

Poland

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1. Legal framework

National

The legal protection of trademarks is regulated by the Industrial Property Law, which came into force on August 22 2001. The law was subsequently amended in order to harmonize it with EU directives and the regulations on the Community trademark.

International

Poland has been a party to the Paris Convention for the Protection of Industrial Property since November 10 1919. The first trademark registration was granted on April 11 1924.

Poland has also ratified the following international treaties:

- the Madrid Agreement (Indications of Source) and the Hague Act 1925, since December 10 1928;
- the Madrid Agreement (International Registration), since March 18 1991;
- the Madrid Protocol, since March 4 1997;
- the Nice Agreement on the International Classification of Goods and Services, since March 4 1997;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks, since March 4 1997; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights, since January 1 2000.

On May 1 2004 Poland became a member of the European Union. Since accession, all Community trademarks applied for or registered before that date have been extended to Poland.

Today, anyone seeking trademark protection in Poland has three options:

- File a national application with the Polish Patent Office (PPO);

- File an international application designating Poland with the World Intellectual Property Organization; or
- File a Community trademark application with the Office for Harmonization in the Internal Market.

Trademarks registered by the PPO are valid only in the territory of Poland.

2. Unregistered marks

Protection

The Industrial Property Law provides for the protection of unregistered marks that are recognized as well known, have acquired a reputation or are used locally in a limited manner.

Polish law does not define what is meant by a 'well-known mark'. According to the doctrine and its interpretation, a well-known mark should be used in most of the country and should be associated by Polish consumers with a specific product. It need only be known; a favourable impression of the quality of the goods is not required. In contrast, when dealing with a famous trademark the number of people that can identify the mark on the market is inconsequential; of greater importance is the superior quality associated with the mark.

The owner of an unregistered well-known trademark may demand the cessation of use of an identical or similar trademark in respect of identical or similar goods, if such use is likely to mislead the public as to the origin of the goods.

The Industrial Property Law also protects the rights of prior users. Anyone who, in running a small-scale commercial enterprise, has used in good faith a mark which is subsequently registered as a trademark by another party will

be entitled to continue using that mark free of charge, to the same extent as before. The prior user may request that its rights be recorded in the Trademark Register.

The owner of an unregistered mark which is not well known and has not acquired a reputation, but which has been used in good faith on the Polish market, may also enforce its rights on the basis of the Unfair Competition Law (Articles 3 and 10). In order to benefit from such protection, the mark must be used as a trademark for commercial gain and cannot infringe the rights of third parties. In the case of a conflict between users of identical or similar unregistered marks for identical or similar goods or services, the user that was first to launch its product on the market will enjoy the rights to the mark.

Use requirements

The degree of use required to establish rights to an unregistered mark depends on the type of mark involved.

To establish rights to a well-known trademark, the owner must have used the mark for commercial gain to such extent that the mark is recognized by a significant number of the potential distributors of the trademarked goods, or their customers.

A mark that has acquired a reputation need not be used to the same extent as a well-known trademark, but it must have a genuine use on the Polish market.

To establish a right of prior use, the mark should be used in one region only – for example, in one town or district. In addition, the number of potential customers must be limited.

To establish rights to unregistered marks protected by unfair competition law, all uses are significant.

3. Registered marks

Ownership

Under Polish law, any natural or legal person, irrespective of nationality or residence, can apply for and own a mark. However, there are restrictions on the types of entities that can own collective marks and guarantee marks. The general rule is that a trademark can be applied for and owned by one person (except in situations where several entrepreneurs apply for joint registration). Collective and guarantee trademarks may be applied for and owned by organizations only.

Scope of protection

A trademark may consist of any sign that is capable of being represented graphically and of distinguishing the goods or service of one undertaking from those of others. Such signs include words, designs, ornaments, combinations of colours, shapes – including shapes of goods or their packaging – melodies and other sound signals.

Polish law does not distinguish clearly between absolute and relative grounds for refusal. Nevertheless, some distinctions can be made.

The following constitute absolute grounds for refusal:

- marks that cannot constitute a trademark;
- marks that are devoid of any distinctive character – that is, which:
 - are not capable of distinguishing in trade the goods for which registration is sought;
 - consist exclusively of elements that may serve in trade to designate the kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function or usefulness of the goods; or
 - have become customary in the current language, and/or are used in genuine and established business practices;

- marks whose use infringes the moral or economic rights of third parties;
- marks whose use is contrary to law, public order or morality;
- marks whose use may mislead the public, in particular as to the nature, quality or characteristics of the goods;
- marks for which registration has been sought in bad faith;
- marks that incorporate:
 - the name or abbreviated name of the Republic of Poland, or its symbols (emblem, national colours or national anthem);
 - the names or armorial bearings of Polish regions, towns or communities;
 - the insignia of the armed forces, paramilitary organizations or police;
 - reproductions of Polish decorations, honorary distinctions or medals, military medals or military insignia; or
 - other official or generally used distinctions and medals, in particular those of governmental administrations, communes or non-governmental organizations performing public-interest activities, where these activities extend to the entire territory of the state or a substantial part thereof, unless the applicant can produce evidence of its right to use the trademark in the course of trade, in particular in the form of an authorization issued by a competent state agency or permission given by an organization;
- marks that incorporate the abbreviated names or symbols (armorial bearings, flags or emblems) of other countries or international organizations, as well as official signs and marks indicating control and warranty adopted in other countries, if the prohibition against registration derives from an international agreement, unless the applicant can produce a form of authorization issued by a competent authority which allows it to use the mark in the course of trade;
- marks that incorporate officially recognized signs accepted for use in trade, such as safety marks, quality marks and hallmarks, to such extent as could mislead the public as to the nature of those signs, unless the applicant can prove its right to use them;
- marks that incorporate religious, patriotic or cultural symbols, to the extent that these could offend religious sensibilities, patriotism or national tradition;
- marks comprised exclusively of the shape or another feature of the goods or their packaging which is dictated exclusively by the nature of the goods or packaging, is necessary to achieve a technical result or gives substantial value to the goods; and
- marks identifying wines and spirits that incorporate geographical elements which are discordant with the true origin of the goods, and may thus be considered to mislead the public.

The following constitute relative grounds for refusal:

- marks that are identical or similar to a registered geographical indication, where registration is sought for identical or similar goods or services, unless the applicant is entitled to use that indication and the trademark registration is not intended excessively to restrain other entitled parties from using the registered geographical indication;
- marks that are identical or similar to an earlier trademark, where registration is sought for identical or similar goods or services, if the earlier trademark was well known and used as another's trademark before the priority date of the registration; and
- marks that are similar to an earlier trademark for which protection has been revoked, where registration is sought for identical or similar goods and services, as long as no more than two years have elapsed since the earlier trademark was revoked.

In addition, a trademark will not be registered if:

- it is identical to a trademark registered – or pending registration with an earlier priority date (provided it is subsequently registered) – on behalf of another person for identical goods or services;
- it is identical or similar to a trademark registered – or pending registration with an earlier priority date (provided it is subsequently registered) – on behalf of another person for identical or similar goods or services, if use of the mark is likely to mislead the public, in particular by evoking associations between the marks concerned; or
- it is identical or similar to a famous or well-known trademark registered – or pending registration with an earlier priority date (provided it is subsequently registered) – on behalf of another person for any goods or services, if use of the mark would unfairly advantage the applicant or damage the distinctive character or reputation of the earlier trademark.

4. Procedures

Examination

As at the filing date, each trademark application must include the following information:

- a request for registration of the mark, indicating the applicant and defining the trademark;
- a representation of the mark; and
- a list of the goods and/or services for which registration is sought (indicating the Nice classes).

The following information is also required, but may be provided at a later date:

- power of attorney;
- application fees;
- regulations on the use of a collective or guarantee mark;

- priority document (a declaration may be required in some cases); and
- appropriate authorization, if the mark incorporates flags, emblems, safety signs or the like.

The proceedings begin with an examination of the application to ensure it satisfies the formal requirements. The PPO will then check that the list of goods and services is correct, and examine the application for absolute and relative grounds for refusal. Should the PPO identify any obstacles to registration, it will ask the applicant to comment on them within one month (for Polish nationals) or two months (for foreign applicants), before issuing a decision on the matter. If the applicant fails to respond to the PPO, the registration proceedings will be terminated.

Under Polish law, a foreign trademark applicant must be represented before the PPO by a Polish patent attorney. National applicants can act either personally or through a Polish patent attorney.

The PPO will publish a trademark application in the *Official Gazette* within three months of receipt. For a six-month period thereafter, anyone may submit a written observation explaining why the trademark should not be registered. By submitting observations, that person does not become party to the proceedings and is not kept informed of their progress.

The examination stage lasts on average between 36 and 42 months.

Registration

If the examination procedure reveals no obstacles to registration, the PPO will issue a decision to register the trademark, on condition that the applicant pays the publication fee and the fee for the first 10-year protection period. The applicant has three months to pay the official fees.

Once the official fees have been paid, the decision will be published in the *Official Gazette* and the PPO will issue a certificate of protection.

Opposition

Within six months of publication of the decision to register a trademark, anyone can file an opposition to registration based on the same grounds on which a trademark can be invalidated. The PPO must immediately notify the trademark owner of the opposition and invite it to respond within a specified period. If the trademark owner claims that the opposition is unjustified, the case will be submitted for examination in litigation proceedings. Otherwise, the PPO will reverse its decision to register the trademark and terminate the proceedings.

Cancellation

A trademark may be invalidated, in whole or in part, at the request of anyone with a legitimate interest in the mark, as long as that person can prove that the legal requirements for registration have not been satisfied.

However, a request for invalidation is inadmissible in the following circumstances:

- if it is brought on the grounds that the registered mark conflicts with an earlier trademark or infringes the moral or economic rights of the requesting party, where the requesting party has tolerated the use of the registered trademark for a period of five successive years while being aware of such use;
- if five years have elapsed since registration, where the trademark was not distinctive at the time of registration, if it has since acquired a distinctive character through use; or
- if it is brought on the grounds that the registered mark conflicts with a well-known trademark, where the owner of the well-known trademark has tolerated the use of the registered trademark for a

period of five successive years while being aware of such use.

These exceptions do not apply if the trademark application was filed in bad faith.

Revocation

The rights of a trademark owner will be revoked:

- upon the expiry of the term of protection for which the trademark has been registered; or
- upon surrender of the right by the trademark owner before the Patent Office, with the consent of all parties that enjoy rights in relation to the trademark.

At the request of any party with a legitimate interest, the rights of a trademark owner will also be declared revoked:

- if the trademark has not been put to genuine use, in connection with the goods or services for which it is registered, within five years of registration, without legitimate reason;
- if, as a result of the trademark owner's actions or negligence, the trademark has lost its distinctive character and is now comprised exclusively of elements that may serve to indicate, in the course of trade, the kind, quality, quantity, price, composition, intended purpose or usability of the goods for which it is registered, or the method, time or place of their manufacture; or
- if, as a result of the owner's actions or those of an authorized third party, the trademark might mislead the public, in particular as to the nature, quality, characteristics or origin of the goods.

5. Enforcement

Complexity

The remedies available under Polish law to protect the owners of registered and unregistered rights include civil, penal and border measures.

Civil measures: Unregistered rights are generally enforced in Poland on the basis of the Unfair Competition Law. In specific cases, unregistered rights may also be enforced on the basis of the Copyright Law or the Civil Code. Registered rights are enforced through the Industrial Property Law. The procedure will be governed by the Civil Procedure Act, regardless of the basis of the lawsuit.

According to Article 730 of the Civil Procedure Act, the court can issue a preliminary injunction before or during the enforcement process. Any party to the process can request a preliminary injunction, provided it can prove the probability of its claims. The request is treated urgently and must be dealt with within a week of filing (Article 737 of the Civil Procedure Act). If the preliminary injunction is issued before the enforcement process begins, the court will indicate the timeframe within which the lawsuit must be filed (Article 733 of the Civil Procedure Act). The grant of a preliminary injunction may be made conditional on the applicant's posting of security.

Under the Industrial Property Law and the Unfair Competition Law, a right holder may request:

- cessation of the infringement;
- elimination of the results of the infringement, including the infringing materials;
- transfer of unlawfully obtained profits;
- compensation for damages;
- publication of a statement acknowledging the infringement; and
- in case of intentional infringement, payment of an adequate sum to a non-governmental organization.

The burden of proving the basis and amount of damages rests with the trademark owner, which may claim for both the loss suffered and the profit lost.

Penal measures: Both the Industrial Property Law and the Unfair Competition Law provide penal sanctions for the infringement of registered and unregistered rights. According to Article 305 of the Industrial Property Law, counterfeiting is punishable by up to five years' imprisonment.

Border measures: Since July 1 2004 customs actions in the IP field have been predominantly governed by EU Council Regulation 1383/2003 on customs action against goods suspected of infringing certain IP rights and the measures to be taken against goods found to have infringed such rights. According to this regulation, Customs will take action at the request of the right holder.

Timeframe

On average, it takes about 18 months from filing of the lawsuit to the first instance civil court decision. However, the timeframe varies significantly depending on the court's location. In general, lawsuits in Warsaw take much longer than those outside the capital.

6. Ownership changes – legalization requirements

There are no legalization requirements in proceedings before the PPO. The trademark attorney can certify all relevant documentation himself.

Poland has finally joined the Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents, which will come into force on August 14 2005. From this date, legalization (where required) will be replaced with certification by apostille. This simplified procedure applies in all jurisdictions that are party to the convention, including the EU member states, the United States and Russia.

7. Areas of overlap with related rights

In Poland, there are two significant regulations, apart from the Industrial Property Law, that have a degree of overlap with trademark rights. The first is the Copyright Law and the second the Unfair Competition Law.

Copyright Law: Trademarks and protected designs (known as ‘industrial designs’ in Poland) can both qualify for copyright protection. A trademark will be protected under the Copyright Law only if it constitutes a ‘work’ within the meaning of the law – that is, if it has artistic merit. Such trademarks enjoy double protection, and both criminal and civil litigation can be based on the Copyright Law, the Industrial Property Law or both.

Unfair Competition Law: This law ensures a level playing field for entrepreneurs by identifying various prohibited acts of unfair competition. These include certain acts that relate to trademark use, such as the following:

- misleading designation of an enterprise;
- false or fraudulent designation of goods or services with geographical indications or regional names;
- misleading designation of products or services; and
- imitation of products.

As with the Copyright Law, the Unfair Competition Law can be applied independently of or together with the Industrial Property Law. The pros and cons of both laws are outlined below.

Unfair Competition Law:

- Advantages – wider scope of protection.
- Disadvantages – harder to prove infringement.

Industrial Property Law:

- Advantages – relatively easy to prove infringement of rights, as the trademark

owner holds a registration certificate and its rights are entered in the Trademark Register. Law’s provisions are more clearly defined than those of the Unfair Competition Law.

- Disadvantages – protection restricted to registered trademarks (and to some extent, trademark applications).

8. Online issues

Trademark owners can use their marks on the Internet. Online use may be considered ‘use’ within the meaning of the Industrial Property Law if it is connected with the trademarked goods or services. Such use also covers online advertising. Trademarks can also be freely used by their owners in the form of domain names.

The unauthorized use of trademarks on the Internet (eg, in metatags) may constitute trademark infringement, which can be the subject of civil or even criminal proceedings. This also applies in the case of unregistered marks, which are protected under the Unfair Competition Law.

Disputes over the unauthorized registration of domain names comprised of or including trademarks are handled by the Arbitration Court.

Thus far, the PPO has refused to register domain names as trademarks. However, Polish trademark specialists have pointed out that this would not contravene any provision of the Industrial Property Law and should thus be accepted by the PPO.