

NEWSLETTER

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The institution of the letter of consent in Trademark Law

The amendment from July 24, 2015, which entered into force on December 1 of the same year, in addition to a number of technical amendments made in the Law on Industrial Property (Act of 30 June 2000; OJ 2001 No. 49, item 508), also introduced quite significant (especially for businessmen) institution regulated by Art. 133 - the so-called **the institution of the letter of consent**, which largely expand opportunities and in many cases facilitate the process of obtaining the right of protection for a trademark, despite the conflict of character.

Letter of consent is a **written statement of the owner of the registered trademark with earlier priority allowing to make another entity registration of a trademark**, which is in conflict with an already existing right of protection enjoyed by just the original owner.

After the amendment of September 11, 2015 relevant consent can be applied also to a conflict of trademark **with existing personal and property rights of third parties**. A third party whose personal or property rights are violated by later trademark, may grant the owner of such a mark written consent to the granting of the right of protection.

‘Art. 133. If the holder of the earlier trademark or the holder of an earlier personal or property right express written consent to grant the right of protection for a later trademark objection, referred to in art. 152^{6a} paragraph 1 or art. 152¹⁷ paragraph 1, must be dismissed.’

Basis for refusing protection right for a trademark because of the existing conflict of personal and financial interests of third parties is governed by art. 132¹ paragraph 1 point 1 Law on Industrial Property and is dependent on the cumulative fulfillment of the following two reasons:

- 1) **the existence** of another person's personal or property right **before the date of priority of the trademark** (these include personal rights from art. 23 KC, copyrights, etc.).
and
- 2) the possibility of violations of the above interests through the **use** of such marks at issue.

‘Art. 132¹ paragraph 1. After considering the objection referred to in Article. 152^{6a} paragraph 1 or art. 152¹⁷ paragraph 1, considered to be legitimate, the right of protection for a trade mark is not granted:

1) the use of which violates the personal or property rights of others; (...)’

Taking also into account the introduction of the so-called ‘opposition procedure’, which in a nutshell means conducting a *quasi* proceedings examining the relative fulfilment of conditions for the registration of the trademark on the application of (the applicant), and the inclusion of two groups of situations institution of letter of consent referred to in the aforementioned Article 133 Law on Industrial Property, it is clear that the **effect of granting consent of the concerned letter is a rejection of the opposition referred to in Article 152^{6a} paragraph 1 or art. 152¹⁷ paragraph 1.**

‘**Art. 152^{6a} paragraph 1.** Within 3 months from the date of announcement of **international trademark** on the territory of the Republic of Poland, entitled to the earlier trademark or holder of an earlier personal or property right may object to the designation of the Republic of Polish international trade mark for the reasons referred to in art. 132¹ paragraph. 1-3. This term can not be restored.’

‘**Art. 152¹⁷ paragraph 1.** Within 3 months from the date of publication of the trademark application, entitled to the earlier trade mark or holder of an earlier personal or property right may **oppose a trade mark application** for the reasons referred to in Article. 132¹ paragraph 1-3. This term can not be restored.’

This regulation facilitates the situation for entities , which in uncontested and necessary conditions for the conduct of its business, would like to use similar trademarks. No such provision born with the major complications in terms of collision between trademarks, especially in the relations of domination and dependence of companies.

Often, in fact, there were situations in which the company - daughter wanted to register a collision mark with later priority, and in spite of the existing capital relations between the companies such property rights were not given.

To a large extent the letters of consent will make the proceedings of obtaining the right of protection for a trademark easier, which was also highlighted in the explanatory memorandum to the amendment from July 24, 2015. We read there that the introduction of such a specific provision will allow for an increase in the number of positive decisions issued by the Polish Patent Office regarding the granting of rights of trademark protection up to 1,000 decisions per year.

It is worth noting that the ability to regulate letters of consent, which decided to use the Polish legislator, results from art. 4 paragraph 5 of the Directive 2008/95/EC of the European Parliament and Council from October 22, 2008 aiming to approximate the laws of the Member States relating to trademarks.
