

University of Gdańsk
Faculty of Law and Administration
Maciej Zejda, M.A.

Summary of the Ph.D. thesis
„The scope of permitted use of trade marks by third parties”

Supervisor: dr hab. J. Kruczałak-Jankowska, prof. UG

Advisor: dr Krzysztof Czub

1. RESEARCH OBJECTIVES AND STATE-OF-THE-ART

The thesis' main research objective is to determine the scope and assess the adequacy of the internal borders of the rights of the trade mark holder in relation to third parties which have interest to use a trade mark without obtaining consent of the proprietor. The subject of the thesis was limited to the analysis and assessment of permitted use of trade marks arising out of the structure of exclusive rights conferred on the proprietor as a result of registration – i.e. as an internal limitation of exclusive rights. Limitations arising out of certain legal situations (e.g. legal actions, court or administrative decisions), general limitations of all rights (e.g. the rules of social conduct or abuse of rights), and limitations concerning the conflict between right holders (e.g. co-ownership, meaning limitations of right holder's authorities *vice versa*, conflict between trade mark rights and prior rights of third parties) and even exhaustion of the rights conferred by the trade mark.

The main aim of the thesis is to answer the following questions:

1. Does the scope of trade mark exclusive rights allow for adequate application of the grounds for permitted use of trademarks by third parties?
2. Does the internal limitations of the scope of trade mark rights relating to the aim of such third party use allow to sufficiently protect the justified interest of the third parties?
3. Is it justified to consider a non-infringing trademark use in relation to freedom of speech provisions?

Despite theoretical and practical importance of the analyzed problems, it was never before subject of complex analysis in Polish legal doctrine. An article “Permitted use of trademarks (Polish law in comparison)” by G. Pacek, constitutes some contribution to the discussion on permitted use of trade marks. There is also a number of articles concerning certain, individual grounds of permitted use by third parties. However, none of these papers cover in full the subject of the thesis and do not refer

to the changes arising out of the reform of European trade mark law. The opinions on permitted use are an ever-developing issue, hence many problems covered by legal doctrine deserve new perspective and comparison with new developments in judiciary. In summary, the thesis constitutes first, complex analysis of permitted use of trademarks by third parties in Polish literature.

2. MAIN CONSIDERATIONS

The thesis consists of introduction, four chapters dealing with the main issues related to the research topic, and conclusion.

In the first chapter the author analyses the character of copyright law and industrial property rights limitations in the light of international, European and domestic regulations, as well as compares solutions of copyrights and industrial property rights to trademark law.

The second chapter considers – in light of EU law – a third-party trademark use in the course of trade, in relation to goods or services. This chapter also examines of third parties' acts interfering with exclusive rights conferred on the proprietor due to registration of trade mark.

Within the third chapter the author analyses specific grounds of permitted use, separately of the scope of exclusive rights, on the basis of EU law. In particular, thorough analysis was given to interpretation of general clause and the scope of certain grounds limiting exclusive rights. The legal nature of the provisions constituting permitted use by third parties was also scrutinized in third chapter.

Fourth chapter considers legal comparative analysis of the American and Australian legal systems in order to assess EU regulation from broader perspective.

3. CONCLUSIONS

The conducted research allows to draw i.a. the following conclusions:

- Broad scope of protection given by CJEU to double-identity infringements causes, that there is a lack of adequate limitation which may balance the interest of the proprietors, consumers and third parties. A potential solution lays in application of the functional test as a measure balancing the interests of all the parties in case there is a conflict between exclusive rights and the need for use of trade marks by third parties.
- The possibility to protect trade marks with reputation due to negative comments concerning non-verifiable image connected by the proprietor with its trade mark shall be criticized.
- The interpretation of the unfair advantage criteria in the context of infringing trade marks with reputation shall not be approved. The interpretation of unfair advantage by CJEU describe the process of gaining advantage rather than examine the character of such advantages, particularly if it shall be treated as unfair.

- Restrictive interpretation of the “due cause” requirement shall be criticized, specifically within the requirement of necessity to use trade mark with reputation. However, the correlation of the “due cause” requirement with the concept of fair competition and good faith shall be approved. Such perspective on the permitted use allows to balance the broadly interpreted concept of unfair advantage by recourse to the individual and public interest.
- The limitations of exclusive rights conferred by registration of trade marks related to the purpose of the third-party use are undermined by restrictive interpretation of the general clauses and thus do not protect sufficiently the interests of third parties.
- The wording of the EU law shall be interpreted as accepting the assessment of the “due cause” requirement with reference to the free speech rule.
- Introduction of a clear limitation of trade mark rights, allowing third parties to use it in parodies would strengthen the balance between the interest of parties in trade.
- American law allows third parties to use third parties due to the freedom of speech even when the use is aimed at a financial gain. Third parties’ successful defense depends on the lack of consumer confusion and also prove that the use of the trade mark has material cultural meaning.
- Comparing the foreign legal systems described in the thesis with EU law, it can be concluded that the situation of third parties is best protected by clear-cut grounds of infringement.

In summary, in order to achieve better protection of third parties’ interest under EU law, a proposal shall be put forward to increase the flexibility of the permitted use criteria, by ending their correlation with infringement criteria. Another solution is to boost the infringement by introducing a clear requirement that the third party use of a trade mark must indicate the origin of the goods or services.