

The Trademark Lawyer

Issue 3 2017

GLOBAL REACH, LOCAL KNOWLEDGE

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Welcome to Barcelona!

It's time for the 139th INTA annual meeting,
and with that comes our annual bumper edition



CTC Legal Media

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Continent Focus: In honor of the INTA annual meeting, we've focused closely on European trademark law by citing articles from more than seven different European countries.



- Trademark registration in Mozambique
- Opposition system in Poland
- Canadian litigation
- Platform technology
- Domain names in Russia
- Indian litigation
- Trademark squatting

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Klaudia Błach-Morysinska

Letters of consent and the new opposition system

Klaudia Błach-Morysinska from Zaborski, Morysinski Law Office, here with a jurisdictional update, gives insight to the latest amendments to the Polish Industrial Property Law.

Crucial amendments to the Polish Industrial Property Law concerning the changes in the procedure of obtaining protection rights for a trademark were implemented at the end of 2015 and on 15 April 2016. The first of them refers to the letter of consent, which was not accepted before the amendment. The second – more revolutionary – refers to the change of the trademark registration proceeding from the examination system to the opposition system.

The examination system and letters of consent

Until 14 April 2016, the Polish Patent Office (further: PPO) examined relative grounds for refusal *ex officio*. The PPO's experts examined whether the applied trademark is not identical or similar to any prior trademarks and refused protection where a risk arose that the public may, in particular, be misled into thinking that a trademark may be associated with an earlier trademark. If the expert decided that the applied trademark was identical or confusingly similar to the earlier applications or registrations, the provisional refusal of protection was issued. The applicant could present its statement to defend the application. Based on the argumentation the PPO's

expert took a decision as to whether the trademark should be registered or the protection should be refused.

It should be noted that until 1 December 2015 it was not possible to file a letter of consent to the PPO, as they were not accepted. This practice was justified by consumer protection and had nothing common with business protection. It caused many ridiculous situations where for example the EUTM of the mother company was cited against the Polish application of its affiliates. There were situations where the amicable existing market operators became the parties to a dispute before the PPO, caused by the PPO's provisional refusal of protection.

After the amendment effective as of 1 December 2015, **letters of consent** were accepted to successfully challenge the provisional refusal of protection. As a result of this change, it is now possible to obtain the registration of an identical or similar trademark if the owner of the earlier trademark agrees thereto in writing. It should be underlined that according to the PPO's interpretation, this new rule would apply only to the trademarks applied for after 1 December 2015. For trademarks filed before that date, the letter of consent would not be accepted.

New opposition system

As of 15 April 2016, a change was made in the procedure for granting trademark protection rights in Poland. The **examination system** was changed **into the opposition system**, which diametrically changed the trademark application proceeding. The full examination system was changed into the opposition system with no *ex officio* examination of the relative grounds for refusal. Now, the owner of the earlier trademark must monitor the trademarks database and react by filing an opposition against the trademarks that, in their opinion, are similar and misleading to their earlier trademarks.

The new registration procedure may be divided into the following steps:

1. Formal examination – once filed, the PPO will examine the trademark application only in terms of formal issues. At the same time, the application will be published in the PPO official database.

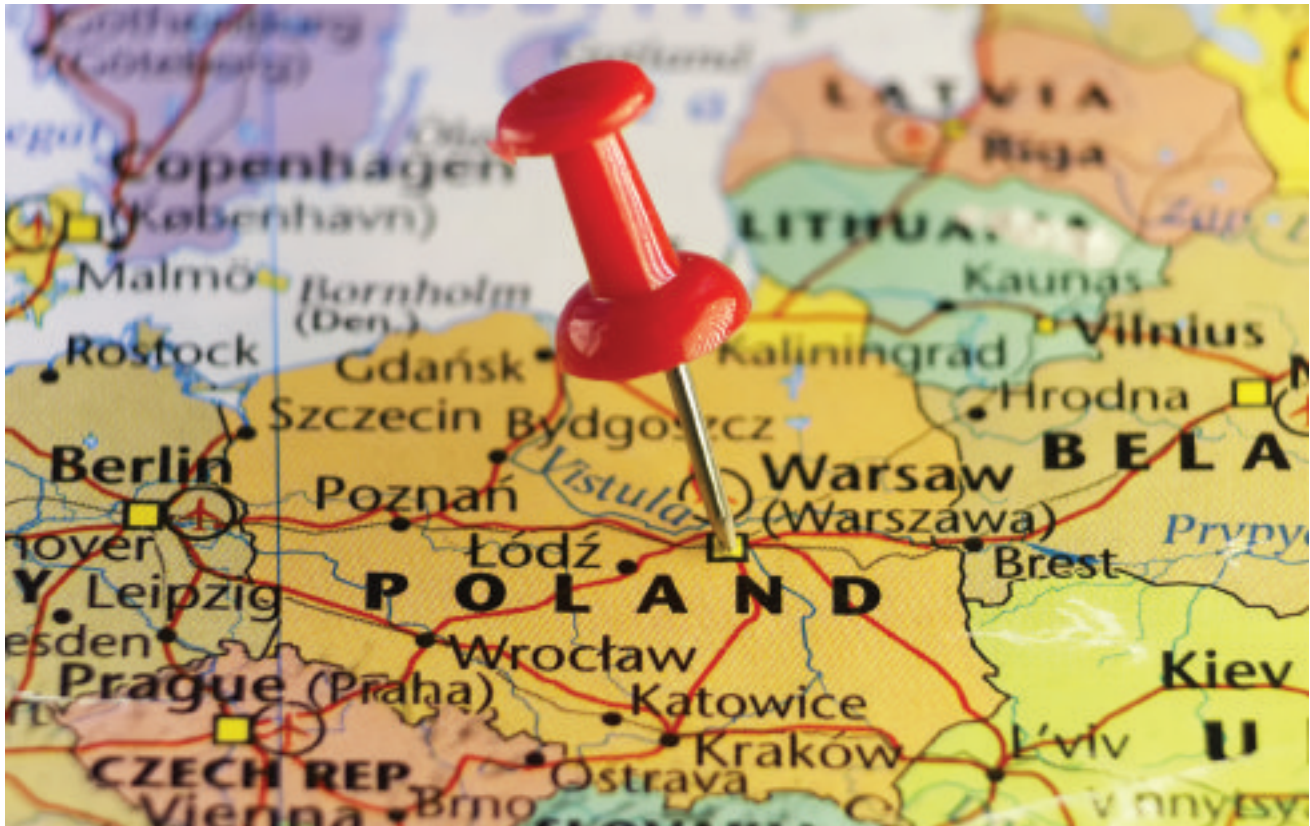
Résumé

Klaudia Błach-Morysinska, Zaborski, Morysinski Law Office

Klaudia specializes in intellectual and industrial property law, copyright, advertisement and unfair competition law. She provides expert-level legal assistance in courtroom litigations and in administrative disputes involving IP. Klaudia has a vast expertise before the Polish courts and authorities and international authorities.

Klaudia is an Advocate, Patent Attorney and European Trademark and Design Attorney. She authored numerous publications in the field of industrial and intellectual property law and gives lectures in intellectual and industrial property rights.

Klaudia is a member of the Legislative Committee and Application Committee at the Polish Patent Attorney Chamber, AIPPI (Design Committee), PTMG, INTA, ECTA (Law Committee).



2. **Essential examination** – the PPO will examine the absolute grounds for refusal, without checking potential collisions with prior trademarks. If the PPO decides, for example, that the applied sign may not be a trademark, is devoid of a sufficiently distinctive nature or was applied in bad faith, it will dismiss the application.
3. If no absolute grounds of refusal are found, the trademark application will be **published in the Polish Patent Office Bulletin** (approx. 2 months from the filing of the application).
4. Third parties may file **remarks** based on the absolute ground of refusal from the publication date up to the registration date.
5. Third parties may **file an opposition** within 3 months of the Polish Patent Office Bulletin's publication. The opposition procedure is separate from the main application proceeding and requires a separate decision. The main rules of the new opposition system may be described as follows:
 - a) The opposition motion should indicate the application against which the opposition is entered and the earlier trademarks, which are the bases of the opposition;
 - b) The opposition fee should be paid. It should also be noticed that the fee was decreased to PLN 600 (approx. EUR 150);
 - c) The opposition may be **based just on the relative grounds of refusal**;
 - d) The PPO will notify the applicant about the filing of an opposition without delay;
 - e) The PPO will set a **2 month cooling off period** which may be **extended to 6 months**, which will precede the actual *inter partes* phase and will be a chance for the amicable resolution of the dispute;
 - f) If no agreement is concluded within the cooling off period, the written phase starts and the PPO will decide upon the case. The PPO will instruct the applicant to respond to the opposition within the prescribed period, addressing charges, facts, and evidence;
 - g) The applicant has the right (no obligation) to file a defence, where a **non-use charge** against the earlier trademark on which the opposition was based may be raised. If the non-use complaint is justified, the PPO will dismiss the opposition.
- h) The defence is forwarded to the opponent who has the right to file a reply to the applicant's defence and present new evidence within the prescribed period;
 - i) The applicant has the right to respond to the opponent's writ within the period prescribed by the PPO;
 - j) During the written phase, all **evidence** must be presented with the first writ so as not to be dismissed;
 - k) After the opposition examination, the PPO will issue a decision dismissing the opposition or recognising it in whole or in part. If the PPO accepts the opposition as justified, the trademark application will be dismissed.
 - l) The party that does not accept the PPO's decision may file **a motion for the re-examination** of the case. The new facts or evidence may be presented only if the party proves that it was not possible to present the evidence earlier or there was no need to present it earlier. The board of appeal will examine the decision; the outcome may be appealed to the administrative court.
6. If no opposition is filed or the opposition was dismissed, the decision on granting the protection should be issued.

The opposition should be left non-examined by the PPO if it falls under one of the following criteria:

 - i) If it is not filed on time;
 - ii) If it does not name the trademark application being opposed;
 - iii) or it does not mention the earlier right;

If the opposition does not meet the formal requirements, the PPO will set a time limit in which the opposing party is obliged to address the deficiencies, on penalty of the procedure's discontinuation.

At first glance, the new Polish procedure may seem similar to the EUIPO opposition procedure, but there are some differences. In Poland, there is no formula to file the notice of opposition. The opposition is a regular writ starting the procedure where all the facts, statements and evidence should be included. As the PPO is bound by the legal

and factual basis of the opposition, it is very important to provide the Office with relevant argumentation and evidence.

Differently from the EUIPO opposition procedure, in Poland the opposing party should provide the PPO with arguments and evidence in the opposition motion. This means that the opponent should gather all evidence at the beginning of the case. Bearing in mind that all the documents must be translated into Polish, this may be very costly – especially with renowned trademarks. It should also be noted that in the situation in which there is no agreement during the cooling-off period and the applicant will file no defence, the opposition motion might be the only writ in the written phase of the opposition proceedings. The new regulation does not ensure the opponent the possibility to file an additional writ to complete its statement. The PPO may, but is not obliged to, ask the opponent for any additional writ or evidence. Therefore, if (i) the opposition does not include full argumentation and evidence, (ii) there is no agreement and (iii) the applicant does not file any written defence, then there is a risk that the PPO will make a decision based on the incomplete opposition motion.

This issue was raised during the meetings with PPO experts. They admitted that the first oppositions, especially regarding renowned trademarks, were filed together with a large amount of evidence. At the end of the day, in some cases, an agreement was concluded and the extensive evidence was useless. To avoid such situations, the PPO assures that in the situation in which an applicant files no defence, the PPO will call the opponent to complete the argumentation and evidence of the opposition motion. As there is no statutory obligation and no strengthened practice in this area, it seems to be safer to file an opposition motion with full argumentation and evidence. We have to wait to see how the new procedure will work in practice.

Conclusion

Considering the letter of consent, its practical value is not very big. It has been introduced into the Polish system too late. Moreover, it should apply just for the trademarks applied for after 1 December 2015. Bearing in mind that the amendments introducing the opposition system are binding as of 15 April 2016, the letter of consent seems to be useless for the trademark applications filed after 15 April 2016. Its practical use refers just to the trademarks filed between 1 December 2015 to 14 April 2016.

In view of switching from the examination system to the opposition system, the aim of this change is to shorten the duration of the trademark registration procedure – from approx. 12-18 months to approx. 6-8 months – which is very much welcome by Polish IP practitioners. The unused or abandoned prior trademarks will not constitute registration obstacles. Only the active trademarks that collide in the market may be an effective basis of the opposition.

As the PPO will not send notifications of new trademark applications to owners of earlier rights, they will be forced to carry out their own monitoring of trademark applications. The entrepreneurs will be obliged to follow announcements in the Polish Patent Office Bulletin in order to react to the identical or similar trademark applications.

Considering the opposition proceedings, it is important to collect all evidence at the beginning of the case as it is safer to present the evidence with the first writ.

We are waiting for the constituting of the PPO's practice of calling the opponent to file an additional writ with argumentation and evidence in the case of the applicant's passivity or further amendments to the law in this scope. This would be a good practice for opponents, as it would decrease the opposition costs and increase opposition attractiveness.

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