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Trademark registration in Poland: which route to choose?

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Trademark registration in Poland: which route to choose?

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Today's market presents consumers with a vast range of choice. Customers are surrounded by countless different products, and when it comes to choosing what to buy there are several factors – not necessarily practical features or utility – that can influence their decision. Simply put, in order to be noticed, a product must be more distinctive than its competitors. Therefore, it is crucial that the form of the product and the trademark it bears are familiar to consumers and can easily be recognised on the market. The trademark is the perfect weapon with which to fight off competition: an attractive, fashionable or original mark can win the customer's attention even more effectively than the product itself.

This function of rendering the product distinctive on the market is supplemented by the trademark's function as a hallmark of the quality of the goods – effectively, it serves as an advertisement that encourages consumers to purchase the goods. The trademark is therefore a valuable and influential tool in the battle to win business, and it is thus in the best interests of every company to guarantee effective protection of its trademarks.

In Poland, as in all other EU member states, there are three procedures under which trademark protection may be obtained:

- The national procedure – registration with national patent offices;
- The international procedure under the Madrid Agreement and Protocol – registration through the World Intellectual Property Organisation (WIPO); and
- The Community trademark (CTM) procedure – registration through the Office for Harmonisation in the Internal Market (OHIM).

Choosing the most effective procedure

Before filing an application for trademark protection, Polish trademark owners usually

compare the costs and effects of the various registration procedures.

The national procedure is simple but costly. In each country it is necessary to engage the services of a local patent attorney and it is not possible to appear before the local patent office without a representative.

International registration under the Madrid Agreement and Protocol is very convenient. This kind of registration is effectively a bundle of national registrations (ie, registrations in the designated countries), and its effect is identical to that of registration under the national procedure.

CTM registration gives protection to a trademark in 27 EU member states. It is obtained through one application and subsequently one registration. In case of refusal in any EU member state, conversion into a national application is possible (through the national registration procedure).

Choosing one procedure, or a combination of more than one, depends on many aspects, such as:

- The territorial range of protection required;
- The costs of registration;
- Potential threats of opposition and refusal on absolute or relative grounds;
- The intent to use the mark;
- The possibility to file an international application under the Madrid Agreement and Protocol based on a national application rather than through registration;
- The possibility to convert a CTM into a national application; and
- The opportunities to enforce one's rights and combat counterfeiting etc.

Since 1st October 2004 the European Union has been a party to the Madrid Agreement. As a result, a further question must be considered: whether to file a Madrid application designating the European Union based on a national registration, or whether

to file a Madrid application based on a CTM.

It appears that the Madrid/CTM procedure is likely to be chosen more frequently than the national procedure, to the benefit of users of both systems.

Decision process

The statistical data published by OHIM confirms the continuing increase in CTM applications.

Year	CTM applications	CTM registrations
1996	43.154	—
1997	27.286	577
1998	31.634	24.249
1999	41.304	34.270
2000	57.387	34.763
2001	48.913	38.536
2002	45.238	35.892
2003	57.710	34.308
2004	58.994	34.442
2005	64.812	59.749
2006	77.487	61.494
2007	88.251	68.068
Total	642.170	426.348

The CTM application system has also become very attractive to Polish applicants: the number of CTM applications filed by Polish trademark owners is substantially higher than the number filed by trademark holders from the other Central and Eastern European countries which joined the European Union alongside Poland.

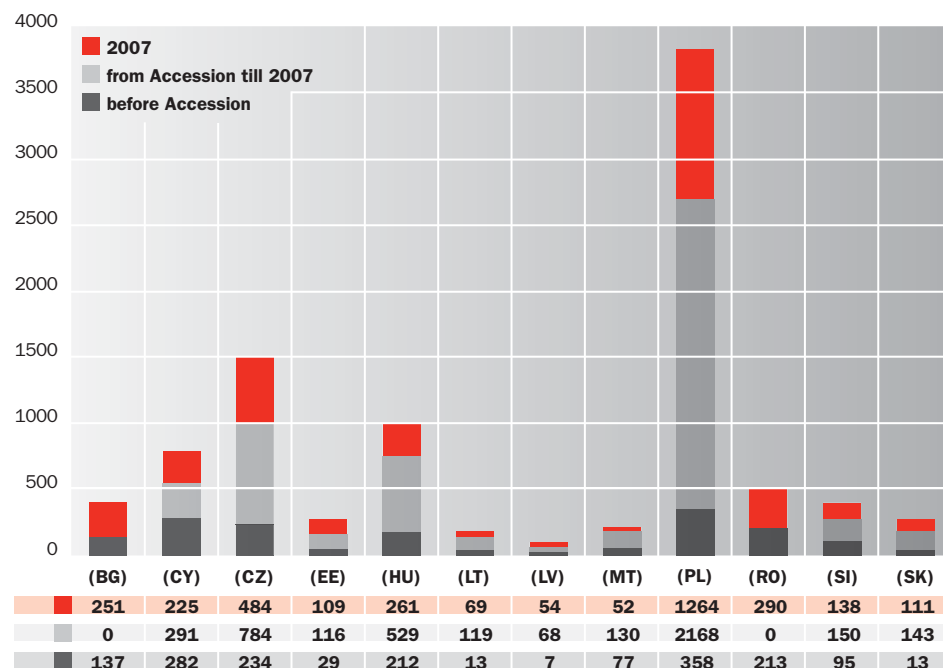
On the other hand, statistical data published by the Polish Patent Office indicates that the number of national applications filed after EU enlargement has remained static, while the number of international registrations designating Poland under the Madrid Agreement and Protocol has gone down by roughly 25%.

Also, the number of Polish brand owners applying for international registration under the Madrid Agreement and Protocol has substantially decreased: 459 applications were filed with WIPO in 2006, but only 300 applications in 2007.

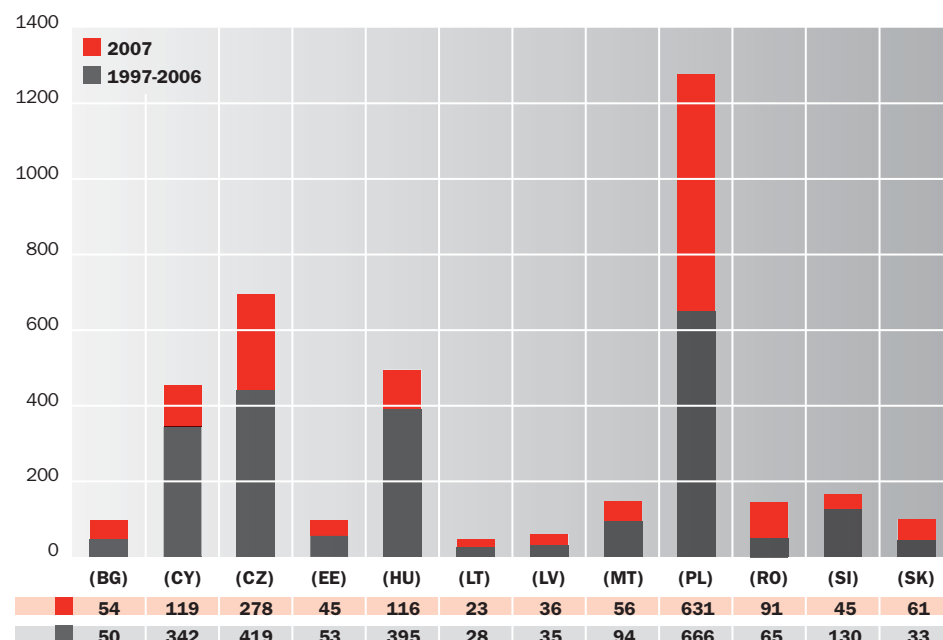
According to the data published by the Polish Patent Office, at the end of 2007 the number of valid national trademark registrations stood at 103,417 and the number of valid international registration stood at 113,778.

The above data confirms the popularity of the CTM system. However, in Poland, the national system is still attractive to many

CTM applications by new EU members (OHIM statistics)



CTM registration by new EU members (OHIM statistics)



applicants. It is believed that enforcement of one's rights before the Polish courts is more effective if the trademark owner enjoys protection under the national system.

Impact of EU enlargement

Pursuant to the Accession Treaty, all CTM

National applications

Year	Total number of applications	Applications under the national procedure	Notifications of registration under international procedure
2003	24,330	15,179	9,151
2004	23,074	14,934	8,140
2005	21,312	14,812	6,500
2006	21,624	15,338	6,286
2007	20,640	15,051	5,589

National registrations

Year	Total number of registrations	Number of registrations under the national procedure	Number of decisions on registrations extending to Poland under the Madrid Agreement and Protocol
2003	18.336	9.975	8.361
2004	21.837	12.790	9.047
2005	21.571	14.527	7.044
2006	26.839	19.793	7.046
2007	24.808	19.329	5.479

applications and registrations were automatically extended to the countries which joined the European Union from the accession date onwards, and thus have equal effect throughout the enlarged European Union. Those CTMs constitute earlier rights in respect of applications and registrations filed or granted after the accession date (for Poland, after 1st May 2004).

The owners of trademarks which were registered or for which registration was sought in Poland before the accession date have the right to prohibit the owners of extended CTMs from using their Polish marks

if the extended CTMs are similar or identical to the earlier Polish marks. The concept of "earlier rights" is often misunderstood by the owners of CTM applications and registrations, as the evaluation of which mark is earlier is based on the accession date, not on the date of application or registration with OHIM.

The situation is analogous when it comes to the conversion of applications from the CTM system to the national route. The application date in Poland of converted CTM marks filed with OHIM before the accession date is not the date of filing with OHIM, but rather the date of Polish accession – 1st May 2004.

It should also be borne in mind that OHIM will examine a CTM application on formal and absolute grounds. If there are reasons to refuse the application, OHIM will handle this. On the other hand, it is down to the owner of an earlier right to file an opposition during the application period or to seek a declaration of invalidity on relative grounds at any time after registration of the CTM.

Conclusion

Undoubtedly, the advantage of the CTM system is the possibility to file a single application with OHIM, rather than many applications with national patent offices, which nonetheless grants protection in 27 countries. This is what makes the CTM system so attractive.

In general, it is a normal strategy of trademark owners to choose between the national route and the CTM system, or to file simultaneous applications under both systems. They may also opt for designation of the European Union via the international system.

From the perspective of Polish trademark owners, it seems that the national system will retain its significance and will continue to supplement the CTM system.



Slawomira Piotrowska is a patent and trademark attorney, and has been a partner at Patpol since 1992. Before joining the firm she worked for many years in the Polish Patent Office, first in the Department of Patent Examination and then in the Trademarks Department. Between 1993 and 1997 she was the first president of the Warsaw District Board of the Polish Chamber of Patent Attorneys; she is a member of the National Board of the Polish Chamber of Patent Attorneys. She participates in the work of many international organisations, including MARQUES, AIPPI, INTA and ECTA (Harmonisation Committee). Since 2005 she has been a member of the ECTA Council. In 2004 she became a European patent attorney and she is an official representative before the European Patent Office and OHIM.

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