

Intellectual property protection
on the cosmetics
and perfumes market

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Intellectual property protection on the cosmetics and perfumes market

Włodzimierz Szoszuik

We devote this publication to the cosmetics and perfumes industry, and to the intellectual property protection phenomena and processes specific to that industry.

Research and reports published in recent years confirm that the cosmetics and perfumes market in Poland is doing very well. Lately, the rate of its development has been incomparably faster than in other European countries.

Cosmetics and perfumes are purchased more often and in larger quantities than ever before. In recent years, the profile of demand has changed, with customers now including an increasing number of older people and men. Sales of more expensive products are growing. The distribution channel grid is expanding. Nowadays, cosmetics can be purchased not only in drugstores but also in pharmacies and discount stores. Indeed, low-cost outlets have begun to lead the market and increasingly often open their own cosmetic departments. A large part of sales is carried out via the Internet.

Strong market competition, especially between large players, is another characteristic of the market of cosmetics and perfumes. The customer is bombarded with new formulas, promises of better and faster effects, more convenient and more sophisticated packaging. Local producers are becoming popular. Trust in local brands is growing.

Unfortunately, in parallel to producers competing fairly, there is also a growing number of those who choose to take the easy path. In recent years, there has been a significant increase in the number of counterfeit cosmetics and perfumes produced in Poland. Counterfeits, however, are not the only phenomenon detrimental to makers of genuine products. Many violations take on a dimension that

is more sophisticated, which does not mean that it is less harmful.

It's no coincidence that this edition is entirely devoted to the cosmetics and perfumes industry. We consider it an industry with a bright future. We discern phenomena and processes in it that do not exist anywhere else. Changes taking place on the cosmetics and perfumes market may affect the models of protection of intellectual property rights that the business will want to adopt. We see this happening in our everyday practice.

This edition will answer questions such as whether a perfume scent can be protected. Is it legal to sell perfume and cosmetic sample testers? Is it possible to prohibit retailers from selling perfumes online? What designations it is better not to choose for a new cosmetic? What is the main subject of disputes between entrepreneurs within the industry? Is a genuine trademark intentionally written with a typo necessarily a counterfeit trademark? Can the composition of mascara be patented? Our goal is to submit to a legal analysis the phenomena occurring on the cosmetics and perfumes market from the perspective of the interested players: cosmetics and perfumes producers, parties entitled to different types of intellectual property rights, sellers, retailers and cosmetic packaging makers – who together form the broadly understood cosmetics and perfumes industry.

Enjoy the read!



Patents from Zduńska Wola in Hollywood?

Norbert Walasek

The cosmetics industry remains one of those industries where the role of innovation cannot be overestimated. Patent law makes it possible to monopolize innovative solutions and ensure their unimpeded exploitation.

Maximilian Faktorowicz was born in Zduńska Wola in 1872. He went to Moscow where he founded a drugstore and practiced in the theater as a makeup artist. In 1904, he made it to America. There, using the experience gained from working in the drugstore and at the theater, he became involved – intellectually and financially – in the development of the art of make-up for the needs of the film industry. He owed his enormous success above all to the innovative solutions he used in his products. Cosmetics created for the film industry soon found themselves on the market, whereas Max Factor products are still valued today. Maximilian Faktorowicz died in Los Angeles in 1938, but the company he created has been setting trends in the cosmetics industry in the next decades, basing its development strategy on innovation protected by patents.

Patent

A patent is a right that grants exclusive use of an invention – an innovative technical solution which it covers. Patent protection lasts 20 years. It should be remembered that patent law is territorial and that a patent-guaranteed exclusivity covers only the area in which the right was granted. The invention is defined in patent claims written in a patent document. They are complemented with drawings and description of the invention.

An invention can be any solution in any technical field provided that it has not been known before, it does not ensue in an evident manner from what has been known before, and it is suitable for use in industry.

In principle, inventions can be classified into one of four groups:

- Spatial products (e.g. equipment)
- Amorphous products (e.g. chemical compositions)

- Methods (e.g. production methods)
- Applications (e.g. applications of known substances to achieve a specific goal).

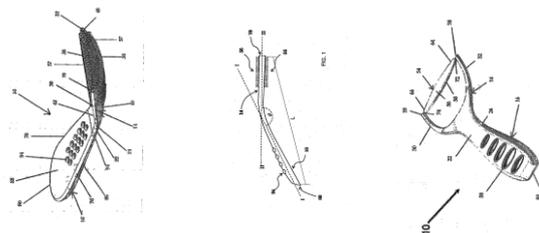
Patents in the cosmetics industry

In the cosmetics industry, we come across patents from each of these categories.

Spatial products are, among others, devices, tools, instruments or their parts, consisting of spatially or functionally connected elements serving the implementation of a specific technical purpose.

An example of such solution in the cosmetics industry is the invention protected by patent PL/EP 2330941 (Avon Products, Inc.) named *Ergonomic Mascara Applicator*.

As indicated in the description of the invention: *the application of mascara with conventional mascara applicators usually requires dozens of repeated strokes and rotations or twists to achieve the desired eyelash appearance. Because of the manner in which a conventional mascara applicator is held and manipulated, the application of mascara can be a difficult and tiresome exercise. A solution to these difficulties is provided by the invention, which is an ergonomic applicator for applying a cosmetic composition to the eyelashes comprising (i) a handle portion and (ii) a head portion.* The applicator described in detail in the patent document would be also presented in accompanying drawings:



Amorphous products include chemical compounds and compositions with specific components, often defined by quantitative and qualitative indicators or physicochemical parameters.

An example of such solution in the cosmetics industry is the invention protected by patent PL/EP 1765277 (Avon Products, Inc.), named *Mascara Composition*.

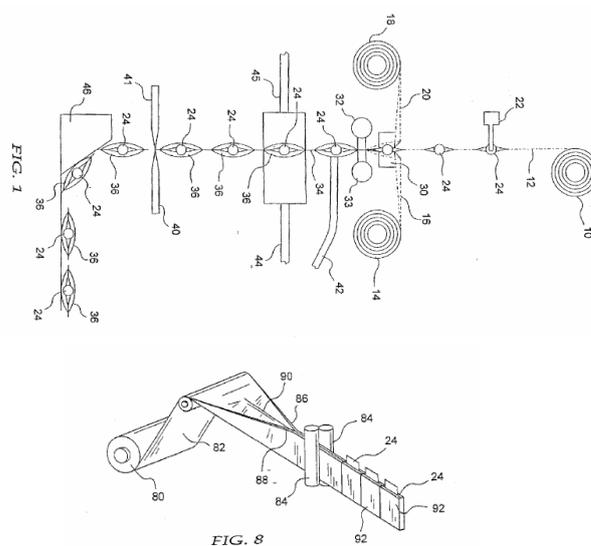
The description indicates that, with presently marketed mascaras, *thickening and lengthening of the eyelashes is typically achieved by incorporating in such products a high level of waxes and film formers. This generally leads to difficulty in washing the mascara off the eyelashes, which in turn causes damage to the eyelashes. Attempts to solve this problem by use of thin moisturizing mascaras have been unsuccessful as such products usually are not thickening or lengthening in effect. Moreover, they do not wear well and smudge and smear easily.* As indicated further in the description of the invention: *to remedy the deficiencies of prior art compositions, the inventors have developed a composition that thickens and/or lengthens [...] the eyelashes yet is readily removable therefrom by washing.* The composition described in the first independent claim provides, among others, for *the use of a mascara base and a keratin conditioning agent in an amount effective to improve the aesthetic appearance of the eyelashes to which the mascara composition is applied; the composition is an oil-in-water emulsion and the eyelash conditioning agent is present in an amount of about 0.5% to 5%.* Further, the claim enumerates a number of other substances included in the composition, in particular, vegetable protein derivatives, sometimes with a precise indication of their amount.

Methods, in turn, are used, for example, in the production process. They are defined by a set of activities and also, possibly, by the applied conditions and raw materials.

An example of such solution used in the cosmetics industry is an invention protected by patent PL 206409 (Colgate-Palmolive Company), named *Method for Producing and Filling a Multiplechamber Sachet*.

The invention is a method of producing and filling a multiplechamber sachet comprising a dispensing outlet, a device used, among others, in packaging liquid cosmetics. The method is described in detail in the first patent claim, where it is indicated that the process involves two sources of film forming

outer film walls and a film forming an internal partition wall, providing a nozzle dispenser outlet with two dispensing channels. Also indicated are the subsequent stages of supplying and combining the above elements, their sealing and filling of the sachet. The implementation of the invention is also illustrated in accompanying drawings:



The last category is the **use of a substance** known in the current state of the art for achieving a new effect.

An example of such solution used in the cosmetics industry is the invention protected by patent PL/EP 1971320 (Unilever N.V.), named *Antiperspirant Compositions*.

According to the description of the invention, *it relates to the field of antiperspirant compositions and to methods of reducing perspiration. In particular, this invention is concerned with reducing perspiration on the surface of the human body by the use of water-soluble or water-dispersible thiomers.* This is an innovative solution because, as indicated in the description, *conventional antiperspirants are astringent metal salts, such as salts of aluminium and/or zirconium. Such materials can function extremely effectively; however, they can cause some problems, including the possibility of skin irritation.* The solution was to replace metal salts with thiomers known in the current state of the art.

As we can see, the set of solutions in the cosmetics industry that could be subject to patent protection is large. It encompasses both innovative devices and tools, production methods, including packing processes, and finally – probably the most important – cosmetic compositions or – as in the case of natural cosmetics – a new application of substances found in nature.

Innovation in Poland

It turns out that patent protection is used primarily by large international companies and businesses from countries widely regarded as having highly innovative economies. The largest number of patent claims in the cosmetics industry – as in other industries – comes from the USA, Japan, Germany, France and Great Britain.

The Polish cosmetics market ranked sixth in Europe already in 2011, reaching the value of EUR 3.3 billion. However, Polish entrepreneurs take advantage of patent protection much less often than, say, their competitors on the common EU market, not to mention global companies. While companies such as L'Oreal, Unilever or Procter & Gamble have thousands of patent applications and patents granted in Poland, domestic entrepreneurs, including leaders in the Polish cosmetics industry, have incomparably fewer.

Meanwhile, according to the industry press, the Polish cosmetics industry is no longer competing only in price but also in the scale of investment in modern production lines and research programs, as well as in the innovativeness of marketed products. If this is so, then Polish entrepreneurs either forget about the possibility of obtaining patent protection or consider that the costs of such protection exceed the possible benefits.

Is patenting worth it?

Patent protection is limited only to the territory of the country in which the patent was granted and,

as a general rule, in relation to a scope often narrowly established in the patent granting decision. The cost of such protection, especially if it is not limited to the Polish market, is substantial. In addition to official fees, the patent applicant should expect translation costs as well as the cost of remunerating qualified attorneys assisting in the preparation of patent documentation and providing representation in the registration procedure. Sometimes, instead of investing in patent protection, it may be more cost-effective to allocate resources to the development of an effective marketing strategy, advertising, design or brand promotion. This allows the entrepreneur to promote a new product and benefit from introducing it on the market ahead of the competition. Nonetheless, taking into account the following facts, it is always worth considering the possibility of patent protection as part of a business strategy:

- Seemingly insignificant innovations including upgrades and improvements may also be patent protected;
- Commercialization of a new solution may consist not only in its application but also in obtaining remuneration for licenses granted to other entrepreneurs who wish to use the invention;
- Only patent protection gives one a genuine opportunity to benefit from innovativeness, without sharing it with others, and thus the fullest return on investment made in this respect.

Therefore, a full analysis of business and legal terms of economic activity may lead to the conclusion that patent protection is the optimal form of protection – despite the related costs.



Can one have exclusive right to a scent?

Joanna Woźniak

The original, unique, scent is one of the most important features of luxury perfumes and its composition is usually a closely guarded secret. Paradoxically, however, granting legal protection to a scent is extremely difficult. Indeed, this issue has not been resolved in the decisions of the Polish Patent Office or Polish common courts.

Nonetheless, for a long time, the possibility of protecting a scent as a trademark has been the subject of decisions of the European Intellectual Property Office (EUIPO), EU courts as well as foreign courts.

Scent trademark – how to register it?

As defined in Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, an EU trademark:

- May consist of any signs, in particular words, including personal names or designs, letters, numerals, colours, the shape of goods or the packaging of goods, or sounds, provided that such signs are capable of:
- Distinguishing the goods or services offered by one undertaking from those of other undertakings; and
- Being represented in the Register of EU trademarks in a manner allowing the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

As we can see, this definition does not exclude the registration of a scent, although it requires that the trademark be displayable in the register. The previous Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trademark directly requested that a trademark consist of a designation that can be represented graphically.

The interpretation of this condition by EUIPO has varied from one decision to the next. In the best known and so far only affirmative decision concerning the registration of a scent (*Vennootschap onder Firma Senta Aromatic Marketing vs. Markgraaf B.V.*, reference number R 156 / 1998-2), the Office decided to register the “scent

of freshly cut grass” for tennis balls. In its justification, the Board of Appeal indicated that the graphic representation may consist in a description of the scent which is distinguishable, recognizable and which everyone knows on the basis of experience. Thus, the Board considered it sufficient to specify that *the mark consists of the scent of freshly cut grass applied to the product*, i.e. tennis balls. EUIPO registered the mark under number EUTM-000428870, but after the expiration of the 10-year protection period the owner did not extend it.

In the *Ralf Sieckmann vs. Deutsches Patent- und Markenamt* case (C-273/00), the Court of Justice of the European Union confirmed that a trademark may consist of a designation which, by its very nature, is not visually discernible, but only under certain strictly defined conditions. The case concerned proceedings taking place before the German Patent Office for registration of a scent trademark in the form of a chemical substance known as 3-phenylacrylic acid methyl ester having the formula $C_6H_5-CH = CHCOOCH_3$. The applicant, apart from the chemical formula, also presented the German Patent Office with a sample of the scent and pointed out that it is described as balsamic and fruity with a slight hint of cinnamon. The German court examining the matter asked the CJEU whether the phrase “a designation which can be represented graphically” included only those designations which could be presented directly in a visible form, or should the phrase be interpreted to refer to designations such as scent or sound, which cannot be perceived with the sense of sight, but can be expressed indirectly using auxiliary methods. The Court also asked the CJEU – in the event the latter adopted the second, broader, interpretation – whether the requirement of a graphic representation would be met if the scent

was reproduced in the form of a chemical formula, published description, deposit or combination of these methods.

The CJEU decided that a graphic representation may consist of a description of the trademark by means of images, lines or characters, provided that such representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. Referring these criteria to scent marks, the court ruled out the use of the chemical formula of a scent as not allowing its direct identification. It also pointed out that the chemical formula of a substance is not identical to its scent and, as such, is not sufficiently clear and precise. For similar reasons (lack of clarity, precision and objectivity) it also rejected the possibility of using a verbal description. The court also considered that submission of a scent sample as evidence was not an admissible graphic representation and noted that such samples are not sufficiently stable or durable. In conclusion, the court decided that also the combination of the above elements did not allow the recognition of the scent as having been presented graphically in accordance with the requirements of the law.

Similar arguments were put forward by the court of first instance in the judgment issued in the *Eden SARL vs. EUIPO* case (T-305/04), in which the applicant claimed registration of “the scent of ripe strawberries” described verbally and graphically by a drawing of a strawberry.



In the opinion of the court, the term “scent of ripe strawberries” is not sufficiently precise and objective because there may be different scents that meet this criterion. The strawberry drawing itself represents the fruit and not the scent to be registered as a trademark.

Such formulation of the requirements for scent marks made it practically impossible to register them as trademarks. Indeed, it is difficult to point to other methods of graphically representing a mark that is fleeting by nature and is not perceived

by the sense of sight than those considered in the abovementioned judgments.

Guided by this argument, EUIPO refused, for example, to register the scent of tea tree oil for industrial safety gloves (case R-012741401). It pointed out that the verbal description of the mark does not constitute its sufficient graphic representation because it is not sufficiently clear, precise and objective.

In view of this, the applicants sought other forms that could represent the scent mark. One of them made reference to a colour matrix of the spectrum of scents, i.e. the method used in the perfume industry to present a given fragrance. The French Institute for the Protection of Fragrances (*Institut Pour la Protection des Fragrances*) applied for registration of a scent containing a note of grass, fruit of a citrus tree (bergamot, lemon), flower (orange blossom, hyacinth) as well as rose and musk, for use in cosmetics, pharmaceuticals, paper products, bags and household textiles (bedding, towels and tablecloths) (case R 186 / 2000-4). The mark was to be represented using the color matrix shown below.



EUIPO refused to register the mark indicating that the proposed graphic representation is not understandable to the public concerned because it does not allow the determination of the subject or scope of protection. The colour matrix used in the perfume industry is not legible outside that industry and is not perceived as a code serving to record the scent. It also does not contain any guidelines that would make it possible to decipher the scent’s graphic record.

The new regulation regarding the EU trademark (2017/1001) abolished the requirement of graphic representation of the mark but did not eliminate the fundamental problem mentioned in the discussed decisions and judgments – how to present a scent in an unambiguous and precise way? Perhaps the solution to this dilemma will come with the development of technology rather than law.

Can a scent be considered a “work”?

In view of the difficulty in registering a scent as a trademark, a different method of granting protection may be to classify it as a “work” within the meaning of copyright law. It seems that the broad definition of a work contained in legislative acts does not a priori exclude such interpretation. The Polish Act on Copyright and Related Rights of 4 February 1994 indicates that the subject of copyright is any manifestation of creative activity of an individual nature, established in any form, regardless of the value, purpose or manner of expression. A similar definition is granted to a “work” in the legislation of other European countries. For example, the provisions of the French Code of Intellectual Property (*Code de la propriété intellectuelle*) protect copyrights to all products of the intellect, regardless of their type, form of expression, matter and purpose.

However, also in this area, despite similar definitions of a “work”, there is no uniform judicial practice of the European courts regarding the classification of scents. For example, the case-law of the French *Cour de Cassation* consistently refuses to grant copyright protection to scents, whereas such protection is allowed by the Supreme Court of the Kingdom of the Netherlands (*Hoge Raad der Nederlanden*).

In the judgment of 10 December 2013, ref. no 11-19872, the French *Cour de Cassation* upheld the already established case-law, according to which scent is a result of the application of specialist knowledge (know-how, French: *savoir-faire*) and not an outcome of creative activity and, as such, it is not a form of expression benefiting from protection as a work. In the aforementioned ruling, in response to the allegation that the court of appeal had adopted this thesis *a priori*, without examining the originality of the perfume (i.e. its author's creative contribution), the *Cour de Cassation* elaborated on its position. It pointed out that copyright protection applied to works in the form received by the senses, if such works could be recognized precisely enough to be passed on to recipients. In the court's opinion, the scent of perfume considered

outside the manufacturing process (which in itself is not a creative activity) does not meet this requirement.

A different position in a similar case was expressed by the Supreme Court of the Kingdom of the Netherlands in the judgment of 16 June 2006 in the case of *Kecofa vs. Lancôme*. This court recognized that copyright protection extends beyond works perceived by means of sight or hearing to include any sense, provided that the given work meets the criterion of originality. In the court's opinion, the scent of perfume is a subject of copyright separate from the scent of its carrier (i.e. a fluid with specific chemical composition). Consequently, the reproduction of a scent may constitute a violation of copyright, even if the exact chemical formula of the fluid is not exactly reproduced and the same scent effect is produced as a result of the creation of a different formula.

Other ways to protect perfumes

So far, Polish courts have not been required to indicate which legal provisions are appropriate to the protection of scents. It seems that, until solid jurisprudence is established on this issue, the surest way – along with the protection of the perfume formula as a trade secret – is to continue protecting the name and the external form of the product or its packaging based on the provisions of industrial property law and the principles of fair competition, rather than the protection of the scent formula alone.

This solution – although it does not protect the essence of perfume as a product – nonetheless allows an effective protection of the product's position on the market and the expenditures involved in its development and preservation. A new and original scent can be created, an existing scent can be forged, but the hardest thing is to persuade the consumer to reach for it. In addition to the high quality of the product, a well-known and respected trademark is one of the best guarantees that our product will be chosen by consumers and appreciated on the market.



From the drugstore to the courtroom – what are the main reasons behind disputes between cosmetic and perfume companies in Poland

Lena Marcinoska

On the Polish market of cosmetics and perfumes we will find both global producers and Polish brands. The latter are getting better and better. The cosmetics market in Poland doesn't stop to grow. That growth has been particularly dynamic in recent years. Competition is also intensifying. It can lead to an increase in the number of court litigation cases related to intellectual property rights. Below we indicate what in our experience has been the most common subject of disputes among industry players.

Original, but not for this market!

Our practice and observations indicate that a large number of cases that find their way to the courtroom refer to trademarked perfumery products sold in Poland, even though they had not been previously placed on the market in the European Economic Area (EEA) by the right-holder or with his consent. So we are talking here about perfumes that are original but – in simplified terms – were intended by the right-holder for a different market, e.g. Asian or American, and should not be sold in the EEA.

The discussed practice often involves the issue of removing, masking or altering production codes that identify perfumes or the issue of their repackaging. Sometimes it also encompasses the sale of perfumes which the right-holder did not intend for sale at all, for example that of testers. The holder of the trademark that has been placed on such perfumes has the right to oppose these practices. Courts are increasingly often admitting lawsuits in these types of cases.

The “lookalike”

It happens that some cosmetic and perfume manufacturers take a shortcut when introducing a new product on the market and lawlessly render the packaging of that product similar to the packaging of other brands, particularly reputed ones (the so-called “lookalike packaging”). The similarity usually applies to two areas – on the one hand, the shape of the packaging, and on the other its graphic appearance, including composition, layout, graphics, colour scheme and fonts.

In our practice we meet packaging rendered similar in this twofold manner that holds lip gloss, mascara or eyelash serum, eye shadow or a perfume bottle and its external packaging. Infringers often “reverse the colours”, use a mirror image of some packaging components or render similar the shape of containers, including their characteristic profiling or convexities. In the case of creams or shower gels, the similarity applies to the graphic components of the packaging or labels, and less frequently to the shape. Often the individual components of the packaging differ from the individual components of the original packaging, but, nonetheless, their accumulation and composition make the impression of similarity. This similarity causes customers to reach for a familiar packaging, even if it is not identical to the packaging of the original product. As a result, that product can be sold instantly without its seller having to conduct promotional campaigns, incur advertising expenses, etc.

A war against these types of infringements is not easy but should be nonetheless waged. They are the enemy of fair competition. Some customers, guided by the appearance of the packaging, will confuse the products or will be under the illusion that goods in a similar packaging have the features of goods known to them earlier. Our practice shows that an effective battle with these violations is possible. Many cases end in an amicable settlement.

It is somewhat easier, especially in court, when the right-holder can provide an industrial design that embodies the external form of his product against the infringing packaging. In one such case, the

court, confirming infringement of an industrial design, prohibited the defendant from marketing mascara *in packages of elongated shape and characteristic profiling, whose lateral surface is curved, with a convexity in the middle, consisting of two parts, where the lower part constitutes a container while the upper part bears the form of an ellipse when looked at from above, and in the side view has the form of a solid with the top cut at an acute angle* (judgment of the District Court in Warsaw of 31 January 2013, case XXII GWwp 16/12).

On the one hand, there are many weak marks...

Designations chosen in the cosmetics industry to identify products are often relatively simple and undistinctive. These marks are often descriptive, indicating the type of goods or carrying expressions characteristic of products of the given type. But this is not a good practice. It leads to problems with the subsequent pursuit of the protection of such designations, even when they are registered as trademarks.

For example, let's take a word designation containing the words "happy", "derm" or "phyto". The court pointed out that these words largely described the cosmetic product and its properties. They were commonly used by cosmetic-selling businesses. In the meantime, the designation whose protection the plaintiff claimed consisted exclusively of these words. Unfortunately, even a combination of these words did not strengthen the distinctive ability of the mark.

Interestingly, the issue of the so-called generic nature of the designation also appears in Polish judgments regarding the BOTOX trademark. The defendants in these cases claim that the designation has entered the colloquial language. However, the courts indicate that this does not deprive the BOTOX trademark of its distinctive character. Indeed, it is used only for the determination of a specific preparation and not for different products that have common characteristics. The courts emphasized that, in this particular case, the common knowledge does not deprive the trademark BOTOX of distinctive character but strengthens it

(judgment of the District Court in Warsaw of September 1, 2015, case XXII GWzt 17/15, non-final).

Here is another example worth considering. The court decided in a judgement that the designation PANORAMIC for mascaras is strongly distinctive.. It indicated that the designation allows the association with the effect obtained when using the product, but does not describe it, leaving that to the imagination of the buyer in whose memory this association will remain. In this case (judgment of the Court of Appeals in Warsaw of February 20, 2009, case I ACa 944/08), the court found that the designation PANORAMA used for the same product types, i.e. mascaras, creates a risk of confusion and infringes the PANORAMIC trademark.

An attempt to claim protection for non-distinctive designations may fail. The courts emphasize that the consequences of choosing a "weak" mark encumber the plaintiff. Therefore, the choice of the designation should be well-thought-out and should take into account the likely possibility of having to claim its protection in the future. Our experience shows that this issue is often neglected.

...and on the other, there are many strong marks too

At the other extreme, in opposition to a large group of evidently weak marks, we see in this industry an equally characteristic accumulation of strong renowned trademarks. There are not many other markets on which such marks exist in large numbers. What is more, some of them are marks associated with high quality and luxury. The issue of renowned trademarks is also present in the judgments of Polish courts. For example, the courts confirmed an infringement of the renowned trademark Cartier for perfume products, by the defendant's products marked Chartier. In the same case, the court also ruled on the confusing similarity and violation of the principles of fair competition (judgment of the Court of Appeals in Katowice of February 22, 2011, case V ACa 507/10). In another judgment related to the same case, the arbitration court raised the issue of infringement of the plaintiff's rights to the renowned trademark Cartier by

registering the chartier.pl domain name (see the judgment of the Court of Conciliation for Internet Domains dated March 12, 2015, case 57/14/PA), under which the defendant operated an online perfume store. Another trademark whose repute was confirmed is REXONA (judgment of the Court of Appeals in Warsaw of February 26, 2013, case I ACa 1001/12) and the already mentioned BOTOX.

Substitutes instead of proprietary marks

Cases of another type that we often come across are those where defendants use third-party trademarks in commercial information about their own products. This applies in particular to designations of luxury perfumes. Infringers use phrases such as “alternative to”, “alternative perfumes”, “inspired alternative perfumes”, “perfume substitutes, inspiration” or “perfume equivalents”, and follow them with a renowned trademark. Infringers claim in court that their actions are justified by the need to inform consumers about the features, properties and intended use of their products. Courts, however, tend to consider such actions as unlawful and violating the trademark’s distinguishing and promoting function. Indeed, defendants engage in this manipulation with the objective of swaying consumers to purchase their products by transferring thereon consumers’ positive perceptions of the quality or effectiveness associated with the earlier, usually well-known, trademark.

Cosmetics or household chemicals?

In one of the cases pending in court there was a problem with establishing the similarity of goods bearing opposing trademarks. The dispute concerned the trademark KINDII, which the plaintiff uses for child body care products, and the disputed mark KINDY LOVE, which the defendant uses for his household chemical products that serve to wash children’s clothes and undergarments. The

lower courts have recognized that the goods of both parties were targeted at consumers interested in products for young children and infants. Despite this, they did not accept that there was a similarity of goods. Consequently, they concluded that there was no risk of confusion since in market conditions the goods offered by the parties were not substitutable, and the only aspect that connected them was that they interested the same group of customers. As a result of the plaintiff’s last-resort appeal, the case went to the Supreme Court (judgment of the Supreme Court of February 11, 2015, case I CSK 50/14). The Supreme Court referred the case back to the court of appeals and instructed it to examine not only the actual and current extent to which the plaintiff uses the trademark but also the entire range of goods or services for which the mark was registered. The judgement that will be issued in this case may provide interesting information about the similarity of goods, especially those located at the border between cosmetics and other types of products, e.g. chemical, medical or pharmaceutical.

Summary

If the cosmetics and perfumes market will continue to grow, and everything seems to indicate that it will, we should expect a growing number of potential points of contention. As indicated above, cases concerning infringements of intellectual property rights and principles of fair competition in the cosmetics and perfumes industry undoubtedly have their specificity. In the above examples we focused exclusively on products. However, it should not be overlooked that the cosmetics market is not limited to goods, but also, and perhaps above all, it offers services – various cosmetic treatments, massages, therapies, spas, consultations or training. Therefore, violations may affect a much wider area.



Prohibition of online sales of luxury products?

Dr Monika A. Górska

Can an authorized retailer be prohibited from selling online or on a third-party online platform?

The perfume industry, including its luxury end, largely relies on selective distribution channels. These channels are usually founded on extensive agreements detailing the obligations associated with the principles of selling perfumes or décor of points of sale, but also prohibiting specific activities. Meanwhile, authorized retailers are increasingly selling perfumes online or on third-party internet platforms. To what extent can the leader of a selective distribution network intervene in such sales? Can it completely prohibit an authorized retailer from selling online? Can the party restrict such sales?

Total ban on online sales

In its selective distribution agreements, the company Pierre Fabre Dermo-Cosmétique SAS (“PFDC”) provided for a total ban on online sales of cosmetic and personal care product brands such as Avène, Klorane, Galénic and Ducray. PFDC distribution agreements specified that the sale of these brands should take place under strictly defined conditions and in the mandatory presence of a qualified pharmacist. Therefore, online sales were out of the question. PFDC justified the requirement for the physical presence of a pharmacist at the point of sale by pointing at the nature of the products and the need to allow the customer to seek an individual opinion of a specialist based on direct observation of skin, hair or scalp epidermis.

The French competition authority found that the prohibition on online sales imposed by the PFDC distribution agreements was inconsistent with competition law. Indeed, the prohibition of online sales in combination with a selective distribution system has a competition restricting purpose. The authority considered that the prohibition on online sales imposed on retailers by the PFDC corresponded to the ban on active and passive sales, which is not allowed. It was not convinced by the argument that the ban on online sales would im-

prove the distribution of dermo-cosmetics, preventing the risk of trademark infringement and unwarranted enrichment at the expense of authorized entities, or that the nature of products and the desire to make the consumer comfortable required physical presence of a pharmacist. The case, as a result of PFDC's appeal, was forwarded to the CJEU.

In its judgment of October 13, 2011, case C-439/09, the CJEU reverted to an in-depth analysis of the contractual clause in question in the light of the antitrust case-law and regulations. It accepted in principle the argument concerning the selective distribution network and its pro-competitive nature, provided that the selection of resellers is based on objective qualitative criteria established in a uniform manner for all resellers and is applied in a non-discriminatory fashion. The CJEU also agreed that, to maintain quality and ensure proper use of a given product, such distribution network is required and that the defined criteria do not go beyond what is necessary. Whereas it rejected the argument concerning the need to protect the prestigious image of distributed brands. According to the CJEU, the protection of a prestigious image cannot justify the restriction of competition. A contractual clause in a selective distribution system that completely excludes online sales may in the CJEU's view constitute an unlawful restriction of competition.

Partial ban on online sales

The dispute between the company Coty Germany and its authorized retailer Parfümerie Akzente concerns the ban on the sale of luxury perfumes on a platform belonging to a third party. Parfümerie Akzente runs sales of distributed products via the Internet, partly through its own online store and partly on *amazon.de*. Coty Germany introduced the following provision in its selective distribution agreements: “the authorised retailer is entitled to

offer and sell the products on the internet, provided, however, that the internet sales activity is conducted through an “electronic shop window” of the authorised store and the luxury character of the products is preserved”. The agreement also prohibits the use of a different business name as well as a recognisable (to clients) engagement of a third-party undertaking which is not an authorised retailer of Coty Prestige.

Coty has lost the case before the domestic court. The court, referring to the principle described in the judgment issued in the *Pierre Fabre Dermo-Cosmétique* case (C-439/09), considered that the contractual clause was inconsistent with the relevant provisions of antitrust law. The case was presented to the CJEU (C-230/16). The Advocate General provided his opinion on July 26, 2017.

The Advocate General recalled that the Court has consistently taken a cautious approach when dealing with selective distribution systems. Such systems may be declared compliant with antitrust law provided that the choice of resellers is based on objective criteria of a qualitative nature, determined in a uniform manner and applied in a non-discriminatory fashion. As a rule, the Court's case-law indicates that selective distribution systems favour and protect the development of the brand's image. They also stimulate competition between suppliers of branded goods, in that they allow manufacturers to organize efficiently the distribution of their goods and satisfy customers. Selective distribution systems are, especially for goods with distinctive qualities, a vector for market penetration. Brands, and in particular luxury brands, derive their added value from a stable consumer perception of their high quality and their exclusivity in their presentation and their marketing. Whereas that stability cannot be guaranteed when it is not the same undertaking that distributes the goods. The Advocate General stated that the effects of selective distribution systems are neutral and may even be beneficial from the point of view of competition.

The Advocate General devoted a considerable amount of space to a detailed analysis of Coty's selective distribution network and the context of the

disputed contractual provision. Selective distribution systems of luxury and prestigious articles serve to protect the brand image of these goods and preserve their quality. Therefore, as long as they meet the conditions developed in case-law, and the selective distribution agreements themselves do not contain “hardcore” restrictions of competition, they should be assessed as compliant with antitrust law.

The Advocate General recognized that the ban on using third-party platforms may be justified by the objective of maintaining and controlling quality criteria, which requires, in particular, the provision of certain services when selling articles, as well as the presentation of sold products in a specific manner. This prohibition, in the Advocate General's opinion, also allows maintaining the protection and positioning of brands in the face of such phenomena as counterfeiting of products and parasitic use of third-party trademarks, which are likely to restrict competition.

The leader of a selective distribution network may require quality standards for the use of the Internet site to resell its goods, just as he may require quality standards for a shop or for selling by catalogue or for advertising and promotion in general. However, in making use of third-party platforms in distribution of the products, the authorised distributors — and, what is more, the network leader — in particular no longer have control over the presentation and image of the products, since, inter alia, those platforms frequently display their logos very prominently at all stages of the purchase of the contract goods. According to the Advocate General, the absolute prohibition imposed on the members of a selective distribution system from using a third-party online platform for their Internet sales thus constitutes a restriction comparable with the restriction which is justified and necessary in order to ensure the functioning of a selective distribution system based solely on brick and mortar trade, and is therefore legitimate in the light of competition law. In other words, when certain conditions are met, a contract clause prohibiting members of the selective distribution network from selling on third-party online platforms is lawful.

Judgment in the Coty Germany vs. Parfümerie Akzente case (C 230/16)

The Court agreed with the position of the Advocate General and, on December 6, 2017, issued a judgment in which it stated that antitrust law did not preclude prohibiting in contracts with authorized retailers of luxury perfumes the use, in a manner discernible to clients, of platforms belonging to third parties which are not authorised retailers for Internet sales, provided that the following conditions are met:

- The contractual clause aims to preserve the luxury image of the goods;
- It is laid down in a uniform manner and is applied in a non-discriminatory fashion;
- It is proportionate in the light of the objective pursued.

Incidentally, the use of third-party platforms in a manner discernible to clients seems to be a very important criterion given that online sales via the Internet using a third-party platform, but in a manner not discernible to the client, should not be restricted.

The CJEU reiterated in the judgment that the quality of luxury products is not just the result of their material characteristics but also of the allure and prestigious image which bestow on them an aura of luxury. Recalling the Copad judgment (C-59/08), the Court stated that the aura of luxury is essential in that it enables consumers to distinguish them from similar goods.

In the justification of the judgment the Court accepted that the contractual clause under consideration aims to preserve the luxurious and prestigious image of Coty's goods, that it is objective and uniform and that it is applied without discrimination to all authorized retailers. The Court also noted that a different assessment of the case would in fact deprive the leader of the selective distribution network of control over the appropriate conditions for the sale of luxury goods online. The lack of a contract between third party vendors and third-party platforms would prevent the vendor from enforcing compliance with quality require-

ments from these platforms, which could consequently contribute to the destruction of the luxury aura of these goods. Like the Advocate General, the Court stated, based on studies carried out by the European Commission, that online retailer stores form the preferred online distribution channel. In these circumstances, the Court found that the contractual clause under consideration is adequate and proportionate to the preservation of the luxury image of goods.

The Court also pointed out that, should the domestic court conclude that the clause at issue is caught, in principle, by the prohibition of agreements, decisions and concerted practices laid down in EU law, it is possible that that clause might benefit from a block exemption under Regulation 330/2010. The Court concluded that, in the circumstances of the case, the contractual clause under consideration neither constitutes a restriction of customers nor a restriction of passive sales to end users, restrictions which are automatically excluded from the benefit of a block exemption because they are liable to have severely anti-competitive effects (Court of Justice of the European Union, Press Release No. 132/17).

This judgment is important from the point of view of the practice of competition law. It confirms that restrictions of sales on third-party Internet platforms are not among the hardcore restrictions. They do not constitute a restriction of competition prohibited due to the objective. Therefore, when analyzing such restrictions, one should examine their circumstances and effect. Consequently, any such restrictions must always be subjected to prior careful analysis. It is worth noting (as the Court has) that an absolute prohibition of online sales is, in principle, not admissible. This view is fixed in the European competition case-law.

The difference in the assessment of the absolute ban on online sales and the ban on sales on third-party platforms

The Coty case differs from the case of Pierre Fabre Dermo-Cosmétique in that the latter was not about luxury products, but about cosmetic and personal hygiene products, and moreover, the contractual

clause introduced an absolute ban on online sales. In the light of competition law, such ban was not justified. Coty, on the other hand, did not envisage an absolute ban on online sales but only obliged its authorized retailers to refrain from selling contract products via third-party platforms, because in the opinion of the network leader such platforms are not required to comply with the quality requirements which he imposes on his authorized retailers. Parfümerie Akzente could sell perfumes via its own websites. On the other hand, it could not sell perfumes on third-party platforms due to the risk

of losing its control of the quality of sales of luxury goods.

Both described cases show that luxury products are somewhat governed by their own laws. However, the fact that an authorized retailer of such products may be prohibited from selling via third parties, such as *amazon.de*, in a manner discernible by the public, should not lead us to the hasty conclusion that the total ban on selling cosmetics and perfumes online can be successfully defended.



A counterfeit with a typo – is it really a counterfeit?

Ewa Górniewicz-Kaczor

In order to bring the perpetrator to criminal liability for trade in counterfeits, it is first necessary to determine whether the traded goods are counterfeited, i.e. whether they bear a counterfeit trademark. Can we speak about a counterfeit trademark only if it is identical to a registered trademark? Well, no. A counterfeit trademark may also be a mark slightly different from the registered one, i.e. a mark that is confusingly similar.

The situation on the market

The Polish market for counterfeit perfumes is dynamic. For many years, counterfeit perfumes were available on the market in traditional volumes – such as we see on the shelves of renowned perfumeries. Poland was perceived mainly as a transit country and also as a market for counterfeit perfumes and cosmetics imported mainly from China and Turkey.

Statistics of the Ministry of Finance show that the number of counterfeit cosmetics originating from outside the EU and detained at the border has been falling from one year to the next. In 2014, that number was close to 140,000 units, in 2015 – over 15,000 units, and in 2016 – over 8,000 units. This does not mean, however, that the number of fake cosmetics present on the market is falling. Poland is unfortunately becoming an important producer of counterfeits. Until recently, counterfeit products made in Poland were mainly detergents, washing liquids and creams. Their place has been taken by perfumes.

At the turn of 2016 and 2017, the Central Bureau of Investigation broke up a group involved in the production of counterfeit perfumes. The perpetrators produced and distributed perfumes in small volume containers – 20 and 33 ml (so-called “perfumery pens”). The scale of the practice was enormous. The media widely commented that this is one of the biggest hits in this type of illegal business in Europe. However, we still hear about the detention of other people who trade such goods.

Counterfeit trademarks with a typo

We note more and more cases in the cosmetics sector where the objective is to determine if the designation used on the product – very similar but not identical to a registered trademark – should be considered a counterfeit and, consequently, could be prosecuted.

In our practice we see more and more perfumes with designations representing modified registered trademarks. The differences are usually minor. Often almost imperceptible. In the case of word

marks, they are repeated letters, usually at the end of the word, or modifications that appear to be typos. With colour graphic trademarks, it can also be a difference in color or shade. The aggrieved party, in this case the trademark owner, may have grounds for motioning for prosecution and for seeking protection of his rights through criminal proceedings.

How was it in the past and how is it today?

This regulation has not always functioned in the Polish legal order. Under the Trademarks Act that preceded the Industrial Property Law Act, the marketing and designation of goods (or services) with a registered trademark which the perpetrator was not entitled to use was a punishable offence. Many legal scholars held the position that, based on the regulations in force at that time, the issue was only about deceptively similar marks. However, the Supreme Court did not share this position explaining that the legislator – in view of a clearly formulated provision – did not intend to penalize behaviours related to goods bearing confusingly similar marks (Supreme Court ruling of October 27, 1994, case I KZP 26/94). The Supreme Court pointed out in the justification of the ruling that since the Trademarks Act distinguishes between the notions of “registered trademark” and “mark similar to a registered trademark”, and there is no such distinction in the criminal provisions of that Act, it is clear that “similar mark” is not subject to the provisions of criminal law. Despite the Supreme Court having taken this stand, legal scholars continued to maintain their position. They referred to arguments of a purely practical nature resulting from their experience with such matters.

Only the entry into force of the Industrial Property Law Act, which replaced the Trademarks Act, led to the penalization of trade and production of goods bearing confusingly similar marks. Art. 120 par. 3 pt. 3 of the Act defines a counterfeit trademark as one that is:

- An identical mark used unlawfully, or;
- A mark that cannot be distinguished in ordinary trading conditions from a registered trademark.

Counterfeit identical mark

The first category of counterfeit marks, i.e. marks that are identical, does not essentially raise any doubts. When using a mark identical to the registered trademark, it is crucial to determine whether the use is unlawful, i.e. whether it occurred without the consent of the rightful trademark holder. Both the doctrine and the jurisprudence hold the position that the circumstance whether the consumer may be misled or not is irrelevant when using an identical designation. Even the seller who openly informs the buyer that the offered product is a fake will not avoid criminal liability in this way. The fact that the buyer knowingly takes part in the trade in counterfeit goods does not affect the seller's culpability.

Counterfeit similar mark

The situation of confusingly similar trademarks is definitely more complicated. From the very beginning there was a danger of interpreting problems with regard to understanding the notion of a “similar mark” under criminal law. It is worth noting that, in order to define a “similar mark” in criminal law, the legislator did not use the notion of “misleading” known under civil law, which already had accumulated rich case-law, but the notion of “distinctiveness in ordinary trading conditions from a registered mark”. Therefore, the question arises whether to understand the term “similar mark” in criminal law one can make use of the rich jurisprudence of civil law. Legal literature does offer statements leading in this direction.

The counterfeit mark and the registered mark must be similar to each other with this additional caveat that the similarity must exist under ordinary trading conditions. Regardless of the differences in details, the similarity consists in the general impression that a given designation may give, and this is a matter of fact (judgment of the Supreme Court of October 15, 1935, case III K 912/35). Criminal liability as concerns similar marks depends on the existence of the risk of confusion as to the identity of the manufacturer. If “the existence of a risk” is raised, it means that even a potential possibility of a mistake is taken into account. Therefore, it is not

necessary to demonstrate that such mistake has actually occurred. The mere possibility of confusing the marks is sufficient.

In practice, most interpretation problems are caused by the understanding of the term “ordinary terms of trade”. There are no unambiguous criteria on the basis of which this concept can be interpreted. Assessment of similarity in ordinary terms of trade is made from the perspective of a person potentially interested in a given commodity. When assessing, it is necessary to take into account the amount of time and attention the potential consumer devotes to the selection of a given type of goods. If we buy an article hastily because, for example, it is a product of everyday use which we often purchase, we will dedicate much less attention to such purchase than, for example, when choosing a household appliance. Much importance may also lie in whether the consumer already knows the product, i.e. whether he already had contact with it or bought it in the past. When we reach for a well-known product on the store shelf we do not pay attention to the details of its packaging. We are guided by the image of this product preserved in our memory.

However, it is difficult to look for a closed catalog of factors that have an impact on the assessment of ‘ordinary terms of trade’. Certainly, the general principles that govern human perception should be taken into account. Usually we only remember the general, superficial, image of the mark, without any details. As a consequence, small typos can be simply overlooked, especially when the registered trademark is a foreign word containing letter combinations not typical to the Polish language.

The aforementioned circumstances explain to a certain degree the concept of a counterfeit trademark within the meaning of criminal law. However, no guidelines provide a full-proof basis for creating a rigid framework for the assessment. And although such solution is not ideal, so far it has not been possible to develop a better one.

And how is it in practice?

Criminal proceedings regarding similar marks are rather rare, although – as we have already signalled – there are more such cases now than in the past. Cases in which courts have hitherto condemned the infringers and thus confirmed that marks used on goods that are non-identical with registered marks are counterfeit trademarks, mainly related to perfumes in which the reproduction concerned the entire outer form of the product, the shape of the perfume bottle and the cardboard packaging along with the graphic layout and the colour scheme. In comparison with registered marks, designations used on such perfumes usually differed in one letter added or removed at the end of the trademark, and possibly in a changed order of one or two letters.

The courts underline in the justifications of their judgments that, particularly in the case of registered trademarks that are foreign words, it is more difficult for consumers to precisely recall their appearance. In turn, in one of the cases that concerned a figurative mark, the court found that its mirror image was a counterfeit designation.

In each such case it is necessary to conduct a thorough analysis and make an individual assessment. It may turn out in the end that the designation used on the product is not sufficiently similar to the registered trademark. Then the provision of art. 305 of the Industrial Property Law Act will not apply. Nevertheless, it should be kept in mind in such cases that the regulation of this act is not the only basis that gives the aggrieved party the opportunity to act under criminal law. Also the provisions of the Copyright and Related Rights Act and the Act on Unfair Competition Countermeasures may constitute such basis. Irrespective of the above, the brand owner may counteract infringements also in civil courts.



The Patent Office also recognizes the specifics of the cosmetics market

Monika Wieczorkowska

The cosmetics market is growing and with it the number of different trademarks reported for this type of products. Therefore, conflicts between trademark registrations are inevitable. Their assessment is essentially the result of an assessment of the similarity of the compared goods and the similarity of the compared trademarks.

Registrants of conflicting trademarks for cosmetic products often invoke arguments that, in their opinion, eliminate a collision despite the similarity of the goods and the marks. The first argument concerns the difference in the price of products having opposing marks. The second – an increased level of attention of the buyer of cosmetic products, who will not confuse them. Administrative jurisprudence responds to these arguments.

Are differences in the prices of cosmetic products important in assessing the risk of confusion?

The owner of the trademark CLINIQUE HAPPY objected to the registration of the word and graphic mark HAPPY. Both marks were intended for hair shampoos. The applicant for registration of the designation HAPPY argued that there is no risk of misleading consumers also due to the fact that the compared marks serve to mark goods addressed to different buyer groups. The goods offered by the applicant are mass production goods, whereas the earlier mark is used to designate luxury goods. Due to price differences between these products, their distribution channels are different and, therefore, the risk of confusion does not occur.

In its judgment of May 12, 2017, case II GSK 4628/16, the Supreme Administrative Court (SAC) did not agree with this argumentation. It stressed that price differences of similar products designated with opposing marks are not taken into account in the assessment of the risk of confusion. A trademark is registered for a specific product, regardless of its price. In addition, the trade policy of the trademark holder may change during the period when the mark is protected.

Therefore, the different price of products should not have any impact on the assessment of the risk of confusion. SAC's argument is correct.

What is the level of attention of a buyer of cosmetics?

When analyzing the probability of misleading consumers, it should be considered who are actual and potential customers of specific trademarked goods and services, i.e. who belongs to the so-called relevant buyer group.

It seems that cosmetics are purchased by people who take care of their physical appearance or health and who buy cosmetics for this purpose and use the services of beauty salons. As a rule, they are unprofessional consumers who buy these goods for their own needs in drugstores, supermarkets and hair and beauty salons. However, such products may be also purchased by professional consumers – beauticians or hairdressers who acquire cosmetics and accessories in order to supply their salons with products that they will use serving third parties – customers. Such consumers usually order products in bulk, often online, in contrast to customers of ordinary stores who usually buy retail. It follows that the group of buyers of cosmetics and cosmetic services is unlimited, broad and diverse.

A factor that can also influence the assessment of potential confusion is the level of attention of the relevant buyers. Generally, the Polish Patent Office, similarly to the European Intellectual Property Office (EUIPO), recognizes that the level of attention of cosmetics buyers is quite low due to the popularity of cosmetic goods and their everyday use. It counts them among goods purchased impulsively, without much thought. In turn, according to the Office, when selecting cosmetic services

provided by beauty salons and other cosmetic services, the consumer's level of attention may be slightly higher due to the impact of such products on human health (see the decision on the Vita Cell trademark, no. Z.426273, dated 25 May 2016).

However, even if we assume that cosmetics can be bought by professionals, while cosmetic services require a higher level of attention from a non-professional buyer, it should be remembered that these are not arguments determining that there is no risk of misleading buyers or that there is no risk of association. The basic principle often stressed in jurisprudence is that the average buyer retains in his mind only an imperfect image of memorized

marks. For this reason, the Office indicates in its decisions that, when the goods are identical or similar, the coexistence of similarity between the marks determines the possibility of confusion, even despite the increased attention given by buyers of cosmetics and users of cosmetic services (see the decision on the Hair House trademark, no. Z.425111, dated 17 May 2016). Therefore, in order to avoid this kind of conflict of trademarks, it is worth considering in advance what trademark we want to protect in order to sufficiently distinguish it from marks registered by other business operators.

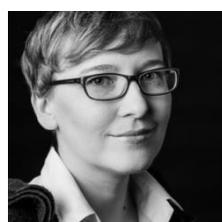


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Intellectual property

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Intellectual property law protects intangible assets, primarily works, patents, trademarks and industrial designs—assets of an “intellectual” nature which when incorporated into material objects become the subject of trade. They are of vast economic importance and often are crucial to the commercial success of an enterprise. Laws govern in detail the manner in which rights to these assets are obtained and how they may be exploited, and also define what actions of third parties constitute infringement of IP rights. There is a separate legal regime for combating unfair competition. It complements the protection afforded to specific types of intellectual property but also provides separate grounds for protection of business interests.

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We draft and advise on various contracts involving transactions in intellectual property rights.

We combat infringements of industrial property rights and unfair competition.

We assist clients in protecting intellectual property on the internet.

We advise on how to protect personal interests and how to effectively and safely conduct transactions involving such interests.

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