to in this article is low since merely an allusion to an earlier trademark, association or just a connection with it would suffice.²⁷ As a result, the scope of protection granted to a reputed trademark is wider than the protection against confusion in respect of other trademarks. This is justified by the great value of reputed trademarks.²⁸

This phenomenon often occurs in the circulation of similar trademarks and “involves taking advantage of the reputation, parasitism, dilution of a trademark, transferring negative emotions onto a reputed trademark in the case when products with similar marking are of worse quality”²⁹ or when the so-called “free riding” occurs, whose purpose is to take advantage of the reputation earned by a reputed trademark.³⁰ Drawing on the doctrine and EU case law, A. Tischner distinguishes three cases where the use of a trademark can:

- a) give rise to unfair advantage gained from the distinctive character of the mark or
- b) cause harm to its distinguishing capacity, or
- c) infringe the good repute of the trademark by weakening, eroding or diluting it.³¹

At the same time, when analysing EU case law, the author argues that if a reputed trademark is infringed, one has to “demonstrate a change in the market behaviour of an average consumer brought on by the use of the latter trademark, or high probability that such a change will occur.”³² A similar position is presented by R. Skubisz, who claims that there must be a mental link between the change and the infringement of the trademark.³³ Nonetheless, the likelihood of a link arising between the designation of a third party and a reputed trademark is not sufficient.³⁴ In accordance with the EU case law, owing to the assignment of the representation of an earlier trademark or qualities it represents to products labelled with an identical or similar later trademark, we deal with an obvious exploitation of the repute of a trademark.³⁵

The criteria enumerated in art. 296 para. 2 point 2 IPL were defined in a judge-

²⁷ G. TYLEC, “Komentarz do art. 296,” in *Prawo własności przemysłowej. Komentarz*, by T. Demen-decki, A. Niewęglowski, J.J. Sitko, J. Szczotka, and G. Tylec (Warsaw: Wolters Kluwer, 2015), 1169.

²⁸ TISCHNER, “Komentarz do art. 296,” 1418.

²⁹ KUBIAK, “Komentarz do art. 296,” 820.

³⁰ See a judgement of the General Court dated July 6, 2012 (ROYAL SHAKESPEARE), Case T-60/10, ECLI:EU:T:2012:348.

³¹ See TISCHNER, “Komentarz do art. 296,” 1423.

³² *Ibid.*

³³ SKUBISZ, “Czerpanie nienależytych korzyści,” 1288.

³⁴ *Ibid.*, 1295.

³⁵ Judgement of the Court of Justice of 18 June 2009 (L’Oreal), case C-487/07, Reports of Cases 2009 I-5185, point 41; Judgement of the General Court of 7 December 2010 (Nute Partecipazioni SpA and La Perla Srlv. v Worldgem Brands Srl), case T-59/08 point 40, ECLI:EU:T:2010:500.

ment of the Supreme Court dated February 10, 2011, expressing the opinion that for the above-mentioned appraisal, what matters is the very possibility of gaining an unfair advantage by the user or being detrimental to the distinctive character or repute of the earlier trademark rather than gaining these benefits or actions infringing the trademark's repute.³⁶ What is at stake here is a criterion of hypothetical character, namely whether the mere possibility of taking unfair advantage³⁷ or damage to the distinctive character of a trademark is enough.³⁸ As underscored by the Court of Appeal in Wrocław in its judgement of October 3, 2007 – unlike in the case of non-reputed trademarks – in respect of reputed trademarks the criterion of applying the provision of art. 296 para. 2 point 3 IPL is not the likelihood of confusion arising but merely the possibility of another trademark being associated with the reputed trademark registered earlier, causing that the former trademark will attract customers via positive images conveyed by the reputed trademark. Simultaneously, it should be noted that an association between trademarks occurs when the marking used by the infringing party invokes the reputed trademark used originally by the lawful possessor in a potential customer even if that recipient is aware of complete independence of both entities. When the confronted trademarks are used simultaneously for marking similar products, it is not necessary to invoke any additional criteria.³⁹

A different view but consistent with the EU law is expressed in this regard by the Court of Appeal in Warsaw in its judgement dated April 6, 2011, saying that good reputation is not a value in itself, therefore with regard to protection of a reputed trademark granted by art. 296 para. 2 point 3 IPL we should also say that the use of another (similar) trademark brought the infringer undue advantage, there was a possibility of gaining it, the use itself was detrimental, or there arose the possibility of detrimental impact on the distinctive character or repute of the earlier trademark. These criteria have a normative and hypothetical character. An assertion that the subsequent use of another trademark has or may have a detrimental effect on the distinctive character of a reputed trademark calls for a demonstration of a changed

³⁶ Judgement of the Supreme Court dated February 10, 2011, file ref. no. IV CSK 393/10, OSNC 2011/11/127, in *Biuletyn Sądu Najwyższego* 2011, no. 5, item 13–14; Judgement of the Supreme Court dated February 22, 2007, file ref. no. III CSK 300/06, OSNC 2008, no. 1, item 11; Judgement of the Supreme Court dated July 5, 2012, file ref. no. IV CSK 23/12, OSP 2013, no. 708, item 79.

³⁷ Similarly in the judgement of the Supreme Court dated August 10, 2006, file ref. no. V CSK 237/06, LEX no. 201179; Judgement of the Supreme Court dated November 24, 2009, file ref. no. V CSK 71/09, LEX no. 627240.

³⁸ Judgement of the Supreme Court dated February 5, 2010, file ref. no. III CSK 120/09, LEX no. 585820.

³⁹ Judgement of the Court of Appeal in Wrocław dated October 3, 2007, file ref. no. I Aca 767/07, LEX no. 519252.

market behaviour of an average consumer of goods for which this earlier trademark has already been registered – a change resulting from the use of the later trademark or a real likelihood that such a change will occur in the future.⁴⁰

In view of the above, even if a trademark is not registered or its registration in a particular territory respects the rule of speciality,⁴¹ this does not deprive trademark of protection. These designations can be protected pursuant to the unfair competition law and the provisions of the Civil Code. This is particularly important in respect of the use of certain signs as trademarks. However, the most difficult task is to demonstrate the repute of a mark.⁴²

If we look at the content of Directive 2008/95, it should be noted that this provision does not have an obligatory character for the Member States, yet it has been implemented as is by the majority of them.⁴³ Art. 5 para. 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks,⁴⁴ which was repealed on November 28, 2008, provides that “any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.” An analogical regulation can be seen in Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks.⁴⁵ Art. 5 para. 2 provides that any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trademark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due reason constitutes an unfair use of its distinctive character or the repute or is detrimental

⁴⁰ Judgement of the Court of Appeal in Warsaw dated April 6, 2011, file ref. no. I Aca 866/10, Warsaw jurisdiction 2011/3/22.

⁴¹ For more on the rule of speciality, see J. BUCHALSKA, “Zasada specjalności ograniczająca prawo z rejestracji wzoru przemysłowego,” *Przegląd Prawa Handlowego* 6 (2014): 46–52.

⁴² See the judgement of the Provincial Administrative Court in Warsaw, dated May 22, 2014, file ref. no. VI SA/Wa 3168/13, retrieved from www.orzeczenia.nsa.gov.pl.

⁴³ E. SKRZYDŁO-TEFELSKA, “Renomowany znak towarowy,” in *Własność przemysłowa. Orzecznictwo z komentarzami*, ed. R. Skubisz (Warsaw: Wolters Kluwer, 2008), 611.

⁴⁴ OJ L 40, 11.2.89, p.1 [hereafter Directive 89/1004].

⁴⁵ OJ L 299, 8.11.2008, p. 25 [hereafter Directive 2008/95].

to it. Simultaneously, Article 10(2), point (c) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 15 December 2015 to approximate the laws of the Member States relating to trade marks,⁴⁶ which is scheduled to enter into force on January 15, 2019, provides that without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where the sign is identical with or similar to the trade mark regardless if it is used in relation to goods or services which are identical, similar or dissimilar to those for which the trademark is registered and if it has good reputation in a particular Member State and the use of this marking without due reason brings undue advantage or is detrimental to the distinctive character or the repute of the trademark.

Article 5(2) of Directive 2008/95 mentions detriment arising or taking unfair advantage. Therefore, a broader interpretation of the said provision is recommended, especially with regard to evidentiary proceedings, whose role is to demonstrate the possibility of causing damage.⁴⁷ It should be said that for an appraisal of a reputed trademark it is essential to demonstrate merely that relevant section of the public recognize it.⁴⁸

This position is also backed by the European case law. In its judgement dated September 14, 1999,⁴⁹ the Court of Justice determined how the provision of Article 5(2) of Directive 2008/95 should be interpreted, indicating that this article, in contrast to Article 5(1), required that the public have some knowledge of the earlier trademark: "It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trademark, may possibly make an association between the two trademarks, even when used for non-similar products or services, and that the earlier trademark may consequently be damaged. [...] If, at the end of its examination, the national court decides that the condition as to the existence of a reputation is fulfilled, as regards both the public concerned and the

⁴⁶ OJ L 336, 23.12.2015, p.1 [hereafter Directive 2015/2436].

⁴⁷ Similarly in SKUBISZ, *Naruszenie prawa ochronnego*, 1123.

⁴⁸ See Judgement of the Supreme Court dated March, 2009, file ref. no. IV CSK 335/08, OSNC-ZD 2009, no. 3, item 85; Judgement of the Supreme Court dated February 22, 2007, file ref. no. III CSK 323/06, LEX no. 274219; Judgement of the Supreme Court dated February 22, 2007, file ref. no. III CSK 300/06, OSNC 2008, no. 1, item 11. A different interpretation can be found in K. SIKORSKI, *Glosa do wyroku Sądu Najwyższego z dnia 22 lutego 2007 r., III CSK 323/06*, LEX; K. DOBIEŻYŃSKI, *Glosa do wyroku Sądu Najwyższego z dnia 22 lutego 2007 r., III CSK 300/06*, OSNC no. 1/2008, item 11; SKUBISZ, *Czerpanie nienależnych korzyści*, 1286–97.

⁴⁹ Case C-375/97.

territory in question, it must then go on to examine the second condition laid down in Article 5(2) of the Directive, which is that the earlier trademark must be detrimentally affected without due cause. Here it should be observed that the stronger the earlier mark's distinctive character and reputation, the easier it will be to accept that detriment has been caused to it."⁵⁰

Differences between a comparison of a reputed trademark and an ordinary mark were highlighted in the judgement of the Court of Justice dated October 2003,⁵¹ whereby "the protection conferred by Article 5(2) of the Directive [89/104] is not conditional on a finding of a degree of similarity between the mark with a reputation and the sign such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark. [...] Unlike Article 5(1)(b) of the Directive, which is designed to apply only if there exists a likelihood of confusion on the part of the public, Article 5(2) of the Directive establishes, for the benefit of trademarks with a reputation, a form of protection whose implementation does not require the existence of such a likelihood."

An analogical finding was presented by the judgement of the Court of Justice of November 27, 2008.⁵² In the judgement, mainly the investment character of a reputed trademark was examined as well as its impact on competition. In the Court's opinion, that served as both protection of interests of the proprietor of the reputed trademark and reconciliation of these interests with the interest of the public, which would not permit its dominant market position to be undermined. Following *Skubisz*, three aspects can be pointed out when an assessment of a trademark infringement is made. "Firstly, it is necessary to prove the existence of a mental link (association) between a registered trademark with a reputation and a third party's sign [...]. Secondly, the criterion of harming the distinctive character of a reputed trademark is fulfilled when the market position of this trademark has been undermined. Lastly, the proprietor bears the burden of proof regarding all – except for reasonable grounds (proper reasons) for the use of the later trademark – criteria of infringement of the law resulting from the registration of a trademark. If no evidence can be adduced by the proprietor, negative consequences should be expected."⁵³

⁵⁰ Compare the judgement of the General Court of 26 September, Case T-301/09 (*CITIGATE*), OJ C 343, 10.11.2012, p. 17.

⁵¹ Case C-408/01.

⁵² Case C-252/07 (*Intel*), ECLI:EU:C:2008:655.

⁵³ *SKUBISZ, Kolidzja późniejszego znaku towarowego*, 37.

The main element in the assessment of a trademark infringement is an appraisal of its effect.⁵⁴

As regards the difference between the Polish and EU regulations, Skubisz presents a clear view. The EU regulations concerning comparison between a reputed trademark and a sign which infringes reputation use the indicative mode, saying that “its use constitutes an unlawful exploitation of its distinctive character.” In contrast, Polish regulations refer to modality – “the use of this marking can bring unfair advantage to the user or be detrimental to the distinctive character or the repute of the earlier trademark.” “The said discrepancies are important for the application of law. Undoubtedly, it is easier to show the possibility (likelihood) of a certain behaviour than to prove that such a behaviour is already happening. This could even lead to the conclusion that Article 5(2) of the Directive was not properly transposed to Polish law.”⁵⁵

In this context, the author makes reference to EU legislation, mainly to the discrepancy in the linguistic layer between Article 4(4), point (a) and Article 5(2) of the Directive 2008/95. The judgement of the Court dated June 18, 2009, demonstrated that the use of a sign which is identical with or similar to registered marking without due reason [...] gives rise or can give rise to unfair advantage taken of the distinctive character or the repute of that trademark.⁵⁶

The considerations presented above are rounded up by Skubisz, who says that “in light of the judgement in the L’Oreal case the regulation of art. 296 para. 2 point 3 IPL should be evaluated, since it provides that one criterion of an infringement is the possibility of taking undue advantage of the distinctive character or repute of a trademark. The position of the Court manifested by the judgement confirms the compatibility of the article with Article 5(2) of the Directive, despite its rather unfortunate wording. When requesting protection, the proprietor of a reputed trademark should submit evidence enabling a *prima facie* confirmation of the existence of a real threat of gaining undue advantage of the repute or distinctive character of his trademark.”⁵⁷ When discussing the idea of evidentiary procedure and

⁵⁴ See A. TISCHNER, *Odpowiedzialność majątkowa za naruszenie prawa do znaku towarowego* (Warsaw: Wolters Kluwer, 2008), 42.

⁵⁵ SKUBISZ, “Czerpanie nienależytych korzyści,” 1288. See IDEM, „Ingerencja w prawo ochronne na renomowanym znaku towarowym; brak uzasadnionego powodu używania znaku,” in *Prawo własności przemysłowej*, ed. R. Skubisz, vol. 14 B of *System prawa prywatnego* (Warsaw: Wydawnictwo C.H. Beck, 2012), 1123.

⁵⁶ Judgement of the Court (First Chamber) of 18 June 2009 (L’Oréal SA et al.), Case C-487/07, ECLI:EU:C:2009:378.

⁵⁷ SKUBISZ, *Czerpanie nienależytych korzyści*, 1290–91. See SKUBISZ, “Naruszenie prawa z rejestracji,” 452–53.

art. 6 of the Civil Code, Skubisz argues that “if the proprietor adduces evidence for the existence of these criteria, the burden of proof gets transferred and the defendant is obliged to demonstrate the existence of reasonable grounds to use the said marking.”⁵⁸

The content of art. 296 para. 2 point 3 IPL is especially significant with respect to a reputed trademark. A comparison of this norm with Article 5(2) of Directive 2008/95 suggests that in accordance with the Polish legislation addressing trademark infringements, the possibility of unfair advantage or detriment is considered. The different content of art. 296 para. 2 point 3 IPL is due to the fact that Directive 89/104 (and the following) made it possible for the Member States to better protect trademark proprietors.⁵⁹

As regards Regulation No 207/2009, it must be remarked that neither the Polish literature of the subject or doctrine contains any interpretation of Article 9(1), point (c) and Article 8(5) of this Regulation. Therefore, for the sake of our argument we may find some jurisprudential opinions useful. Two criteria are treated as equivalent (referred to in Article 9(1), point (c), and Article 8(5) of Regulation 207/2009) yet they are not assigned a different character although they are invoked at a different stage – submission or infringement of a Community (now EU) trademark.⁶⁰ Foreign literature, on the other hand, stresses that Article 8(5) refers to the distinctive character of a trademark, while Article 9(1), point (c) addresses the “investment” function of a reputed trademark, which is to be “compensated” against its wider protection.⁶¹

It should be clearly stated that both the doctrine and jurisprudence emphasise that trademarks are protected only against the likelihood of confusion, so the mere association of trademarks is not sufficient to define the scope of protection.⁶² As regards reputed trademarks, we can speak of an infringement also where a mere association is established between a reputed trademark and a later mark. As a result,

⁵⁸ IDEM, *Ingerencja w prawo ochronne*, 1129.

⁵⁹ See Judgement of the Court (Sixth Chamber) of 9 January 2003, Case C-292/00 (Davidoff et al.), ECLI:EU:C:2003:9.

⁶⁰ Compare, for example, Judgement of the Court of Justice of October 18, 2005 (Class International), Case C-405/03, ECLI:EU:C:2005:616; Judgement of the Court of the First Instance (First Chamber) of 6 February 2007 (Aktieselskabet af 21. november 2001), Case T-477/04, ECLI:EU:T:2007:35.

⁶¹ C. HOWELL, “Intel: a mark of distinction?” *European Intellectual Property Review* 11 (2007): 442; Judgement of the Court of Justice of 18 June 2009 (L’Oreal SA), Case C-487/07, ECLI:EU:C:2009:378.

⁶² PIOTROWSKA, *Renomowane znaki towarowe*, 78; K. SZTOBRYN, *Glosa do wyroku TS z dnia 2 września 2010 r., C-254/09 P*, LEX.

a better knowledge of a reputed trademark can increase the risk of confusion in the context of connection between the marks.⁶³

Reference to an interpretation of Article 9(1), point (c) of the Regulation was made only by the Court of Justice in its judgement of July 18, 2013, while examining the likelihood of confusion when a colour was used which was similar to a registered trademark. This question was formulated as follows: “should Article 9(1), points (b) and (c) of Regulation 207/2009 be interpreted in such a way that the fact that a third party using marking which is alleged to infringe the rights to a registered trademark is associated by a large portion of the public with a specific colour or combination of colours, used for this marking, constitutes a significant factor in a comprehensive appraisal of the likelihood of confusion or undue advantage within the meaning of this provision?” In the Court’s opinion, the very fact that Asda is associated with green – a colour used by this company for signs which are alleged to infringe the rights to Specsavers trademarks – could in particular result in a reduced likelihood of confusion or association of these markings with the signs of the Specsavers group because the relevant section of the public might assume that the green colour used in them is characteristic for Asda. In the Court’s view, since Article 9(1), points (b) and (c) of Regulation 207/2009 should be interpreted in such a way that the fact that a third party using marking which is alleged to infringe the rights to a registered trademark is associated by a large section of the public with a specific colour or a combination thereof, used for this marking, constitutes a factor in a comprehensive appraisal of the likelihood of confusion or undue advantage within the meaning of this provision.⁶⁴

In a judgement issued on May 10, 2012, the Court of Justice reasoned that the proprietor of an earlier trademark is not obliged to prove that an actual and lasting infringement of his trademark occurred within the meaning of Article 8(5) of the said regulation. When it can be predicted that such a violation will result from the manner in which the later trademark will be used (acceptable to the trademark proprietor), the owner of the earlier trademark cannot be obliged to await such an

⁶³ M. SIERADZKA, “Czerpanie nienależnej korzyści z renomy wcześniejszego znaku towarowego,” *Gdańskie Studia Prawnicze – Przegląd Orzecznictwa* 3 (2012): 143; Judgement of the Court of the First Instance of 22 October 2003, *Les Éditions Albert René v OHIM – Trucco sistemi di telecomunicazione SpA (STARIX)*, Case T-67/04 (trademarks and designs), ECLI:EU:T:2003:280; a judgement in the case T-185/07 (*CK CREACIONES KENNYA*); Judgement of the Court (First Chamber) of 6 July 2012 (*ROYAL SHAKESPEARE*), Case T-60/10, ECLI:EU:T:2012:348.

⁶⁴ Judgement of the Court (Third Chamber) of 18 July 2013 – *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd, Specsavers Optical Superstores Ltd v Asda Stores Ltd*, Case C-252/12, ECLI:EU:C:2013:497.

infringement to occur in order to forbid the said use. Furthermore, the Court argued that the proprietor of the earlier mark should nonetheless demonstrate the circumstances suggesting a high probability of such an occurrence in the future. The owner of the earlier trademark is not obliged to prove the existence of an actual and lasting infringement of his trademark, but he has to present evidence so that the existence of a real future threat of taking unfair advantage of the repute or distinctive character of his trademark or a conduct which will harm it can be demonstrated *prima facie*, assuming that such a demonstration can be made by way of deduction involving a probability analysis and considering practices acceptable in a particular trade sector as well as other circumstances of a given case.”⁶⁵

A direct reference (though based on the earlier Regulation 40/94) was made to the issue in question by the General Court in its judgement dated May 19, 2011,⁶⁶ whereby it should be made clear that the proprietor of an earlier trademark does not have to demonstrate the existence of an actual and ongoing infringement of his trademark. He should, nonetheless, present evidence to validate a future but non-hypothetical likelihood of gaining unfair advantage or detriment.⁶⁷ In the opinion of Advocate General Paolo Mengozzi, it is essential that the owner of an earlier trademark adduce evidence that the use of a later sign or trademark “causes” an unfair advantage taken of the distinctive character or repute of the earlier trademark or it is detrimental to them.” To this end, he is obliged to substantiate not the existence of an actual and current infringement but rather to “furnish evidence of a strong likelihood of such an infringement occurring in the future.” If such evidence is adduced, the proprietor of the later sign should demonstrate that he has a good reason to use this sign.⁶⁸ As highlighted in a judgement of the Court dated November 14, 2013, Regulation No 207/2009 and its case law do not call for evidence of real damage

⁶⁵ Judgement of the Court (First Chamber) of 10 May 2012 – Helena Rubinstein SNC and L’Oréal SA v OHIM – Allergan Inc., Case C-100/11 P, ECLI:EU:C:2012:285, point 93; see Judgement of the Court of the First Instance (Fifth Chamber) of 22 March 2007 – SIGLA SA v OHIM – Elleni Holding BV (VIPS), Case T-215/03, ECLI:EU:T:2007:93, points 36–42, and the case law cited there; Judgement of the General Court (First Chamber) of 6 July 2012 – Jackson International v OHIM – Royal Shakespeare (ROYAL SHAKESPEARE), Case T-60/10, ECLI:EU:T:2012:348.

⁶⁶ Case T-580/08, ECLI:EU:T:2011:227.

⁶⁷ See K. SZTOBRYN, *Glosa do wyroku S(PI) z dnia 19 maja 2011 r., T-580/08*, published in LEX, together with the case law cited there, i.e. Judgement of the Court of 27 November 2008 – Intel Corporation Inc. v CPM United Kingdom Ltd, Case C-252/07, ECLI:EU:C:2008:655, point 71. See also Judgement of the Court of First Instance (Fifth Chamber) of 25 March 2009 – L’Oréal v OHIM – Spa Monopole (SPALINE), Case T-21/07, ECLI:EU:T:2009:80; similarly, see the opinion of Advocate General E. Sharpston presented in the case of Intel Corporation, point 84.

⁶⁸ Opinion of Advocate General Paolo Mengozzi delivered on 16 February 2012 on Case C-100/11 P (Helena Rubinstein SNC and L’Oréal SA v OHIM), ECLI:EU:C:2012:95.

but they even allow for a real likelihood of such detriment, permitting the use of deduction.⁶⁹ A presentation of a likely detriment cannot be limited merely to indicating an Internet link (correlation) between the signs.⁷⁰ The existence of a relation between services labelled with conflicting trademarks is not sufficient; nor does it have a determining character. Obviously, the presence of this link increases the likelihood that recipients, when confronted with a registered trademark, will think of an earlier trademark, but this circumstance in itself is not sufficient to lessen the power of attraction of the earlier trademark. This will happen only when it is demonstrated that the services labelled with the registered trademark show features or properties which can potentially harm the reputation of the earlier trademark.⁷¹ However, this effect is more likely if there has been a family of trademarks in the market.⁷²

In a judgement of the Court of the First Instance dated May 25, 2005, it was declared that taking unfair advantage of the distinctive character or the repute of an earlier trademark should be deemed to include cases of actual exploitation and the utilisation of a famous trademark or an attempt at taking advantage of its reputation. The Court argued that it was not demonstrated that the SPA-FINDERS trademark permitted its proprietor to take undue advantage of the distinctive character or repute of an earlier SPA trademark, because no evidence whatsoever had been furnished in connection with the likelihood of exploitation and use of the SPA trademark or in connection with an attempt at taking advantage of its reputation. It should be emphasised that this case concerned entirely different trademarks – mineral water and tourist publications and office.⁷³

It is not necessary, however, to prove that in the case of an earlier reputed trademark and a registered trademark, in the opinion of a particular section of the public, there is likelihood of confusion. If the degree of similarity is sufficiently high, it will be enough to make a section of the public believe that there is a connection between the two. The existence of such a connection should be assessed globally, with all relevant factors considered in a particular case. As regards comparison of signs in

⁶⁹ Judgement of the Court (Fifth Chamber) of 14 November 2013 – Environmental Manufacturing LLP v OHIM – Société Elmar Wolf, Case C-383/12 P, ECLI:EU:C:2013:741.

⁷⁰ Point 47 of Judgement of the General Court (Sixth Chamber) of 29 March 2012 – Poslovni Sistem Mercator v OHIM – Mercator Multihull (MERCATOR STUDIOS), Case T-417/09, ECLI:EU:T:2012:174.

⁷¹ Judgement of the Court of the First Instance (Fifth Chamber) of 22 March 2007 – SIGLA SA v OHIM – Elleni Holding BV (VIPS), Case T-215/03, ECLI:EU:T:2007:93.

⁷² Judgement of the General Court (Fifth Chamber) of 26 September – IG Communications Ltd v OHIM – Citigroup and Citibank (CITIGATE), Case T-301/09, OJ C 343, 10.11.2012, p. 17.

⁷³ Judgement of the Court of the First Instance (Second Chamber) of 25 May 2005 (SPA-FINDERS), Case T-67/04, ECLI:EU:T:2005:179.

respect of visual, phonetic or conceptual similarities between trademarks, it should be based on an overall impression evoked by these signs, focusing on the distinctive and dominating elements.⁷⁴

Therefore, the Supreme Court reasoned in the judgement the presented gloss is⁷⁵ that despite differences in the content of the provisions regulating registration or declaration of invalidity their purpose is to protect reputed trademarks. This standpoint was also invoked by the European Court of Justice in the Intel Corporation case. Therefore, the Supreme Court, referring to the above-mentioned case law, rightly argued that regulations included in art. 296 para. 2 point 3 IPL should be addressed by analogy to Article 8(5) and Article 9(1), point (c) of Regulation No 207/2009. In the body of EU cases, it is explicitly stated that “ordinary” trademarks are protected only against the likelihood of confusion. As regards reputed trademarks, we can speak of an infringement also where a mere association is established between a reputed trademark and a later mark. This more comprehensive kind of protection of trademarks is intended to reconcile the investment function with the possibility of placing other similar marks on the market. As a result, a better knowledge of a reputed trademark can increase the risk of confusion in the context of an association made between the marks. For further proceedings in our case, it will be essential that the proprietor of the earlier trademark be under no obligation to demonstrate the occurrence of an actual and lasting infringement of his trademark. He should, nonetheless, present evidence to validate a future but non-hypothetical likelihood of gaining unfair advantage or detriment. This evidence is to confirm that the use of the later sign or trademark “causes an unfair advantage to be taken of the distinctive character or repute of the earlier trademark or is detrimental to them.” In view of the above, not only the existence of a real and current sign which can cause an infringement should be proved, but also circumstances which are very likely to give rise to such an infringement in the future and which can be appraised using deduction.

⁷⁴ Judgement of the Court of the First Instance (Second Chamber) of 14 October 2009 (TiMi KiNDERJOGHURT), Case T-140/08; Judgement of the Court of the First Instance (First Chamber) of 16 April 2008, Case T-181/05; judgements of the Court dated: November 27, 2008, (Intel Corporation), Case C-252/07, ECLI:EU:C:2008:655, point 42; March 12, 2009 (Antarctica), Case C-320/07 P, ECLI:EU:C:2009:146, point 45; a decision in the case of Japan Tobacco v OHIM, point 26; Judgement of the General Court (Fifth Chamber) of 26 September 2012 (Citigroup et al.), Case T-301/09, ECLI:EU:T:2012:473.

⁷⁵ Judgement of the Supreme Court dated February 2, 2017, file ref. no. I CSK 778/15, LEX no. 2297410.

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PROTECTION OF A REPUTED TRADEMARK. NOTES
IN LIGHT OF THE JUDGEMENT I CSK 778/15 OF THE SUPREME COURT

Summary

The article seeks to demonstrate differences between Polish and EU regulations concerning the infringement of reputed trademarks, in particular in light of a comparison of the concept of likelihood of confusion and that of association made between reputed trademarks. The basis for this article was the judgement of the Supreme Court of 2 February 2017, I CSK 778/15.

Key words: trademark; reputed trademark; colour *per se*.

Translated by Tomasz Pałkowski



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