

LAZARSKI UNIVERSITY

FACULTY OF LAW AND ADMINISTRATION

Wojciech Gierszewski

Summary of the PhD dissertation entitled „Trademark descriptiveness as an obstacle and limitation of a trademark protection – substantive and procedural aspects”

prepared under the supervision of:

dr hab. Malgorzata Manowska, prof. UŁa, and dr Dominika Harasimiuk

This dissertation aims to analyse the notion of trademark descriptiveness as an obstacle and limitation of the scope of the Polish and EU trademarks. The subject matter concerned has not been subject to such thorough analysis so far whilst it is of great relevance to the school of thoughts and the legal practice.

Trademark descriptiveness is a term used in the doctrine and judicial decisions. It exists mainly as a ground for refusal in granting trademark. Its role as a limitation of scope of the trademark is less important. It may be perceived on the two layers: general and direct. The general layer helps to identify an obstacle as being a part of group of signs informing about the goods and its features. The direct layer demonstrate what the descriptiveness is expressed with i.e. what kind of information about goods or services it communicates. The criterias for assessing the trademark descriptiveness were not set by legislature but by the judicial decisions and the doctrine. There are general criterias common for all kinds of trademarks and particular criterias concerning certain types of trademarks and its substance.

The analysis of a case law reveals that it is extremely problematic to keep the common criterias even for the most typical kind of trademarks. Even for them there are many different scenarios that require application of additional criterias. Both general and particular criterias are not always understood evenly. The case law shows many discrepancies that raise questions about systemic consistency of the notion of descriptiveness. Moreover uneven decision making practice require to ask whether the notion of descriptiveness achieves its goal. That leads to another question whether the notion of descriptiveness is a question of facts or whether it has shifted towards legal assesment. Trademark descritpiveness despite of being an absolute

grounds for refusal in getting trademark protection may be overcome by proving the acquired distinctiveness. The problem in the analyzed area is also the scope of protection of a trademark consisting of or comprising descriptive indication.

This dissertation therefore aims to establish the scope of the notion of descriptiveness both on the general and direct layer. It also tries to answer whether trademark descriptiveness is a matter of facts or just a legal assessment based on the set criteria. In the light of the above the two main research hypotheses were set. First one according to which the notion of descriptiveness is characterized by multi-facet instability and the second one according to which trademark descriptiveness is a matter of facts.

The research conducted in this work was based on the dogmatic method with the auxiliary use of other methods typical in legal science.

The work consists of 9 chapters. In the 1. Chapter all the trademark introductory issues were raised including the main characteristic of grounds for trademark refusal. 2 Chapter presents the regulations on descriptiveness: local, European and international. It also discusses the role of judicial decisions in rightly understanding the notion discussed. Chapter 3. analyses the ratio legis of descriptiveness also in the historical perspective. Chapter 4. discusses the criteria and methodology of assessing trademark descriptiveness as well as typical issues related to it. Chapter 5. analyses the scope of trademark descriptiveness with respect to most typical types of trademark and also to its word layer and the meaning of graphical elements. Chapter 6. presents the meaning of certain characteristics grouped in notion of descriptiveness and analyses relevant case law. In 7. Chapter the conditions of acquired distinctiveness were discussed. Where Chapter 8. concentrates on procedural aspects of the notion concerned. Conclusions in the Chapter 9. allows for positive verification of research hypotheses. They indicate the need of decision making practice and judicial decisions improvement. As a way to achieve it the work presents many corrections and indications in better understanding criteria used for the assessment.