



大成 DENTONS

# **Strong brands and cost-effective protection** with Dentons Warsaw

Grow | Protect | Operate | Finance

## Please see the nine key questions and answers on how to develop a strong brand and have cost-effective protection:

 **Q1: How do you create a strong brand?**

 **A:** You want your brand to stand out from the crowd. It should not be similar to your competitors' brands. It's best if it does not refer to the subject matter of your business. In fact, the more distinctive your brand, and the less it refers to inherent features of your offering, the more likely it is that you will be able to register your brand smoothly. This will also help you successfully enforce your rights against similar rival brands in the future.

Just think how difficult it is to protect a pharmaceutical brand that is predominantly based on the generic name of an active ingredient. And then think how strong a "fruit" related name for an IT company is.

 **Q2: What is a trademark search?**

 **A:** You really don't want to face trademark infringement claims in the future or see third party oppositions being filed against your brand.

So, before you file for trademark protection, you first need to search for brands that conflict with your desired trademark. Your marketing team could play a valuable role here, conducting presearches and drawing up your top brand candidates.

Your trademark counsel will next clear the brand. S/he will search trademark databases of intellectual property (IP) offices that grant rights in territories where you're going to use your new brand (e.g., USPTO for the US and EUIPO for the EU). Searches may also cover a general search on the Internet and social media, and a search for similar company names, Internet domains, apps stores, etc.

You will finally get guidance on how safe it is to adopt a specific brand, and how likely it is that you would need to invest in defending your brand in the future, considering conflicting marks.

 **Q3: Do I need to register a trademark?**

 **A:** The fact that you've been operating under a brand for a long time and have gained recognition under the brand would often give you good arguments against claims of owners who later file similar trademarks or when you sue them for use of similar brands.

### So why apply for a trademark?

In the above cases you would rely in legal terms on unfair competition, passing off or suchlike. However, that sort of protection is unwieldy and not user-friendly. For your claim to succeed, you'll probably need to show recognition on the market or goodwill.

Worse still, trademark laws can play tricks on you if you operate under unregistered brands. They may specifically allow you to use an existing unregistered brand that was first on a market and is used for a small, local business, even though your competitor later filed and registered a similar trademark. However, they do not provide clear answers on what happens if you want to use your unregistered brand at the national level or want to grow under that brand.

There is a clear clash between unfair competition (or similar) and trademark laws that are specifically designed to set rules on use and protection of brands. You may have strong arguments on your side (first on the market, you enjoy protection despite your rival's later registration) but your competitor will also have a bundle of good counterarguments that could sway the court. Do you accept this risk?

Trademark registration is a simple solution to obtain full rights to your brand, from the very moment of filing a trademark application. You can easily defend yourself against claims of third parties and protect your brand against use by

third parties. You do not need to use your brand immediately, but from Day One of filing you can claim priority to use it over competitors. You avoid the hassle of evidencing prior use or having to argue on rights that you should enjoy based on your prior use of the brand. You simply submit a registration certificate in any court dispute and that evidences your rights to the brand.



#### **Q4: Where do I register my brand?**



**A:** You register your brand in the territories where you're going to sell your goods/services.

You could apply for local (national) marks, but you can also apply for regional protection (e.g., for the EU). The latter is actually cheaper if you're targeting a few countries in the EU. Once you file a local or regional trademark you can file an international application allowing you to cover multiple territories in just one application. Again, this is the cheaper option. Ask your trademark counsel to go into the pros and cons.



#### **Q5: Which type of trademark?**



**A:** It depends on your desired scope of protection and your trademark protection budget.

##### **Fulllest protection strategy**

For top protection, file separate trademarks covering specific elements of your brand, namely:

- a word trademark constituting the name of your brand
- a word-figurative trademark constituting the graphic version of the name of your brand
- a figurative trademark for stand-alone, purely graphical (not verbal) element of your brand (if there is one)
- as well as a word-figurative trademark combining all these elements together, if used this way in commerce.

If you want to amend your brands in the future (verbal or graphical layers) you need to file amended trademarks.

This strategy gives you the strongest protection. It likely blocks similar rival brands (words, graphics, etc.). It also protects your trademarks against counter actions by your competitors. When you enforce your trademark rights against your competitors, they will do everything to undermine your rights. They may cancel your trademarks if you do not use them. For EU marks this use requirement activates 5 years after registration. If you trademark all versions of the brand you use, you should have no problems defending your trademark rights from being revoked.

##### **Cost saving strategy**

Alternative strategies deliver substantial savings on registration and renewal fees, while securing your position to a decent extent.

##### *Filing a word trademark only*

If your brand constitutes a word in simple graphics, with simple ornamentation, you could file only a word trademark. In fact, if you use your mark in a version that does not affect the perception of characteristic elements of your registered trademark or its distinctive character, you would likely defend your mark against revocation in the future.

However, if your brand constitutes a word inscribed into characteristic graphics and ornamentation you would be well-advised to file both a word trademark and a word-figurative trademark. The word trademark lets you fight (i) more word variations of your competitor's brand that is similar to the name of your brand, and (ii) more graphic variations of your competitor's word-figurative brand that exploits a word similar to your brand. On the other hand, the word-figurative trademark lets you fight competitors' brands which are less similar to the name of your brand but share visual similarities with your brand.



Alternatively, you might file only for a word-figurative trademark in the above case. You get at least basic protection over a distinctive word and characteristic graphics (depending on circumstances). This might let you fight identical words or graphics. However, fighting only similar words might prove problematic. Also, you will likely need to file graphically amended versions of your trademark in the future. Otherwise, your protection might be fully revoked due to non-use of the version of the trademark as registered, and lack of any word mark registration.

#### *Non-substantial amendments to your brand*

When you provide non-substantial amendments to your brand in the future (in verbal or graphical layers) you might forego filing amended trademarks. Do talk with your counsel first and confirm that the amended versions do not affect the distinctive character of your registered trademarks. Otherwise, you would have to file amended trademarks to avoid revocation of your registered trademarks in the future.

#### *Combination of a word and separate graphical element*

You may see combinations of a word brand (even in its graphic version) with a separate purely graphical element registered together as one word-figurative trademark.

This type of filing can deliver big savings on fees. It might be a good strategy for secondary brands in your portfolio that lack star potential going forward. The combination will protect you against competitors using a similar combination, or the same word or graphical element of your brand. However, you may have tough time enforcing your rights against a competitor who only uses one similar element to the one used in your combination, either a similar word or a similar graphical element.

Only file this sort of combination if you're positive you'll use these two elements combined together in the future (on your

website, products, invoices etc.). If not, your trademark may be revoked in the future. You will not defend this trademark if you provide only evidence showing separate use of these two elements (e.g., a flyer showing the purely graphical element; an invoice showing the name of the brand only). You cannot rely on evidence showing only part of your registered trademark.

#### **Summary**

It is crucial to decide which trademarks to file. Brand owners should pay close attention to this stage. The decisions made at this stage will affect how much your trademark portfolio will cost you in the future, how broad your protection will be under your registered trademarks and how effectively and at what cost you will be able to enforce your rights against competitors.



#### **Q6: How broad is my protection under the registration?**



**A:** Your trademark counsel will help you determine specific areas of business (classes of goods and services) and the particular goods/services your trademark will cover. For a smartphone app you will consider class 9, targeting in particular sale of downloadable computer software, and class 42 addressing in particular software design.

Next, your counsel will propose an exact list of goods and services your mark will cover in each class. Your mark will only be protected for the exact goods and services listed in the application, not for the whole class.

Most importantly, this list must cover specifically the goods/services you will provide under your brand. Please be patient with your counsel determining what exactly you are going to provide under the new brand. Otherwise, you may lose your trademark rights in the future. If the list does not cover the exact products or services you offer, your registered trademark will qualify for revocation.

 **Q7: What do registration proceedings look like?**

 **A:** After you file a trademark, the IP office may require some amendments to the list of goods/services. It may also question whether the brand is distinctive enough and thus whether or not it qualifies to be a registered trademark. For example, if the brand solely refers to the type of goods/services, and lacks any distinctive elements, you will get a provisional refusal. This would be the case for a drug brand constituting the word “Paracetamol” with simple pill graphics.

If your trademark is accepted at this stage, the IP office or third parties may now flag conflicting prior trademarks. Hopefully, you will resolve all such issues, and the IP office will grant you trademark protection (10 years in most territories).

 **Q8: How much will it cost?**

 **A:** Assuming you apply for a word trademark in China, US and EU, in 3 classes, your basic trademark search fees could start at EUR 4,500. The budget would ultimately depend on the exact IP office databases you instruct your trademark counsel to search, as well as any other rights you’d like covered by the search, such as Internet domains.

Hopefully the registration proceedings go smoothly and your registration fees are the initial filing fees, this will cost you roughly EUR 4,000-5,000 in the above scenario. However, the costs may go up a few times if an IP office doubts if the brand is distinctive enough and if it qualifies for trademark protection, or if third parties oppose your application based on their prior rights.

To make sure your registration costs correspond with budgets, please:

- design distinctive brands, and
- search the brand against conflicting trademarks before filing.

 **Q9: Anything else I need to be aware of?**

 **A:** Sooner or later you will need to start using the registered trademarks for goods/services covered in the territories of protection. Otherwise, you may lose your rights in relation to goods/services you do not provide under a trademark in a specific territory.

You may need to file, e.g., a declaration confirming use of the trademark in the US in the middle and before lapse of the first 10-year protection period.

You need to file to renew the trademark before the protection period lapses (10 years in most cases).

After registering your brand, you need to monitor similar trademark applications and oppose registration of conflicting marks. It is much easier to oppose a trademark before it is registered than fight a registered and used trademark.

## Best brand protection practices based on trademark laws and our experience in a nutshell:

-  Develop distinctive brands.
-  Search your new brand against conflicting trademarks.
-  Make conscious choices what exact trademarks you file protection and cost-wise.
-  Draw up an accurate list of goods/services providing exact and full coverage.
-  Use your registered trademarks and consult any adaptations with your trademark counsel.
-  Observe specific deadlines for filing declarations of use (where applicable), renewing trademarks, etc.
-  Monitor conflicting trademark applications.

# What we can do for you now

We are happy to boost the development and protection of your brands by:

- **training your marketing team** on how to develop distinctive brands, perform basic trademark searches and protect your brands
- **consulting on your existing and upcoming brands** to ensure sufficient protection.

This can be done immediately, free of charge (as regards the brands consultancy, to the extent it constitutes basic advice on the scope of existing and expected protection).

**Feel free to reach out to us.**

# About Dentons Warsaw's trademark team

## The trademark team at Dentons Warsaw helps brand owners:

- design distinctive trademarks
- develop strategies for protection of brands
- prosecute trademarks, whether at national, regional or international level
- monitor conflicting trademark applications
- enforce trademark rights and represent clients in opposition or invalidation proceedings
- fight counterfeit products
- transfer trademark rights
- manage trademark portfolios
- audit existing portfolios

We are a Key User with EUIPO.

We form part of a global team representing clients worldwide, which means you can benefit from direct access to the knowledge and experience of top experts in your markets.

You can enjoy high-level and unified trademark services globally under one roof.

### Dentons Warsaw's trademark team

You will also have direct access to the talents of our lawyers specializing in other aspects of law, such as tax law, corporate law, competition law and employment law. In short, comprehensive solutions.

By offering the same quality of service irrespective of location, we can readily respond to all your needs.

We are fully able to implement and coordinate your international projects.

## Our experience

### **World's leading nonalcoholic beverages producer:**

Providing IP protection strategy for 3D trademarks and designs.

### **International online food-delivery provider:**

Providing strategic advice on adopting a pan-European brand and color identification. Clearing the brand against conflicting trademarks, including "color" trademarks. EU portfolio management and representation in opposition and invalidation proceedings concerning the house brand.

**US producer of personalized bottles:** Developing strategy for Europe-wide 3D trademark and design protection. Filings in the European Union Intellectual Property Office (EUIPO).

**NIKE:** Providing brand protection services on an international scale and representing the client in customs seizures of goods infringing its trademarks.

**Global provider of financial services:** clearing and registering numerous trademarks around the world, including in China, India, UAE, US, Brazil, Mexico, Colombia, South Africa, Nigeria, Kenya. Portfolio management.

**Global broadcaster of TV channels:** Developing trademark protection strategy following rebranding. Filing EU, international and local trademarks and representing the client in registration and opposition proceedings.

**Leading European dairy products producer:** Numerous trademark filings in Poland, as well as leading cancellation and revocation proceedings before the Polish Patent Office (PPO).

**Global RE developer:** Successful invalidation of a competitor's office building trademark before the PPO, following claims raised against our client.

**Global airline:** Numerous trademark prosecutions in Poland and the EU, and opposition against the EU trademark.

**American media company:** Filing numerous EU and Polish trademarks for new TV programs.

**Chinese producer of raw materials:** Successful registration of an EU trademark despite the EUIPO's descriptiveness reservations.

**Japanese multinational manufacturing corporation:** Filing EU trademarks and representation before the EUIPO.

**Polish biscuits and chocolate products manufacturer:** Leading successful bad faith based invalidation proceedings before the PPO concerning trademarks filed by the previous owner of the company.

**Chinese manufacturer, Shanghai Stock Exchange listed:** Acquisition of the worldwide portfolio of trademarks for machine elements.

**UK media company:** Clearing the brand in the UK and EU, followed by EU, UK and international filings. Representing the client in opposition proceedings.

**Leading European confectionary manufacturer:** Enforcing the client's rights to a top chocolate brand in relation to a conflicting trademark filing in Poland.

**Polish meat substitutes producer:** Filing EU and international trademarks for an innovative Polish plants-based food producer. Representation in opposition proceedings.



# What Clients say

Our trademark team is recommended by international research and ranking agencies, clients and peers.

## **World Trademark Review 1000, 2023**

Aleksandra Politańska-Kunicka “is diligent, dedicated and detail oriented. She analyses her cases from all angles and develops a strategy that covers all bases.”

Marek Trojnarski “is a proactive and responsive partner, and his global network adds significant value for clients that require support across multiple jurisdictions.”

## **Chambers Europe, 2023**

Karol Laskowski’s advice is extremely precise, easy to understand and ultimately proved extremely successful. Karol understands all queries extremely quickly.

Marek Trojnarski is very responsive and very client-oriented. “He has great knowledge and insight into the practical challenges, not only the theoretical side of the law.”

## **The Legal 500 EMEA, 2023**

Karol Laskowski has incredible knowledge of the TMT field, not only in the legal part but also in the technical background. He understands every inquiry and project extremely quickly. His legal solutions are always brilliant.

Marek Trojnarski is a great lawyer who is always willing to help and find a pragmatic, customer-friendly solution.



# Feel free to reach out to us



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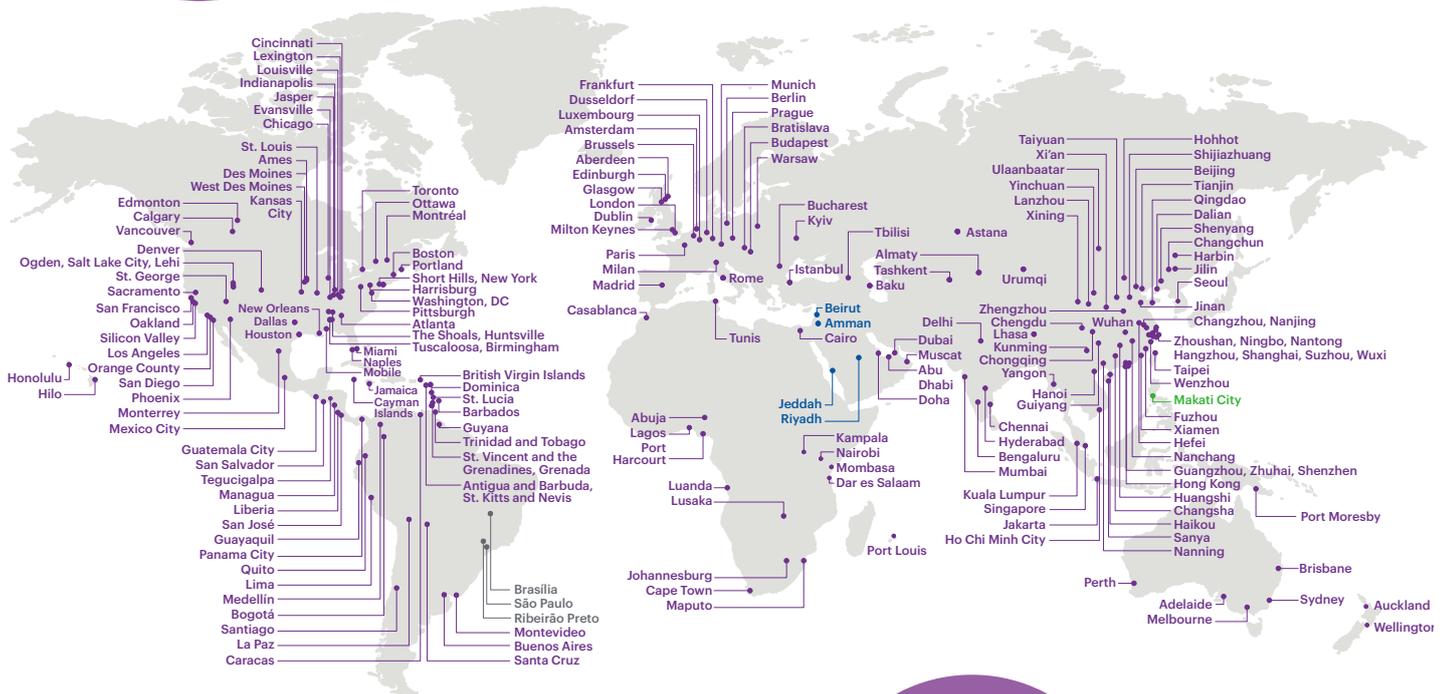
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# We are where you need us

**200+**  
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 Locations in gray represent Brazil Strategic Alliance.

**80+**  
countries

May 2023



**12,700+**

Total number of lawyers  
and professionals



## **ABOUT DENTONS**

Dentons is designed to be different. As the world's largest global law firm with 21,000 professionals in over 200 locations in more than 80 countries, we can help you grow, protect, operate and finance your business. Our polycentric and purpose-driven approach, together with our commitment to inclusion, diversity, equity and ESG, ensures we challenge the status quo to stay focused on what matters most to you.

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