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## The Title Covered by the Exclusive Right as the Subject of Legal Protection under Polish Industrial Property Law

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Silesian Journal of Legal Studies 3, 26-38

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2011

Artykuł został opracowany do udostępnienia w internecie przez Muzeum Historii Polski w ramach prac podejmowanych na rzecz zapewnienia otwartego, powszechnego i trwałego dostępu do polskiego dorobku naukowego i kulturalnego. Artykuł jest umieszczony w kolekcji cyfrowej [bazhum.muzhp.pl](http://bazhum.muzhp.pl), gromadzącej zawartość polskich czasopism humanistycznych i społecznych.

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# THE TITLE COVERED BY THE EXCLUSIVE RIGHT AS THE SUBJECT OF LEGAL PROTECTION UNDER POLISH INDUSTRIAL PROPERTY LAW

## 1. INTRODUCTION

Intellectual property is often defined as "knowledge which may be transformed into value". Nowadays, the importance of knowledge is steadily growing in the economic system. Today, not only material goods decide the value of enterprise, but also intellectual property which becomes more and more important. Thus, the management of intellectual property is particularly significant in the growing standard of enterprise. Consequently, in terms of the functioning of business entities it is crucial to register markers as trademarks. Granting the protective right as the exclusive law on trademarks gives possibility to use trademarks in an earning and professional way in the whole area of the Republic of Poland and consequently add many benefits to Polish traders. In this study the author quotes several judgements delivered under the Act of Trademarks of 31 January 1985 (Journal of Polish State Law 1985, No. 5, item 17), which, however, keeps the whole novelty under the currently obtained Act of Industrial Property Law [i.p.l.] of 30 June 2000 (Journal of Polish State Law 2001, No 49, item 508; consolidated act Journal of Polish State Law 2003, No. 119, item 1117). This study aims to present the protection of the title in the light of the Industrial Property Law.

## 2. PREMISES

The title "as such" is a word which is used to identify a concrete literary or scientific book, novel, article, magazine, film, musical or even theatrical play (Słownik języka polskiego, 1981). It does not need to have a general character or refer to the whole item but it can also be a headline of any part of the work. The title functions as an identifier, which is not a distinguishing marker in the classic sense of the word. Generally, the aim of the classic distinguishing markers as trademarks, *entrepreneurs'* markers and geographical indications is to identify the traders with the products or services they offer on the market (Skubisz, 1997: p. 13). In theory of literature it is assumed that the title performs two functions: it identifies intellectual literary work (identification function) and introduces the readers into the literary work (initial metastatement function) (Tylec, 2006: p. 30).

Titles can be protected under the Polish copyright law (Journal of Polish State Law 1994, No. 24, item 83) but only when the title fulfills the prerequisites contained in the Polish copyright law in Article 1, especially in the provision saying that it has to be creative. Thus, titles can be divided into ones which are creative and can be protected by

legal measures contained in the Polish copyright act (they are called original in French literature and strong in German) or ones which are not creative and cannot be protected (banal or weak). Polish doctrine divides titles in a different way which is patterned after the French and German considerations. There are original titles characterized by a high intellectual and emotional charge like *Faust*, *Diaboliad* etc., trivial titles which present only the content of the work like *The Peasants*, *Revenge*, *The Wedding*, *The Little Match Girl*, *The Ugly Duckling* etc., and titles which do not extend beyond specifying the genre *Tales*, *Poems*, *Sculptures* etc. (Tylec, 2006: p. 29).

A trademark is an intangible asset, which is regulated under Article 120 (1) of The Act of Industrial Property Law (further: i.p.l.). A trademark is “*any sign capable of being represented graphically [...], provided that such signs are capable of distinguishing the goods of one undertaking from those of other undertakings*”. A trademark is a word, number, a phrase, a symbol or a design, or a combination of words, phrases, symbols or designs or colours, a three-dimensional shape of goods or of their packaging, as well as melodies or other acoustic signals used by an individual, a business organization or other legal entity to identify uniquely the source of its products and/or services to consumers, and to distinguish its products or services from those of other entities. It can be said that a trademark is connected with the source of origin, which means with the enterprise understood as the entrepreneur (the subject approach). That exemplary catalogue of markers which can be treated as trademarks is presented in Article 120 (2) of the Act of Industrial Property Law. However, even if a marker is included in that list, it does not automatically mean that the protection is granted. A trademark is registrable if it is able to distinguish the goods or services of a party and thus not to confuse consumers about the relationship between one party and another, and consequently not to mislead consumers with respect to the qualities of the product. This point of view is also represented and underlined in the jurisdiction (see the case of the three-dimensional sign „TUBA”, of 6 July 2004, 6 II SA 1617/03, unpublished judgement adjudication, see *Orzecznictwo sądów administracyjnych. Własność przemysłowa*, 2007: p. 49).

The owner of a registered trademark is the subject who can authorise his exclusive rights (the right of protection), it can be the creator of the marker/the sign or the person who is not the creator but the applicant. There are many kinds of trademarks, for example an individual trademark which can be submitted by a natural or legal person even if they are not an entrepreneur in the meaning of the industrial property law. In case of entities lacking legal personality, a right of protection may only be granted on behalf of a legal person, of which the entity is member, or on behalf of a natural person or persons running that entity on their behalf. Besides, the Act provides for a registration of a individual trademark which can be used by several traders who have jointly applied for the protection. It is the so called joint right of protection. It is important to underline that such use cannot be contrary to public interests and not intended to mislead the public, in particular as to the nature, intended purpose, quality, properties or origin of the goods (art. 122 i.p.l.).

The legislator regulated the possibility to register also a collective mark, which can be divided into two groups. An ordinary collective trademark (art. 136 i.p.l.) which can be granted to “*any organisation enjoying the status of legal entity and created in order to represent the interests of the undertakings*”. It can be used in the course of trade by that organisation and the entities grouped therein. The principles of the use of a trademark should be determined by the regulations adopted by that organisation. A collective guar-

antee mark (art. 137 i.p.l.), which is given for compliance with defined common standards for all goods and services. That trademark can be granted to an incorporated organisation (enjoying the status of legal entity), but its aim is not to concentrate on a representativeness of traders' interests, because the only entitled person to use a trademark is the entrepreneur not an organisation. The conditions of using a trademark should be specified in special regulations (Du Vall, Nowińska, Promińska, 2007: p. 215–221).

### **3. THE CAPABILITY OF DISTINCTIVENESS AND THE CAPABILITY OF DISTINGUISHING – THE SO CALLED ABSTRACT CAPABILITY OF DISTINGUISHING AND CONCRETE CAPABILITY OF DISTINGUISHING**

The Polish definition of trademark rests on the fundamental function which trademarks should perform. The constitutive condition of a trademark is not an individual/original/imaginative feature, as it is the case in the copyright law, but only its capability to distinguish goods and services in terms of origin (Błęszyńska-Wysocka, 2008: p. 13). This is the so called abstract prerequisite, which is used to rate a mark as trademark in a potential way. It means that the mark has to be distinctive *in abstracto*, in spite of a concrete good or service. Firstly, it is important to analyse if a mark fulfills the following conditions: it has to be perceivable by human sense, it has to be uniform and independent (self-dependent) against other goods, further it has to be capable to be represented graphically. According to such research, if a concrete sign fulfills the above-mentioned terms it means that it has a potential capability to be conceded as a trademark. At this point it is necessary to underline that it does not automatically mean that the protection is granted. A required prerequisite is the so called sufficient distinctive character, otherwise the concrete capability of distinguishing. The sign has to be researched in relation of concrete goods or services, *in concreto*. It is crucial to consider if a mark is capable to individualise the good or service on the market among other goods or services which derive from the same brand, though from other entrepreneurs (Du Vall, Nowińska, Promińska, 2007: p. 185–186; Skubisz, 1997: p. 55; see e.g. the judgement WSA VI SA/Wa 1765/2006).

Trademark as a special kind of sign is characterised by functional and structural elements. The first one was already reviewed in the first part, in turn it is important to concentrate on the second one – a structural topic pertains to the external construction of the mark, because the perception of the shape/layout of the symbol is the most prominent manner for the potential customers (Koczanowski, 1976: p. 19 and subsequent pages).

### **4. THE CAPABILITY OF DISTINCTIVENESS OF TITLES – PREMISES**

In accordance to the above-named capabilities in the literature it is possible to distinguish two categories of marks: marks which have the capability of distinctiveness and – marks which have the capability of distinguishing.

Marks which are simultaneously perceived by a human sense, are uniform and independent (self-dependent) and are capable to be represented graphically, are marks which can fulfill the function of the trademark, because they have the so called capability of distinctiveness.

#### **4.1. PERCEIVING BY HUMAN SENSES**

Perceiving by the human senses is the prerequisite, which was described by the doctrine. It means that anything can be distinctive, if it can be perceived by human senses. The fundamental are visual, auditory and touch modality. In the literature there are voices for including the so called new forms of trademarks, by regulations of the Industrial Property Law. It is said that even if marks cannot be visually perceived they can be trademarks. The olfactory and gustatory modality was the issue of some judgments of the European Court of Justice. It was underlined that the mark can be considered trademark even if it is not possible to perceive it by visual sense, provided that the sign is represented graphically in the clear, accurate, complete, easy, approachable, understandable, tenacious and objective way (see the case C-273/00 Sieckmann vs Deutsches Patent- und Markenamt, TE 2002 p. I-11737). Nowadays, the problem is very contemporary, because the technology is unpredictable.

#### **4.2. THE GRAPHICAL REPRESENTABILITY**

The graphical capability refers to presentation of the mark in a graphical way. That prerequisite was entered into Polish system of Industrial Property Law pursuant to the First Council Directive 89/104/EEC 21<sup>st</sup> December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, s. 1) and Council Regulation (EC) No 40/94 of 20<sup>th</sup> December 1993 on the Community trademark (OJ 1994 L 11, p. 1).

That expression is not so obvious as it may seem at the first glance, particularly because of the interpretation of registration of the marks perceived in a different way than by means of visual, auditory and tactile modality (see the case of the smell of the fresh cut grass, OHIM 2<sup>nd</sup> Board of Appeal, of 11 February 1999, R 156/1998-2). The arguments for that condition are connected with undoubted reflection and ascertainment of a demanding protection and the exclusive right. Besides, the technical aspects, such as registration and publication applications need the representation of the marks in the graphical manner. It is said that, that term should not be interpreted in the absolute remedy, because the melody or other acoustic signals can be presented by the indirect graphical form as a notation (Włodarczyk, 2001: p. 56).

The remedies used in the graphical representation depend on technical progress. In the literature can be found some thesis, according to which the trademark applied to registration should be presented in such way in which the subject (the consumer/recipient) sees it (Du Vall, Nowińska, Promińska, 2007: p. 188; the case MIXEŁKO/MIXEŁKO ŁACIATE the verdict of the Supreme Court of 22 February 2007, III CSK 300/2006).

#### **4.3. THE UNIFORMITY**

The potential recipient should command the whole sign during one visual act of cognition. To this end the sign should be characterised by conciseness and clarity (Koc-

zanowski, 1976: p. 19–22). Conciseness ensures immediate perception of the sign, the more laconic the sign the easier it is to remember. Clarity of the trademark allows to communicate in a minimal graphical structure the maximum of the content. The trademark should be simple and concise, so the protection can be granted to titles which are not very long and catchy. It is not possible to register a sign which is very long and thus not easy in sensual reception (see the verdict of the Supreme Administrative Court NSA of 8 June 2005, II GSK 65/2005). The sign has to be a link among the society, which is the quintessence of the uniformity of the mark. If the sign does not fulfil this term the decision should be negative under Article 129 (1) i.p.l. (Włodarczyk, 2001: p. 77–78).

#### 4.4. INDEPENDENCE

This prerequisite is the fundamental criterion of the capability of distinctiveness of the trademark. It is also called in the doctrine separateness or independence of the trademark in respect of goods or services. The mark ought to be a distinguishing and independent instrument, which is not imposed by the nature of the good. In that point of view independence does not mean that the mark is physically separate from the good. The customer links the sign with the product, but simultaneously has the awareness that the mark exists independently, it means that it can function without a physical link with the good in the economic circulation (Skubisz, 1997: p. 30; Włodarczyk, 2001: p. 59).

Independence is specified by Article 131 (2) (vi) i.p.l. There are circumstances which are exceptions: a form which is dictated exclusively by the nature (the required feature), a form which is necessary to achieve a technical result (the functional/utility feature) and a form which gives substantial value to the goods (the valuable feature) (Włodarczyk, 2001: pp. 62–64).

#### 4.5. SUMMARY

If the title of the work fulfils all the above-mentioned prerequisites thereby it has the capability of distinctiveness, that means that according to the rule of liberty of choice of the trademark, every configuration of the matter can be included in the legal status of the trademarks if the special regulations do not constitute something else, i.e. the sign will distinguish by sufficient distinctive character (Włodarczyk, 2001: p. 51). It is crucial to remember that the capability of distinctiveness is curiously significant in accordance with granting the right of protection for the trademark. The signs which are not self-dependent against the goods and services, do not fulfil the features of uniform or may not be presented graphically, therefore they may not be capable of being the trademark *in abstracto* and fulfill the main important function – distinguishing the goods and services of particular entrepreneurs. Thus, the right of protection for that kind of signs will not be granted under Article 129 (1) (i) i.p.l., besides, the legal basis for denial can be found in Article 131 (2) (vi) i.p.l.

## **5. THE CAPABILITY OF DISTINGUISHING OF TITLES – PREMISES**

The capability of distinguishing has got the sign, which fulfils all the above-mentioned prerequisites: perceiving by human senses, uniformity and self-contain against goods, and being capable to represent graphically, but simultaneously it cannot be the not-distinctive sign, descriptive and customary (Włodarczyk, 2001: p. 66). If the signs have the capability of distinguishing the protection can be granted under the provisions of Industrial Property Law. As it was already underlined in the judgements, the trademark will fulfill the capability of distinguishing, if it is represented graphically in the clear, strict, self-sufficient, easily available, comprehensible, tenacious and objective manner (see the verdict of WSA of 3 November 2006, VI SA/Wa 693/2006). In accordance with that the sign has to be made in such a way, that it will be consolidated by the customers in their memories and further will be read by them in the strict and desirable remedy. If the sign is not specified, does not appear in the same structure, it will not have the sufficient distinctive character (see the verdict of NSA of 23 November 2004, GSK 864/2004).

### **5.1. TITLES NOT HAVING THE CAPABILITY OF DISTINGUISHING – THE SO CALLED NON-DISTINGUISHING TITLES**

The Industrial Property Law in Article 129 (1) (ii) articulates the Polish notion formed in the doctrine that the protection will not be granted if the sign lacks its sufficient distinctive character. There are also specified circumstances when the marker will be indistinctive, under Article 129 (2): the markers deprived of the capability of distinguishing *sensu stricto* (not distinctive signs), the descriptive signs and the free signs (Funka, 2006: p. 35).

#### **5.1.1. TITLE AS THE MARKER NOT DISTINCTIVE SENSU STRICTO VERBALLY AND GRAPHICALLY**

In terms of the markers not distinguishing in the trade the legislator presented this problem in Article 129 (2) (i) i.p.l. Such signs “*are not capable of distinguishing, in trade, the goods for which they have been applied*”. They are also called markers deprived of the capability of distinguishing or deprived of the character of distinguishing (Włodarczyk, 2001: p. 68).

##### **5.1.1.1. RULES OF ESTIMATING THE NON-DISTINCTIVENESS**

The non-distinctiveness of the marker means that the sign does not perform the function of distinguishing (the function of identification and communication) the submitted goods and services. In Article 129 (1) (ii) i.p.l. signs which do not have the sufficient distinctive character may not be trademarks. Thus it is enough to present any of the distinctive points of the marker, even to a minimum degree.

Refusal to grant the protection should be admitted only when the sign in the obvious way cannot be used as a distinguishing marker of goods and services (the rule of obvious indistinctiveness). Article 130 i.p.l. is a stepping-stone to the non-distinctiveness of a sign under Article 129 (2) (i) i.p.l. W. Włodarczyk indicates that such circumstances should be taken into consideration as a kind of sign, a nature of goods and services

to which the mark referred to, typical conditions in the trade that goods and services, and the character of recipients. The rule of concrete non-distinctiveness – the assessment of the distinctive character is made according to the concrete goods and services which are marked by the sign. The rule of the overall consideration of the whole sign not its individual elements. In accordance with that, sometimes even if the elements of the sign are not distinctive, the sign will be the trademark because as a whole it has the capability of distinguishing. Finally, we should take into consideration the rule of the average recipient's attitude to the submitted goods and services in the ordinary market conditions. This entity is the recipient who is fairly well-informed and fairly reasonable. (Włodarczyk, 2001: pp. 72–75).

#### 5.1.1.2. TITLE AS A TRADITIONAL VERBAL TRADEMARK

From the point of view of titles the most important are the verbal and graphical trademarks (hereinafter referred to as verbal-visual). These so called traditional trademarks are mostly subject to the registration in the Polish Patent Office. The legislator has given them implied priority by placing them in the first position in the exemplary enumeration of signs which are trademarks under the Industrial Property Law (Article 120 (2) i.p.l.).

The verbal markers are signs which are expressed by means of a word or a combination of words, a misspelt word, onomatopoeias, and also sentences, texts, letters, syllables and even figures or numbers or mathematical symbols. J. Koczanowski distinguished among the collective category of verbal trademarks some subgroups: a verbal mark *sensu stricto*, a number mark, a letter mark and a slogan (Koczanowski, 1976: p. 25). Under the judgement of Polish judges a sign being a number can be a trademark, if it does not indicate directly the feature of the good, its quantity, quality, weight etc. (see the case of the verbal trademark “495” of 27 February 2004, II SA 1828/2002).

Among the titles we can distinguish those which are expressed by a colloquial, imaginative, quasi-imaginative, descriptive or quasi-descriptive word. Colloquial words are ones which are included in a Polish dictionary. These can be everyday words, banal, ordinary, without any originality. In the category of the colloquial words we can distinguish groups of quasi-imaginative and imaginative words. The former in their nature are not imaginative words as such, but in their recipients' minds they appear imaginative only when associated with the specific goods and services. In turn the essence of the fancy words is connected with their originality and novelty. Their creative character can manifest itself in making up a word, making a colloquial word strange, not banal or out of the ordinary. For example W. Pielewin's “*Empire V*”, which is the effect of a wordplay and hiding the word vampire, W. Gombrowicz's “*Ferdydurke*”, M. Bulgakov's “*Diaboliad*”, W. Wharton's “*Birdy*” etc. In the scope of the verbal words it is worth emphasising the non-distinctiveness of the so called quasi-descriptive words (a kind of imaginative words) and descriptive ones. The idea of the former boils down to the reception of the sign as descriptive by average customer even if the word is used as fancy. These seconds are used to describe applied goods and services under the meaning in Article 129 (2) (ii) i.p.l. (Włodarczyk, 2001: pp. 78–82).

Incidentally, it should be noted that when referring to professional terms (medical, pharmaceutical) we have to realise that generally such terms in the expectations of average recipients will appear imaginative but in reality they will be only descriptive phrases in their nature. Accordingly, a negative decision should be made under Article 129 (2) (ii) i.p.l. (Włodarczyk, 2001: p. 82).



### **5.1.1.3. THE TITLE AS THE TRADITIONAL GRAPHICAL TRADEMARK (VERBAL-VISUAL)**

This kind of trademarks are also very popular in the Polish Patent Office. The visual signs can adopt various forms of expression. Particularly it can be a drawing presenting concrete subjects or abstract composition, a punch, a stigma, a label etc. The graphical signs as well as the verbal signs have to be characterised by the graphical representativeness, uniformity and independence. That kind of signs are obviously presented in a graphic form – the shape, colour, pattern etc. They are uniform if the structure is not so sophisticated, and self reliant if it is independent of goods and services. The verbal titles can be presented in a graphical manner, as the visual-verbal. It has to be underlined that under Article 129 (1) (ii) i.p.l. it cannot be denied the protection because of the non-distinctiveness in the meaning of Article 129 (2) (i) i.p.l. only because the verbal element of the sign is not distinctive or the graphical part is not distinctive. This approach is rooted in the rule of the overall consideration of the sign (Włodarczyk, 2001: p. 106).

### **5.1.1.4. SUMMARY**

In fact the verbal signs are generally presented in such a way that they can fulfill the abstract capability of distinguishing in spite of the contents, which they expressed. According to J. Koczanowski trademarks are considered “as such”, if a word, letter or number included in the normalised form indicates trademarks’ individuality. Even if they are included in some artistic forms, they will be still considered verbal signs if the graphical setting is only an esthetic and non-distinctive element of the marker. This is the difference between the verbal and the compartment signs, in which the most prominent part of the mark is the artistic composition (Koczanowski, 1976: p. 29).

### **5.1.2. TITLE AS A DESCRIPTIVE MARKER**

Trademarks which are descriptive markers are the second group of the non-distinctive signs. The protection may not be granted under Article 129 (1) (ii) i.p.l. or Article 129 (2) (ii) i.p.l. The descriptive sign is a marker which consists only of the elements included in Article 129 (2) (ii) i.p.l. which are used on the market as signs conferring information about the features of goods and services.

This group of signs is indistinctive because of a few factors. Firstly, a trademark “as such” has to be an information carrier, which states the source of origin of the goods and services. Secondly, as a result of granting the exclusive right on the trademark, it is not possible to lead to such situation, when the capability of informing the consumers about features of the goods is limited (Du Vall, Nowińska, Promińska, 2007: p. 193).

The descriptive signs are also called the signs of the features of goods and services. In this category of signs a group of named signs can be distinguished such as: markers of kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function or usefulness, which are included in the open catalogue of descriptive signs, and there is also another group of unnamed signs to designate any other features of goods and services (Włodarczyk, 2001: p. 161).

Under Article 129 (2) (ii) i.p.l. the legislator stipulated the most typical descriptive signs. They include the so called signs of kind (the generic terms). Within this group we can distinguish: names of goods and services, which generally mean goods or services or even their genres, e.g. “a book” for books, “a dictionary” for dictionaries, “a guide” for guides etc., names of components, scientific names of chemical elements, scientific

ic names of therapeutic plants. Furthermore, the generic terms are also signs of manufacturing process which indicates the method of producing the good. Among the descriptive markers we can distinguish the signs of origin, directly indicating the source of origin of the good. The quality and quantity markers may present accordingly the features of the good and its weight and number, etc. The value markers, which can show the value of goods or services, e.g. a cheap book. The signs of intended purpose, which shows the aim of the good and service. The composition markers may serve the purpose of informing on the ingredients of the good. The signs of function and usefulness are markers which complete the list. (Włodarczyk, 2001: pp. 196–212).

#### **5.1.2.1. RULES OF ASSESSING THE DESCRIPTIVENESS**

The descriptive or informative character of the sign is a feature which shows not the abstract but the concrete capability of distinguishing of the trademark (see the case “SUPERMARKET”, the verdict of the Supreme Administrative Court of 8 June 2005, II GSK 65/05). The prohibition of granting the protection on descriptive signs has its source in the principle of freedom of communication in the scope of description of goods and services (Włodarczyk, 2001: p.165 and the following).

As it was already underlined, the sign is indistinctive if its elements are only descriptive and have a dominant character – the rule of exclusive description (Włodarczyk, 2001: p. 161; see the case “MISS” verdict of the Supreme Court of 1 February 2001, I CKN 1128/98, and see also Stefanicki 2002: p. 83). The above-mentioned rule is closely connected with the rule of the overall consideration of the sign (see the case “MIĘTA C.FIX” verdict of the Supreme Court of 11 March 1999, III RN 136/98; see the case “100 PANORAMICZNYCH” verdict of the Supreme Court of 4 December 2002, III RN 218/2001). Furthermore, we should take into account the rule of the approaching of the average recipients, which manifests itself in free access to all signs informing about the name or features of the goods or services (see the case “WAWELSKIE” verdict of the Supreme Court of 10 December 1996, III RN 50/96). Finally, any circumstances connected with the usage of the goods in trade must be taken into consideration. The prohibition of granting the right of protection to the descriptive markers is perceived as a restriction of the rule of the freedom of choice of the trademark, and for this respect such descriptiveness should be current, concrete and direct (Włodarczyk, 2001: p. 169).

Further, the rule of current descriptiveness refers to the phrase used in the act “*may serve, in trade, to designate*” a description of goods and services (Du Vall, Nowińska, Promińska, 2007: p. 194). Thus the signs which were used in the past and nowadays are archaic and no longer used may not be declared as descriptive, e.g. *Bogurodzica*, nor the signs which will gain their descriptive function in the future if there appear special conditions. The rule of concrete descriptiveness means that the sign consists of descriptive elements necessary for the description of the concrete goods and services to which it pertains to. Besides, according to the rule of direct descriptiveness only the signs which explicitly and directly indicate the features of the applied goods or services can be regarded as the signs presented in Article 129 (2) (ii) i.p.l. (Włodarczyk, 2001: pp. 172–182).

#### **5.1.2.2. THE TITLE AS A DESCRIPTIVE VERBAL AND GRAPHICAL SIGN (VERBAL-VISUAL)**

In the first instance the descriptive character of the sign such as titles can be a single word informing about a feature or features of the submitted goods, e.g. the work entitled

*Comedy, Drama, Musical, Opera, Hit Parade, Sports News* etc. Additionally such signs can be represented by a combination of words in one word, e.g. *Telemagazine, Telegrosik, Teleshop* etc. Besides, the titles indicating a function performed by certain works of human intellect, e.g. *Real Player, Quick Play, Photoshop* etc. While considering such cases it is crucial to take into consideration the position expressed by the doctrine, according to which, the very fact of combining two descriptive words into one, does not decide the descriptiveness of the newly formed word. At this point it is worth stressing the fact that it is not justifiable to point out this general argument that that all figures are always quantity markers. When studying the descriptiveness of a given marker, it is important to look at as a whole, not as a specific part, and to pay attention to the goods and services for which the sign is submitted (see the case of verbal trademark “495” of 27 February 2004, II SA 1828/2002). Descriptive signs can be not only verbal markers but also graphical ones (hereinafter verbal-visual). In the case of the combined markers the fixed rule is applied in the judgements according to which the verbal part of the markers has its dominating sense ascribed to its visual layer (Włodarczyk, 2001: pp. 189–190).

### **5.1.2.3. SUMMARY**

The aim of the provisions of Article 129 (1) (ii) icm Article 129 (2) (ii) is to eliminate cases of granting the exclusive right for the descriptive signs, but at this point it is important to underline Article 156 (1) (ii) i.p.l., in which the legislator provided for the limits of the protection for the trademark. The right of protection shall not entitle the right holder to prohibit third parties using, in the course of trade indications concerning, in particular, the features and characteristics of goods, the kind, quantity, quality, intended purpose, origin, the time of production or of expiration of usability period. Summing up this regulation allows to use by unauthorised persons registered signs or signs similar to them in a justifiable way, provided that the sign is used only as the descriptive sign.

### **5.1.3. THE TITLE AS THE CUSTOMARY MARKER**

The third group of the non-distinctive signs includes the so called free trademarks, which are a collective group of markers asserted in the free sign form, it means the sign generally using under meaning of art. 129 (i) (ii) i.p.l. (Włodarczyk, 2001: p. 214 and the following). This group includes the signs which have become in the current language and are used as the name of the good and also the signs, which are used in fair and established business practices. The first group comprises the markers which were original, imaginative and thus were of a distinguishing character (they identified a given good), but as a result of usage they have become commonly applied to indicating and describing the good. Actually they became generic names. The second group of the signs is researched according to the established practices of the trade, which should be understood as commercial usage and commercial custom. Therefore, customary use in a more restricted group than the general public is sufficient to constitute a ground for refusal (Du Vall, Nowińska, Promińska, 2007: p. 195; see the case of “WEISSE SEITEN” of 16 March 2006, T-322/03).

#### **5.1.3.1. RULES OF ESTIMATING THE FREE CHARACTER OF THE MARKER**

The rule of specified usage in the past means that the sign will be free under the meaning of Article 129 (i) (iii) i.p.l. if the sign was formerly used as the identification marker

of goods and services, and in time it stopped performing such a function. The rule of national usage means common usage on the territory the Republic of Poland. The rule of regional usage of the sign means that the trademark does not have to be used on the territory of the whole country, it will be enough if it is used in its part. The rule of common usage cannot be identified with the common knowledge, because the very fact of popularization of the marker does not decide the free character of the trademark. The rule of current usage means that free signs can be regarded as signs which are currently and commonly used. The rule of representational reference is not explicitly stated in the act. Not only the fact of a common usage of the sign in the current language or a common usage in fair and established business practices is crucial in order to consider the sign as a free trademark, but also the sign has to be used accordingly to the description of the features of goods or services or to be used as a sign of their identity. Besides, the rule of the overall assessment of the sign and the rule of concrete reference, i.e. the assessment should be made in connection with a concrete good or service, to which the sign was applied (Włodarczyk, 2001: pp. 219–225).

### **5.1.3.2. SUMMARY**

As a result of the lack of activity on the part of the entitled person free trademarks are subject to degeneration or “watering” or “dilution”, which means that the content of the information conveyed by the sign is changing in a special way. Instead of the information on the product’s origin, the marker conveys information on the good “as such”. The process of degeneration of trademarks conducted to change the original function of the distinguishing trademarks and make them only ordinary words, for example a computer, petrolatum, nylon etc. In the doctrine we can distinguish two theories of degeneration of trademarks: the objective theory and the subjective theory. The first one assumed that the transformation of the original trademark to the name of the product is finished when in the opinion of the interested group of customers a given marker lost its distinctive features and is associated only with the product “as such” instead of the origin from a specific enterprise. The second theory underlined the essence of the behaviour of the entitled person. It means that as long as the authorised person demonstrates his interest in retaining the sign as the trademark, despite the common opinion of its degeneration (changing its function into the name of the product), the sign will be the trademark (Wiszniewska, 1992).

## **6. SUMMARY**

In respect of the above presented division of the titles into ones which are creative and can be protected by legal measures contained in the Polish copyright act and ones which are not creative and cannot be protected, this study aimed at drawing attention to the possibility of extending the protection of titles to the protection regulated under the industrial property law. The industrial regulation covers also non-business entities that can be creators.

The category of creators is very wide and includes: literary activity, artistic activity, photography, music etc. Every such entity has the right to give its work a title which includes the quintessence of the work and leads to the theme of the work. Under the industrial property law it is possible to find titles which can be treated as trademarks if

they possess the capability of distinctiveness. Surely this requirement will be fulfilled in the case of titles which are uniform in their substance, i.e. they are laconic and short enough to be memorized by the recipient as a result of one act of perception. The complicated construction of the title, e.g. *The Disintegration of the Persistence of Memory* by Salvador Dali, in the process of analysis of a concrete case can be proved to show the distinguishing or indistinctive character. It is not forbidden to register longer phrases (slogans/catchwords) but it is necessary to prove the distinguishing features. Independence of the title, which is the trademark, in most cases is not so difficult to establish because the title is the author's finished statement which introduces us to the work and differentiates the work from others. Firstly, according to the kind of work and position of the author on the artistic stage, the title's function is to identify the author and secondly to identify the subject matter of the work. Independence is related with independent choice of the title by the author, generally this process is unlimited.

In the case of the imaginative signs the distinguishing function is obvious, but simultaneously it has to be underlined that other words even trivial can be trademarks. The process of assessing the sign and its capability of distinguishing is always conducted *ad casum*, and according to the rule of the overall consideration of the marker and in connection with the goods and services. The description can be surely found in the titles indicating the content of the work, its kind, for example *Poradniki, Przegląd ustawodawstwa, Kroniki etc.*, the feature of the good and service for example Leonardo da Vinci's *Sketches of Horses* or his *Self-portrait*. However, such kind of titles can be registered as graphical trademarks. The non-distinctiveness *sensu stricto* and the descriptive character is not the only goal of the process of study, moreover the free character has to be excluded of the sign under the meaning of Industrial Property Law. It cannot be forgotten the so called secondary distinguishing capability, because even the non-distinctive, descriptive and free marker in some cases can be contained under industrial property law protection.

The trademark, which is the instrument of the market economy has to achieve the goal of increasing the economic position of the entrepreneur on the market stage. The quintessence of the trademarks is concentrated on the identity of the goods and services, cooperated with the advertising and guarantee function of the trademark. Willy Olins underlined, that long time ago "*the appearance of the brand presented and promoted the product*" (Olins, 2004: p.13). Everything that is positive, valuable, with high quality, put in the emotional frame, is behind the visual form of the brand. That whole figure builds the prestige of the product, which is introduced to the market. Although the creator as the artistic subject, is not interested in becoming an entrepreneur, is the representative of the liberal professions. The author builds his position on his own works and in accordance with that the registration of the titles is useless for him. It can be said that the author is a brand of his own. The registration process is expensive and time-consuming, which is the disadvantages for the authors.

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