

Summary of doctoral dissertation of Mateusz Żuk titled „Zależność ochrony znaku towarowego od jego zdolności odróżniającej w prawie Unii Europejskiej” (“Relationship between protection of a trade mark and its distinctive character under the European Union law”)

The subject of the doctoral dissertation is the relationship between the scope of protection of trademarks and their distinctiveness under the EU trademark law. The provisions of the regulation on the European Union trade mark and the directive harmonizing the trade mark rights of the Member States are analyzed, as well as the extensive case law of the Court of Justice and the General Court, as well as the decision-making practice of the European Union Intellectual Property Office and the case law of national courts. The dissertation concludes that relationship is a principle of EU trade mark law limited by significant exceptions.

In terms of protection against a likelihood of consumer confusion, the author considers whether highly distinctive marks benefit from broader protection than marks with medium and low distinctiveness. According to the author, the assessment should take into account the knowledge of the earlier trade mark (reputation, well known status or recognition), which may replace the factor of the distinctiveness of the earlier trade mark. In addition, the author analyzes whether the assessment of the risk of confusion should take into account a factor, whether a common element of trademarks is a distinctive element of the later mark or whether it has only a descriptive function. The work also discusses the exceptions to the said relationship resulting from: a wide scope of protection against the risk of confusion and a presumption of distinctiveness of a trademark under the EU trade mark regulation.

The key relationship for the dissertation occurs in the case of extended protection of reputable trademarks that have high distinctiveness. The author believes that the concept of high distinctiveness is only needed to clarify the scope of protection of a trade mark against a detriment to distinctiveness. In the remaining scope of extended protection, the concept of distinctiveness has a secondary role in relation to the concept of trade mark reputation, which is key in this standard of protection. The author discusses the exception to the discussed relationship in the form of the lack of extended protection of (unregistered) well-known trademarks.

In terms of protection in the case of so-called double identity situations, there is no relationship between the distinctiveness of the trade mark and the scope of its protection. Regardless of their degree of distinctiveness, trademarks benefit from protection against the

actions of a third party which may harm the function of indicating the origin of goods or services. In terms of protection against damage to the reputation or the function of communicating brand image proposed in the dissertation, the distinctive character is not a factor differentiating the scope of protection. According to the author, the important features are brand image and knowledge of the trademark. Therefore, distinctive character of a trade mark is not its only feature determining the scope of its protection.

The dissertation identified specific substantive law mechanisms aimed at preventing the protection of marks devoid of distinctiveness. Amongst them, the most important are the following institutions: limitation on the effects of a trademark, territorial restrictions on a prohibition and freedom of movement of goods and services, as well as abuse of rights doctrine. Such a mechanism may also be a rebuttal of the presumption of a national trade mark in proceedings aimed at its protection, which, however, the author criticizes.

The dissertation also considers mechanisms of procedural law aimed at preventing the protection of trademarks devoid of distinctive character. The most effective tool for this purpose is an application for a declaration of invalidity of an earlier trade mark submitted within a counterclaim before a court. The author postulates that this legal concept should be adopted under Polish law as it is not contrary to the provisions of the directive.