

Trademarks

Intellectual and industrial property, including trademarks, play an essential role in building a company's business strategy. Moreover, they act as a strong marketing tool against competitors and help the company to be successful. They are also assets of tangible material value; therefore, it is crucial that the company's development strategy includes the protection of intellectual property rights.

Trademarks

Any sign capable of being represented graphically may be considered as trade mark, provided that such signs are capable of distinguishing the goods of one company from those of another.

The most common forms of trademarks are:

- word trademarks, e.g. words, phrases, slogans;
- figurative trademarks, e.g. figurative signs such as drawings, ornaments;
- figurative trademarks: combination of word and figurative elements;
- 3D trademarks: 3D forms of objects, goods, or packaging;
- sound.

Protect strategically and efficiently!

To be effective, the appropriate protection of designation individualizing the goods or services on the market must be based on a well thought-out strategy, starting with the right type of sign, its search, then selecting the right procedure of protection for the trademark. The development of an appropriate strategy is both the key to effective protection as well as an opportunity to significantly reduce fees associated with the application.

Registration regulations and procedures

In order to obtain protection, a trademark must be filed with the selected Patent Office:

- the Polish Patent Office – protection covers the territory of Poland;
- the European Union Intellectual Property Office (EUIPO) in Alicante – protection covers all EU countries (European Union Trademark);
- the Bureau of the World Intellectual Property Organization (WIPO) in Geneva – International Registration in selected countries which are the parties to the Madrid Protocol/Agreement;
- Patent Offices in selected countries – protection in the territory of a selected country.

Trademark registration procedure

The right of protection for a trademark is granted after the relevant office has examined whether the mark has a distinctive character (i.e. it is not contrary to public morality, and does not contain descriptive elements). The Polish Patent Office and the EUIPO do not examine whether the mark applied for is in conflict with previously filed and registered trademarks before issuing a decision on granting the right of protection for a trademark. The holders of these earlier marks may file an opposition against such application within three months from publication of the information on the application. The filing of an opposition extends the registration proceedings.

Trademark search

Before we proceed to file a trademark, the following vital questions need to be answered: What can I protect and what is not registrable? Does my sign infringe the rights of other entities? As a result, the proposed sign should be searched before it is applied for registration, in order to avoid unnecessary filing costs.

How long does it take on average to obtain trademark protection?

The time required to obtain a right of protection for a trademark depends largely on the selected procedure. Under the national procedure it takes about 6-8 months. If we try to obtain protection for the European Union trademark, the application proceedings usually take 4-7 months. If the application encounters obstacles - for example, an opposition is filed against it - the registration proceedings will be extended.

What is the right of protection of a trademark and how long does it last?

The right of protection for a trademark is an exclusive subjective proprietary right, limited by time and territory. Furthermore, it is transferable and may be inherited. The first term of protection lasts for 10 years, and it can be extended for subsequent 10-year periods, which makes the duration of the right of protection in effect unlimited.



What further action is required after the trademark has been granted protection?

Once the right of protection for a trademark is obtained, we need to remember to take action in order to maintain it, i.e.:

- to pay renewal fees,
- to use the trademark in a genuine manner in order to protect it against cancellation,
- to watch the market for new applications of trademarks identical and similar to the filed trademark in order to undertake actions against infringers;
- to watch the market for infringement acts.

JWP offers:

- comprehensive trademarks searches;
- trademark watching in the territory of Poland, European Union, and worldwide;
- filing and handling trademark applications with the Polish Patent Office, the European Union Intellectual Property Office (EUIPO), the International Bureau of the World Intellectual Property Organization (WIPO);
- handling domestic trademark registrations with foreign Patent Offices;
- supervision and renewals of granted trademark exclusive rights all over the world;
- records and updates in domestic, community and international registers;
- litigation before the Polish Patent Office, the EUIPO, and the European Court of Justice;
- preparing cease & desist letters in trademark and unfair competition matters;
- trademark related litigation before administrative courts (district administrative courts, the Supreme Administrative Court);
- trademark protection on the border;
- drafting trademark agreements;
- negotiations in order to sign a coexistence agreement;
- mediation in intellectual property cases.

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