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IP&Law – Kancelaria Rzeczników Patentowych J Markieta,
M Zielińska-Łazarowicz Sp p



Authors

Małgorzata Zielińska-Łazarowicz and
Joanna Piłka

1. Legal framework

The Industrial Property Law 2000 (as amended) governs trademarks in Poland. In addition, since May 1 2004 the EU Community Trademark Regulation (207/2009) has been in force in Poland.

Poland is bound by the following international conventions and treaties:

- the Paris Convention for the Protection of Industrial Property;
- the Madrid Agreement Concerning the International Registration of Marks and its Protocol;
- the Nice Agreement Concerning the International Classification of Goods and

Services for the Purposes of the Registration of Marks;

- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- the Singapore Treaty on the Law of Trademarks.

2. Unregistered marks

There are two types of protection for unregistered marks in Poland: protection as a well-known trademark under Article 6*bis* of the Paris Convention and protection as an unregistered mark under the Unfair Competition Law 1993. According to the Unfair Competition Law, in some circumstances the holder of an unregistered trademark can

prevent third parties from using later marks on the market provided that the earlier unregistered trademark was used in the course of trade. No strict rules define the use of an unregistered mark for the purpose of obtaining protection under the Unfair Competition Law, but some guidance is set out by case law. The duration of use is not as important as the requirement that the sign be used as a trademark (ie, in the course of trade for the goods or services for which protection is sought). A sufficient level of distinctiveness is also required for the unregistered mark.

Well-known marks enjoy stronger protection under the Industrial Property Law. The scope of protection granted to well-known trademarks is similar to that for registered trademarks.

3. Registered marks

Ownership

Any natural or legal person can apply for and own a trademark registration.

Under some circumstances, a collective trademark registration may be granted to a group of natural or legal persons. The registration of a collective or guarantee mark is also admissible. Along with the trademark application, applicants for collective rights or marks are obliged to file a set of rules defining use of the trademarks.

A trademark application can be filed by the applicant itself or its representative. Foreign applicants must be represented by a Polish patent attorney and a power of attorney is required. It is also necessary to submit documents proving that the person who signed the power of attorney is duly authorised to represent the applicant. The power of attorney and documents supporting the authorisation can be filed later, but it is advisable to file them at the same time as the trademark application.

Protection

To be protected as a trademark, a sign must be capable of being represented graphically and of distinguishing the goods of one undertaking from those of others. In particular, the following signs may be considered as

trademarks: words, designs, ornaments, combinations of colours, three-dimensional shapes of goods or packaging, melodies or other acoustic signals. In addition, service marks can be protected.

Absolute grounds for refusal

Trademark protection will not be granted for a sign which:

- is not considered a trademark;
- is devoid of distinctive character;
- consists exclusively or mainly of elements which designate the kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function or usefulness of the goods; or
- has become customary in the current language and is used in business practice.

These grounds for refusal can be overcome by proving that the applied mark acquired distinctiveness through use.

Trademark registration will be also refused for a sign that:

- constitutes a form or feature of the goods or their packaging, is dictated exclusively by their nature, is necessary to achieve a technical result or gives substantial value to the goods;
- is contrary to law, public order or morality;
- may mislead the public as to the nature, properties or geographical origin of the goods;
- incorporates without authorisation names, flags or symbols of Poland, other countries and international organisations;
- incorporates symbols of a religious, patriotic or cultural nature; or
- contains geographical indications for wines and spirits from other areas.

Relative grounds for refusal

Registration can also be refused for a trademark:

- applied for in bad faith;
- whose use infringes third parties' personal or economic rights;
- that conflicts with an earlier registered or well-known trademark; or
- that conflicts with other earlier rights (eg, copyrights, geographical indications, company names and industrial designs).

According to Polish law, both absolute and relative grounds for refusal are examined *ex officio*.

4. Procedures

Examination procedure

A trademark application is published in the *Patent Office Bulletin* three months after the filing date. Following publication, third parties may submit observations as to the grounds for refusal of the trademark application. A party filing observations does not become a party to the proceedings.

A trademark application is subject to examination by the Patent Office on both formal and substantive grounds. If obstacles to protection are found, the Patent Office will request the applicant to remedy any deficiencies within a fixed time limit. During the pending proceedings the applicant is allowed to modify the lists of goods and services for which protection is sought.

If the Patent Office finds that the statutory requirements for registration of a trademark have not been met, the registration is refused. A request for re-examination of the case can be filed, and that decision can be appealed to the administrative courts.

Registration

If the statutory requirements for registration are met, a decision on registration is granted and lasts for 10 years. Failure to pay the relevant fee makes the registration void.

Opposition

Any party can oppose a decision on registration within six months of the publication date of the registration. The grounds for opposition are the same as those for invalidation. If the rights holder finds the opposition to be unjustified, the case is transferred to litigation proceedings. If the opposition is upheld, the registration is removed.

Removal from register

The trademark registration lapses on the expiry of the protection period for which it was granted if no extension request is submitted and the due renewal fee is paid. The extension is also possible within six months of

the expiry and on payment of additional fee.

A trademark registration can be also surrendered by its owner for all or part of the goods for which it was granted.

Revocation

A trademark registration can be revoked on the following grounds:

- Non-use – the trademark was not used for five consecutive years;
- Loss of distinctiveness – due to the actions or negligence of the trademark holder, the mark has become a customary mark in the trade for the goods for which it is registered; and
- Improper/misleading use – due to the actions of the trademark holder, the mark is likely to mislead the public as to the nature, quality, characteristic features or origin of the goods.

In proceedings for revocation for non-use, the burden of proof that the trademark has been used or that serious reasons for non-use exist rests with the mark owner. The Patent Office will dismiss the request for revocation of a trademark registration due to non-use if genuine use started or resumed before submission of the request.

Invalidation

A trademark registration may be invalidated in whole or in part at the request of any person or entity with a legal interest therein. The requesting party must prove that the statutory requirements for the grant of protection have not been met.

An invalidation request will be rejected if:

- the party requesting invalidation on the basis of its earlier rights was aware of and tolerated the use of the conflicting trademark for five successive years; this limitation shall not apply to a trademark registered in bad faith;
- five years after registration, the registered trademark has acquired distinctiveness through use; or
- the owner of the well-known trademark requesting invalidation was aware of and tolerated the use of the conflicting trademark for five successive years.

Opposition, revocation and invalidation

proceedings are carried out by the Litigation Division of the Patent Office. Such decisions can be appealed directly to the administrative courts.

Searches

The Polish Patent Office conduct no searches on behalf of third parties.

5. Enforcement

The law provides for both civil and criminal actions for infringement of a trademark. Civil actions follow the same procedural rules for registered and unregistered rights. Following implementation of the EU IP Enforcement Directive (2004/48/EC), the scope of claims available to mark owners has been significantly limited. Mark owners have been deprived of the right to demand redress for the consequences of the infringement and publication of a relevant statement in the press. Such demands are still available under the Unfair Competition Law.

Infringement

Any person whose trademark rights have been infringed (ie, the holder of a registered or unregistered mark or the exclusive licensee of a registered trademark entered into the Trademark Register) may initiate a civil action against an alleged infringer.

According to the Industrial Property Law, infringement of a registered trademark consists of unlawful use in the course of trade of:

- a trademark that is identical to a registered trademark in respect of identical goods;
- a trademark that is identical or similar to a registered trademark in respect of identical or similar goods if it is likely that the public will be misled, including in particular if a risk of association between the trademarks exists; or
- a trademark that is identical or similar to a renowned trademark registered for any kind of goods, if such use would give the user an unfair advantage or be detrimental to the distinctive character or repute of the earlier trademark.

The holder of a registered trademark cannot prohibit a third party from using a

mark identical or similar to its own mark if it has failed to use the mark in the five years following registration.

Civil proceedings

In general, trademark infringement matters are handled by common civil courts and judges without specific IP knowledge. The only specialised trademark court in Poland is that appointed in accordance with EU Regulation 207/2009 to deal with Community trademark cases.

The first instance courts are district courts, and their decisions may be appealed to the Court of Appeal. The Court of Appeal's decisions may be appealed to the Supreme Court.

On May 3 2012 amendments were introduced to the Code of Civil Proceedings which affect trademark cases. The separate proceedings provided for disputes between entrepreneurs have been cancelled. Some new restrictions have been implemented into the general rules governing proceedings in order to allow the court to gain additional knowledge of cases before setting a hearing and, as a result, to accelerate the proceedings. The court can now request parties to file additional explanations in writing, and can hear parties in closed sessions, if necessary. The parties must provide any evidence at the earliest possible opportunity – for the plaintiff, that is when bringing an action with the court; while for the defendant, that is in its response. Later filed evidence may not be considered by the court, although this is at the judge's discretion. Generally, the parties cannot submit any new explanations or documents, apart from a single request for evidence, unless explicitly ordered by the court. Documents or explanations submitted without the court's request will be dismissed.

Remedies

A trademark holder whose rights have been infringed may demand:

- cessation of the infringing activities;
- surrender of the unlawfully obtained profits; or
- compensation for damages (in case of wilful infringement).

Damages may be compensated in accordance with general principles of law or by payment of a

sum of money corresponding to the licence fee or other reasonable remuneration.

At the request of the mark owner, the court can also order publication of the judgment. Further, the court may order disposal of the unlawfully manufactured or marked products and the means used in their manufacture or marking. The court may order their removal from the market or assign them to the rights holder instead of damages. Alternatively, it may order destruction of the illegal goods.

Where the infringement was committed unintentionally, the court may, at the infringer's request, order it to pay the mark owner an adequate amount of money if cessation of the infringement or destruction of the goods would be excessively severe for the infringer and the payment of money satisfies the mark owner's interests.

No punitive damages are available for trademark infringement.

Interim injunction

A request for an interim injunction may be filed before initiating court proceedings, together with a lawsuit or in the course of court proceedings. If the request is filed before bringing a lawsuit, the court – upon granting the injunction – will set a deadline of no more than two weeks for the initiation of a lawsuit against the infringer. If the deadline is not met, the interim injunction will lapse. An interim injunction request before initiating infringement proceedings is heard in *ex parte* proceedings.

In order to obtain an interim injunction, the mark owner must prove its legal interest and justify the grounds for injunction by proving the infringed rights and the factual and legal circumstances of the infringement. The evidence threshold for interim injunction proceedings is lower than that in main proceedings. The mark owner must also indicate the demand to be protected by interim injunction and the method of injunction (eg, seizure of goods by the court bailiff or a ban on sales).

An interim injunction is granted for the duration of the main proceedings and lapses no later than one month after the main proceedings end. If the plaintiff loses the lawsuit or withdraws the action before the

court verdict is given, the alleged infringer can demand compensation for the damages it has suffered due to the injunction.

Requests for disclosure of information and to secure evidence are allowed and, in practice, are used in cases involving financial claims.

Timeframe

It usually takes six to 12 months from bringing a lawsuit until the first hearing in an infringement case, although cases before the Community Trademark Court are heard more quickly. The duration of enforcement proceedings depends on the complexity of the case, the parties' strategies, the evidence requested and the court's workload. It takes between 18 months and two years to obtain a first instance decision. The recent amendment to the Code of Civil Proceedings is expected to improve and accelerate proceedings.

Criminal proceedings

In Poland, criminal actions are undertaken against counterfeiting activities. According to the Industrial Property Law, a counterfeit trademark is any trademark that is identical to or indistinguishable in the course of regular trade from a registered trademark, and which is unlawfully used for the goods covered by the trademark registration. Anyone that marks goods with a counterfeit trademark or a registered trademark without authorisation for the purpose of putting them on the market is liable to a fine, the limitation of freedom or two years' imprisonment. In order to initiate an investigation, the mark owner must submit a motion. After filing a motion, the proceeding is continued *ex officio*. For aggravated crimes the perpetrator is subject to more severe penalties (imprisonment of between six months and five years) and the proceedings may be initiated *ex officio* (no motion for investigation is required).

Legislative proposals are underway to remove these types of trademark crime from the Industrial Property Law.

Border seizures

In Poland, border protection is an effective legal tool against trademark infringement and counterfeiting. Under EU Regulation 1383/2003, a mark owner may ask Customs to seize goods that are suspected of trademark

infringement. The seizure is notified to the trademark holder and the owner of the seized goods. Within 10 working days of the seizure (extendible for the next 10 working days), the mark owner must undertake necessary action against the alleged infringer, whether civil or criminal. If no action is undertaken in that time and consent for destruction is not given, the goods are released.

6. Ownership changes and right transfers

A trademark registration or pending application may be assigned or subject to succession. The assignment agreement is valid only if it is in writing. All changes must be entered in the Trademark Register in order to be effective against third parties. Once assigned, the rights of the assignor and the assignee are independent.

Special rules relate to the transfer of collective marks.

The holder of a registered trademark may authorise another party to use the trademark under a licence agreement. The licence agreement is valid only if it is in writing. A licensee may grant a sub-licence only with the mark owner's consent; the grant of further sub-licences is not permitted. Although registration of a licence agreement is not obligatory, the exclusive licensee recorded in the register may, to the same extent as the mark owner, enforce its claims in the event of infringement, unless the licence contract stipulates otherwise.

7. Related rights

Registered trademarks can enjoy cumulative protection based on the Unfair Competition Law. An 'act of unfair competition' is defined as an act against the law or good custom if it threatens or infringes the interests of another company or customer. This regulation is often used by mark owners to support claims against taking unlawful advantage of the reputation of or goodwill in a company's mark. Further, a specified act of unfair competition is the marking of goods or services, or the lack of such marking, which may mislead customers

as to the origin, quality or other essential features of the goods or services, as well as concealing a risk of using the goods or services.

Shape marks, product packaging and device marks (eg, logos) are also often registered as designs or enjoy copyright protection.

8. Online issues

Registration of a domain name creates no exclusive right to a domain name and is not decisive when assessing who is entitled to the domain name. Generally, sole use of a domain name does not constitute trademark use; there must be another link to the content or purpose of the website or the activity of the domain name owner in order to recognise the registration of a domain name as trademark infringement or an act of unfair competition.

The Polish national domain registry is maintained by the Research and Academic Computer Network (NASK). In order to register a domain name, the applicant must accept the dispute settlement procedure included in the NASK Domain Name Regulations. According to the regulations, '.pl' domain name disputes are resolved by the arbitration or civil courts. Two arbitration courts are responsible for resolving domain names disputes: the Arbitration Court at the Polish Chambers of Information Technology and Telecommunication and the Arbitration Court at the Polish Chamber of Commerce. The World Intellectual Property Organisation Arbitration and Mediation Centre resolves domain name disputes in which both parties are non-Polish residents. A legally valid decision of the arbitration or civil court stating that the domain name owner has infringed trademark rights constitutes grounds for termination of the domain name agreement by NASK and registration of the domain name for the trademark owner.

Poland has no specific regulations regarding the unauthorised use of trademarks online. Mark owners usually seek protection under the Unfair Competition Law. Under Article 3, particular acts of unfair competition cover the infringement of trademark rights through the Internet.

Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?	Examination for relative grounds for refusal based on earlier rights?	Non-traditional marks registrable?
 / 		 3-D, colours, packaging, sounds
Unregistered rights		Opposition
Protection for unregistered rights?	Specific/increased protection for well-known marks?	Opposition procedure available? Term from publication?
		6 months 
Removal from register		
Can a registration be removed for non-use? Term and start date?	Are proceedings available to remove a mark that has become generic?	Are proceedings available to remove a mark that was incorrectly registered?
5 consecutive years' non-use 		
Enforcement		
Specialist IP/trademark court?	Punitive damages available?	Interim injunctions available? Time limit?
Community Trademarks Court only 		
Ownership changes	Online issues	
Mandatory registration for assignment/licensing documents?	National anti-cybersquatting provisions?	National alternative dispute resolution policy for local ccTLD available?
 / 		

IP&Law – Kancelaria Rzeczników Patentowych J Markieta, M Zielińska-Łazarowicz Sp p

ul Wańkowicza 5A lok 23

02-796 Warsaw, Poland

Tel +48 22 254 25 35

Fax +48 22 254 25 34

Web www.ipandlaw.com



**Małgorzata Zielińska-
Łazarowicz**

Patent and trademark attorney

malgorzata.lazarowicz@ipandlaw.com

Małgorzata Zielińska-Łazarowicz is a lawyer, registered trademark and patent attorney and professional representative before the Office for Harmonisation in the Internal Market (OHIM). She obtained her law degree from the University of Warsaw and completed further postgraduate studies in IP rights and European law there. Ms Zielińska-Łazarowicz specialises in IP-related enforcement and litigation, including designs, trademarks and unfair competition law. She represents clients before the IP authorities and courts, advises on IP issues, prepares legal opinions and licence agreements. She is a member of the International Trademark Association (INTA) and the International Association for the Protection of Intellectual Property.



Joanna Piłka

Patent and trademark attorney

joanna.pilka@ipandlaw.com

Joanna Piłka is a registered trademark and patent attorney, as well as a professional representative before OHIM. She obtained her MEcon from the Łazarski University, Warsaw and completed further postgraduate studies in IT and IP rights. Ms Piłka focuses her practice on prosecution and litigation in relation to trademarks, designs, inventions and utility models. She specialises in cases related to industrial designs, including the registration and protection of designs in Poland and the European Union. She is a member of the INTA.