

**Summary
of Professional Accomplishments and Contributions
in Science and Research**

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Lublin 2019

1. Name and Surname: Joanna Jowita Sitko

2. Diplomas, Degrees– place and time of them being granted, title of the doctoral dissertation

- *Diploma obtained upon the completion of Patent Attorney Training* – Polish Chamber of Patent Attorneys in Warsaw (16.02.2009), (license No 3283).
- *Diploma of the postgraduate studies on Industrial Property Law* – University of Warsaw, Faculty of Law and Administration (28.02.2007). Graduation with honors.
- *PhD in jurisprudence* – Maria Curie Skłodowska University in Lublin, Faculty of Law and Administration (18.10.2006). Doctoral thesis titled: „*Firma i jej ochrona*” („*Company Name and Its Protection*”) (the dissertation supervised by prof. Maria Poźniak - Niedzielska).
- *Master of Arts*– Maria Curie Skłodowska University in Lublin, Faculty of Law and Administration (26.05.1999). MA thesis titled: „*Licencja w polskim prawie autorskim oraz jej odniesienia do prawa Unii Europejskiej*” („*Licence Agreement in the Polish Copyright Law with the References to the European Union Law*) (the dissertation supervised by prof. Ryszard Skubisz). Graduation with honors.

3. Hitherto employment in research institutions

October 2009 – present	Assistant Professor at the Department of Enterprise Organization of the Faculty of Management of the Lublin University of Technology
May 2009 – present	Patent Attorney and partner at a law & patent office in Warsaw
October 2007 – August 2009	Assistant Professor at the Department of Commercial and Business Law of the Faculty of Law and Administration of Maria Curie Skłodowska University in Lublin
October 2001 – June 2007	Lecturer at the University College of Enterprise and Administration in Lublin
October 2002 – June 2007	Lecturer at the Faculty of Humanities (Cultural Studies)
May 2000 – September 2009	academic at the Department of Commercial and Business Law of the Faculty of Law and Administration of Maria Curie Skłodowska University in Lublin

4. Accomplishments as indicated in Article 16 of the Act of 14 March 2003 on Academic Degrees and Academic Title and Degrees and Title in Art (Journal of Laws of 2016, item 882 as amended by Journal of Laws of 2016, Item 1311):

4.1. Title of the accomplishment

Monograph titled „*Naruszenie prawa do znaku towarowego renomowanego. Studium prawnoporównawcze*”. (*Infringement of the Rights to a Trade Mark with a Reputation. Comparative Law Studies*)

4.2. Author, title of the publication, year published, publisher, reviewers

J. Sitko, *Naruszenie prawa do znaku towarowego renomowanego. Studium prawnoporównawcze, (Infringement of the Rights to a Trade Mark with a Reputation. Comparative Law Studies)* published by Wolters Kluwer, Warsaw 2019.

Reviewer: Prof. Urszula Promińska

4.3. Presentation of the monograph’s objective, obtained results, and a discussion of their possible application

The monograph titled “*Infringement of the Rights to a Trade Mark with a Reputation. Comparative Law Studies*” summarizes my hitherto research and didactics. The **research objective** of the monograph was a comprehensive discussion of premises concerning the infringement of the right to a trade mark with a reputation and circumstances excluding the infringement of the right to the category of distinctive marks in three legal systems - American federal law, EU law, and Polish law. The matter is complex in all three legal systems. This is due to the fact that the premises are not only expressly stated in legal regulations, but also stem from judicial decisions. The state of affairs in the American federal law is a consequence of the common law enforced in this system. Whereas, preliminary rulings of the Court of Justice of the European Union are of significance in the Polish and EU legislation. It is noteworthy that one of the fundamental premises concerning the infringement of the right to a trade mark with a reputation (i.e. the association between conflicting marks)¹, as well as the definition of the trade mark with a reputation itself², have been established by neither EU nor Polish legislators,

¹ Case C-408/01, *Adidas-Salomon v. Fitnessworld*, para 29, 31, available at: http://curia.europa.eu/jcms/jcms/j_6/en/

² Case C-375/97, *General Motors Corporation v Yplon SA (Chevy)* [1999] ECR I-05421, para 31.

but were formulated in the preliminary rulings of the Court of Justice. Due to the fact that preliminary rulings are the ones in which the Court interprets the regulation of particular directive pertaining to trade marks (at present, the directive 2015/2436³), the interpretations currently find application in litigation based upon the Polish law that implements the directive⁴.

I was enticed to undertake the issue of trade marks with a reputation by disturbing conclusions concerning the trade marks emerging from a trend I observed in judicial decisions linked with both EU and Polish cases. I observed that a very low similarity between the conflicting sign and the trade mark with a reputation was sufficient for the court to rule on the infringement. Such an occurrence did not emerge in the American federal law. The protection of trade marks with a reputation is much different from regulations embraced in Europe. One of the fundamental differences is the way the trade mark with a reputation is defined. Pursuant to § 43 c) (2) A) (15 U.S.C. § 1125) of the Lanham Act⁵, global reputation ought to be indicated in the American federal law, i.e. the familiarity and recognition of the trade mark among the general public in USA⁶. Whereas, the niche reputation is protected according to the Polish and EU legislation, i.e. trade mark with a reputation may be also a designation known only among a narrow group of e.g. experts in the field. It results from the definition of the trade mark with a reputation expressed in the *General Motors* case⁷. The second vital difference pertains to the form of the infringement. As opposed to the Polish and EU legislation, American law does not distinguish undue advantage being derived from the repute or the distinctive character of the mark as a separate form of infringement. Moreover, unlike the Polish and EU legislation, in

³ Directive (UE) 2015/2436 of the European Parliament and of the Council of 16 December 2015 r. to approximate the laws of the Member States relating to trade marks (OJ UE L 336/1).

⁴ See R. Skubisz, E. Skrzydło-Tefelska, *Związanie sądu krajowego wyrokiem Europejskiego Trybunału Sprawiedliwości Wspólnot Europejskich, wydany na podstawie art. 234 Traktatu o Wspólnocie Europejskiej* [in:] *Prawne problemy członkostwa Polski w Unii Europejskiej*, (ed.) L. Leszczyński, Lublin 2005, p. 68–69; P. Dąbrowska-Kłosińska, *Skutki wyroków prejudycjalnych TS w postępowaniu przed sądami krajowymi w świetle orzecznictwa i Traktatu z Lizbony*, EPS 2010/12, p. 9 i n.; J. Sitko, *Wpływ prejudycjalnych wyroków Trybunału Sprawiedliwości na prawo znaków towarowych na przykładzie znaków renomowanych* [in:] *100 lat ochrony własności przemysłowej w Polsce. Księga jubileuszowa Urzędu Patentowego Rzeczypospolitej Polskiej*, (ed.) A. Adamczak, Warszawa 2018, p.794-800.

⁵ Trade mark Act of 1946 (Lanham Act), Public Law 79-489, 60 Stat. 42.

⁶ American federal law features a statutory definition of a trade mark with a reputation enforced by the Trade mark Dilution Revision Act of 2006 (TDRA) that was included in the Lanham Act. Pursuant to § 43 c) (2) A) (15 U.S.C. § 1125) of the Lanham Act, „a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.” Although a term “famous trade mark” instead of “trade mark with a reputation” is used in, American law, in my monograph I use one, unitary term “trade mark with a reputation” in relation to all the legal systems I describe. It will make the disquisition more clear.

⁷ Pursuant to the ruling of the Court of Justice (C-375/97, *General Motors*), a trade mark may benefit from extended protection applicable to trade marks with a reputation if the trade mark is known by a „significant part of the public” concerned by the products or services it covers. The recognition must apply to a “substantial part of the territory” the mark is protected in.

American law, the sole fact of registration of the mark with a reputation is not a necessary provision of its protection. The above differences imply several consequences for the protection of trade marks with a reputation in the three legal systems. The consequences are discussed in detail further on. The vital differences in the approach to the protection of trade marks with a reputation on both continents became the reason behind the American federal law being selected as the reference point for the analysis of regulations adopted in the EU and Polish legislation.

As a consequence, the **research objective** of the monograph was to compare the Polish and EU legislation with regulations adopted in the American federal law with regard to the infringement of the right to a trade mark with a reputation and circumstances excluding liability of infringement. Due to the fact that both EU and Polish legislation concerning the protection of trade marks with a reputation is symmetric in general, these two were discussed jointly. Whereas, separate subchapters were devoted to issues pertaining to the American federal law. The regulations of the Polish Act – Industrial Property Law (IPL)⁸ are generally harmonious with the EU legislation concerning the field due to the requirement of domestic regulations being adapted to the ones featured in subsequent directives (directive no. 2015/2436 since 15.01.2019). In addition, the symmetry between the Polish and EU legislation is enhanced by the fact that directives concerning trade marks with a reputation are analogous with those regulating the protection of the EU trade mark with a reputation, which stems from the regulation 2017/1001⁹.

The **practical objective** of my research was to formulate *de lege ferenda* conclusions concerning Polish legal regulations for trade marks with a reputation.

In addition, the monograph approach to the protection of trade marks with a reputation in the Polish and EU legislation seems legitimate due to changes stimulated by amendments affecting regulations for both EU (see directive 2015/2436 and regulation 2017/1001) and domestic trade marks (draft amendment of the Act on Industrial Property Law of 2018¹⁰). As a consequence, I included changes emerging from the latest legal acts, primarily the amendment of Article 296.2.3 of the IPL (despite deadline having passed for adapting the domestic law to the regulations of the directive 2015/2436, legislative works are ongoing). The amendment is to include the premise of the due cause for the infringing party to use the mark as a circumstance

⁸ Act on Industrial Property Law of 2010 (*Dziennik Ustaw* 2017, item 776, as amended).

⁹ Regulation (UE) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ UE L 154/1).

¹⁰ Bill (2018) of the Act on amendments of the Act on Industrial Property Law of 2010 (USC 129).

excluding the infringement. These legislative changes and guidelines emerging from the abundance of judicial decisions of the Court of Justice of the European Union have not been analyzed comprehensively in any monograph discussing both the Polish and EU legislation¹¹.

The following two theses were presented on the basis of the research premises.

Thesis 1. Regulations adopted in the American federal law seem to balance the interests of all marketplace actors, i.e. the owner of the mark with a reputation, other entrepreneurs and consumers, better than the Polish and EU legislation. Whereas, Polish and EU regulations offer exceptionally broad protection for the owner of the trade mark with a reputation. These issues are discussed in the first part of the monograph. In chapters II to V I discuss premises of the infringement of the right to a trade mark with a reputation in detail and in chapter VI I analyse circumstances which exclude infringement of the right to a trade mark with a reputation.

Thesis 2. The protection of trade marks with a reputation in the Polish and EU legislation is closer to the principles adopted for the protection of distinctive marks under counteracting unfair competition law than to those specific to the formal protection resulted from administrative decisions. This is acknowledged by the specific character of premises for the protection of trade marks with a reputation present in the Polish and EU legislation (which make a reference to the actual scope of the mark's use rather than the fact of its registration and data included in the registry alone). As a consequence, I also discussed the protection of the trade mark with a reputation on the basis of the Counteracting Unfair Competition Act¹². In addition, I undertook to settle doubts pertaining to the cumulative application of regulations of Counteracting Unfair Competition Act for the protection of the registered trade mark with a reputation, i.e. a mark which meets protection criteria emerging from the Act on Industrial Property Law. This was discussed in the final section of the monograph (see Chapter VII).

At least three arguments can be present **in order to support the thesis stating that the American federal law is the most balanced with regard to protecting the interests of all marketplace actors** (the owner of the trade mark with a reputation, other entrepreneurs and consumers):

- A) the presence of a broader catalog of the forms of infringement of the right to a trade mark with a reputation in the Polish and EU legislation,

¹¹ See I. Simon Fhima, *Trade Mark Dilution in Europe and the United States*, Oxford 2011. The book relates to trade marks with reputation in European Union law and American federal law.

¹² Counteracting Unfair Competition Act of 1993 (*Dziennik Ustaw* 2018 r., item 419 as amended).

- B) adopting a lower similarity threshold for conflicting marks in the American legislation for ruling on the infringement than the threshold featured in the Polish and EU regulations,
- C) establishing a greater severity concerning the demonstration of a detrimental activity concerning the repute or the distinctive character of the mark, while loosening the requirements for demonstrating parasitism on the repute or the distinctive character of the mark, which disturbs the balance of the regulation in question.

Re. A. The broad scope of protection concerning trade marks with a reputation adopted in the Polish and EU legislation, which offers the opportunity for protecting the trade mark against parasitism *per se*, seems to favor the owner. The EU and Polish legislation distinguish four (*de facto* three) forms of infringements, i.e. actions detrimental to the distinctive character of the trade mark, actions detrimental to the repute of the trade mark, unfair advantage taken of the distinctive character of the trade mark or unfair advantage taken of the its repute (the doctrine and judicial decisions make a premise that the last two forms are always ruled on jointly)¹³. As a consequence, the Polish and EU legislation offer the opportunity for protecting the trade mark against parasitism *per se* (i.e. against the unfair advantage taken of the distinctive character of the trade mark or its repute, regardless of the risk of the public being confused as to the origin of goods or services, and regardless of the risk of the repute or the distinctive character of the mark being diluted).

On the other hand, in American regulations, advantage being taken of the repute or the distinctive character of the trade mark may be considered as an infringement exclusively when: there exists a likelihood of confusion on the part of the public as to the origin of goods marked with the conflicting marks, or the likelihood of dilution of the trade mark with a reputation. This is due to the fact that the American legislation does not offer protection against parasitism *per se*. However, it does protect against dilution by blurring (detriment to the distinctive character of a mark) or dilution by tarnishment (detriment to the repute of the mark). With regard to the unfair advantage being taken of the mark by a third party, it is limited to cases which fit the term “confusion as to the origin of goods”. It ought to be noted that as far as trade marks with a reputation are concerned, protection against the risk of confusion is broader and the likelihood of the similarity of marks is lower than in case of regular marks (the issue was discussed in more detail in Chapter V, Item 4.1.).

¹³ See R. Skubisz (in:) *System Prawa Prywatnego*, t. 14B, *Prawo własności przemysłowej*, (ed.) R. Skubisz, Warsaw 2017, p. 805; case C-252/07, *Intel Corporation*, para 27.

The difference emerging in the three legal systems for the protection of trade marks with a reputation seems to suggest that it is easier to prove an infringement of the right to a trade mark with a reputation in the EU and Polish systems than in the American federal law. This is due to the fact that if, in the Polish or EU legislation, there arises a case in which a third party uses a similar (or identical) mark to the trade mark with a reputation, and the groups of recipients of goods marked with the conflicting marks are analogous, it suffices to indicate that, due to the similarity of marks, there exists a likelihood of the trade mark with a reputation being associated with the mark of the infringing party, and that such an association may result in unfair advantage being taken of the repute or the distinctive character of the mark, regardless of whether there arises a risk of the public being confused or the repute or the distinctive character of the mark being diluted (see *L'Oréal v. Bellure*¹⁴). In other words, it suffices to prove that, in the mind of the public, values associated with goods (services) marked with the trade mark with a reputation may be transferred to goods (services) marked with the trade mark of the infringing party.

On the other hand, the American federal law offers no opportunity for ruling on the infringement of the right to a trade mark with a reputation if the subsequent mark only resembles the trade mark with a reputation, thus bearing the risk of positive association being transferred from the mark with a reputation onto the subsequent mark, and at the same time, there is no likelihood of the public being confused as to the origin of goods (services) and no likelihood of the mark with a reputation being diluted. As a consequence, it may be observed that, if *L'Oréal vs. Bellure*¹⁵ was ruled on the basis of the American Lanham Act, it is likely that the person entitled to the mark L'Oréal would not be capable of proving the infringement¹⁶. In addition, in several cases pertaining to the parody of trade marks with a reputation featured in the monograph, American courts did not rule in favor of the infringement even though the parodies clearly resembled the original trade marks and made associations with their positive representations¹⁷. All these cases pivoted upon the lack of likelihood of the public being confused and the repute or the distinctive character of the mark being diluted. The above finding sufficed for the claim to be dismissed.

¹⁴ Case C-487/07, *L'Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v. Bellure NV, Malaika Investments Ltd., Starion International Ltd.*, (*L'Oréal v. Bellure*), para 49.

¹⁵ C-487/07, *L'Oréal v. Bellure*.

¹⁶ See D.S. Welkowitz, *Trade mark Dilution Federal, State and the International Law*, Arlington 2012, p. 657–658.

¹⁷ See judgment of the United States Court of Appeals for the Fourth Circuit, *Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC*, 507 F.3d, 252 (4th Cir. 2007); judgment of the United States District Court for the Southern District of New York w sprawie *Tommy Hilfiger Licensing v. Nature Labs LLC*, 221 F. Supp. 2d 410, 423 (S.D.N.Y. 2002).

Re. B. An additional argument in favor of the thesis (excessive protection of the interest of the owner of the trade mark with a reputation in the Polish and EU Industrial Property Law) is the disturbing phenomenon of an extremely low threshold of similarity of marks being adopted as a premise for ruling on the infringement of the right to a trade mark with a reputation in the Polish and EU legislation. This is especially valid with regard to cases in which the conflicting marks are applied for identical goods. In such cases, it is obvious that recipient groups overlap (in case the goods differ, the situation must be examined). Based upon judicial decisions, even a slight similarity of the subsequent mark to the trade mark with a reputation is frequently sufficient in order to determine whether there exists a likelihood of the trade mark with a reputation being associated with the subsequent mark, and consequently, to determine whether there arises a likelihood of unfair advantage being taken of the repute or the distinctive character of the mark (see in particular: case T-629/16, *Shoe Branding* (three parallel stripes vs. two parallel stripes); case C-252/12, *Specsavers International* (SPECSAVERS v. ASDA OPTICIANS); case T-480/12, *Coca-Cola Company* (COCA-COLA v. MASTER); case T-359/15, *Arrom Conseil* (NINA RICCI v. ROMEO HAS A GUN BY ROMANO RICCI), ruling of the Supreme Court in Poland, V CSK 109/08 (VELUX v. OKPOL). All these cases were ruled in favor of the infringement of the right to the trade mark with a reputation.

The threshold of similarity is much higher in the American federal law. With regard to proceedings concerning the dilution by tarnishment (i.e. actions to the detriment of the repute of a trade mark) the requirement of a *substantial similarity standard* is adopted. Due to the character of the infringement, i.e. an action to the detriment of the repute, a premise is made that in order for the detriment of the repute to be considered, the subsequent mark must evoke strong associations with the trade mark with a reputation instead of merely bringing the mark to mind¹⁸. Moreover, in principle, the substantial similarity standard is applied as a premise enabling the dilution by blurring to be considered. For example, with regard to the marks of CITYBANK and CAPITAL CITY BANK, the appeal board of the USPTO ruled there were no substantial similarities and no dilution by blurring occurred¹⁹. Similar rulings were made with regard to the proceedings concerning the conflict between the reputed combined trade mark STARBUCKS and the subsequent combined mark CHARBUCKS. The Appeal Court of the Second District ruled that the CHARBUCKS mark used by the defendant for the coffee roasting company is merely minimally similar to the STARBUCKS trade mark with a reputation applied

¹⁸ D.S. Welkowitz, *Trade mark Dilution ...*, p. 421 and the judgements evoked there.

¹⁹ *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d, p. 1667 (T.T.A.B. 2010).

in the coffeehouse chain, and that the similarity was not sufficient to rule upon the dilution of the mark.

Re. C. Findings discussed in the previous section are particularly alarming when we consider the fact that, in the EU and Polish legislation, parasitism is much easier to be proved than detriment to the trade mark. This is due to the lack of the necessity to provide an evidence of a change in the economic behavior of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future. Pursuant to the ruling of the Court of Justice in the *Intel Corporation* case, the heightened evidence threshold is valid only for the pursuit of protection against the dilution of the trade mark with reputation²⁰. It ought to be noted that, in the EU, and thus Polish legislation, a liberal approach towards the protection against parasitism of the trade mark with a reputation constitutes a type of response to regulations concerning the protection of a trade mark with a reputation against actions to the detriment of the repute or the distinctive character of the mark becoming stricter²¹. However, it does not seem to be valid to make the criteria for one type of the infringement of the trade mark stricter while loosening criteria for another type of infringement of the same right. This would result in the marginalization of claims based upon the action to the detriment of the trade mark with a reputation to the benefit of those based upon parasitism of the repute or the distinctive character of the mark.

As a consequence, it seems that the American federal law maintains a greater balance in the protection of trade marks with a reputation. This is not the case in the EU (and Polish) legislation, since despite the introduction of the heightened evidence threshold in relation to the action to the detriment of the repute or the distinctive character of the mark, it is possible to obtain protection against parasitism *per se* on the basis of more liberal criteria for determining the similarity of marks. Such a situation leads to the excessive protection being granted to the owner of the mark with a reputation in the Polish and EU legislation. This conclusion is acknowledged on the basis of the aforementioned rulings based upon the EU and Polish regulations.

In light of the above, the American federal law seems to offer a more balanced trade mark protection, which facilitates market balance being maintained. By doing so, the protection

²⁰ See case C-252/07, *Intel Corporation Inc. v. CPM United Kingdom Ltd.*, para 77.

²¹ See M. Senfleben, *Adapting EU Trade mark Law to New Technologies: Back to Basics?* (in:) *Constructing European Intellectual Property: Achievements and New Perspectives*, (ed.) K. Geiger, Cheltenham, Northampton 2013, p. 152.

of the interests of owner of the mark with a reputation, their competitors and consumers is more proportionate.

It ought to be noted that the protection against parasitism *per se* in the Polish and EU regulations emerges from the legal rights which have been in operation for several years. As a consequence, it offers a well-grounded protection on the European continent. Therefore, one ought not to expect any legislative changes being introduced into these regulations any time soon. In light of the above, **one ought to postulate, *de lege ferenda*, the protection to be made stricter, especially in the context of requirements concerning the extent of similarity of marks.**

In relation to the second thesis, the protection of registered trade marks with a reputation in the EU and Polish legislation approaches the principles adopted for the protection of marks on the basis of the Counteracting Unfair Competition Act instead of regulations specific for the formal protection emerging from administrative decisions.

First of all, the assumption emerges from the fact that the premise determining the protection of the trade mark with a reputation, i.e. the repute, does not result from registry data (as opposed to all circumstances to be examined in case of the infringement of the right to a registered trade mark) but from the fact of the actual use of the mark. This needs to be evidenced in any proceedings, much like in the case of protection against unfair competition on the basis of the Counteracting Unfair Competition Act.

Secondly, principles for determining the priority for the protection of the right to a trade mark with a reputation in trade mark law²² indicate certain similarities to these in operation concerning the Counteracting Unfair Competition Act. There should exist not only the priority of registration of the mark with a reputation, but also the priority of the repute. The priority of reputation is indicated by evidence confirming the dates of the actual use of the mark.

Third of all, on the basis of the preliminary rulings of the Court of Justice of the European Union concerning trade mark law, the material (i.e. the one associated with the type of goods or services the mark is protected for) and territorial scope of the protection of the trade mark with a reputation are established by the scope the repute of the mark was proved for. This is due to the fact that the repute is established on the basis of the specific group of recipients of goods (services) offered under a particular mark based upon the actual territorial familiarity of the mark, in accordance with the definition of the trade mark with a reputation offered in the

²² The term “trade mark law” relates to the provisions of the Act on Industrial Property Law and regulation 2017/1001 pertaining to trade marks with a reputation.

General Motors case²³. As a consequence, the trade mark with a reputation may be protected if groups of recipients of goods offered under the conflicting marks overlap. Similar regulations are adopted pursuant to applicable regulations concerning counteracting unfair competition. This is because unfair competition emerges when the client groups of conflicting parties overlap (regardless of whether an actual competition emerges between the parties in the course of the operation in similar sectors- see Chapter VII, Item 2.4. of the monograph).

Next, the judicial practice of the Court of Justice suggests that the infringement of the right to the trade mark with a reputation may be ruled on the basis of the actual form the mark is used in practice instead of exclusively upon its registered form. In the *Specsavers* case²⁴ the Court of Justice ruled that, when deciding upon the infringement, the color of the mark ought to be considered despite the fact that the mark was actually registered in black and white. Clearly, the Court emphasized that such conclusions are only valid when the majority of the public associates the mark with a particular color or a combination of colors. However, the judicial practice may lead to a situation in which registering color combinations for the same mark will become unnecessary since the fact of the long-term use of the color version of the mark alone will be sufficient for ensuring protection for a specific color combination.

Fifth, under some circumstances, the protection of trade marks with a reputation applies principles more characteristic for the act on counteracting unfair competition than the act itself would offer. For example, a reference ought to be made to the ruling of the Court of Justice in the *Intel Corporation* case²⁵. The ruling introduces a necessity of providing the evidence for a change in the economic behavior of the average consumer (or a serious likelihood that such a change will occur in the future) when vindicating the right to the trade mark with a reputation registered prior to the action to the detriment of the repute or the character of the distinctive mark. Such an approach is closer to the principle of indicating a particular infringement instead of proving an abstract one on the basis of the trade mark law.

Six, in the *Interflora* case²⁶ the Court of Justice equates the use of the mark pursuing “due cause” with the use within the scope of fair competition in relation to specific goods and services. The Court argued the following: “In principle, such a use constitutes an element of fair competition in the sector of goods and services. Therefore, it occurs in the course of a “due cause” pursuant to Article 5, Section 2 of the directive 89/104/EEC and Article 9, Section 1,

²³ C-375/97, *General Motors*, para 31.

²⁴ Case C-252/12, *Specsavers International Healthcare Ltd. i inni v. Asda Stores Ltd.*, para 50.

²⁵ Case C-252/07, *Intel Corporation*, para 77.

²⁶ See case C-323/09, *Interflora Inc. i Interflora British Unit v. Marks & Spencer plc i Flowers Direct Online Ltd.*, para 91.

Item C of the regulation 40/94” (at present, Article 5, Section 3, Item A, directive 2015/2436 and Article 9, Section 2, Item C, regulation 2017/1001). Consequently, similarities between regulations adopted for registered trade marks with a reputation and those concerning counteracting unfair competition may be found directly in judicial decisions of the Court of Justice.

The thesis concerning the incorporation of the principle regarding the protection against unfair competition into regulations pertaining to trade marks with a reputation, which results from the comparative legal study of the surveyed legal systems, seems to suggest that when protecting trade marks with a reputation, the EU legislation, which lacks separate protection against unfair competition, tends to draw upon the principles applied in counteracting unfair competition. Poland is an EU member state, thus the trend transferred to the Polish trade mark law. This is due to the fact that the regulations concerning trade marks with a reputation present in the Act on Industrial Property Law constitute an implementation of the directive and ought to be interpreted in light of its objectives and guidelines emerging from the preliminary rulings of the Court of Justice concerning the subject matter. Despite the fact that the above procedure may be justified by the lack of a separate regulation determining the protection against unfair competition in the EU legislation, the approach may be difficult to defend in reference to the Polish law. When analyzing the situation in light of the Polish regulations which feature both trade mark protection and the one emerging from the actual use of the mark (on the basis of the Counteracting Unfair Competition Act), such a significant interference of protection systems, which emerges from the judicial decisions of EU bodies, seems to result in the dilution of the principles for the protection of trade marks with a reputation.

Moreover, when making a reference to the comparative legal study, it is noteworthy that, in the context of the subject matter, the protection of trade marks with a reputation adopted in the American federal law seems as if the judgement of Solomon. Pursuant to the § 43 c) (15 U.S.C. § 1125) Lanham Act (constituting the basis for protection against the dilution of the trade mark with a reputation) both registered and used trade marks with a reputation, and those merely applied in operation, may be protected. As a consequence, this specific regulation equals the protection of registered and used trade marks. This is due to the fact that in case of trade marks with a reputation, the protection is based upon their general recognition among the American public instead of the mere fact of their registration or the fact that the use of the mark commenced. Moreover, in order to eliminate any doubts as to the application of cumulative protection of trade marks with a reputation in the American federal law, the § 25 RLUC (a collection of principles for proceeding in cases of unfair competition) states that the protection

of trade marks with a reputation, except the case of confusion, is granted exclusively under applicable regulations of the Lanham Act, i.e. the § 43 c) (15 U.S.C. § 1125) Lanham Act. Such an approach cancels any dilemmas associated with cumulating the protection of a registered trade mark with a reputation on the basis of regulations pertaining to registered protection, as well as those referring to unfair competition. It enables collision-free combination of regulations specific to both protection systems with regard to trade marks with a reputation.

To conclude the above considerations, it ought to be noted that the combination of regulations for the protection of trade marks with a reputation specific to the Industrial Property Law and those associated with counteracting unfair competition ought not to come as a surprise provided that it applies to a legal system which lacks separate protection systems, which is the case in the EU legislation and American federal law. On the other hand, the phenomenon ought to be perceived as alarming in the Polish legal system because the owner of a mark with a reputation may obtain protection in the framework of both the Industrial Property Law as well as based upon the Counteracting Unfair Competition Act.

The solution to the above dilemma is by no means straightforward. First of all, it requires the respect for legislative traditions of those EU member states (including Poland) whose systems feature separate acts on counteracting unfair competition (missing in the EU legislation) in addition to legal acts introducing regulations of subsequent directives. Secondly, it requires respect for the EU legislator's pursuit of unification of trade mark protection throughout the EU both in terms of domestic regulations in the individual member states and those pertaining to the EU trade mark. As a consequence, it may be worthwhile for the EU legislator to consider the regulations featured in the American federal law.

Based upon the Industrial Property Law, one ought to consider the possibility of granting uniform protection to both registered trade marks with a reputation and those unregistered but used in practice. This is due to the fact that in case of trade marks with a reputation, the critical protection premise is the recognition of the mark among the public (if the premise is not acknowledged, the fact of registration is meaningless). Trade marks with a reputation constitute a specific category of marks, which due to the requirement of sufficient recognition, escapes the exclusive application of regulations applicable in the system based on registration.

5. Remaining science and research accomplishments

The following main research fields may be isolated in my hitherto research:

- A) Trade mark law,
- B) Protection of distinctive marks of entrepreneurs and enterprises,
- C) Issues associated with the collision and cumulation of Industrial Property Rights.
- D) Other issues associated with Intellectual Property Rights.

Re. A. Publications pertaining to trade mark law

In the postdoctoral period, my research focused upon issues associated with trade mark law. In the period, I published several papers and commentaries, gave oral presentations and open lectures devoted to the issue. The objective of the paper titled *Special Criteria of Trade mark Protection with Regard to Pharmaceutical Products in the European Union Legal System* (IIC - International Review of Intellectual Property and Competition Law, September 2014, Vol. 45/6) aimed to analyze regulations applied when registering and protecting trade marks for pharmaceutical products in light of the EU legislation and judicial decisions. The study revealed that, even though trade marks for the products are subject to the same regulations applied for any other trade mark, certain regularities may be observed. The paper indicates that due to the necessity of long-term clinical trials being conducted, which precedes the introduction of the trade marked product to market, the argument that the clinical trials constitute an adequate reason for the lack of genuine use of the trade mark seems valid. In light of such an approach, the avoidance of the ruling concerning the invalidity of the right to the mark becomes possible due to the lack of the genuine use. Issues associated with trade marks for pharmaceutical products were also the subject of my presentation given in English during a conference in Helsinki (*Trade marks of Pharmaceutical Products in the European Legal System*, a conference speech in English, Helsinki AIPPI Forum & ExCo, 5-11 Sept. 2013).

The next paper, published in a journal featured on the ISI Master Journal List, was titled *Trade marks with a reputation and famous marks: differences in approach between the European Union, Poland and the United States in relation to the principle of speciality* (Queen Mary Journal of Intellectual Property 2017, no. 7). It considers whether trade marks with a reputation are indeed without the specialization principle, i.e. for any type of goods. Conclusions emerging from the analysis suggest that the ruling of the Court of Justice in the *General Motors* case is contradictory to EU regulations in terms of permitting a trade mark to

be considered as one with a reputation when the mark has the niche reputation. Should a mark be protected for any type of goods, one ought not to assume that the trade mark with a reputation may only be recognized by a small group of experts in the field. In such a case (defined as the niche reputation), the infringement of the right to the trade mark with a reputation may be dismissed by arguing that groups of recipients of goods or services do not overlap for the conflicting marks. In the process, due to the type of goods the trade mark with a reputation is applied for, it becomes impossible to prove the infringement of the right. On the other hand, the grammatical and teleological interpretation of legal regulations pertaining to the regulation 2017/1001 and the Act on Industrial Property Law, clearly suggests that the reputation is to offer the owner of the mark protection regardless of the type of goods the trade mark of the third party was registered for (and is subsequently used for), or the type of goods the mark is subsequently used on the market, i.e. regardless of whether the group of recipients of goods (services) overlaps for the conflicting marks. As a consequence, the paper postulates to narrow down the protection of trade marks with a reputation to those recognized by the general public (instead of recipients of goods or services for which the mark is used) inhabiting a significant part of the territory of the member state, or in the case of the EU trade mark, a significant part of the EU territory. The above issue is discussed in the monograph as well.

My further publications are also devoted to the subject matter of trade marks with a reputation. The following gloss to the ruling of the European Court of Justice in Luxembourg is noteworthy. The gloss is titled „*Wszystkie pasy nasze są*” – *spór dotyczący czerpania nienależnych korzyści z renomy znaku towarowego* („*All stripes are ours- a conflict regarding unfair advantage taken from the repute of a trade mark*) (gloss to the ruling of 1.03.2018, T 629/16, *Shoe Branding Europa BVBA against EUIPO – Adidas AG*, Glosa, Prawo gospodarcze w orzeczeniach i komentarzach, 2018, no. 3). The gloss discusses an alarming trend in the Polish and EU legislation. The trend is characterized by extensive protection being granted to trade marks with a reputation due to a very low threshold of similarities of marks in litigations proceeding on the unfair advantage being taken of the repute or the distinctive character of the mark. The issue is discussed in more detail in the monograph.

My research in the subject of the protection of trade marks with a reputation in the Polish and EU legislation contributed to the discussion of the frequent lack of cohesion between the rulings of Polish courts and guidelines emerging from the preliminary rulings of the Court of Justice of the European Union. The matter was discussed in the paper titled „*Wpływ prejudycjalnych wyroków Trybunału Sprawiedliwości na krajowe prawo znaków towarowych na przykładzie znaków renomowanych*” (*The impact of preliminary rulings of the Court of*

Justice upon the domestic trade mark law on the example of trade marks with a reputation (in:) *100 lat ochrony własności przemysłowej w Polsce. Księga jubileuszowa Urzędu Patentowego Rzeczypospolitej Polskiej*, (eds.) A. Adamczak, Warszawa 2018.

My research in the protection of trade marks with a reputation was summarized in an open lecture given during an academic seminar in Kraków [*Ochrona prawa do znaku towarowego renomowanego (analiza prawnoporównawcza)* (*Legal protection of a trade mark with a reputation (comparative legal study)*)]. The seminar was organized by the Department of Intellectual Property Rights of the Faculty of Law and Administration of the Jagiellonian University, Kraków, 18.01.2018.

In the research regarding trade marks, I devoted much attention to the possibility of parodying a trade mark by a third party. Initially, I analyzed the issue in light of applying the parody of the trade mark with a reputation both in commercial transactions and outside in three legal systems, i.e. in the American federal law, and the EU and Polish legislation (*Granice parodystycznego wykorzystania znaku towarowego renomowanego w prawie polskim, unijnym i amerykańskim* (*Limits of parodying a trade mark in the Polish, EU and American legal systems*) (in:) *Wynalazczość i Ochrona Własności Intelektualnej*, (eds.) A. Adamczak, Cedzyna 2017, Issue 41, and a presentation under the same title given at the Seminar of Patent Attorneys of Universities- Cedzyna, 18-22 Sept. 2017). A further publication pertaining to the subject of parodies concerning trade marks focuses upon the analysis of all premises of the infringement of the right to the trade mark with a reputation (i.e. both general premises and specific premises) in a situation when the infringement pivots around the use of a parodied trade mark by a third party (*Parodia w kontekście naruszenia prawa do zarejestrowanego znaku towarowego (analiza prawnoporównawcza)* (*Parody in the infringement of the right to a registered trade mark (comparative legal study)*), (in:) *Qui bene dubitat bene sciet. Księga jubileuszowa dedykowana Profesor Ewie Nowińskiej*, (eds.) J. Barta, J. Chwalba, R. Markiewicz, P. Wasilewski, Warszawa 2018). Conclusions emerging from the two papers clearly indicate that the American federal law is much more liberal than the Polish and EU legislation with regard to the protection of trade marks with a reputation against parodistic use by a third party. Research results in the subject matter were presented during a domestic academic conference (*Parodia znaku towarowego – jak daleko można się posunąć (analiza prawnoporównawcza)* (*Parody of a trade mark- how far can one go (comparative legal study)*), a presentation given during the Domestic Academic Conference titled „*Własność Intelektualna w działalności gospodarczej*”, Lublin, 10.03.2017))).

My research also discussed a specific category of trade marks, i.e. notorious trade marks. The paper titled *Ochrona znaku towarowego powszechnie znanego a zasada terytorialności w prawie polskim i w federalnym prawie amerykańskim (analiza prawnoporównawcza) (Protection of a notorious trade mark vs. the principle of territoriality in the Polish and American federal legal systems, comparative legal study)*, PPH 2019, no. 2)) indicates that in the Polish legislation, the protection of notorious trade marks does not constitute an exception from the principle of territoriality because applicable regulations pertaining to the protection of notorious trade marks (outlined in international regulations) were incorporated into the Act on Industrial Property Law, thus becoming an element of the Polish trade mark law. On the other hand, as far as the American federal law is concerned, the conclusion is valid that the protection of notorious trade marks constitutes an exception from the principle of territoriality. Moreover, the discussion resulted in the emergence of a disturbing finding. *De lege lata*, the Polish legislation unified the term “trade mark with a reputation” with the notorious trade mark. However, due to the fact that this finding undermines the validity of operation of two separate categories of trade marks, i.e. the trade mark with a reputation and the notorious trade mark, I offer two alternative approaches to the situation. First of all, if the division into two separate normative categories of trade marks is to be maintained, a clear distinction of premises enabling the distinction into a trade mark with a reputation and the notorious trade mark ought to be made (regardless of the difference pertaining to regulations concerning their protection). Secondly, if the unifying trend is to be upheld, maintaining a single category of the mark seems valid. However, the mark would be protected in different manners depending upon the registration or lack of thereof²⁷. The present situation where the Polish legislator distinguishes two separate categories of trade marks defined analogically seems irrational.

Trade marks constituting a combination of colors constituted a further category of trade marks I was interested in. The analysis of current regulations and judicial decisions conducted in the paper titled *Warunki rejestracji i zakres ochrony kompozycji kolorystycznej jako znaku towarowego (Registration and the scope of protection of a color composition with regard to trade marks)*, *Zeszyty Naukowe KUL* 2018, Issue 1, allowed me to formulate certain conclusions. The scope of protection of color trade marks (constituting a composition of colors with no contours) resembles the one specific to the protection of graphic marks featuring colors encapsulated in geometrical figures of specific shapes. The mark constituting a color combination is not protected in relation to all possible color combinations composing a

²⁷ In such a case, the registration of the trade mark enables the protection to be extended to the scope applicable to trade mark with a reputation.

particular mark. The protection of such a mark is strictly determined by indicating color proportions and means they are combined in (e.g. straight line, undulating line, blurred line, etc.). This clearly differentiates it from the protection of a mark consisting of a single color *per se*.

In addition, I co-authored the commentary to the Act on Industrial Property Law. The commentary consists of 300 pages of a comprehensive discussion regarding the act on trade marks and protection of rights to trade marks granted by the Polish Patent Office (*Znaki towarowe i prawa ochronne (w:) Prawo własności przemysłowej. Komentarz*) (*Trade marks and rights to trade marks [in] Industrial Property Law. Commentary*) T. Demendecki, A. Niewęglowski, J. J. Sitko, J. Szczotka, G. Tylec, Warszawa 2015).

Moreover, with regard to trade marks, I also undertook the popularization of the subject matter by giving presentations for various target groups (a presentation titled *Podobieństwa i różnice w systemie ochrony znaków towarowych i wzorów przemysłowych* (“*Similarities and differences in the protection of trade marks and industrial designs*”)) given on invitation of the Polish Chamber of Patent Attorneys, Lublin Chapter, Lublin, 12 Dec. 2011; presentation titled „*Via Urząd Patentowy – droga od pomysłu do rejestracji znaku towarowego*” (“*Via Patent Office- from an idea to a registered trade mark*”) given on invitation of students representing IPR science club of the MCSU, Lublin, 11 March 2016).

Re. B. Publications pertaining to distinctive marks of entrepreneurs and enterprises

My significant contribution to the research field is connected with the protection of business names. I undertook studies in the subject matter at the onset of my research career, prior to obtaining the PhD. I analyzed legal regulations and premises for the protection of distinctive marks (*Ochrona oznaczeń przedsiębiorstw, (w:) Zarządzanie przedsiębiorstwem: ekonomia, prawo, kultura, etyka*) (*Protection of Business Names [in:] Management of an Enterprise: Economics, Law, Culture, Ethics*), (eds.) A. Rakowska, Kazimierz Dolny 2001). At the beginning of the 21st century, the subject matter presented several uncertainties. It was the period of reforms in the protection of distinctive marks when current legal regulations were only emerging. For decades, when the Commercial Code of 1934 was in operation, the business name was a mere designation of a commercial code company. Since 2003, pursuant to the Civil Code and the Act of 14 February 2003 on the amendment to the Act on Civil Code and other Acts, it serves as a designation of any entrepreneur. I analyzed these new legal regulations in a law-related journal (*Firma w świetle przepisów kodeksu cywilnego, (Company Name in the*

Light of the Polish Civil Code), Przegląd Prawa Handlowego, no. 5/2003, and subsequently in my doctoral thesis published by Wolters Kluwer (*Firma i jej ochrona, (Company Name and Its Protection)*), Warszawa 2009. The monograph discusses not only the newly introduced regulations pertaining to the legislation, but also describes regulations adopted in French, English and German law in detail. The study of foreign legal systems was facilitated by a grant sponsored by the French government (October- November 2003). I was able to stay in Paris for the period of two months and participate in classes pertaining to copyrights and industrial property offered by the Université Panthéon-Assas. In addition, I was an intern in the Kimbrough & Associés legal office dealing with IPR. Moreover, the grant sponsored by the Ministry of Science and Information also contributed to my research in the field. The grant financed the doctoral thesis titled „*Firma i jej ochrona*” (*Company Name and Its Protection*) and enabled me to become an intern in the Queen Mary Intellectual Property Research Institute in London (consultations with Prof. Jeremy Phillips).

I continued the studies of company names in the postdoctoral period. My publication titled *Dualizm oznaczeń przedsiębiorcy i przedsiębiorstwa - obrzeża prawa własności przemysłowej, (Dualism of Designations of the Entrepreneur and the Enterprise – Peripheries of Intellectual Property Law)*, PPH 2008, no. 4, focused upon similarities and differences emerging between the company name and company designation, which (prior to the novelization of 2003) were frequently considered interchangeable. Due to legal changes, a clear cut distinction was made between the company name- a designation individualizing the entrepreneur as a subject of law, and the company designation or a part of it- a designation serving to distinguish the company or its elements as an object of the entrepreneur’s rights. As a consequence, the incorporation of the term company name as an example of the designation of an enterprise, instead of the entrepreneur, into Article 5 of the act on counteracting unfair competition, may come as a surprise. In the aforementioned publication of the PPH, I verified the definition of the term “company name” applied in Article 5 of the act on counteracting unfair competition in light of changes introduced in the novelization of 2003. I believe that when the premise is made that the specific regulation pertains to company designations in the operational sense, one ought to perceive the inclusion of the company name as a legislative error, because clearly the company name designates the subject of rights of the entrepreneur. As a consequence, it is difficult to imagine that the term company name is featured in Article 5 of the act merely in the operational sense. Therefore, it seems that due to the fact that the regulation was not changed in the amended legislation, and the term was not dropped, then, pursuant to the theory of the rational legislator, one ought to assume that Article 5 of the act

incorporates all three meanings of the term featured in the theory of law, i.e. subjective, objective and functional.

Re. C. Publications devoted to issues associated with the collision and cumulation of Industrial Property Rights

I believe that issues associated with the collisions of various industrial property rights, and the possibility of applying cumulative protection to these, constitute a significant element of my research. Prior to obtaining the PhD degree, I focused my attention upon studying the relations emerging among various categories of distinctive denominations, especially company names, company designations and trade marks. I primarily analyzed the possibility of registering and using a trade mark which would be identical or similar to a company name previously used in marketplaces (*Dopuszczalność rejestracji znaku towarowego zawierającego nazwę innego przedsiębiorstwa w świetle ustawy Prawo własności przemysłowej*, (*The Permissibility of a Trade mark Registration Containing a Company Name of Another Entrepreneur in the Light of the Polish Industrial Property Act*), Przegląd Ustawodawstwa Gospodarczego, no. 10/2001; *Prawne problemy tzw. pogranicza oznaczeń odróżniających w świetle ustawy – Prawo własności przemysłowej* (*The Legal Aspects of the Borderline Cases of the Distinctive Denominations in the Light of the Industrial Property Act*), Biblioteka Przeglądu Prawa Handlowego 2002, *Własność przemysłowa - aktualne problemy prawne i etyczne* (coauthors: Maria Poźniak – Niedzielska, Janusz Malarczyk). The aforementioned issues were also the subject of an oral presentation I gave in English at the V Seminar of Polish and German AIPPI Group (International Association for the Protection of Industrial Property). The presentation was titled *Conflicts between commercial names and trade marks under the Polish legal system*, 8-9 November 2002, Kraków.

I continued research in the collision and cumulation of industrial property law in the postdoctoral period. However, in the period, my attention was devoted to the relationship between trade marks and industrial designs. I gave an oral presentation in Cedzyna during the 2011 Seminar for Patent Attorneys of Universities. The presentation was subsequently featured in a periodically published bulletin of the Polish Patent Office (*Kolizja pomiędzy prawem do znaku towarowego, a prawem do wzoru przemysłowego w świetle orzecznictwa krajowego i unijnego, (in:) Wynalazczość i Ochrona Własności Intelektualnej, (Conflict of Rights to a Trade mark and Design in the Light of Domestic and European Union Judgements [in:] Ingenuity and*

Intellectual Property Protection), (eds.) A. Adamczak, zbiór referatów z Seminarium Rzeczników Patentowych Szkół Wyższych, Cedzyna 2011, Issue 35).

I undertook the issue of the collision and cumulation of rights to trade marks and industrial designs due to a significant tightening of descriptive forms which may be protected under both of these. My further publication titled *Kumulacja i kolizja prawa do znaku towarowego i wzoru przemysłowego w prawie krajowym i unijnym (Cumulation and Conflict of Rights to a Trade mark and Design in Domestic and EU Law)*, *Zeszyty Naukowe UJ, Prace z Prawa Własności Intelektualnej*, 2012, Issue 2 (116) aimed to indicate differences between the protection in the framework of domestic and EU (Community at that time) trade marks and the one under domestic and EU (Community at that time) industrial designs. In addition, I aimed to outline consequences associated with the choice of either as well as possibilities of using cumulative protection and its impact. Moreover, the paper discussed rulings on the collision between the right to a trade mark and to an industrial design. The review of legislation and judicial decisions led me to conclude that the matter ought to be ruled on the basis of regulations applied in case of the infringement of the right to a trade mark or industrial design, analogically to matters ruled in relation to the collision between goods of the same type, i.e. between two conflicting trade marks or industrial designs. At the time of composing the paper, the issue was not straightforward. This was reflected in an inadequate legal basis for ruling on several proceedings concerning the collision of the right to a trade mark with the right to an industrial design (see e.g. the ruling of the Court of Justice of the EU of 12.05.2010 in the *Beifa Group Co. Ltd. against OHIM*, T-148/08).

Results of studies concerning borderline cases of trade marks and industrial designs were presented in two consecutive presentations (presentation titled „*Pogranicze prawa do znaków towarowych i wzorów przemysłowych w świetle wybranych przykładów z orzecznictwa*” (*Borderline of trade marks and industrial designs in light of selected judicial decisions*)), given upon the invitation of the International Association for the Protection of Industrial Property, Warszawa, 22 April 2012, and an open lecture titled „*Kumulacja i kolizja praw własności przemysłowej na przykładzie znaków towarowych i wzorów przemysłowych*”, (*Cumulation and Collision in Industrial Property Law on the Example of Trade marks and Designs*) given in the headquarters of the Patent Office upon the invitation of the President of the Patent Office, Warszawa, 25 November 2011)).

This trend concerning the legal basis and adequate premises for ruling upon the collision between the right to a trade mark and industrial design was also discussed in the gloss to one of the rulings of the Warsaw Provincial Court of Appeal titled *Zakres kompetencji Urzędu*

Patentowego w sprawach o unieważnienie prawa z rejestracji wzoru przemysłowego ze względu na naruszenie prawa osoby trzeciej. Glosa do wyroku WSA w Warszawie z dnia 21 listopada 2008 r. VI SA/Wa 710/08, (The scope of competences of the Polish Patent Office with regard to invalidation of a right in registration for industrial design caused by the infringement of a third party's right – commentary to the judgement of the Provincial Administrative Court dated November 21, 2008 (VI SA/Wa 710/08), Glosa. Prawo gospodarcze w orzeczeniach i komentarzach, 2012, no. 3. The publication analyzes the scope of actual competences of the Patent Office in relation to the possibility of invalidating the right to register the industrial design due to a collision with a previous right to a trade mark and the possibility of invalidating the right to a trade mark due to the infringement of the right to the industrial design. The analysis of regulations conducted in the gloss led me to formulate several conclusions. First of all, the Patent Office ought not to rule upon the infringement of the right by a third party in cases where the person entitled to the intangible asset activates administrative and civil measures in order to ensure protection. In such a case, the Patent Office ought to suspend the proceedings on the basis of Article 97, §1, Item 4 of the Administrative Procedure Code until the court rules on the case (the Patent Office is bound by the final and binding ruling of the court regarding the infringement of the right by a third party). On the other hand, if the person entitled to specific intangible asset pursues their rights exclusively in the Patent Office and seeks to invalidate the registration of the industrial design on the basis of Art. 117, Section 2 of the Industrial Property Law, then the Patent Office may independently rule upon the invalidation. This is due to the fact that, having considered the case regarding the invalidation of the right to register an industrial design on the basis of Article 117, Section 2, IPL, the Office has competences to rule on the infringement of the right by a third party. However, this does not mean that this state of affairs is commendable. This is because matters which proceed upon the infringement of the objective right, ought not to be ruled by the Patent Office as cases under the Civil Law (Article 2 of the Civil Code), which was justified in conclusions to the gloss. Unfortunately, the present status quo does not allow a different position to be adopted. Therefore, *de lege lata*, one ought to favor the thesis offered by the Provincial Administrative Court featured in the glossed ruling with the reservation that the Patent Office cannot be exclusively competent to rule on the premise justifying the invalidation of the right under Article 117, Section 2 of the Industrial Property Law. The gloss draws attention to the fact that the thesis may result in several complications which, in practice, would disturb the reliability of the law and unquestionable character of final and binding judicial decisions. Due to the fact that the court is not bound by a binding administrative decision (in terms of evaluating facts constituting the basis for ruling in

civil matters), a paradox may emerge with regard to the collision of rights. The Patent Office may be forced to rule in the same matter twice. A situation may arise where the Patent Office denies the invalidation of the right to register an industrial design on the basis of Article 117, Section 2 of the IPL because it will not recognize the infringement of the previous right to a trade mark. However, the petitioner, dissatisfied with the ruling, will subsequently petition the common court to proceed on the same case. The court may ban the use of the industrial design by ruling on the infringement of the previous right to the trade mark. In such a case, the owner of the trade mark may reapply for the invalidation of the right to register the industrial design, and the Patent Office, being bound by the final and binding court ruling (see Article 365, Section 1, Code of Civil Proceeding) will be forced to invalidate the right, despite having previously ruled otherwise. The matter can become even more complicated. The Patent Office may invalidate the right to register the industrial design due to the infringement of the right by a third party. Subsequently, common court may rule upon the lack of the infringement, which hypothetically is possible, since the court is not bound by binding administrative decisions in the aforementioned scope.

Re. D. Publications pertaining to other issues associated with IPR

Apart from the main stream of my research mentioned above, I studied various issues in the field of IPR. I authored six chapters in a joint publication devoted to commercial contracts. Only three of these were compiled in the postdoctoral period (*Umowa licencyjna w prawie patentowym (in:) Umowy gospodarcze wg standardów UE (Licence Agreement in Patent Law [in:] Commercial Contracts According to the Standards of the European Union)*, (eds.) A. Kidyba, Warszawa 2007, section. 7.5.; *Umowa o przeniesienie prawa ochronnego na znak towarowy (w:) Umowy gospodarcze wg standardów UE (Sale Agreement in Trade Mark Law [in:] Commercial Contracts According to the Standards of the European Union)*, (eds.) A. Kidyba, Warszawa 2010, section. 7.6.; *Umowa o przeniesienie patentu (w:) Umowy gospodarcze wg standardów UE, (Sale Agreement of Patent [in:] Commercial Contracts According to the Standards of the European Union)*, (eds.) A. Kidyba, Warszawa 2011, section. 7.7.).

I also discussed issues associated with intellectual property management (*Intellectual Property Management in Enterprise, Organizacja i Zarządzanie Kwartalnik Naukowy, 2012, Issue 3; Zarządzanie własnością intelektualną w przedsiębiorstwie na przykładzie analizy*

strategii ochrony formy trójwymiarowej [in:] Integracja zarządzania w warunkach GOW (Intellectual Property Management in Enterprise on the Example of 3D Form Strategy of Protection [in:] Integration of Management in the Economy Based on Knowledge), (eds.) E. Skrzypek, Lublin 2012). The discussion led me to conclude that intellectual property management, very much like knowledge management, may be executed in accordance with several strategies. These may be general or specific in character. General strategies are characterized by the fact that they set the framework for intellectual property protection in an enterprise and include the development strategy of the whole organization. Specific strategies are frequently closely related with the general ones because they are developed in order to achieve general objectives. They are characterized by the fact that they pertain to specific non-material resources.

In addition, I translated two rulings of the Court of Justice of the European Union. The court presented details regarding the issue of patent protection for pharmaceutical products (*Własność przemysłowa. Orzecznictwo Trybunału Sprawiedliwości Unii Europejskiej (Industrial Property. Judgements of Court of Justice of EU)*, (eds.) R. Skubisz, edition 3, Warszawa 2015, Chapter 34 and 35).

In addition, a single paper discussing issues pertaining to Criminal Law constitutes a sole departure from the subject of IPR. In co-authorship with Małgorzata Dumkiewicz, Associate Professor, I compiled the paper titled *Stalking na tle prawa karnego i cywilnego (in:) Dobra osobiste w XXI wieku – nowe wartości i nowe technologie (coauthor M. Dumkiewicz), (Stalking in the Light of Criminal and Civil Law [in:] Personal Interest in XXI Century – New Values and Technologies)* (coauthor: M. Dumkiewicz), (eds.) J. Balcarczyk, Wolters Kluwer, Warszawa 2012. The paper discusses the issue of stalking, i.e. the type of crime defined in Article 190a of the Crime Law. The publication was motivated by the introduction of stalking into the Polish Crime Law as a separate crime with a specific definition. Grammatical and systemic interpretations of the legal norm included in Article 190a of the Crime Law led me to conclude that the Polish legislator penalizes stalking which results not only in the emergence of fear and anxiety in the victim, but also the violation of the victim's privacy regardless of whether the fear emerges (a different attitude is adopted in the American legal system). Such a regulation prevents stalking in its initial phase when the victim has not experienced fear or being threatened by the perpetrator who purposefully and persistently violates the privacy. In addition, the paper presents a thesis that, pursuant to Article 190a of the Crime Law, only the addressee of the perpetrator's actions may become the aggrieved party.

A detailed list of research papers and information regarding my didactic and science-promoting activities, along with research cooperation was compiled in Appendix 4 to the Associate-professorship application.

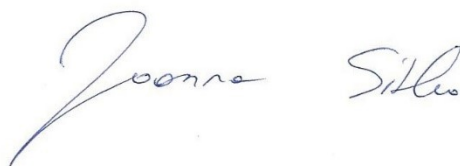
Summary of my research contribution

The subject matter I studied was also discussed by me in the form of oral presentations given at conferences and during open lectures. In the postdoctoral period, I participated in 19 domestic and international conferences, and gave 5 open lectures upon the invitation of e.g. the Polish Patent Office, Department of Intellectual Property Rights, Faculty of Law and Administration of the Jagiellonian University in Krakow, and students' IPR science club at MCSU in Lublin.

In addition, works I conducted in the framework of the membership in the International Association for the Protection of Intellectual Property – AIPPI, exerted a significant impact upon the course of my research. I was a member of a team established in order to discuss issues associated with trade marks' protection in the framework of the panel titled *Pharmaceutical products and trade marks*, during the conference Helsinki AIPPI Forum & ExCo. During the conference, I gave an oral presentation in English titled *Trade marks of Pharmaceutical Products in the European Legal System* (5-11 Sept. 2013).

In 2009, I completed my Patent Attorney training. Being accepted into the profession constituted a significant influence upon my studies in industrial property rights. Being able to practice law enabled me to recognize several considerable research problems I subsequently studied in my research career.

My membership in the Committee for Developing IPR Protection Regulations in Lublin University of Technology was also significant for my career. My work on the committee resulted in the development of IPR protection regulations approved by the university's authorities.

A handwritten signature in blue ink, reading "Joanna Siles". The signature is written in a cursive style with a large initial 'J'.