Poland

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



Authors
Małgorzata Zielińska-Łazarowicz and **Jarosław Markieta**

Legal framework

National trademarks in Poland are governed by the Industrial Property Law 2000 (as amended) and the EU Community Trademark Regulation (207/2009). Polish trademark law is harmonised with EU law through EU Directive 2008/95/EC.

Poland is a party to 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.

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, the holder of an earlier unregistered trademark used on the market can prevent third parties from using later marks that are identical to or similar to the unregistered mark, if this could mislead the public as to the origin

of the goods or services. A sufficient level of distinctiveness and use as a trademark is crucial for a mark to enjoy protection under the law (ie, use in the course of trade and for the goods and services for which protection is sought).

If the unregistered trademark is well known, protection can also be sought under the Industrial Property Law. In particular, the holder of a trademark that is well known in Poland may demand cessation of the use of an identical or similar trademark in respect of identical or similar goods, if such use could mislead the public as to the origin of the product. An earlier well-known trademark can also be an obstacle for registration of a later trademark. A trademark is deemed to be well known if it is known to the majority of potential customers of the relevant goods or services (ie, more than 50%). However, if the trademark is highly distinctive, a lower threshold may be justified.

Registered marks

Ownership

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

Under some circumstances, a jointly owned trademark registration may be granted to a group of natural or legal persons. Collective or guarantee trademarks can also be registered. Applicants for such trademarks are obliged to file rules on the use of such trademarks.

A trademark application can be filed by the applicant itself or its representative. Foreign applicants must be represented by a Polish patent attorney.

Protection

To be protected as a trademark, a sign must be capable of being represented graphically and of distinguishing the goods or services 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.

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

Absolute grounds for refusal

Trademark protection will not be granted for a sign that:

- is not considered a trademark; or
- is devoid of sufficient distinctive character– for example, which:
  - is incapable of distinguishing the goods and services concerned;
  - consists exclusively or mainly of elements that 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 fair and established business practice.

The grounds for refusal resulting from insufficient distinctiveness can be overcome by proving that the applied trademark has acquired distinctiveness through use before the filing date.

Trademark registration will be also refused for a sign that:

- constitutes a form or feature of the goods or their packaging which is dictated exclusively by their nature, is necessary to achieve a technical result or gives substantial value to the goods;
- its use infringes third parties' personal or economic rights;
- is contrary to law, public order or morality;
- could 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 or international organisations;
- incorporates officially recognised signs accepted for use in trade (eg, safety marks, quality marks or hallmarks of legalisation), such that the public could be misled as to the nature of such signs, unless the applicant can prove its right to use them;
- incorporates symbols of a religious, patriotic or cultural nature, whose use could hurt religious feelings, a sense of patriotism or national tradition; or
- where intended for wines and spirits, contains geographical indications that do not match the goods' true origin, such that the public could be misled.

Relative grounds for refusal

Protection will not be granted for a trademark that has been applied for in bad faith.

“The holder of an earlier unregistered trademark used on the market can prevent third parties from using later marks that are identical to or similar to the unregistered mark, if this could mislead the public as to the origin of the goods or services”

Registration will also be refused for an application in respect of identical or similar goods where the trademark applied for is identical or similar to:

- a registered geographical indication, unless the applicant is entitled to use that indication and the trademark registration is not supposed excessively to restrain other entitled parties from using the registered geographical indication;
- a registered geographical indication or designation of origin for agricultural products or foodstuffs;
- a registered geographical indication related to spirits;
- an earlier well-known trademark; or
- a trademark that has previously been registered in Poland whose registration has ended, provided that the interval between the lapse of registration and the filing date of the similar trademark is no longer than two years (excluding trademarks that have lapsed due to non-use or where the owner of the earlier trademark agrees to registration of the later trademark).

Furthermore, registration will be refused for a trademark that is:

- identical to a trademark that has previously been registered or applied for (provided that the latter is subsequently registered) for identical goods or services;
- identical or similar to a trademark that has previously been registered or applied for (provided that the latter is subsequently registered) for identical or similar goods or services, if there is a risk of confusion, in particular by evoking associations with the earlier mark; or
- identical or similar to a renowned trademark that has previously been registered or applied for (provided that the latter is subsequently registered) for any kind of goods, if it would provide the applicant with an unfair advantage without due cause or be detrimental to the distinctive character or repute of the earlier trademark. This provision applies to well-known trademarks accordingly.

Procedures

Examination procedure

Each trademark application may include only one trademark. Multi-class applications are allowed, subject to payment of an extra fee for each additional class above three classes. A trademark application is subject to examination by the Patent Office on both formal and substantive grounds. If obstacles to a trademark application are found, the Patent Office will request the applicant to remedy any deficiencies within a fixed period. Trademark applications will be published three months after the filing date. Following publication, third parties may submit observations against registrability of the trademark. A party filing observations does not become a party to the proceedings.

The applicant will be notified by the Patent Office about any possible grounds of refusal and invited to make comments or amendments. Until a decision has been issued, applicants may make additions and corrections to the application, provided that such additions or corrections do not alter the essential characteristics of the trademark or extend the list of the goods for which protection is sought. If the grounds for refusal cannot be overcome, the registration will be refused. A request for re-examination of the case can be filed, and

“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”

that decision can be appealed to a regional administrative court.

Registration

Trademarks are registered for 10 years from the filing date, provided that the fee for the first protection period has been paid. Failure to pay the fee on time will make the registration void. The trademark registration can be renewed every 10 years, at the request of the trademark owner.

Opposition

Any party can oppose registration of a trademark within six months of publication of the registration. The grounds for opposition are the same as those for invalidation. If the opposition is justified, the trademark will be declared invalid.

Removal from register

The trademark registration lapses on the expiry of the 10-year protection period for which it was granted, if no extension request is submitted and the renewal fee is not paid. A trademark registration can also be surrendered for all or part of the goods or services for which it was granted.

Revocation

A trademark registration can be revoked on the following grounds:

- Non-use – the trademark has not been used for five consecutive years, unless there was a serious reason for non-use (the request for revocation will be dismissed if genuine use started or resumed before the request was filed).
- Loss of distinctiveness – due to the actions or negligence of the rights holder, the trademark has become customary for the registered goods or services.
- Subsequent misleading effect – due to the actions of the rights holder or with its consent, the trademark may mislead the public as to the nature, quality, characteristic features or geographical origin of the goods.
- Removal from the register – the rights holder (legal person) has been removed from the relevant register (ie, has ceased its legal existence).

The trademark right ends on the date of the event giving rise to revocation of the trademark.

Invalidation

A trademark may be declared invalid in whole or in part where the statutory requirements for registration of the trademark have not been met. The party requesting invalidation must prove its legal interest therein.

An invalidation request will be rejected, in particular, if:

- the party requesting invalidation on the basis of its earlier rights (eg, the owner of a well-known trademark) was aware of and tolerated the use of the conflicting trademark for five successive years, unless the trademark was registered in bad faith; or
- five years after registration, the registered trademark has acquired distinctiveness through use.

Opposition, revocation and invalidation proceedings are conducted by the Litigation Division of the Patent Office. Such decisions can be appealed directly to the administrative courts.

Searches

The Patent Office conducts no searches on behalf of third parties.

Enforcement

The law provides for both civil and criminal actions against trademark infringement and

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counterfeiting. Enforcement of trademarks can be supported by the border measures available under the new EU Customs Regulation (608/2013), which entered into force on January 1 2014.

Infringement

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 there is a risk of confusion, including due to association between the trademarks; or
- a trademark that is identical or similar to a renowned trademark in respect of any kind of goods, if such use would give the user an unfair advantage or be detrimental to the distinctive character or the repute of the earlier trademark.

The rights holder cannot prohibit a third party from using a mark that is 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. The only specialised trademark court in Poland is the court appointed in accordance with EU Regulation 207/2009 to deal with Community trademarks and designs.

Polish patent attorneys are entitled to represent rights holders before the courts in civil proceedings regarding enforcement of both Polish and Community trademarks.

Polish court proceedings are highly formalised. In order to initiate court proceedings, a statement of claim must be lodged with the court of first instance. The statement of claim must be reasoned and supported by relevant evidence. Generally, parties are obliged to provide any evidence at the earliest possible opportunity – for the plaintiff, that is when bringing an action with the court; for the defendant, that is in its response. Later filed evidence, motions and explanations can be admitted, although this is at the judge's discretion.

The first-instance decision can be appealed to the Court of Appeal. The Court of Appeal's decisions may be subject to a cassation complaint to the Supreme Court.

Remedies

A rights holder whose trademark has been infringed may demand:

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

The court may order that unlawfully manufactured or marked products and the means used in their manufacture or marking be removed from the market or assigned to the rights holder in lieu of damages. Alternatively, the court may order that the illegal goods be destroyed.

Where the infringement was unintentional and the court decides that cessation or destruction would be excessively severe for the infringer, the court may order the infringer to pay a reasonable amount of money on behalf of the trademark holder instead of cessation or

destruction, if such payment would adequately meet the interests of the rights holder.

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 for the initiation of a lawsuit against the infringer. If this 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 rights holder must prove its legal interest and justify the injunction by proving the existence of the infringed rights and the factual circumstances of the infringement. The evidence threshold for granting an injunction is lower than in the main proceedings. The rights holder must also define the claims to be secured by the injunction and the method of injunction (eg, seizure of the goods by a 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 damages that it suffered due to the injunction.

Requests for the disclosure of information and to secure evidence are also allowed and are usually used in cases involving financial claims.

Timeframe

Trademarks can be enforced after registration. Where the infringer acted in good faith, infringement claims can be brought in respect of the period following publication of the trademark application or, where the infringer was notified earlier, from the date of notification. The limitation period for infringement claims is three years from the date on which the rights holder learned of the infringement; this period runs separately for each infringement. Claims are time barred once five years have elapsed since the infringement.

Criminal proceedings

Criminal actions can be undertaken against counterfeiting products. 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 rights holder must submit a motion. After filing a motion, the proceeding is continued *ex officio* (no motion for investigation is required). 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*.

Ownership changes and rights 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. Special rules apply to the transfer of jointly owned, collective and guarantee trademarks.

Licences

The holder of a registered trademark may authorise another party to use the trademark by signing a licence agreement. The licence agreement is valid only if it is in writing. A licensee may grant a sub-licence only with the rights holder's consent. Granting 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 rights holder, enforce its claims in the event of infringement, unless the licence agreement stipulates otherwise.

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 used by rights holders to support claims against taking unlawful advantage of the reputation of or goodwill in a trademark. A specified act of unfair competition is the marking of goods or services, or lack of such marking, that 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 often registered simultaneously as designs and trademarks. They may also enjoy copyright protection.

Online issues

There is no special regulation protecting rights holders against unauthorised use of their trademarks on the Internet. Online infringements are protected on the basis of general regulations governing trademarks or unfair competition activities. WTR

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?**
Yes/No ✓ / ✗	Yes ✓	3D; colours; packaging; sounds. ✓

Unregistered rights	
Protection for unregistered rights?	**Specific/increased protection for well-known marks?**
Yes ✓	Yes ✓

Opposition
Can a registration be removed for non-use? Term and start date?
Yes: six 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?**
Yes: five consecutive years of non-use. ✓	Yes ✓	Yes ✓

Enforcement		
Specialist IP/trademark court?	**Punitive damages available?**	**Interim injunctions available? Time limit?**
No: Community trademark court only. ✗	No ✗	Yes ✓

Ownership changes
Mandatory registration for assignment/licensing documents?
Yes/No ✓ / ✗

Online issues	
National anti-cybersquatting provisions?	**National alternative dispute resolution policy (DRP) for local ccTLD available?**
No ✗	Yes ✓

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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
Partner
malgorzata.lazarowicz@ipandlaw.com

Małgorzata Zielińska-Łazarowicz is a lawyer, Polish 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 in European law there. She specialises in IP-related enforcement and litigation for designs and trademarks (including Community trademarks and Community designs), and in unfair competition law. She represents clients before the Polish Patent Office, OHIM and the common and administrative courts, as well as advising on various IP issues and preparing legal opinions and licence agreements.



Jarosław Markieta
Partner
jarek.markieta@ipandlaw.com

Jarosław Markieta is a European and Polish patent attorney. He graduated *cum laude* from the Faculty of Electrical Engineering at Warsaw University of Technology, where he specialised in automation and robotics. He deals with cases concerning modern technologies, in particular inventions in the field of computer technology. He specialises in patent prosecution, but also conducts patent invalidation cases and patent enforcement. His specific field of interest is assisting clients in the implementation of licensing systems for the use of patented technologies in Poland. He represents clients before the Polish Patent Office, the European Patent Office and the administrative and civil courts.