

Enforcing patents in Poland

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1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

A holder of a European patent in which Poland has been designated, and which is effective in Poland, enjoys basically the same rights as a holder of a patent issued by the Polish Patent Office under the national route. The exclusive rights may be enforced by the patent holder or they may be assigned to third parties.

In cases of infringement, claims may be lodged with a civil court. Namely, the patent holder may lodge a claim demanding that the alleged infringer cease the infringing activities and redress the consequences of infringement, as well as surrender unlawfully obtained profits and compensate for damages. Moreover, at the patent holder's request, the alleged infringer may also be required to publish an appropriate statement in the press and, if the infringement was wilful, to pay an adequate amount of money to a social organisation enhancing inventive activity.

Damages resulting from patent infringement may be claimed after the grant of the patent. However, damages may be collected from a date prior to the grant of the patent, provided that information concerning availability of the Polish translation of the patent claims as filed has been published in the *Bulletin* of the Polish Patent Office (PPO). Such information (which follows filing of the translation of the claims with the PPO) may be published only at the explicit request of the applicant and after the European publication of the application. It should be noted that although the publication of the above information in the *Bulletin* of the PPO is voluntary, it has a

significant effect upon the scope of protection covered by the European patent.

When the alleged infringer has been notified of the claim of infringement, the patent holder may collect damages from the date of notification. The aforesaid makes further infringement wilful. The European patent holder may also claim a preliminary injunction.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

There are no specialist patent courts in Poland. Common civil courts handle patent infringement matters and the judges adjudicating patent infringement, cases have no technical training. Therefore, the court is allowed to appoint independent experts to submit written or oral opinions when specialised knowledge is necessary. In particular, an expert may be asked to compare the invention covered by the patent with the infringing product or other infringing activities of the defendant so that the court can estimate whether the acts of the alleged infringer fall within the scope of the patent protection.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

In civil proceedings regarding patent infringement all and any evidence must be indicated and, if possible, produced by the party relying on the facts which have to be proved. As a rule, the court does not take into consideration any evidence *ex officio*. In a lawsuit between business entities, the plaintiff is obliged to indicate all the relevant evidence in the statement of claim. If this is not done, the right to submit additional evidence during the proceedings before the court is generally lost. The plaintiff is

allowed to submit further evidence during the course of the court proceedings only on condition that the evidence is unlikely to have been known at the moment of bringing the action before the court, or where the evidence relevant to the case occurred after the action had started.

Each party in a lawsuit is entitled to submit written evidence, such as private or official documents or written opinions of private experts (eg, experts who were not appointed by the court). Opinions of private experts are regarded as documents not issued by official bodies.

The situation of an expert appointed by the court is different. The choice of the expert depends first of all on the character and complexity of the matter in hand. The appointed expert may be chosen from among registered Polish patent attorneys or other highly qualified specialists in the relevant field. The court is also entitled to expertise from a research or scientific institute. In patent infringement trials, the expert should aim to explain the technical aspects of the invention.

Cross-examination of witnesses is also permitted.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Infringement and validity cases are dealt with in Poland by different authorities: infringement is handled by common civil courts, while invalidation is the province of the Litigation Division of the Polish Patent Office. The decisions of the Patent Office are subject to appeals to administrative courts. Under some circumstances, the issues regarding a patent's validity may influence the infringement proceedings. If the defendant (alleged infringer) claims invalidity of the patent at issue, the court may suspend the infringement proceedings until the invalidity case is resolved.

The level of proof necessary in infringement cases results from the general rules of civil procedure, which means that a party is generally entitled to request oral examination of witnesses, to appoint experts, to produce documents (private or official) and/or to demonstrate samples, if necessary. All and any evidence should prove the circumstances relevant to the lodged demands.

The evidence allowable in invalidity proceedings is generally comparable to the evidence in infringement proceedings. The party demanding invalidation of a patent is

obliged to prove its legal interest as well as the claimed non-patentability of the invention in question. If it comes to an appeal, the administrative courts examining a decision of the Patent Office issued in an invalidity proceeding will generally base their decision on the evidence collected by the Patent Office. But where there are doubts regarding evidence essential to the case, the court may examine additional evidence (only documents are permissible).

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Where both litigating parties (the patent holder and the alleged infringer) are business entities, the patent holder is obliged to send a cease and desist letter to the alleged infringer before filing the statement of claim with the court. A cease and desist letter (so-called warning letter) is a final invitation to resolve the claim amicably through settlement. A copy of the cease and desist letter along with the alleged infringer's reply should be attached to the statement of claim lodged with the court.

The warning letter shall, in particular, indicate the right of the patent holder to use the invention within the territory of Poland, as well as the allegedly infringing activities. The warning letter is treated as evidence of the plaintiff's goodwill to settle the matter outside court. If discovery of evidence is requested by the infringer to prove the holder's claims, it should be indicated by the patent holder before the trial, on pain of charging the plaintiff with extra procedural fees for the lack of goodwill to settle the dispute amicably.

During the court proceedings the court may summon any person to submit any documents relevant to the proceedings which are in that person's possession, unless the document contains state secrets. If any party refers to trade books, the court may require the surrender of those books to the court.

The adaptation of Polish law to European Directive 2004/48/EC as of 29th April 2004 on the enforcement of intellectual property rights is expected to bring some new discovery options to IP matters.

6. To what extent does any doctrine of equivalents apply in an infringement action?

According to Polish patent law, particular emphasis should be placed on clear and unequivocal wording of patent claims. Such strict interpretation of the patent claims is not compatible with the concept of

interpretation of patent exclusivity set out in the Protocol on interpretation of Article 69 of the European Patent Convention (EPC). Bearing in mind that the EPC is binding in Poland, it should be expected that the practice of the Polish Patent Office and the courts will be consistent with the practice resulting from the EPC.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Enforcement of software patents may be difficult because the Polish Patent Office is reluctant to grant protection to those patents and is frequently inclined to invalidate them. As regards biotech patents, enforcement is usually more complicated because of the specific nature of the subject matter.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

As a rule, courts are not bound by the opinions and decisions of other courts which have handed down decisions in similar cases. The two exceptions are the decisions of the Supreme Court and the Supreme Administrative Court. In practice, opinions and decisions of other courts are frequently taken into consideration by courts when judging similar cases. Coherent and uniform court decisions guarantee certainty and reliability of the law.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

The Polish courts are generally not bound by the reasoning of foreign courts that have tried similar cases. However, they may draw conclusions from foreign courts' judgments when solving similar legal problems that are not precisely regulated by Polish law. The individual character and particular provisions of foreign legal systems, as well as the background of a specific case, have to be taken into account before taking the foreign reasoning into consideration.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

The basic way of delaying a court case is to start litigation proceedings before the Polish Patent Office claiming invalidation of the patent in question. As two separate

authorities hear the two cases, starting invalidation proceedings often causes the suspension of the infringement proceedings until validity is decided. The plaintiff can counter such delaying tactics by, for example, trying to convince the court that the invalidation claim is inappropriate or that it constitutes a misuse of law.

Another way of delaying or even blocking an infringement case in the court is to anticipate the infringement claim by filing a claim requesting a finding that the alleged infringer is exploiting its own rights and consequently is not infringing. If the supposed plaintiff does not file its claim in time, the case charging infringement will be unallowable by statute until the first case is resolved. One way to avoid such a situation is to file a preliminary injunction or the infringement claim as soon as possible (after sending a cease and desist letter first).

11. How available are preliminary injunctions and how do you get them?

A patent holder is entitled to file a request for a preliminary injunction before initiating court proceedings (before lodging a claim to the court), as well as simultaneously with those proceedings. If the request is filed before initiating the court proceedings, the court, upon issuing a decision to grant the preliminary injunction, will appoint a two-week deadline for the filing of the statement of claim.

If the plaintiff misses the deadline, the court will reverse the preliminary injunction. In order to obtain a preliminary injunction, it is necessary to prove the legal interest in requesting the preliminary injunction, justify the grounds for filing the request and indicate the way in which the injunction should take place (eg, seizure of goods in the infringer's warehouse, ban on further sale, etc). The patent holder has to prove its patent rights with an official document and should also prove that the exclusive rights have been infringed.

Preliminary injunctions should not aim to satisfy the claims raised by the plaintiff, but in practice they often lead to a court order in which the alleged infringer is requested to stop its activities under the sanction of compulsory enforcement of the said order.

An important consequence resulting from claiming a preliminary injunction is that if the plaintiff loses the lawsuit or decides to withdraw the court action before the verdict, the alleged infringer is entitled to demand compensation for the damages arising from the preliminary injunction order.

12. How long does it take to get a decision at first instance?

Patent infringement proceedings in Poland can last from approximately three to five years, depending on the complexity of the case, the strategy undertaken by the parties and the number of cases at the court pending examination. However, there is no general rule and in some cases it may take longer to complete the proceedings.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

A decision of the court of first instance is subject to an appeal to the court of second instance. The appeal should be filed with the court that issued the initial judgment within two weeks of the date of delivery of the reasoned court decision to the party.

The court of second instance examines all substantive and procedural issues, the breach of which may have provided grounds for the appeal. It is worth emphasising that the court of appeal judges the case within the limits of appeal and only nullity of the appealed decision is considered *ex officio*. Therefore, broadening the claims or adding new claims once the appeal has been filed is not allowed.

The court of second instance judges the cases on the basis of the evidence collected both in the first instance proceedings and in the appeal proceedings. However, the facts and evidence which were available to the party during the first instance proceedings may not be taken into consideration in the appeal proceedings unless they are specifically relevant to the appeal. It may take a few years before a verdict in the appeal proceedings is issued.

Under some circumstances explicitly provided for by law, a decision of the court of second instance may be subject to a cassation pleading to the Supreme Court. It is an extraordinary legal remedy and may be based only on breach of substantive law involving incorrect interpretation or incorrect application of such law or on breach of procedural provisions, which should have had relevant effect on the result of the case. The appeal should be filed within a fixed term of two months from the date of delivery of the appeal decision.

14. To take a case through to a first instance decision, what level of costs should a party to litigation expect to incur?

It is difficult to anticipate the range of costs

associated with infringement proceedings. The potential costs depend on the complexity of the matter and the value of the object of the litigation. The costs of representation, or the costs connected with entering and handling the court proceedings, as well as the costs of preparing the relevant documents, have to be taken into account. As a rule, the losing party is burdened with the costs of the court proceedings.

15. Who can represent parties in court? Is specialist representation required?

As a rule, the parties in patent infringement cases may be represented in court by professional representatives, ie, lawyers (attorneys or legal counsel) or by patent attorneys. A legal entity may also be represented by an employee.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

A patent holder or any other entitled person (ie, an exclusive licensee entered onto the patent register) whose patent has been infringed may demand cessation of the infringement, redress of its consequences and surrender of unlawfully obtained profits as well as compensation for damages. At the patent holder's request, the patent infringer may also be required to publish an appropriate statement in the press and, if the infringement was wilful, to pay an adequate amount of money to a social organisation supporting inventive activity.

The responsibility for compensation for damages applies only where the infringement was wilful. Compensation for damages includes the actual lost earnings as well as any profits which the patent holder would have achieved if the infringement had not occurred. A readily applicable method of measuring the damages is licence analogy. Thus, lost profits can reside in the possible lost royalties and/or in the decline in sales. It is worth emphasising that the plaintiff has to prove the direct causal relationship between the damage that it has suffered and the infringing activities.

The monetary remedies have more of a compensatory than a punitive character. Furthermore, anyone who appropriates someone else's authorship, misleads another party regarding authorship of an invention or otherwise infringes the rights of the creator to an inventive project shall be liable to a fine, limitation of freedom or imprisonment for a period of up to one year.

A person committing such an act for material or personal profit shall be liable to imprisonment for a period of up to two years.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Alternative means for resolution of patent disputes are available, but not commonly used in Poland (arbitration and mediation).

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is that it will do so?

Poland has signed neither the London Protocol nor the European Patent Litigation Agreement yet.

19. Are there any features of the enforcement system in your jurisdiction that you would like to point out?

The main feature of the patent enforcement proceeding is the so-called rule of evidence preclusion. Pursuant to this rule, it is necessary for the plaintiff to mention in the statement of claim all the statements relevant to the case and attach all evidence to support those statements, under the penalty of being precluded from serving the court with further evidentiary materials after the proceedings have started.