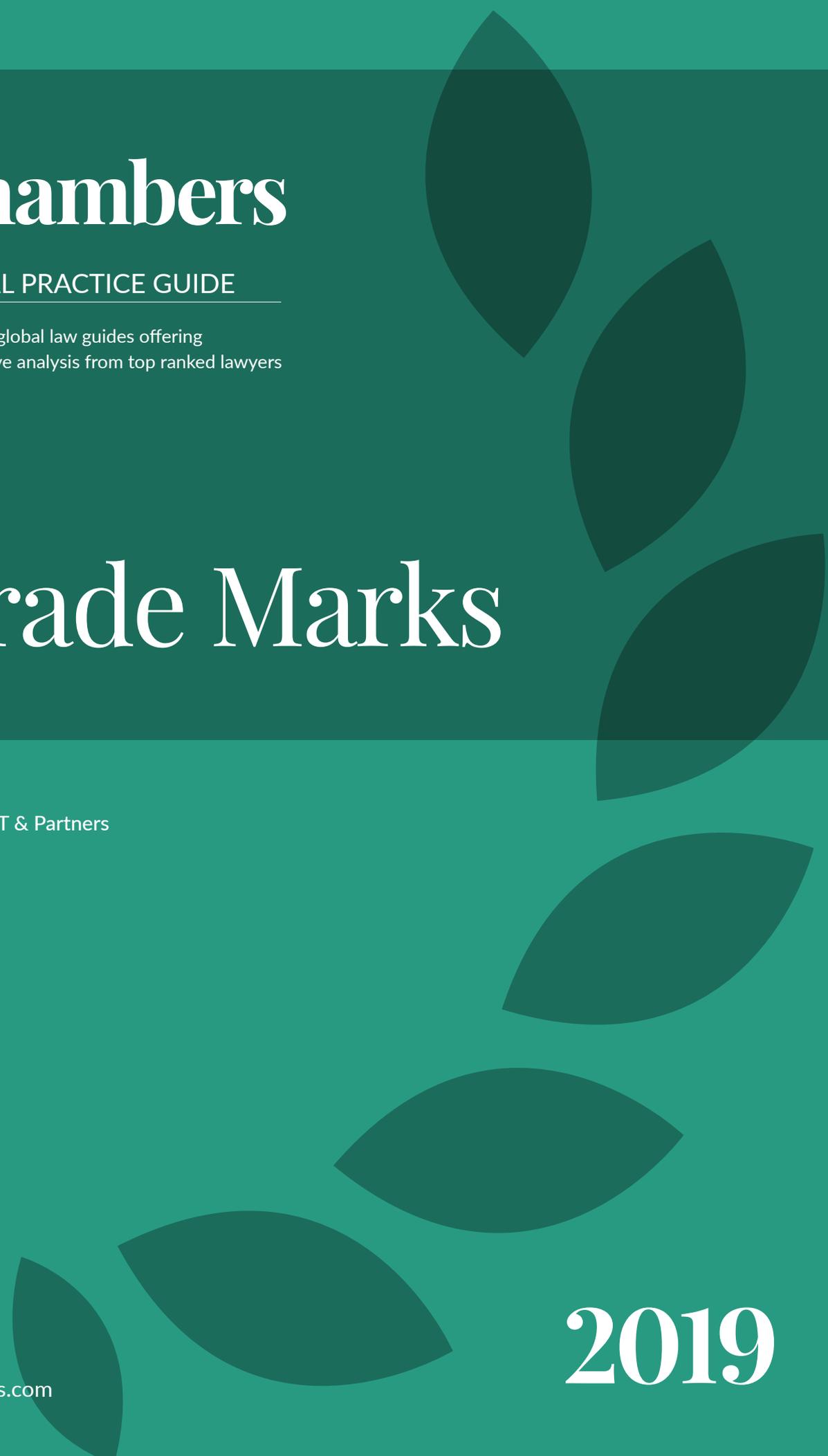


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The cover features several large, dark green leaf-like shapes scattered across the background, creating a natural, organic feel. The leaves vary in size and orientation, with some pointing upwards and others downwards.

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# Trade Marks

Poland  
KONDRAT & Partners

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# 2019

## Law and Practice

Contributed by KONDRAT & Partners

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**Kondrat & Partners** is one of the most dynamic law offices in Poland, and a leader in the areas of intellectual property, pharmaceutical law and life sciences. The team is made up of more than 50 attorneys-at-law, advocates, patent attorneys and doctors of biotechnology and chemistry. It advises global and Polish companies on regulatory matters,

and represents clients in court disputes and administrative procedures before the Polish Patent Office, WIPO, EPO and EUIPO. Clients hail from different industry sectors, mainly pharmaceutical, cosmetic, food, IT, telecommunication, fashion and media.

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## 1. Types of Trade Marks & Registration

### 1.1 Types of Trade Marks

In the Polish legal system, a trade mark may be any sign capable of being represented graphically if it is able to distinguish the goods or services of one undertaking from those of another. The Polish legal system differentiates between different types of trade marks: registered trade marks, collective trade marks and unregistered trade marks. The rights incorporated in such trade marks are based on statutory law, rather than case law.

### 1.2 Requirement for Registration of Trade Mark Rights

In the Polish legal system, trade mark rights can be acquired only by way of registration, not by the use of a mark. By prior use of a mark, the owner acquires a right protected under the unfair competition act.

### 1.3 Standards for Registration

In the Polish legal system there are no different standards for the registration of different types of marks, due to the fact that the provisions of the Polish Industrial Property Act define only one procedure for the registration of a trade mark.

In relation to a particular type of trade mark, the procedure may differ in certain details, such as the necessity to provide certain documents (approval of the relevant competent body in relation to certain marks, pictorial representations of figu-

rative or graphic trade marks, etc). For trade marks like those involving only a single colour or a combination of colours, it is necessary to prove acquired distinctiveness.

### 1.4 Trade Mark Register

The Polish Patent Office (PPO) is the trade mark office of Poland and is responsible for the registration and administration of trade marks in Poland. The PPO keeps a register of trade marks and a database, which is publicly available through the official website: <http://regservtd.uprp.pl/register/advancedSearch?lng=de>

### 1.5 Types of Registers

The Polish legal system has only one type of trade marks register, which is kept by the PPO. It includes various search tools, like 'quick search', 'structured search' and 'advanced search'.

### 1.6 Prior Trade Marks

When filing for a new trade mark registration, it is best to conduct a search on a website for any similar or identical prior trade marks. Since there is no official database of unregistered trade marks, conducting such a search is much more difficult than in the case of registered trade marks.

Due to the fact that Poland is also a Member State of the European Union and a member of the Madrid System, which is governed by the World Intellectual Property Organization (WIPO), a search for any similar or identical trade marks in

the WIPO and European Union Intellectual Property Office (EUIPO) databases is also recommended.

### 1.7 Registration Requirements

In order to file an application for the registration of a trade mark, the Applicant must submit the following documents/materials:

- an application form (available for download through the PPO website);
- a copy of a photograph or print of the mark if it has a graphic representation or partially consists of one);
- two copies of a data carrier containing an audio recording of a sound if the trade mark consists of sounds;
- proof of payment of the application fee; and
- Power of Attorney with the proof of payment of the stamp duty on power of attorney.

In addition to the above, for certain applications the following documents are also required:

- proof of priority or the Applicant's statement of the basis of the claim of the priority;
- a regulation for usage of a sign in the event that it is a joint ownership of a collective trade mark; and
- a confirmation of the right to use a special sign, listed in the provisions of the Polish Industrial Property Act, such as Polish national symbols (colours, anthem, emblem), signs of the armed forces, abbreviations or symbols (armorial bearings, flags, emblems) of foreign states or international organisations.

### 1.8 Ability to Register a Trade Mark

In accordance with the provisions of the Polish Industrial Property Act, an application may be submitted to the PPO by an individual, a corporation or other organisation.

Due to the provisions of the Polish legal system, a trade mark is an asset of its owner, and therefore each entity capable of being an owner can register a trade mark, unless specific provisions stipulate otherwise.

### 1.9 Registration of Signs

The Polish Industrial Property Act does not have an exhaustive list of signs that can be protected as a trade mark. Such marking must be able to be represented graphically if it is able to differentiate the goods or services of one undertaking from those of another.

The most common types of trade mark signs are verbal (word, sentence), graphics (drawings, ornaments) and figurative (combinations of word and figurative elements).

There are also other forms of trade marks that can be applied for, such as spatial (including the shape of goods or pack-

aging), sound (melodies, other tones), or a combination of types (eg, verbal and graphic-spatial).

### 1.10 Other Rights to Signs

As well as trade marks, the Polish legal system also recognises other rights to signs and source-identifiers, such as company names, trade names or domain names.

These rights arise out of the long-term use and promotion of the signs in Poland. Such rights are mainly stipulated by the provisions of the Polish Unfair Competition Act and the Polish Civil Code, due to the fact that such rights constitute the personal rights of their owner.

### 1.11 Registration Procedure of a Trade Mark

The registration procedure starts with the submission of an application for the registration of a trade mark for goods and services according to the Nice Classification list, in respect of which the submitting party applies for registration, pays the application fee and submits the required attachments.

If the application meets all formal requirements and is not rejected by the PPO, it is disclosed in the PPO database within two months of the date of notification.

If the application is not rejected and meets the absolute grounds of refusal, it is then published in the Bulletin of the Patent Office.

Third parties are allowed to submit oppositions to the application for a period of three months, commencing with the publication of the trade mark in the Bulletin of the Patent Office.

If there are no oppositions to the application within the three-month period, the PPO issues a decision granting or refusing the right to protection.

### 1.12 Use of the Applied for Mark in Commerce

The Polish Industrial Property Act does not require an Applicant to prove prior usage of the trade mark in commerce before the registration.

### 1.13 Registration of Series Marks

The Polish Industrial Property Act does not provide the possibility for an Applicant to register a series of marks in one application; each application must be proceeded separately.

If the Applicant manages to register at least three trade marks sharing the same feature or features, such trade marks constitute a family/series of trade marks.

### 1.14 Length of Registration Process

Depending on the level of complexity of the trade mark, the process of applying for registration may last from six months to one year, or even longer in certain situations.

Professional representation is not required in the procedure before the PPO if the applicant is a citizen or resident, or has registered premises in a member state of the European Union, or another country that is party to the Agreement on the European Economic Area or the Swiss Confederation. Such an Applicant may act in his own name and on his own behalf. Other Applicants have to act through a professional representative.

The official fee for an application for the registration of a trade mark (regardless of its type) for goods and services that are classified in a single class of goods according to the current Nice Classification is PLN45,000. If the application for a registration is submitted in electronic form for goods and services that are classified according to the current Nice Classification in a single class of goods, the fee is PLN40,000.

Apart from the stamp duty for the power of attorney (PLN1,700), attorney fees are subject to agreement with the client, although they are usually in the region of PLN80,000 to PLN90,000 (for a single word mark in one class).

### 1.15 Refusal of the Registration of a Trade Mark

In accordance with the provisions of the Polish Industrial Property Act, protection is not granted for a marking that:

- cannot be a trade mark;
- is not, in the course of trade, able to distinguish the goods for which it is used;
- solely consists of elements that could, in the course of trade, serve to indicate in particular the type of goods, their origin, quality, quantity, value, purpose, production process, composition, function or suitability;
- solely consists of elements that have become common in the current language or in the bona fide and established practices of the trade;
- constitutes the form of a good which is only linked to its nature and which is necessary to obtain a technical result or to significantly increase the value of the good;
- an application is filed for in bad faith;
- is contrary to public policy or good practice;
- contains elements that are symbols, especially of a religious, patriotic or cultural nature, the use of which could offend religious or patriotic feelings or national traditions;
- contains a symbol of the Republic of Poland (emblem, colours or anthem), a symbol of the armed forces, a paramilitary organisation or law enforcement authority, a reproduction of a Polish order, medal or honorary distinction, military insignia or badge or other official or commonly used medal and distinction, particularly of a government or local government administrative authority or social organisation acting in vital public interests, where this organisation operates throughout the country or a significant part thereof, if the Applicant is unable to produce an authorisation, particularly a competent state

or local government administrative authority permit or an organisation's consent, to use such marking in the course of trade;

- contains a symbol (armorial bearings, flag, emblem) of a foreign state, the name, abbreviated name or symbol (armorial bearings, flag or emblem) of an international organisation or an official sign or hallmark indicating control and warranty adopted in a foreign state if prohibited under international agreements, unless the Applicant can produce a competent authority permit entitling him to use such marking in the course of trade;
- contains an officially recognised marking adopted for use in the course of trade, particularly a safety mark, quality mark or verification mark, where it may mislead the public as to the nature of such marking if the Applicant cannot demonstrate that he is entitled to use it;
- by its nature, may mislead the public, particularly as to the nature, properties or geographical origin of a good; or
- is the protected designation of a plant variety and refers to the plant variety itself or a closely related species.

### 1.16 Process for Overcoming Objections

Once a decision is issued by the PPO stating that the refusal of the trade mark applied for is based on absolute grounds and therefore cannot be registered, the Applicant can request a re-examination of the case by the PPO, and subsequently appeal to the Administrative Court in Warsaw (pol. *Wojewódzki Sąd Administracyjny*). In either case, the general basis for an appeal would be to submit the proof of the circumstances demonstrating the lack of basis for the oppositions raised by the PPO.

In addition to the above, absolute grounds are examined in each registration proceeding by the PPO ex officio, and consequently the trade mark cannot be registered. In order to overcome the opposition, it is necessary for the Applicant to prove the absence of absolute grounds for refusal.

### 1.17 Existence of Prior Rights

According to the Polish Industrial Property Act, the priority to obtain a right of protection for a trade mark is determined by the submission date of an application for the registration of a trade mark in the PPO.

Apart from this rule, due to the provisions of international agreements to which Poland is a signatory, it is possible for priority to be claimed from an earlier application filed in an Industrial Property Office other than the PPO. This is subject to the condition that another application will be filed with the PPO within six months of the date of the first proper application. In this case, the declaration issued by the PPO will use the date of the first application as the date of priority. The same conditions apply to priority claimed through the international or officially recognised exhibition of the trade mark.

### 1.18 Third-party Rights

The Polish Industrial Property Act stipulates that third parties have the right to participate in trade mark registration proceedings. A third party may join the proceedings either through filing an opposition to the registration or by submitting observations.

The right to file an opposition is limited to entities entitled to an earlier trade mark or the proprietors of earlier personal or property rights.

As for the submission of observations with respect to the registration, a third party to the proceedings may indicate the possible absolute grounds for the rejection of the trade mark registration, pursuant to the provisions of the Polish Industrial Property Act.

### 1.19 Revocation, Change, Amendment or Correction of an Application

According to the Polish Industrial Property Act, until the final decision is issued by PPO, the Applicant may revoke, change or modify the application.

In order to revoke an application, the Applicant must submit a motion to the PPO.

Changes, corrections and modifications of an application for the registration of a trade mark cannot result in changes in the essence of the trade mark, nor extend the list of goods and services provided.

### 1.20 Assigning an Application or Granting a Licence

The Polish legal system allows for the assignment or granting of a licence in relation to a trade mark during the registration process. Information on each change or assignment of such a trade mark must be submitted to the PPO.

The provisions of the Polish Industrial Property Act do not require the Applicant to inform the PPO of such circumstances, and do not stipulate any particular regulations regarding either applications based on use or applications based on an intent to use.

### 1.21 Remedies Against the Trade Mark Office

If a mark is refused for registration by the PPO, the remedy is to file for a re-examination of the refusal with the PPO within two months of the Applicant receiving the PPO decision on refusal.

If the application for a re-examination meets all formal requirements and the official fee has been paid, the PPO issues a final decision, which either upholds the decision or waives it in part or in full, depending on the scope of appeal indicated by the Applicant.

The Applicant may appeal to the Administrative Court in Warsaw against the final decision of the PPO within 30 days of receiving the decision. The appeal has to be submitted through the PPO first, which may at this stage grant the appeal in favour of the appellant in full. If the PPO does not grant the appeal, it is heard before the Administrative Court, which issues a judgment in the matter. The Polish legal system allows for a cassation appeal to the Supreme Administrative Court (pol. *Naczelny Sąd Administracyjny*) against the judgment of the Administrative Court.

### 1.22 Use in Commerce Prior to Registration

The Polish legal system does not have any requirement for the Applicant to use the trade mark in commerce before the issue of an application for a registration.

Provisions regarding the genuine use of a trade mark in the Polish Industrial Property Act concern the procedure for the revocation of a trade mark.

### 1.23 Dividing a Trade Mark

Pursuant to the provisions of the Polish legal system, it is possible to divide a trade mark application. In order to perform such division, an application should be submitted to the PPO by the co-owners, indicating the change of the trade mark to a collective trade mark and enclosing a declaration on the use of the collective trade mark by the co-owners, granting each of them the right to use the trade mark in relation to particular goods and services.

A change in the registration in this particular situation requires the Applicants to pay an additional fee in the amount of 100% of the registration fee.

### 1.24 Term of Protection

The term of protection of a trade mark in the Polish legal system is ten years from the date of submitting the application for a registration, and can be renewed. The decision on protection or renewal of protection is issued by the PPO and, in order to be valid, an official fee has to be paid in the amount indicated in that decision.

An Applicant has to pay the official fee for the first period of protection within three months of receiving the PPO decision. The amount of the official fee is based on the amount of classes in respect of which the trade mark has been registered.

For renewal, the Applicant has to file an application for an extension of protection and pay the official fee. The application shall be submitted before the end of the protection period, but not earlier than one year before its end.

The application for prolongation of a protection can be also submitted within six months of the end of the above-mentioned term. In this case, the Applicant must also pay

an extra fee, in addition to the regular official fee for the prolongation of protection.

### 1.25 Requirements for an Exhaustion

In the Polish legal system, trade mark protection does not extend to activities concerning goods with a mark involving in particular the offering for sale or further placing on the market of goods bearing this mark if the goods were previously placed on the market in Poland by or with the consent of the holder.

In addition to the above, protection is not infringed by import and other aforementioned activities concerning goods bearing this trade mark if the goods were previously placed on the market in the European Economic Area by or with the consent of the holder.

This rule does not apply if there are legitimate reasons that allow the holder to object to the further distribution of the goods. Such a legitimate reason may be derived from a change in the condition of the goods or the impairment of the goods after they had been put on the market.

### 1.26 The Madrid System

Poland has participated in the Madrid System since 18 March 1991.

If an Applicant wishes to register an international trade mark, the trade mark shall be applied for/registered in the competent office in the country of origin. In Poland, international registration must be preceded by application/registration in the PPO.

An application for an international trade mark registration must be submitted to the office of the World Intellectual Property Organization in Geneva through the PPO.

An application for registration can be filed by an individual, a business organisation or any other organised entity that is Polish, has registered premises in Poland or is a Polish resident. An application can be filed if the trade mark was previously applied for/registered in Poland by the Applicant or its legal predecessor.

An Applicant may act in his own name and on his own behalf, or through a professional representative.

### 1.27 Provision of Incorrect Information

Providing incorrect information in connection with a trade mark application may constitute absolute grounds for refusal of registration. In common with other filings, providing incorrect information may result in the rejection of an application. Decisions on this matter are issued by the PPO.

If incorrect information is provided by the Applicant during the registration procedure, according to the provisions

of the Polish legal system, it is possible to make changes and corrections to the application. These changes and corrections cannot affect the essence of the trade mark, and cannot extend the list of goods and services in respect of which the trade mark has been applied for.

### 1.28 Updating or Refreshing a Design Mark

The Polish legal system does not recognise a design mark as a distinct type of trade mark. Therefore, there are no applicable provisions regarding updating or refreshing design marks.

### 1.29 Symbols to Denote Registration

Usually, owners of trade marks in the Polish legal system use the ® symbol to denote the registration of a trade mark.

## 2. Assignment and Licensing

### 2.1 Assignment Requirements or Restrictions

In order to assign the trade mark to another entity, it is necessary to submit a request to the PPO to make the relevant entry in the register.

It is also necessary to enclose a written document justifying the change (the original or copy notarised or authenticated by a professional representative).

### 2.2 Procedure for Assigning a Trade Mark

In the Polish legal system, a trade mark is a tradeable and hereditary asset of its owner. In order to assign a trade mark to a new owner, pursuant to the provisions of the Polish Industrial Property Act, a proper document (sale agreement, donation) must be prepared in writing. This may be an independent act, or it can be part of a more complex agreement.

The agreement on the assignment of a trade mark can be concluded between any types of entities that are able to register a trade mark in the PPO.

To make an entry on the register to make it effective against third parties, the new owner has to file an application to the PPO. For this application to be valid, it is necessary to enclose a written document justifying the change in writing (in the original or an authenticated copy notarised by a notary or authenticated by a professional representative).

If the application meets the formal requirements provided by the Polish Industrial Property Act, the PPO issues a decision on the matter of assigning the trade mark to the new owner.

### 2.3 Registration or Recording of the Assignment

In order to be effective with respect to third parties, the assignment of the trade mark to a new owner must be entered on the register. If such an assignment is not entered on the register, the new owner cannot execute his rights to the trade mark. For example, until an entry indicating the

change of ownership is made, the new owner cannot seek damages related to any infringement of the trade mark.

## 2.4 Trade Marks & Security

In the Polish legal system, a trade mark is a fully tradeable and hereditary asset of its owner. It can be assigned by way of security, subjected to rights in rem, levied in execution, subjected to a pledge, etc.

## 2.5 Licensing Requirements or Restrictions

A trade mark owner may grant another person authorisation to use a mark by concluding a licence contract. A licence agreement must be concluded in writing. If the licence agreement does not indicate otherwise, the licensee may use the trade mark within the scope of the owner's rights.

Information on concluded licence agreements relating to a trade mark is not entered in the register.

The licensee may grant a sub-licence to use a trade mark within the scope of the authorisation granted to him. It is also possible for the licensee to indicate that he is using a trade mark licence by placing the marking 'lic.' next to the trade mark, and he may be obliged to do so on the owner's request.

The licence can be open or limited, exclusive or non-exclusive.

## 2.6 Procedure for Licensing a Trade Mark

No particular procedure is required in order to grant a licence and make it valid or effective against others. The Polish Industrial Property Act does not stipulate any particular obligations of the owner or the licensee in relation to the fact of concluding the licence agreement.

It is possible, and recommended for practical reasons, to enter information indicating the licensee into the register. Such a procedure requires filing an application and enclosing a written document justifying the change in writing (in the original or an authenticated copy notarised by a notary or authenticated by a professional representative). Such an entry makes the licensee's rights effective against third parties.

## 2.7 Registering or Recording a Licence

The Polish Industrial Property Act does not stipulate any particular obligations of the owner or the licensee in relation to the fact of concluding the licence agreement.

Although the Polish Industrial Property Act does not require the licensee to enter his rights into the register, it is recommended to do so, for practical reasons. In any potential actions taken in order to protect the trade mark against infringement performed by the licensee without an entry in the register, it would be necessary to refer to the basis

of his rights and indicate the scope of the granted licence. Such an entry makes the licensee's rights effective against third parties.

## 2.8 Obstacles to the Granting of a Perpetual Licence

The duration of licence agreements is subject to the will of the owner and the licensee incorporated in the licence agreement. A licence expires – at the latest – upon the moment of expiry of the industrial property rights to the trade mark, and the owner, pursuant to the provisions of the Polish Industrial Property Act, is not limited in granting a perpetual licence to the trade mark.

## 2.9 Other Requirements for a Licence or Assignment to be Valid

The Polish Industrial Property Act does not stipulate any particular additional requirements that would have to be met in order to make an assignment or licence to the trade mark valid.

# 3. Opposition Procedure

## 3.1 Legal Grounds and Timeframes for Filing an Opposition

An opposition to the registration of a trade mark can be submitted within three months of the publication of the application for registration in the PPO Bulletin, and this term cannot be extended.

The legal grounds for an opposition to the registration of a trade mark application, subject to the provisions of the Polish Industrial Property Act, are as follows:

- if usage of the trade mark infringes the personal or property rights of a third party;
- if the contested trade mark is identical to a prior trade mark, or one for which registration has been applied with earlier priority for the identical goods or services;
- if the contested trade mark is identical or similar to a trade mark or one for which registration has been applied with earlier priority for identical or similar goods, if it may lead to a risk of confusion, which in particular includes the likelihood of association with the earlier trade mark;
- if the contested trade mark is either identical or similar to a registered, reputable trade mark, or one for which registration has been applied with earlier priority by another person for any goods, if it could bring the Applicant an unfair advantage or be detrimental to the distinctive character or the repute of the earlier mark; and
- if the contested trade mark is either identical or similar to a trade mark that has been well known and used in Poland before the date according to which priority is determined and was used as a trade mark for identical or

similar goods and services of another entity, if this may lead to a risk of confusion, which in particular includes the likelihood of association with the earlier well-known trade mark.

### 3.2 Ability to File an Opposition

An opposition to a registration can be filed by any entity entitled to an earlier trade mark or the proprietor of earlier personal or property rights.

An opposition can be filed in the opposing party's own name and on its own behalf, as well as by its professional representative.

The costs of opposition proceedings are as follows:

- opposition fee: PLN600.00;
- stamp duty on the power of attorney for the professional representation: PLN17.00; and
- reimbursable expenses of the procedure, depending on the level of complexity of each case – eg, costs of expert opinions, cost of certified translations of documents, etc.

### 3.3 Opposition Procedure

The Polish Industrial Property Act stipulates that any opposition to the registration of a trade mark must be submitted within three months of the publication of an application for a registration in the Patent Office Bulletin. The opposition must be in writing. The PPO examines the opposition within limits of its authority and upon the indicated legal basis.

The opposition has to comply with formal criteria arising from the provisions of the Polish Industrial Property Act, and must include the designation of the parties (the Applicant and the Objecting Party), an indication as to the scope of the opposition, and a factual and legal justification of the opposition, with a copy for the Applicant.

The Applicant is then promptly notified of the opposition, and a copy of the opposition is delivered to the Applicant. The PPO reminds the parties of the possibility of an amicable settlement of the dispute. If the parties choose to agree an amicable settlement, they have a period of two months from the date of delivery of the information from the PPO; this term may be extended to six months. After the term for an amicable settlement of the dispute expires, the Applicant is invited to submit his observations together with supporting evidence.

During the opposition procedure, the Applicant is entitled to request the opponent to provide proof of the prior use of his earlier trade marks.

In the course of opposition proceedings, the PPO obliges the parties to take specific actions in terms of not less than:

- one month if the party is domiciled or is a resident in the Republic of Poland; or
- two months if the party is domiciled or established abroad.

The above-mentioned terms can be extended, but by no more than three months.

After presentation of observations by the parties, the PPO issues a decision in which it rejects the opposition or upholds the opposition in full or in part. A party may submit an application for a reconsideration of this decision by the PPO. If the decision is upheld, a party may appeal to the Administrative Court within 30 days of receiving the final decision of the PPO regarding the opposition proceedings.

### 3.4 Legal Remedies Against the Decision of the Trade Mark Office

A party dissatisfied with the decision of the PPO in the opposition proceedings is entitled to submit a request for re-examination with the PPO within two months of receiving the PPO decision.

If the application for a re-examination meets all formal requirements and the official fee has been paid, the PPO issues a final decision in which it either upholds the decision or waives it in part or in full, depending on the indicated scope of the application.

The Applicant may appeal to the Administrative Court in Warsaw against the final decision of the PPO within 30 days of receiving the decision. The appeal must be submitted through the PPO first, which may at this stage grant the appeal in favour of the appellant in full. If the PPO does not grant the appeal, it is then heard before the Administrative Court, which issues a judgment in the matter. The Polish legal system allows for a cassation appeal to the Supreme Administrative Court against the judgment of the Administrative Court.

In order to estimate the likely timescale for the above-mentioned procedure, an application for re-examination of the decision of the PPO is usually resolved within three to four months. Provided the case is straightforward, the Administrative Court issues a judgment in the matter within four to six months. A cassation appeal to the Supreme Administrative Court usually receives a judgment within one year.

## 4. Initiating a Lawsuit

### 4.1 Actions Available to Pursue Infringement

In accordance with the provisions of the Polish Industrial Property Act, anyone whose trade mark protection is infringed or anyone who is entitled to initiate legal actions under the law may do so in a common court seeking civ-

il claims against a perpetrator (for example: to cease the infringement, to surrender any benefits unlawfully obtained and, in the event of culpable infringement, to redress any damage caused in accordance with general principles or by paying a sum of money corresponding to the licence fee, and to seek claims provided by the provisions of the Unfair Competition Act, etc).

If the infringement is a criminal offence pursuant to the applicable regulations, the injured party may initiate proceedings before the common court by filing a complaint. Once the complaint is filed, proceedings are conducted *ex officio*.

In order to pursue infringement, it is also possible to file an application for a revocation of a trade mark in full or in part. The procedure in this case is conducted by the PPO.

The scope of protection and possible actions taken by the owner in respect of the infringement of a trade mark that is registered is different than for an unregistered one. In the event of an infringement of the latter trade mark, the owner is entitled to pursue claims provided only by the provisions of the Unfair Competition Act. An exception to this rule is in the case of trade marks that have been well known and used in Poland, which are also protected by the provisions of the Polish Industrial Property Act.

## 4.2 Courts/Tribunals in Which Infringement Proceedings Can be Initiated

Proceedings relating to trade mark infringements can be initiated before common courts.

Subject to the nature of the infringement, proceedings conducted before common courts can be based on either civil or criminal law.

## 4.3 Effect of Decisions by Trade Mark Office on Infringement Actions

Decisions issued by the PPO create certain situations regarding trade marks, and this situation has to be taken into consideration when stating facts of the case during the proceedings before the court in a civil procedure. The final and valid decision cannot be overruled during a civil procedure.

It is also worth noting that, if a civil procedure is conducted at the same time as a procedure before the PPO and the resolution of the civil case can be subject to a PPO decision, the court may suspend the procedure until a decision is issued by the PPO.

## 4.4 Declaratory Judgment Proceedings

In the Polish legal system, the alleged infringer may issue a claim to the court initiating judgment proceedings, the subject of which would be to assert or declare proprietary

rights to the trade mark. This would involve suing the party that claims to be entitled to the trade mark.

When filing a claim to the court, an alleged infringer would have to submit proof of his rights that would allow a declaratory judgment to be issued by the court.

## 4.5 Courts with Jurisdiction to Hear Trade Mark Matters

Trade mark matters are subject to proceedings before the following courts in two stages:

- in the first instance, before the Regional Court (pol. *Sąd Okręgowy*); and
- in the second instance, before the Court of Appeal (pol. *Sąd Apelacyjny*).

It is also possible to file a cassation appeal to the Supreme Court (pol. *Sąd Najwyższy*) against the judgment of the Administrative Court in a trade mark case.

## 4.6 Prerequisites to Filing a Lawsuit

In the Polish legal system, it is necessary for the statement of claim to meet formal requirements and to include, *inter alia*, information as to whether the parties have attempted mediation or applied other alternative dispute resolution methods or, if no such attempt has been made, the reasons for failing to do so.

There is no particular form in which such an attempt should be made. In practice, the most common form of such prerequisites are cease-and-desist letters.

The Polish Industrial Property Act does not stipulate any particular provisions in relation to a registered trade mark; in this matter, the general provisions of the Polish civil procedure apply.

## 4.7 Legal Representation for Parties to Trade Mark Litigation

In the Polish legal system, parties can act in their own name and on their own behalf (individuals, business organisations and other entities), as well as through a professional representative.

However, certain activities can only be performed by professional representatives. For instance, an appeal against a judgment of the Regional Court to the Court of Appeal in criminal cases must be signed by a professional representative, as must a cassation complaint against this verdict to the Supreme Court (in civil and criminal cases), or to the Supreme Administrative Court.

It noteworthy that, in matters regarding trade marks in administrative courts, a cassation complaint can also be signed by a trade mark attorney.

### 4.8 Interim or Preliminary Injunctions

The Polish legal system provides that interim/preliminary injunctions are available in relation to certain claims – namely, security of injunction. In order to obtain such an injunction, the submitting party has to indicate the circumstances justifying such a measure and the legal interest in having the security or injunction granted.

A legal interest in having a security or injunction granted exists where the absence of a security or injunction would prevent or significantly hinder the enforcement of a judgment issued in the case. An injunction would also be granted by the court if the absence of such an injunction would prevent or significantly hinder the achievement of the objective of proceedings in the case.

### 4.9 Protection for Potential Defendants

A potential defendant may protect itself using a trade secret defence - the court, in admitting evidence or considering the applications concerning securing evidence or claims, ensures the confidentiality of the entrepreneur and other secrets protected by law.

Furthermore, in justified cases, the court may make the issuance of a decision on securing evidence dependent on the payment of a deposit.

Furthermore, pursuant to the provisions of the Civil Procedure Code, the court may make the enforcement of an order granting security or injunction conditional on the obligee's payment of a deposit to secure the obligor's claims arising from the enforcement of the order granting a security or injunction. The obligor's claims shall be satisfied from such a deposit prior to the payment of any other amounts due, but after the payment of enforcement costs.

### 4.10 Obtaining Information and Evidence

Pursuant to the provisions of the Industrial Property Act, a trade mark owner may file a request for securing evidence, which can be effective if there is a concern that its examination will become unfeasible or too difficult, or if for other reasons it is necessary to state the existing state of affairs. The application should identify the Applicant and the Opponent as well as other interested persons, if known, as well as an indication of facts and evidence, and a justification of the need for securing evidence. Evidence may be secured without the intervention of the opponent only in urgent cases, or if the opponent cannot be contacted or where the place of stay is unknown. As a rule, the court summons the interested parties for a time limit set for the taking of evidence but, in urgent cases, the taking of evidence can commence even before delivery of the summons to the opponent.

However, it is impossible to obtain relevant information from a third party due to a Constitutional Tribunal ruling, which declared that the right to information against non-

infringing parties is incompatible with the freedom to conduct a business as guaranteed under the Polish Constitution.

### 4.11 Initial Pleading Standards

Polish procedural law does not have any special provisions governing lawsuits in trade mark proceedings that differ from general civil proceedings.

According to the general rules of civil procedure, each party is allowed to file one brief (statement of claim/statement of defence) which should, in principle, contain all arguments and evidence (including requests to produce evidence that is confidential to that party – eg, documents derived from a third party). Any additional pleadings with supplementary arguments (apart from the statement of claims and response to the statement) may only be submitted with the court's explicit permission. New evidence is allowed only when it would not be reasonable or necessary to request it in the statement for claim/statement of defence, or if it will not delay the proceedings.

Theoretically, the defendant in a trade mark action may initiate a lawsuit in response under the Unfair Competition Act, claiming that he had an earlier right to the sign at issue.

### 4.12 Representative or Collective Actions

The Polish legal system does not provide for any possibility of representative or collective actions for intellectual property rights proceedings. Class actions are permitted in Poland only for claims for liability for damage caused by a dangerous product, for torts, liability for non-performance or improper performance of a contractual obligation or for unjust enrichment, and in relation to claims for consumer protection in other matters.

### 4.13 Restrictions on Assertion of Rights by Trade Mark Owners

Restrictions on the trade mark owner asserting its right against others include limitations on protection, that the trade mark is not used, or if there is conflict with the identification of an enterprise or the rights of the earlier user.

With respect to limitations on protection, trade mark protection does not give the holder the right to prohibit use of the following by other persons, in the course of trade, if these persons' rights to such use is based on other provisions of the Industrial Property Act:

- their addresses and names or the names or other markings identifying a given entrepreneur or his enterprise;
- markings showing in particular the features and characteristics of the goods, their type, quantity, quality, purpose, origin, production date or shelf life;
- a registered or similar marking where it is necessary to indicate the purpose of a good, in particular with respect to offering spare parts, accessories or services; or

- a registered geographical indication.

With respect to the restriction of a trade mark that is not used, a trade mark holder may not prohibit another person from using this or a similar sign in the course of trade if the holder has refrained from genuine use of this trade mark for the goods and services covered by protection rights for an uninterrupted period of five years after the date of the decision granting protection rights, unless there are valid reasons for not using it.

With respect to the restriction due to a conflict with the identification of an enterprise, a trade mark holder may not prohibit a third party from using the name under which the third party conducts business if this name is not used as a marking for the goods being the object of this business and there is no risk of the public being misled as to the origin of the goods, particularly in terms of a different business profile or local range of use of this name.

The other restriction is related to an earlier user – anyone who has used, in good faith, a sign subsequently registered to another person as a trade mark, when conducting a small local business, is still entitled to use this sign free of charge to an extent not greater than previously.

## 5. Infringement

### 5.1 Parties to an Action for Infringement

The necessary parties in the event of an action for infringement are the owner of the trade mark and the defendant. Claims relating to an infringement may be pursued in conjunction with claims stemming from other legal grounds, such as an act of unfair competition if the owner conducts the business activities concerning the infringed rights within the territory of Poland and is a competitor of the alleged infringer.

The Polish Industrial Property Act provides for a third party to file an action for infringement only if it is entitled to an exclusive licence, disclosed in the trade mark register maintained by the Polish Patent Office, and provided that the licence agreement does not exclude such an action. In such an event, the exclusive licensee must prove his or her standing to sue by submitting an excerpt from the register; there is no obligation to disclose the exclusive licence agreement during the infringement proceedings.

Before the registration of a trade mark, a trade mark owner can take action to stop infringement only under the Unfair Competition Act. An act of unfair competition shall be such designation of goods or services, or absence thereof, which might mislead customers as to their origin, quantity, quality, components, production methods, usefulness, repair, maintenance or other important features of the goods or services, or conceal risks connected with their use. In such a case, the

owner will have to prove that he introduced the trade mark in question to the market earlier than the alleged infringer.

### 5.2 Factors in Determining Infringement

In determining whether the use of a sign constitutes trade mark infringement, the main factors are the degree of similarity between the signs and the goods and services in question, and the likelihood of confusion with the other trade mark. However, in the case of well-known trade marks, more weight is put on the risk of association than on the likelihood of confusion between two trade marks, since the former is less demanding to prove. The degree of distinctiveness does not have that much importance in determining whether the use of a sign constitutes trade mark infringement except for well-known trade marks, where the more distinctive the sign, the higher the likelihood of confusion between the signs.

### 5.3 Requirement to Establish Use of a Sign as Trade Mark by Defendant

It is necessary to establish that the defendant has used the sign as a trade mark. This derives from the provisions of the Industrial Property Act, which states that trade mark protection does not give the holder the right to prohibit use by other persons, in the course of trade, of their addresses and names or the names or other markings identifying a given entrepreneur or his enterprise; markings showing, in particular, the features and characteristics of the goods, their type, quantity, quality, purpose, origin, production date or shelf life; or a registered or similar marking where it is necessary to indicate the purpose of a good, in particular as regards offering spare parts, accessories or services.

### 5.4 Defences Against Infringement

This type of defence may be used with respect to priority if the earlier rights protect an earlier registered trade mark. When the earlier trade mark is not registered, the priority defence will derive from the Unfair Competition Act.

An application for the revocation of a trade mark due to the genuine non-use of a registered trade mark for protected goods for an uninterrupted term of five years after the date a decision is issued to grant protection may be filed as a defence, unless there are good reasons for non-use.

Moreover, an application for the invalidation of the trade mark under its failure to comply with one of the absolute grounds – ie, bad faith – may be filed as a defence.

Furthermore, an article concerning the exhaustion of protection may be invoked as a defence – trade mark protection does not extend to activities concerning goods with a mark involving in particular the offering for sale or further placing on the market of goods bearing this mark if the goods were previously placed on the market in the Republic of Poland by the holder or with his consent. Neither is trade mark pro-

tection infringed by import and other activities mentioned above concerning goods bearing this trade mark if the goods were previously placed on the market in the European Economic Area by the holder or with his consent.

With respect to a defence relating to the limitations on protection, trade mark protection does not give the holder the right to prohibit use by other persons, in the course of trade, of the following:

- their addresses and names or the names or other markings identifying a given entrepreneur or his enterprise;
- markings showing in particular the features and characteristics of the goods, their type, quantity, quality, purpose, origin, production date or shelf life;
- a registered or similar marking where it is necessary to indicate the purpose of a good, in particular as regards offering spare parts, accessories or services; or
- a registered geographical indication if these persons' rights to use it are based on other provisions of the Industrial Property Act.

What is more, anyone who has used a sign subsequently registered as a trade mark to another person, in good faith when conducting a small local business, is still entitled to use this marking free of charge to an extent not greater than previously.

In the event of infringement proceedings, Polish law does not provide for any institutions of defence like parody, own-name defence, forfeiture, or equitable estoppel.

### 5.5 Role of Experts and/or Surveys

Experts and surveys are sources of evidence. As a main principle of procedural law, experts are appointed when special information is required. Therefore, an expert shall be appointed at any time when the court seeks particular information related to the case in question.

### 5.6 Trade Mark Infringement as an Administrative or Criminal Offence

According to the Industrial Property Act, trade mark infringement may constitute a civil tort or a criminal offence.

As a civil tort, infringement of trade mark protection consists of the unlawful use of the following in the course of trade:

- any sign that is identical to a registered trade mark in relation to goods that are identical to those for which the trade mark is registered;
- any sign that is identical or similar to a registered trade mark in relation to goods that are identical or similar, if there is a likelihood of confusion on the part of the public – the likelihood of confusion includes the likelihood of

association between the sign and the registered trade mark; and

- a sign that is identical or similar to a reputable trade mark registered for goods of any type where use of such sign without due cause brings the user unfair advantage or is detrimental to the distinctive character or repute of the earlier mark.

With respect to a criminal offence, anyone who marks counterfeit goods with a trade mark or a registered trade mark, for the purpose of placing said goods on the market, while not being entitled to use or distribute goods bearing such marks, will be subject to a fine, restriction of freedom or imprisonment for up to two years. In less serious cases, the perpetrator of an offence specified in the previous sentence will be subject to a fine.

### 5.7 Customs Seizures of Counterfeits or Criminal Imports

Polish custom bodies act in compliance with Regulation (EU) No 608/2013 on the customs enforcement of intellectual property rights, which provides revised procedural rules for customs authorities to enforce intellectual property rights (IPR) on goods liable to customs supervision or customs control.

Under this regulation, after fulfilling certain requirements, the seized goods may be destroyed under the control of the customs authorities without there being any need to determine whether an intellectual property right has been infringed under the law of the Member State where the goods are found. When the conditions specified in the text are fulfilled, the destruction may be implemented without the intervention of a judge.

## 6. Revocation/Cancellation

### 6.1 Remedies and Reasons for Revocation/Cancellation

A trade mark may be cancelled only in proceedings before the Polish Patent Office. The Polish Industrial Property Act provides for invalidity and revocation proceedings. Trade mark protection may be invalidated on request in full or in part, if the conditions required to obtain protection are not met for the reasons referred to in the Polish Industrial Property Act or if there is an earlier right.

The protection rights for a trade mark expire as the result of the expiry of the period for which they were granted or as a result of a waiver by the right holder before the Patent Office and with the consent of all persons entitled by law.

## 6.2 Role of the Trade Mark Office and Civil Courts

As stated above, a trade mark may be cancelled by a revocation or invalidation procedure only before the Polish Patent Office.

## 6.3 Statutory Limitation or Time Period for Filing Actions

The deadline established for revocation actions is five years. An application for the invalidation of a trade mark cannot be filed due to a collision with an earlier sign or violation of the personal or property rights of the Applicant if, for a period of five consecutive years of the use of the registered mark, the Applicant, being aware of its use, did not object to this, or, due to a collision with a well-known trade mark, if for a period of five consecutive years of using a registered trade mark, those authorised to use said well-known trademark, being aware of its use, did not object to this.

## 6.4 Parties Able to Initiate Revocation/Cancellation Proceedings

If a cancellation is based on the existence of an earlier right, then the entity who has a right to apply may apply for revocation. It is noteworthy that the Industrial Property Act only provides for the possibility of an application for a cancellation by an entitled person with rights such as personal or property rights, an earlier protection right for an identical trade mark registered for identical goods or an earlier trade mark identical or similar to one registered for identical or similar goods, where there is a risk of misleading the public, which includes, in particular, the risk of associating the mark applied for with the earlier mark, the protection rights to a renowned mark and the right to a well-known mark. In addition, an entity that has not yet obtained protection rights but that has applied for registration with an earlier priority will also be able to file an application for the invalidation of a trade mark.

An application for the revocation of a trade mark may be submitted to the Patent Office by any third party.

An application for invalidation or revocation of a trade mark may also be submitted by the Prosecutor General of the Republic of Poland and the President of the Patent Office, who have the right to participate in the proceedings if they consider it in the public interest to do so.

## 6.5 Partial Revocation/Cancellation

According to the provisions of the Industrial Property Act, the waiver of protection may relate to only some of the goods for which protection was granted (restriction of the list of goods). Similarly, it is regulated in other provisions of the Industrial Property Act that, if the reason for trade mark protection being revoked relates to only some of the goods, protection is revoked only for these goods.

## 6.6 Amendment in Revocation/Cancellation Proceedings

If an amendment is understood as an amendment of the list of goods and services for which protection is granted, the trade mark owner may revoke the trade mark at any time in full or in part. A revocation of some of the goods and services is, in fact, a limitation (or amendment, as it is in the issue in question) of the list of goods and services. In such cases, the owner may voluntarily revoke some of the goods or services for which he has obtained protection, thus avoiding participating in dispute proceedings regarding the invalidation of the protection rights to his trade mark. The owner then submits the appropriate application to the Polish Patent Office and the Office then issues a decision stating the revocation of the rights for the relevant part of the goods.

If an owner files an application for the waiver of a trade mark, it will take effect from the earliest legally possible date. However, if another party files an application for the revocation of a trade mark, it will have a retroactive effect, from the date of the grant of the protection for a trade mark.

## 6.7 Combining Revocation/Cancellation and Infringement

These two actions are not heard together. Revocation/invalidation proceedings are subject to the exclusive competence of the Patent Office, whereas infringement proceedings may be considered and decided only by the common civil courts (commercial divisions of the regional courts).

Proceedings for the revocation/invalidation of a trade mark may require one to two years for the Patent Office to issue a decision, plus approximately two to three years to exhaust the appeal routes; typically, it takes one to one and a half years in the Voivodship Administrative Court and one to two years in the Supreme Administrative Court. Therefore, it takes three to five years in total until the revocation or invalidation proceedings are finally resolved in the most straightforward scenarios. The proceedings may last much longer if, for example, a decision of the Patent Office is reversed and remanded for re-examination, as this adds at least one year to the overall timing.

Infringement cases usually take one to two years in the court of the first instance and one and a half to two years in the court of the second instance. In the majority of cases, the judgment of the court of the second instance may be further appealed by an extraordinary measure (cassation appeal) to the Supreme Court, which requires at least another year to consider the case.

## 7. Trial & Settlement

### 7.1 Special Procedural Provisions for Trade Mark Proceedings

The Industrial Property Act does not provide for any special procedural provisions for trade mark proceedings in infringement cases.

### 7.2 Decision Maker in Cases

There are no technical judges in Poland. Trade mark cases are handled only by legal judges.

The panel is composed of one professional judge (lawyer) in the first instance and three professional judges (lawyers) in the appeal and the Supreme Court.

The parties have no influence on choosing the judge who will handle the case – the case is handled by the court where the infringement occurred.

### 7.3 Options for Settlement

Polish law provides for different types of conciliation measures, such as court mediation prior to and during infringement proceedings, and court conciliation proceedings prior to infringement proceedings. There are no mandatory settlement procedures that would be required prior to instituting a lawsuit. However, in the statement of claim, the plaintiff must inform the court of measures taken to resolve the case amicably; if none have been taken and the defendant acknowledges the claims, the plaintiff shall bear all costs of the proceedings, pursuant to the Polish Civil Procedure Code.

### 7.4 Other Court Proceedings

In general, it is possible for parallel revocation/infringement proceedings to have an influence on the current proceedings. According to the provisions of the Polish Civil Procedure Code, the court may stay proceedings on its own initiative if the resolution of the case depends on a prior decision to be issued by a public administration body – in the case of revocation proceedings, the public administration body would be the Polish Patent Office.

## 8. Remedies

### 8.1 Remedies for the Trade Mark Owner

The remedies available for the trade mark owner under the Polish Industrial Property Act are as follows:

- cessation of the infringement;
- surrender of unlawfully obtained profits;
- redress for damages in accordance with the general principles of the Polish Civil Code;
- publication of the court judgment (in full or in part); and

- the disposal of unlawfully manufactured or marketed goods owned by the infringing party (in particular the withdrawal or destruction of these goods).

The judge is limited by the statement of claim because according to the principle of the Civil Procedural Code, the court may not award damages or relief other than or beyond those specified in the statement of claim. Therefore, the court may award a smaller amount than the one specified or oblige a smaller amount of goods to be issued than indicated in the lawsuit, taking into account the individual circumstances of the case, but cannot award anything exceeding the claimant's demands.

### 8.2 Rights and Remedies for the Prevailing Defendant

The prevailing defendant has the right to request a reimbursement of legal costs, which consist of court costs and attorney fees. The amount of attorney fees is limited by the official scale of charges and is partially dependent on the value of claims. The court decides on the amount of reimbursed attorney fees, taking into account the complexity and value of the case, although the total amount cannot exceed six times the official charges.

### 8.3 Types of Remedies

There are no different types of remedies in relation to specific types of trade marks. The applicable remedies remain the same, as stated above.

## 9. Appeal

### 9.1 Special Provisions for the Appellate Procedure

There are no special provisions concerning the appellate procedure for trade mark proceedings. The general provisions of the Polish Civil Procedure Code apply to proceedings before the courts of appeal in trade mark cases.

### 9.2 Scope of the Appellate Review

The purpose of appeal proceedings in Poland is to re-examine the case within the limits of the appeal. The court of appeal (the court of the second instance) considers the cases on the basis of the evidence collected both in the first instance proceedings and in the appeal proceedings. The court of appeal considers all substantive and procedural issues that are challenged by the appellant in the appeal and may not, at its own initiative, consider other issues. Consequently, the appeal proceedings imply a full legal and factual review of the case.

### 9.3 Time Period for an Appeal of a Trial Court Decision

Typically, an appeal from a trial court decision normally takes from six months to one year to be decided. However, whether the decision of the court is appealed in full or in part may depend on the complexity of the case – these cir-

cumstances may delay the duration of the appeal from a trial court decision.

### 10. Other Trade Mark Issues

#### 10.1 Dilution as a Ground to Oppose Trade Mark Registration

Dilution is not directly or explicitly mentioned in the Industrial Property Act. According to the provisions relating to that issue, the infringement of trade mark protection consists of the unlawful use in the course of trade of a sign that is identical or similar to a reputable trade mark registered for goods of any type where use of such sign without due cause brings the user unfair advantage or is detrimental to the distinctive character or repute of the earlier mark. Detriment to the distinctive character of a reputable trade mark is defined as 'weakening', 'tarnishment' or 'diluting'.

#### 10.2 Marks Famous Outside the Nation But Not Registered Within It

Protection is granted for well-known trade marks. Regarding well-known trade marks not yet in use in Poland, on considering an opposition to a trade mark application as justified, no protection is granted for a trade mark that is identical or similar to a well-known trade mark for which a right of protection was granted with a prior right for another person for any goods, if the use of the mark without any justified cause could bring the Applicant unfair advantage or be detrimental to the distinctive character or reputation of the earlier mark.

Referring to the protection for unregistered well-known trade marks, on considering an opposition to a trade mark application as justified, no protection right is granted for a trade mark identical or similar to a trade mark that was commonly known and used in the Republic of Poland as a trade mark designated for identifying identical or similar goods originating from another person before the date when priority is given to obtaining a protection right, if there is a likelihood of confusion, which includes, in particular, the risk of associating the mark applied for with a well-known mark.

#### 10.3 Geographic Indicators

In Poland there are two types of indications: regional names and designations of origin. Regional names serve to distinguish goods that originate in a given territory and have special properties that are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and that are produced or processed in this territory.

Designations of origin serve to distinguish goods originating in a given territory and possess certain special properties or other characteristic features attributable to that geographical origin, ie the territory where they are produced or processed.

#### 10.4 Certification Marks

In Poland, the equivalent of the certification mark is a collective guarantee mark. An incorporated organisation that does not use a trade mark itself may be granted protection for a mark intended to be used by undertakings applying the principles laid down in the mark regulations adopted by an entitled organisation and subject in this respect to its control. The holder of protection for a collective guarantee trade mark may not refuse to allow undertakings that meet the criteria set out in the regulations referred to above to use the mark without good reason.

#### 10.5 Use of a Surname as a Mark

Polish law does not provide for any special rules related to the ability to use one's own surname as a mark, even if it might cause confusion with a pre-existing mark.

### 11. Costs

#### 11.1 Costs Before Filing a Lawsuit

Typically, pre-litigation costs (eg, for warning letters, protective briefs, evidence notarisation) consist of legal fees, which depend on an agreement between the client and the attorney. If court settlement proceedings are initiated (mediation, conciliation), additional court fees have to be added (possibly several hundred euros).

#### 11.2 Costs for Bringing an Infringement Action

Typically, the costs for bringing an infringement action consist of court fees and expenses, which initially have to be paid by the party that requests a given action (ie, an appeal). All costs are split between the parties in proportion to the degree to which each of them prevailed (eg, if one party won the case in full or in the majority, then all costs of that party should be reimbursed). The costs are split proportionally based on the value of claims awarded/dismissed, which is established by the plaintiff in the statement of claim but may be verified by the court. Therefore, the conclusion of an infringement action in the first instance may include court fees, expenses and attorneys' fees.

#### 11.3 Costs of Litigation

In general, the unsuccessful party shall reimburse the opposing party, at its request, for any costs necessary to present its case. The necessary costs of proceedings of a party represented by an advocate comprise a fee not higher than the rates set out in separate regulations, out-of-pocket expenses of one advocate, court costs and the costs of a party's personal appearance in court as summoned by the court.

### 12. Alternative Dispute Resolution

#### 12.1 Prevalence of ADR

The prevalence of ADR depends on whether the case is settled before the court or the Polish Patent Office. In the first scenario, the court always suggests the parties resolve the case through alternative dispute resolution methods, so it is at the discretion and will of the parties whether they follow the ADR path.

However, there is no possibility of ADR when a case is before the Polish Patent Office.

### 13. Trade Marks and Other Intellectual Property

#### 13.1 Protection by Copyright

A trade mark may be protected by copyright if it complies with the legal definition of work under the Copyright and Related Rights Act – that is, if such trade mark constitutes a manifestation of a creative activity of an individual nature, established in any form.

In Poland, there are no such forms of protection as design patent and trade dress. Patents constitute a totally separate protection regime, which grants protection only for inventions that are new, involve an inventive step and are susceptible to industrial application.

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