

Poland

Revocation of trademark rights for non-use: practical aspects

A trademark holder that registers a trademark in Poland obtains the exclusive right to use the trademark for goods or services covered by the registration within the Polish territory. Trademark protection is granted for a period of 10 years from the date of filing the application with the Patent Office. Upon expiry of the registration period, the trademark protection may be extended for subsequent 10-year periods – which in practice means that a trademark may be protected for an unlimited time.

But must a trademark holder take any steps to maintain and extend the granted protection for the trademark? Obviously the trademark holder must apply for an extension of trademark protection to the institution that granted it originally, as well as paying the required fees. Furthermore, the trademark holder must use the registered trademark. If the registered trademark is not used, there is a danger that another interested party may apply for revocation of the right.

The use and protection of trademarks is governed by the Industrial Property Law. Article 169 of the law provides for the lapse of trademark protection as a result of non-use of the trademark. The regulation states: “The right of protection for a trademark shall also lapse on failure to put to genuine use the registered trademark for the goods covered by the registration for a period of five successive years after the date on which the protection right was granted, unless serious reasons for non-use exist.”

An official decision regarding the lapse of a trademark right is issued by the Patent Office at the request of any person with a legitimate interest in the lapse of the right. The decision must be preceded by litigation proceedings before the Patent Office between that person and the rights holder. The burden of proving use of the trademark or that justified reasons for non-use of the trademark exist falls rests with the rights holder.

The litigation proceedings are initiated upon

submission of a request for revocation of the right by the interested party. The contents of such a request are important to determine the course of proceedings before the Patent Office. The request will succeed if the necessary circumstances exist and the request fulfils the formal requirements set down by the law.

This chapter discusses various circumstances and requirements that must be taken into account in litigation proceedings concerning revocation of trademark protection for non-use. The problem is considered from a practical point of view, based on the judicial practice of the Polish administrative courts.

Trademarks subject to revocation for non-use

A request for revocation for non-use can be made in regard to a registered trademark in the form for which protection was granted or in a form that differs in non-distinctive elements only. For the request to be upheld, it must be proven that the trademark has not been put to genuine use for goods covered by the registration – for example:

- the trademark has not been used in trade by placing it on goods or packaging;
- the goods have not been introduced onto the Polish market; or
- the trademark has not been used on exported goods or in advertising.

This also applies to services covered by the registration.

An official revocation decision may be issued only with respect to a trademark that has not been used by any person entitled to use the trademark – that is:

- the trademark holder;
- joint owners of the trademark registration; and
- licensees and other persons authorised to use the trademark by the trademark holder.

If a trademark is not used in trade it does not fulfil its basic function of distinguishing the goods or services of one enterprise from those of another. The absence of a trademark on the market makes it impossible to develop brand awareness. In simple terms, it could be said that lapsed trademarks are those which are of minor or no importance to the trademark holder. If the holder really needed them, it would use them to mark its goods or services, thus developing brand awareness.

Establishing 'genuine use of a trademark'

The exact meaning of the term 'genuine use of a trademark' has been widely discussed as it is of great importance to entrepreneurs. They are the main players in the business arena and the parties which actually use the trademarks.

As mentioned above, a trademark holder is legally obliged to use the registered trademark. This obligation plays a significant role in the functioning of the whole trademark protection system. Thus, trademark holders must remember that the purpose of trademark registration is to grant an exclusive right to the commercial use of a sign as a distinguishing feature of goods or services, rather than a tool to use against competitors.

To use a trademark means to apply it in commercial activity in order to distinguish goods or services marked with that trademark by one enterprise from those offered by another. Thus, the trademark is considered to be used only when it is applied in connection with specific goods or services. The trademark shall not be used in any abstract way with no reference to concrete good or services. The idea is that the perception of a trademark by customers creates a bond in their minds between the sign and the related product or service.

As far as goods are concerned, using a trademark means placing it directly on the product or its packaging, or including it in commercial documents or advertisements. The situation is slightly different in regard to services, which are immaterial in nature. In such cases the trademark has no substrate in the form of a concrete product; instead, trademarks are used primarily in advertising and commercial correspondence. However, in some situations there may be a material service carrier where a trademark is located – for example, for banking services trademarks may be placed on payment cards, cheques or bills of exchange, and for transport services trademarks may be found on vehicles or labels attached to cargo or luggage.

The use of a registered trademark is not always synonymous with the appropriate exercise of the granted exclusive right. The right should not serve as a tool for unfair practices, such as registration of a trademark with

the sole purpose of preventing another enterprise from being granted the exclusive right to use the same or similar trademark.

The use of a trademark should not be token, but rather genuine and substantial for goods and services covered by the registration. The question is how to define 'genuine and substantial use' of a trademark. There is no simple answer to this question; however, it may be assumed that genuine use of a trademark is such that it creates both a notional and physical relationship between that trademark and a specific product or service. This relationship must be easily recognisable by entities engaged in trade. Therefore, the product or service marked with a registered trademark must be made available on the market. In addition, the branded goods or services must be used in trade in accordance with the activities of the trademark holder.

The mere use of a trademark in commercial correspondence and advertising, with no properly branded goods or services present on the market, is not sufficient to preserve the exclusive right to trademark protection. Moreover, it is not sufficient to use the trademark occasionally or in a token manner in order to avoid an accusation of non-use. For example, imagine a trademark holder which produced several dozen bags branded with a registered trademark and put them on the market, hoping that this would fulfil the requirement to use the trademark. Although this practice was originally aimed at preserving exclusive trademark rights, it could actually result in the trademark being used with no significant economic effect, meaning that customers would be unaware of the relationship between the trademark and the respective goods or services.

Unlike in this example, the use of a trademark should involve activities and actions that are visible on the market and that have an impact on customers, business partners and competitors. At the same time, such activities need not necessarily be aimed particularly at consumers. The addressee of the above actions is determined by a specific type of goods or services offered by the entrepreneur. For example, the target group for advertising services comprises both consumers and other entrepreneurs. Therefore, an advertising campaign should relate to goods or services that are available on the market and the recipients must have an opportunity to take advantage of the proposed offer.

Genuine and substantial use of a trademark should lead to a situation in which a given sign has established a position on the market and thus is present in the minds of both customers and competitive enterprises. To achieve this, the trademark should be used in trade on a significant and permanent basis.

The requirement for genuine and substantial use of a trademark may be fulfilled by third parties acting with the consent of the trademark owner.

Justifying non-use of a registered trademark

The Industrial Property Law contains a provision from which it may be derived that non-use of a trademark may be justified as long as there are proper reasons for the non-use. Trademark protection shall not lapse if the rights holder is able to prove that there were important reasons preventing it from using the trademark. The term 'proper reasons' refers to all circumstances which may invalidate objections raised against the trademark holder. These may be of a factual or a legal nature and include *force majeure* as well as other external circumstances that cannot be foreseen by the trademark holder (eg, natural disasters; new administrative regulations with respect to environmentally friendly packaging and the distribution of commodities, provided that compliance with such regulations would be time-consuming and costly).

Non-use or insufficient use of a trademark shall not be justified if the trademark holder may be challenged on the grounds of faulty action or omission (eg, commercial difficulties, neglect of business, loss of licence for services or production of goods), which generally means that the blame for the inadequate presence of the trademark on the market lies with the trademark holder.

The burden of proof that the trademark has actually been used or that there are proper reasons for non-use of the trademark rests with the trademark holder. The Polish Patent Office examines the evidence provided and issues a decision regarding revocation of trademark registration.

Submitting a request for revocation for non-use

A request for revocation of a trademark registration may be submitted where an objection can be raised against the trademark holder as to non-use of the trademark for a period of five consecutive years. If actual use of the trademark started or was resumed before the submission of the request, the trademark holder may defend its position during litigation proceedings.

Although the issue may seem simple, doubts arise when it comes to determining the exact date from which the holder is obliged to use the trademark. Procedures related to trademark registration comprise several steps and events that may suggest the right date. This gives

rise to various interpretations and mistakes. For this reason, this chapter is limited to the general statement that the holder is obliged to use the trademark from the date on which the registration procedures are finalised. The date of trademark registration constitutes the initial date for the above-mentioned five-year period of non-use. When calculating the period of non-use, one should go back five years from the date on which a request for revocation of the trademark is filed. The date resulting from this calculation should not be earlier than the final date of the registration procedures. Therefore, the five-year period of non-use must take place between the date of trademark registration and the date on which the request for the lapse of trademark registration is filed.

The request for revocation of a specific trademark registration may be submitted by an entity which can prove its legitimate interest in the revocation. This legitimate interest should derive from a concrete regulation of substantive law. This means that a request for revocation of a specific trademark registration may be submitted only by a party that can prove that the trademark registration infringes legal rights which it holds or blocks the exercise of its legal rights.

Conclusion

This chapter does not attempt to discuss all the problems relating to revocation of a trademark registration for non-use. Rather, it outlines the main issues and gives some practical information that may be useful for both the rights holder and the applicant seeking revocation of a trademark registration on the grounds of non-use.

The most effective way to prevent the lapse of a trademark registration is to ensure the trademark's economic importance. This goal may be achieved by extensive use of the trademark by, for example:

- introducing onto the market goods or services branded with the trademark;
- placing the mark on commercial documentation; and
- using the mark in advertising.

Thanks to such actions, the trademark holder may enjoy the rights deriving from the trademark registration. Finally, and most importantly, the trademark holder must use the trademark in a manner that is consistent with its vision and economic activity.

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