



patpol

EUROPEAN AND POLISH
PATENT AND TRADE MARK ATTORNEYS

IP RIGHTS - PROTECTION AND ENFORCEMENT

- European and Polish patents including biotechnological and pharmaceutical inventions, genetic engineering
- Utility Models
- Community and Polish Trade Marks and Designs
- Domain Names
- Geographical Indications
- IP Enforcement
- Litigation and Related Matters
- Anti-counterfeiting
- Customs Seizures
- Patent and Trade Mark Searches
- Watching Services
- License Agreements
- Counselling

Office address:

162 J, Nowoursynowska Str., 02-776 Warsaw, Poland

Postal address:

P.O. Box 168, 00-950 Warsaw, Poland

Tel.: (48 22) 644 96 57, (48 22) 644 96 59,
(48 22) 644 96 68, (48 22) 644 96 79

Fax: (48 22) 644 44 02, (48 22) 644 96 00

e-mail: patpol@patpol.com.pl www.patpol.com.pl

IP Contacts: *Katarzyna Karcz (Managing Director), Anna Zakrocka (Trade Marks), Jolanta Hawrylak (Patents and Designs), Sławomira Piotrowska (IP Manager)*

Poland

Contributing firm
Patpol – Patent & Trademark Attorneys

Authors
Sławomira Piotrowska
Patent and trademark manager

Jaromir Piwowar
Lawyer

Piotr Wydrzyński
Patent attorney



1. Legal framework

National

The most important law governing trademarks in Poland is the Law on Industrial Property of June 30 2000, last amended on March 24 2009. However, rights under the previous act (the Trademarks Act 1985) remain valid.

International

Poland is a party or a signatory to the following international laws and treaties:

- the Paris Convention for the Protection of Industrial Property;
- the Madrid Agreement on the International Registration of Marks;
- the Madrid Protocol on the International Registration of Marks;
- the Nice Agreement on the International Classification of Goods and Services;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Singapore Treaty on the law of Trademarks; and
- the EU Community Trademark Regulation (40/94).

On May 1 2004 Poland became a member of the European Union. As a result, it is possible to obtain trademark protection in Poland through registration as a Community trademark extending to all EU member countries. Community trademarks already registered or applied for before May 1 2004 have been automatically extended to the territory of Poland from that date. However, special transitional rules apply with regard to such marks, including rules for the protection of prior rights in Poland.

2. Unregistered marks

Unregistered marks that are well known in Poland are protected. In addition, unregistered trademarks that are not well known are protected under the Act on Combating Unfair Competition.

The owner of a well-known mark may request the invalidation of the registration in

Poland of an identical or similar mark in the name of another party for goods or services identical or similar to those for which the well-known mark is used.

Additional protection is available to unregistered well-known marks with a reputation. The owner of such a mark may request invalidation of the registration of a later identical or similar mark, irrespective of the goods or services for which the well-known mark is registered, if use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark. A mark owner is prohibited from bringing such an action if it has tolerated for five consecutive years the use of the later mark while being aware of such use.

According to Article 301 of the Law on Industrial Property, the holder of a well-known trademark in Poland may demand the cessation of use of an identical or similar trademark in respect of identical or similar goods if such use is likely to mislead the public as to the origin of the product.

3. Registered trademarks

Ownership

Any natural or legal person may file an application for registration of a trademark. Several applicants may apply for and obtain the registration of a mark jointly, provided that certain conditions are met.

Any organization that is a legal entity and has been founded to represent the interests of businesses can apply to register a collective mark.

Applications for registration of a certification mark (collective guarantee mark) may be filed by any organization that is a legal entity and does not itself use the mark.

Foreign nationals and legal entities have the same rights as Polish nationals on the basis of international agreements to which Poland is a party or on the basis of reciprocity. Applicants residing abroad must be represented by an admitted patent attorney permanently residing in Poland.

Scope of protection

The Law on Industrial Property provides that any sign capable of being represented

graphically may be considered as a trademark, provided that it can distinguish the goods or services of one enterprise from those of others. The following is a list of signs that may be considered as trademarks:

- words;
- designs;
- ornaments;
- combinations of colours;
- the three-dimensional shape of goods or their packaging; and
- melodies and other acoustic signals.

This implies that three-dimensional marks (in particular the shape of goods or their packaging) may be registered. However, signs constituting the form or another feature of the goods or their packaging cannot be registered where this:

- is dictated solely by the nature of the goods or their packaging;
- is required to obtain a technical result; or
- gives substantial value to the goods.

Therefore, sound marks may be registered. Service marks may also be registered.

Protection cannot be granted to signs that:

- do not constitute a trademark;
- are devoid of any distinctive character;
- are not capable of distinguishing in trade the goods or services concerned;
- consist exclusively or mainly of elements which may serve in trade to designate the kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function or usefulness of the relevant goods; or
- have become customary in the current language and are used in genuine and established business practices.

Articles 131 and 132 of the Law on Industrial Property outline the absolute and relative grounds for refusal of a trademark registration.

4. Procedures

Examination

Applications for trademark registration are published in the bi-weekly *Patent Office Bulletin*, usually after three months from the

date of filing. As of the date of publication, interested third parties may file observations as to why the mark should not be protected. A person filing such an objection does not become a party to any subsequent proceedings.

The Patent Office examines applications as to form and registrability, and to see whether they conflict with the rights of third parties (ie, rights registered or applied for by another party in Poland relating to the same or similar goods or services). If obstacles to registration are found, the Patent Office will order the applicant to remedy any deficiencies within a fixed period; this period may be extended once only by two months upon written request before the end of the fixed period. If the mark is found to be unregistrable (whether or not as a consequence of third-party observations), the applicant will be informed and ordered to give its opinion within a fixed period, which may be extended once only by two months upon written request before the end of the fixed period. If the applicant fails to meet the requirements for registration in respect of only some of the goods or services for which protection is sought, and the applicant has not limited the list of goods or services, the Patent Office may grant the registration in part, covering only those goods or services that comply with the requirements.

Registration

National registration: If the application meets all of the statutory requirements, the Patent Office will grant registration and invite the applicant to pay within three months the protection fee for the first 10-year period. If the fee is not paid in time, the Patent Office will declare the grant of registration lapsed, whereas if the fee is paid in time the mark will be entered in the Trademark Register and a certificate of protection will be issued. The decision to grant protection will be published in the (monthly) *Patent Office Journal*.

International registration: An international registration of a mark designating Poland under the Madrid Agreement or Madrid Protocol will have the same effect in Poland as a national registration. The Patent Office must communicate a

decision to refuse protection for a registration under the Madrid Agreement within one year. A decision to refuse protection under the Madrid Protocol, on the other hand, must be announced within 18 months. Following a decision to refuse, the applicant has two months to file with the Patent Office a motion for re-examination against that decision. Information about international trademark registrations designating Poland is published in the *Patent Office Bulletin*. Third-party observations may be filed as in the case of a national trademark application. International trademark registrations that have been granted protection in Poland are published in the *Patent Office Journal*. Oppositions may be filed under the same terms as in the national procedure (see below).

Opposition

Within six months of the date of publication of the decision granting protection, any interested party may file a notice of opposition against the registration. An opposition may be based on the same grounds on which a registration may be invalidated. The Patent Office will inform the owner of the registration of any opposition as soon as possible and the owner must file a counter-statement within the required time period; failure to do so will result in the cancellation of the registration. If the counter-statement is filed in time, and the owner of the opposed mark does not agree with the opponent's standpoint, the case will be transferred to the Patent Office for litigation proceedings in which the owner of the registration and the opposing party participate, to be dealt with by the Litigation Division of the Patent Office. Decisions of the Litigation Division can be appealed to the district administrative court within 30 days of receipt of the written decision.

Removal from register

Revocation: A trademark registration may be cancelled for the following reasons:

- The protection period has expired without the mark being renewed;
- The rights are abandoned by the owner with the consent of any parties having an interest in the mark (eg, licensees);
- The mark is not genuinely used for five consecutive years or more (except where there are genuine reasons for non-use);
- The mark, as a consequence of the owner's activity or inactivity, has become a mark consisting exclusively of elements which may serve in the course of trade to indicate, in particular, the kind, quality, quantity, price, intended purpose, process, time or place of manufacture, composition, function or use of the goods or services covered by the registration;
- The mark, as a consequence of the use made of it by the owner or with its consent for the goods or services for which it is registered, has become capable of deceiving the public, in particular with regard to the nature, quality, characteristic features or geographical origin of those goods or services; or
- The owner (corporate/legal person) has been removed from the relevant register (eg, final deletion of legal person from the Commercial Register).

The Patent Office can issue an order of revocation in points three to six outlined above during litigation proceedings at the request of any party having a legitimate interest. This also applies to jointly owned marks, collective marks and certification (collective guarantee) marks, all of which can also be revoked if the regulations governing their use are not observed.

The rights of protection in a trademark end on the date on which an event occurs which gives rise to revocation of the rights. Cancellation will be recorded in the Trademark Register. The public prosecutor or the president of the Patent Office may, in the public interest, request the revocation of a mark and intervene in proceedings already in progress. Complaints against decisions of the Patent Office may be lodged with the district administrative court within 30 days.

Rights conferred by trademark protection will lapse if the mark has not been genuinely used for a period of five consecutive years prior to the filing of a revocation claim and there are no genuine reasons for the non-use. If the mark owner has not genuinely used

the mark in respect of specific goods or services, the rights will lapse only in respect of those goods or services. Any person with a legitimate interest may request the Patent Office to issue a declaration that the right of protection has lapsed.

A request for revocation due to non-use will be refused if genuine use in Poland of the mark was commenced or resumed before the request was filed, provided that such use did not commence or resume in the three months preceding the request where it appears that the mark owner has been spurred into action only after becoming aware that a request for revocation would be made.

Use of a registered mark by another person with the consent of the owner will accrue to the owner. For a collective mark or a certification mark, use by at least one party entitled to use the mark is relevant use. Use of a mark in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was granted protection is considered relevant use. Affixing in Poland a mark on goods destined solely for export, or on the get-up or packaging of such goods, is also relevant use.

However, use of a mark to advertise a product that is not available on the market and is not manufactured in Poland for export purposes is not deemed to constitute genuine use of the mark.

In proceedings for a declaration that the right to protection of a mark has lapsed on account of non-use, the burden of proof that the mark has been used or that serious reasons for non-use exist rests with the rights owner.

Invalidation: A mark will be invalidated if it is deemed that the mark was not in fact registrable at the time of registration. Invalidation will occur if any interested party can prove that the statutory requirements for the grant of protection have not been met. A request for invalidation should be filed with the Patent Office and will be dealt with in litigation proceedings by the Litigation Division.

An invalidation claim will not be granted in the following circumstances:

- The mark conflicts with an earlier mark or personal or economic right of another party which has, for a period of five

consecutive years, tolerated the use of the registered mark while being aware of that use;

- The mark conflicts with a well-known mark and the owner of the well-known mark has, for a period of five consecutive years, tolerated the use of the registered mark while being aware of that use; or
- The mark, although not registrable at the time of registration, has, for a period of at least five years from registration, acquired distinctive character.

However, the five-year limitation does not apply if the mark owner obtained the rights in bad faith.

Invalidation may also be requested in the public interest by the public prosecutor or the president of the Patent Office (either of whom may also intervene in invalidation proceedings already in progress, where necessary).

Complaints against a decision of the Patent Office may be lodged with the district administrative court within 30 days of receiving the written decision.

The invalidation will be recorded in the Trademark Register. Partial invalidation is also possible.

Renewal

The protection of a registered trademark begins on the date on which the application is filed and applies for 10 years from the date of application. The registration may be renewed for 10-year periods.

Applications for renewal must be accompanied by payment of the official fee and must occur no earlier than 12 months before, and no later than six months after, the expiration of the registration period (it is necessary to pay an additional fee for late renewal in the six months after the expiration of the renewal period). If the application is satisfactory, the renewal is entered in the Trademark Register.

Merger and change of name

Changes to the owner's name and address are recorded in the Trademark Register upon filing the relevant request. The recordal is made within six to 12 months of filing the request.

Searches

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

5. Enforcement

Civil actions

The Law on Industrial Property provides that a trademark owner's rights will be deemed to have been infringed where there has been unlawful use of the mark in the course of trade, including unauthorized use of a trademark by a licensee and sublicensee. The remedies available to the trademark owner are as follows:

- cessation of the infringement;
- surrender of any unlawfully obtained profits;
- compensatory damages in accordance with the relevant principles of the Civil Code or payment of a lump sum equivalent to a licence fee, or any other remuneration, which would have been due if the infringer had been authorized by the right holder to use the trademark. In this case, the trademark owner is obliged to prove that an intentional infringement of its rights has taken place;
- announcement to the public of a verdict of the court (upon the request of a trademark owner) as a whole or in part, or publication of information regarding the verdict;
- a court order that the infringer (upon its own request, in case of unintentional infringement) to pay the relevant sum to the benefit of the trademark owner if the cessation of infringement or forfeiture of the goods held by the infringer (means of manufacturing, materials) would be excessive, and the above-mentioned sum to be paid would fulfil the right holder's interest.

Civil trademark cases, irrespective of the value in dispute, are examined by higher district courts. The decisions of higher district courts may be appealed to the Court of Appeal. A cassation complaint against the decision of the Court of Appeal may be filed with the Supreme Court.

In civil proceedings, the owner of the infringed trademark right may obtain a preliminary injunction. A request for such an injunction requires evidence:

- of a legal interest requiring an injunction; this is deemed to exist where there is an indication that a failure to impose an injunction will seriously impede the enforcement of the court's decision;
- confirming the ownership of the infringed right; and
- that the infringement has been committed in respect of the goods or services covered by the right.

The request for a preliminary injunction may be brought before filing the statement of claim and also during the course of the proceedings. If the request for a preliminary injunction is filed before the start of proceedings, the court, upon issuing a decision to grant the preliminary injunction, will designate a deadline for the filing of the statement of claim. If the plaintiff misses the deadline, which cannot exceed two weeks, the entire claim is liable to cancellation.

Criminal actions

The Law on Industrial Property defines a 'counterfeit trademark' as any trademark identical to, or indistinguishable in the course of trade from, a registered trademark and unlawfully used in respect of the goods covered by the trademark right. A party either affixing a counterfeit trademark to goods with the intention of introducing them onto the market or committing acts resulting in the turnover of such goods may be subject to a fine, a restriction of liberty or a term of imprisonment of up to two years. A criminal action requires evidence that the acts were committed with intent.

It is for the party aggrieved by the infringement to commence a criminal action. Only after the filing of the motion can the proceedings be started and continued *ex officio*. The sole exception is when a person committing the crime in respect of a registered trademark obtains permanent profits from its criminal activity or commits acts resulting in the turnover of counterfeit goods bearing the trademark, which are of significant value. In

such case the infringer is subject to more serious criminal penalties and proceedings will be started *ex officio*.

The range of protection of trademarks against potential infringement under criminal law is limited compared with that offered under civil law. Criminal provisions of the Law on Industrial Property do not apply in situations where the infringement has taken place in respect of an unregistered trademark, including unregistered famous and commonly known trademarks.

Customs actions

The measures to protect trademarks in customs proceedings in Poland are provided in EU Regulation 1383/2003, which came into effect in the territory of the European Union (including Poland) on July 1 2004. This regulation determines the actions and measures to be taken by customs authorities against goods deemed to infringe IP rights. The territory of Poland as a member state of the European Union is subject to an additional regulation (EU Regulation 1891/2004), which came into effect with retroactive effect as of July 1 2004.

The trademark right owner can file an application for customs protection with the Main Customs Chamber in Warsaw to prohibit the import or export of any infringing goods. The regulations also cover, among other things, infringements of registered and unregistered designs. Actions before the customs authorities can be split into two types: national actions and Community actions. The latter must be made by way of a special form specified by EU Regulation 1891/2004. Customs protection is granted for a period of one year, with a possibility of renewal.

6. Ownership changes and rights transfers

Assignment

Assignment of a trademark is possible with or without transfer of the entire business. Assignment of a mark for part of the goods or services for which it is registered is also possible, provided that the goods or services

for which the mark remains registered in the name of the assignor are not of the same type. After partial assignment, the rights of the assignee will be treated as independent of the rights of the assignor. Assignments must be in writing in order to be valid. Any assignment (and change of name or address) must be recorded in the Patent Office Register in order to be effective against third parties. The required fee must be paid and the following documents must be filed:

- a power of attorney, signed by the assignee, without legalization; and
- an assignment deed, signed by both parties.

A pending application for the registration of a mark may also be assigned, for which in principle the above provisions apply.

Licensing

Exclusive and non-exclusive licences may be granted. A licence agreement must always be in writing; otherwise it will not be valid. Unless specified in the agreement, the licensee shall have the right to use the mark to the same extent as the licensor. A licence may be granted for all or part of the goods or services covered by the mark, and for all or part of the territory of Poland.

7. Related rights

There are some areas of overlap between trademarks and other rights (copyright and design protection).

A device mark may be protected under the Copyright Law if it qualifies as an artistic work and meets the requirement of originality.

A three-dimensional trademark may also be registered as an industrial design.

It is advisable, when filing an application for a three-dimensional mark, to file simultaneously a design application for the same shape. This way, if trademark registration is refused for lack of distinctiveness, the shape will be protected as a design and will enjoy protection without restriction as to the goods or services claimed.

8. Online issues

There are no specific provisions protecting trademark owners against unauthorized use of registered and unregistered marks in various forms online. If a trademark is infringed online (ie, unlawfully used in a domain name), the owner may enforce its rights based on the Law on Unfair Competition as well as the Law on Industrial Property. Proceedings may be filed before a common court or the Arbitration Court at the Polish Chamber of Informatics and Telecommunication or the Arbitration Court at the Polish Chamber of Commerce. The latter deals with disputes relating to the ‘.pl’ country-code top-level domain and has its own set of regulations.

The authors would like to thank Tomasz Mielke, who is no longer with Patpol, for his work on previous versions of the chapter.

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