

PROTECTION OF TRADE MARKS in Poland and the European Union



PATENT OFFICE OF THE
REPUBLIC OF POLAND



EUIPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

INTRODUCTION

Awareness of the need to protect intangible assets in modern market conditions as well as understanding the risks associated with the use of other's rights is extremely important. Undoubtedly, one of the most valuable assets of the business are particularly trademarks.

A trade mark, as an intangible good, is a common asset used by entrepreneurs. It is largely regarded as one of the most important means of business expansion in the market. Trademarks, in principle, may consist of any signs provided they can be represented graphically and will be used in trade to distinguish the goods or services of one undertaking from the goods and services of others.

If you file a trade mark application to the Patent Office of the Republic of Poland, you may obtain an exclusive right to use a trademark, which will be protected throughout the whole territory of the Republic of Poland. If, however, your business is carried out in other Member States of the European Union, it is worth considering the application of an EU trade mark which provides protection effective in all current and future EU Member States.

Obtaining an exclusive right to use a trade mark gives you the possibility to use the symbol ®, which increases the credibility of the company and raises its prestige. At the same time, entrepreneurs strengthen their position on the market as well as create a positive image of the company. A trade mark is a kind of marketing tool enhancing the reputation of the company and attracting investors. In some cases of unfair competition, e.g. imitation of the products, the registered trade mark allows you for fast and effective protection of your rights. It also warns the competition from unauthorized use of the registered mark. The protection right for a national trade mark protects you from unfair practices of other companies in Poland, whilst the registration of an EU trade mark allows you to enforce your rights also abroad.

The aim of this publication is to present the process of the trade mark application, both at the national level - before the Polish Patent Office, and at the EU level - before the European Union Intellectual Property Office. We hope that it will contribute to the effective protection of industrial property rights and strengthen the market position of entrepreneurs.

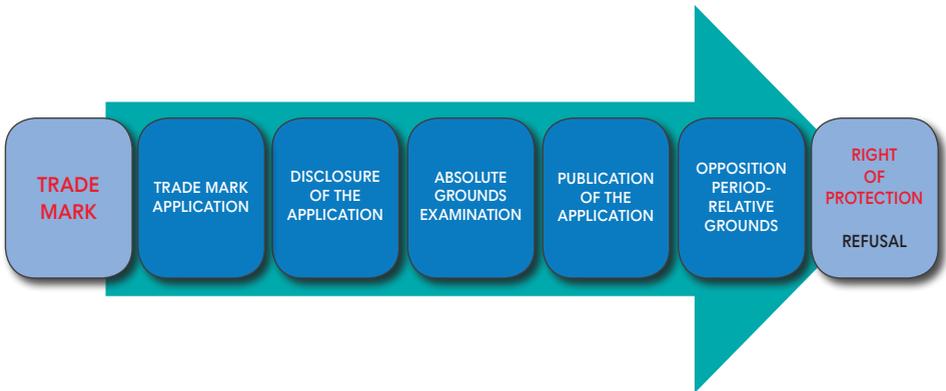
Trade marks are signs used in trade to identify products of a particular entrepreneur. They are capable of distinguishing the goods or services of one undertaking from those of other undertakings, thus providing the basis for building the image and reputation of the company. A trade mark may consist of any signs e.g. words, drawings, designs, melodies that distinguish the source of origin of the products and are not excluded from registration pursuant to the provisions of the law.

Word mark	Figurative mark	Word – figurative mark	3D – word – figurative mark
CHERRY COCA-COLA			

TRADE MARK REGISTRATION – WHY IS IT WORTH PROTECTING

ASSETS	EVIDENCE	CREDIBILITY	PROMOTION
<p>It provides the exclusive right to use the mark on the market</p> <ul style="list-style-type: none"> • a mark may be traded – sold or licensed; • attracts investors; • raises the real value of the company. 	<p>Certificate of protection issued by the Polish Patent Office is the best proof that it is YOU, who has the trademark protection right.</p>	<p>Registration of a trade mark makes it possible to use the symbol ®, which increases the reliability and the prestige of YOUR business. It also warns the competitors from any unauthorized use of your mark.</p>	<p>Using trade marks to promote the goods and services may increase their recognition and create a positive effect on building your brands.</p>

TRADE MARK FILING



The most important thing is that the mark you applied for has a distinctive character, and may be represented graphically.

Before applying for a trade mark, you should check whether there are other identical or similar trade marks protected. In order to do that, you may search the available databases of trademarks protected in the Republic of Poland on your own or ask a professional lawyer to verify it for you.

You can file the application before the Polish Patent Office:



The application must indicate

Data of the applicant	<ul style="list-style-type: none"> ✓ remember that the application should include a signature of a person entitled to represent the applicant
A trade mark in the form for which the protection is sought	<ul style="list-style-type: none"> ✓ the description of the mark should indicate the basic colours which are used in the mark
The list of goods and services	<ul style="list-style-type: none"> ✓ in order to create a list, you may use particular databases such as: <ul style="list-style-type: none"> • TMclass • classification available on the Polish Patent Office website ! Number of classes may affect the <ul style="list-style-type: none"> • charges

At this stage, you should think about the costs associated with the protection of the mark.

APPLICATION FEE

Non-refundable in the event of refusing protection

Trademark application in one class	450,00 PLN
Trademark application (online) in one class	400,00 PLN
for each additional class	120 PLN

Attention! If you receive a request for payment or an invoice, please read carefully and make sure that any demand for payment comes from the Patent Office of the Republic of Poland. Remember that the Polish Patent Office does not issue

- invoices and does not use third party services to send payment requests.

PRELIMINARY EXAMINATION

The Polish Patent Office examines whether the application has been made correctly in both formal and legal terms. Information about the application filed will be revealed in the trade mark search database **Register +**.

ABSOLUTE GROUNDS EXAMINATION

The Polish Patent Office examines whether the sign applied for can be registered as a trade mark. If the Office finds that there are statutory absolute grounds* for refusal, a decision will be issued in relation to the whole or part of the requested protection.

* *Absolute grounds for refusal include e.g. marks that are descriptive in relation to the goods such as the word "milk" to identify milk or milk products.*

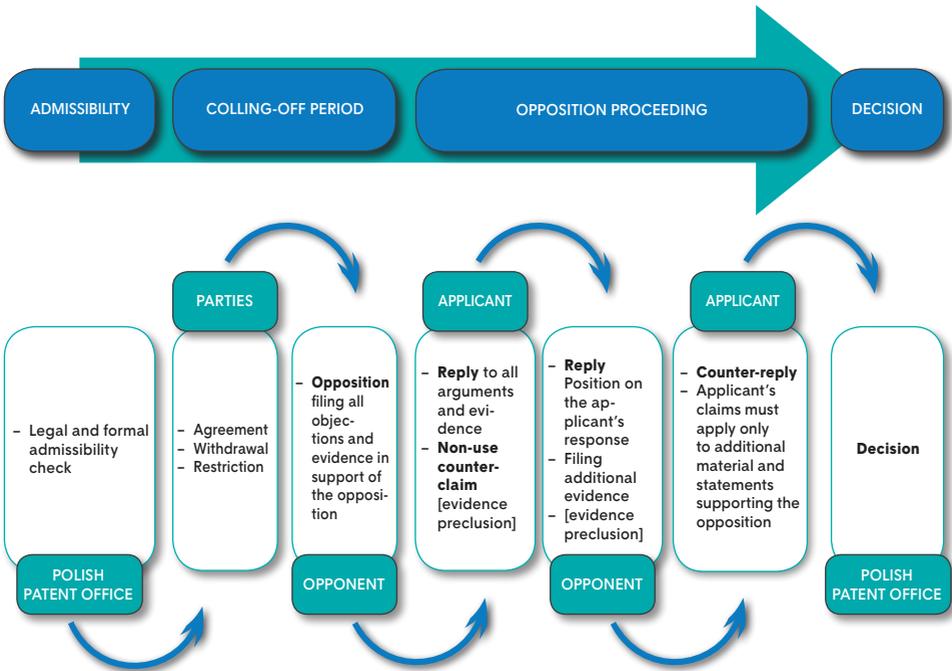
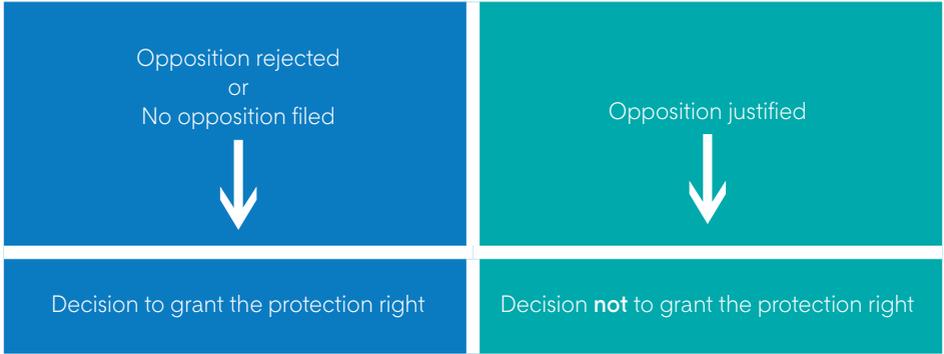
PUBLICATION

If there are no obstacles for registration, a notice of the trade mark application will be published in the Bulletin of the Polish Patent Office (BUP).

OPPOSITION PROCEEDING

Within 3 months from the date of publication in the BUP, proprietors of the earlier trade marks may oppose the trade mark application

- The opposition must indicate the earlier rights that may be affected by the registration of the trade mark;
- There is a possibility for an amicable settlement within 2 months which can be extended to 6 months at the joint request of the parties;
- If the parties fail to reach an agreement, the office issues a decision based on legal and factual grounds presented by the parties:



MONITOR AND RENEW YOUR TRADE MARK

Keep in mind that the trademark protection expires after 10 years if it is not extended. Remember to renew your trade mark protection rights every 10 years and pay for the next protection period.

TRADE MARK PROTECTION FEES

For the first 10-years protection period

For each class	400,00 PLN
Publication fee	90,00 PLN

RENEWAL (second and subsequent protection periods)

Application for extension	200,00 PLN
For each class	400,00 PLN

When you obtain a trade mark protection right, remember to MONITOR new trade mark applications or ask a professional lawyer to watch over your trade mark so

- nobody infringes your protection right.

If you run a business in many countries of the European Union, you may submit an application for registration of an EU trade mark (EUTM) which provides protection in all 28 EU Member States. The EUTM has a unitary character with the same legal effect throughout the European Union. The authority responsible for the registration of EUTMs is the European Union Intellectual Property Office (EUIPO) based in Alicante.

Currently EUIPO registers more than 100 000 EU trade marks (EUTM) per year, offering the protection of industrial property rights for companies and individual entities in a market of more than 500 million consumers.

CHANGES IN THE EU TRADE MARK PROTECTION SYSTEM

The trade mark protection system at EU level has required an amendment for a long time. Thus, in December 2015, the Regulation of the European Parliament and of the Council (EU) 2015/2424 amending Regulation on the Community trade mark as well as the Directive 2015/2436 was enacted.

The aim of the changes was not only to increase the availability and effectiveness of the registration of EUTMs, but also to increase the level of cooperation between EUIPO and national offices, the modernization of the Community system and harmonization of national trade mark systems by simplifying the procedures for notification and registration of trade marks.

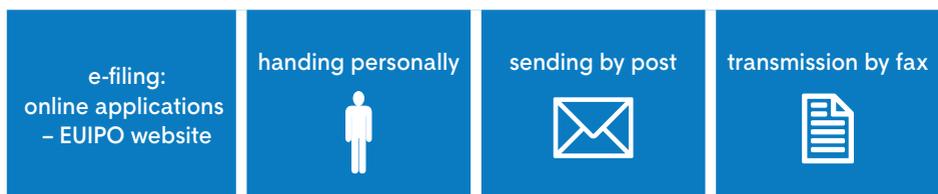
After the Regulation No 2015/2424 entered into force on March 23, 2016, the Office for Harmonisation in the Internal Market (OHIM) changed its name to the European Union Intellectual Property Office (EUIPO) and a Community trade mark (CTM) has been replaced by an European Union trade mark (EUTM).



EU TRADE MARK FILING

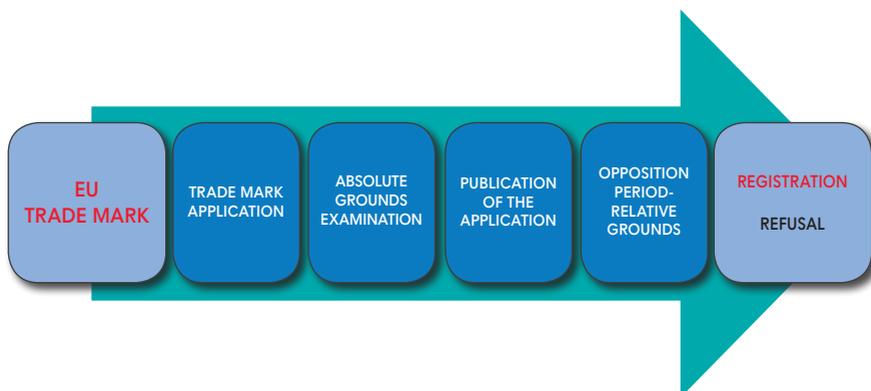
EUTMs include mainly individual and collective marks. Additionally from October 1, 2017, the certification marks will be introduced.

A trade mark may be filed to EUIPO individually or by a representative using any of the following means:



<https://euipo.europa.eu/ohimportal/pl/web/guest/apply-now>
Avenida de Europa 4, 03008 Alicante

- ! From March 23, 2016 it is not possible to apply for the EUTM through the Patent Office of the Republic of Poland.



Applications can be made:

- In the **accelerated** procedure (fast track):
 - individual mark
 - the list of goods and services from TMclass
 - fee paid upfront

- In the **normal** procedure (advanced form):
 - marks other than individual
 - non-traditional marks (sound, smell, tactile, motion)
 - own list of goods and services
 - application fee can be paid within one month of filing

FEES

Basic fee for the trade mark application includes one class. For each additional class, the fee is payable in accordance with Annex I to the Regulation of the European Parliament and of the Council (EU) No 2015/2424.

	EUIPO €
Basic fee for the application	1000 EUR
Basic fee for the application by electronic means	850 EUR
Fee for the second class of goods and services	50 EUR
Fee for each class of goods and services exceeding two	150 EUR
Basic fee for the renewal	1000 EUR
Basic fee for the renewal by electronic means	850 EUR
Fee for the renewal of the second class of goods and services	50 EUR
Fee for the renewal of each class of goods and services exceeding two	150 EUR
Opposition fee	320 EUR
Appeal fee	720 EUR
Fee for a declaration of invalidity	630 EUR

Please note that EUIPO may only examine the trade mark application once payment has been completed. After registering the mark, the protection can be renewed every 10 years indefinitely.

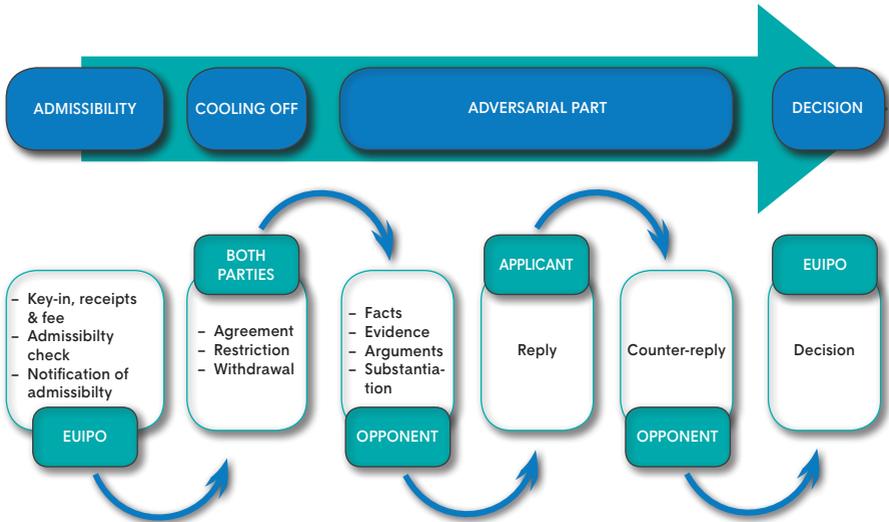
ABSOLUTE GROUNDS EXAMINATION

Upon acceptance of the application, the EUIPO examines whether the sign can be regarded as a trade mark. If the Office finds that there are absolute grounds for refusal, it shall refuse the registration of a trade mark. Otherwise, the application will be published.

OPPOSITION PROCEEDING

A notice of opposition may be filed within a period of three months following the publication of the EU trade mark application.

- The opposition is considered effectively filed once the payment has been completed.
- After examining whether the notice of opposition fulfils the basic requirements, the applicant for the European Union trade mark will be advised of the notice of opposition. At this point, a period of two months commences in which both parties can contact one another to try to come to a friendly settlement. This is known as the cooling-off period.
- If no agreement is reached, the parties are invited to file additional information and evidence to support their positions. The opposing party can present all the facts, arguments and evidence justifying the opposition. The applicant may provide the answers and then again the opponent may respond to those replies.
- Based on the gathered documents, the Office issues a final decision.



Detailed rules of an EUTM are included in the Regulation No 2015/2424 amending Regulation No 207/2009 on the Community trade mark.

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Patent Office of the Republic of Poland is the central body of the government administration, appointed to grant patents for inventions, rights of protection for utility models and for trademarks as well as rights in registration for industrial designs, topographies of integrated circuits, and geographical indications. Furthermore, the Office maintains and provides access to collections of patent specifications and patent literature as well as to databases of all industrial property objects.

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The European Union Intellectual Property Office (EUIPO formerly known as OHIM) is a decentralised agency of the European Union established in 1994 pursuant to Regulation No 40/94 on the Community trade mark. The Office was created to offer IP rights protection and manage the registration of the EU trade mark and the registered Community design. EU trade mark applications can only be filed directly at EUIPO.

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