

Summary

The doctoral dissertation is devoted to the relations between trademark law in the United States and the European Union in terms of the forms of an infringement of famous and reputable trademark protected beyond the principle of specialty as regards common elements and differences under these systems. In both jurisdictions analyzed, there is a category of trademark protected to an extended extent due to the wide recognition or reputation of such a mark and the supplementary functions performed in addition to the traditional distinguishing function. Despite differences in the semantic layer of the trademarks protected in the broader extent, the scope and subject matter of extended protection in the European and American systems are similar. The comparative analysis aims at identifying the main differences and similarities between the principles specific for both jurisdictions. Based on the conducted comparison, it is possible to identify, firstly, the risks arising from the discrepancies that may lead to different scope and principles of protection of famous and reputable trademarks, and secondly, the similarities, which may allow the right holders to harmonise and standardise the measures aimed at maintenance of exclusive rights and enforce the protection of famous or reputable trademarks. This is especially important in cases where these marks are used in both Europe and the United States.

Demonstrating the above correlations is preceded by an analysis of the following research objectives. The first is the identification and analysis of the origin, evolution and current regulations shaping trademark law in both legislations. Further research objectives are the analysis directly related to the subject matter of the form and possible results of infringement of the trademark protected beyond the principle of specialty. The analysis covers the concept of an extended trademark protection and the subject of protection against dilution, regarding the fame analysis in the United States and the reputation analysis in the European Union. These research objectives intend to clearly address the second to last one of them, preceding the comparative legal analysis: the analysis of the special protection of a reputable trademark – in the European Union and a famous trademark – in the United States.

The author identifies two research hypotheses. The first hypothesis assumes that the concept of the dilution of both famous and reputable trademark, along with a form of infringement occurring only in the European Union, i.e. free-riding, constitutes a complex concept of trademark law that is difficult to apply in practice. The second hypothesis states that despite similar origins and assumptions, special protection of a trademark protected beyond the principle of specialty in the European Union and the United States differs in many aspects and

may generate different effects for right owners in both systems when actions of similar nature are taken. This implies the importance of being aware of peculiarities of both legal systems and addressing the challenge of coordinating the rules of protection of trademarks protected beyond the principle of specialty.

The work consists of an introduction, six chapters and conclusions. Chapter 1. is an introduction to the the given problem – it provides a general overview of a trademark by, among others, determining and analyzing its functions – both fundamental as well as supplementary, and describing the origin and evolution of legal protection of trademarks. Chapters 2. and 3. present the conclusions from the analysis of crucial terms under the extended protection regime of a famous or a reputable trademark: the concept of extended protection of a trademark protected beyond the principle of specialty and the subject matter of extended protection, i.e. the standard of fame and reputation of a trademark. Chapters 4. and 5. provide an analysis of the trademark special protection regime, first – the reputable trademark in the European Union and then – the famous trademark in the United States. This is followed by a review of the prerequisites for infringement of a trademark protected beyond the principle of specialty, the normative characteristics of the conflicting use of such a mark, and the circumstances excluding trademark infringement, to establish and describe in detail the forms of infringement of the famous and reputable trademark. Chapter 6 constitutes the final part of the conducted research by way of a comparative analysis. The conclusion provides a synthetic summary to clearly address the research questions and verify the hypotheses.