

Poland

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1 Ownership of marks

Who may apply?

Any natural or legal person or an organisational unit without legal personality (certain types of companies) can file an application for registration of a trademark. Foreign parties 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.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

The law provides that any sign capable of being represented graphically may be regarded as a trademark, provided that it is capable of distinguishing the goods or services of one enterprise from those of other enterprises. Three-dimensional marks may be registered; however, signs constituting the form or another feature of the goods or their packaging, which is exclusively dictated by their nature, is required to obtain a technical result, or gives substantial value to the goods, cannot be registered as a mark.

Sound marks may be registered as trademarks. It is also possible to register a colour per se as a trademark; however, it will only be registered if before the filing date it had acquired distinctiveness through intensive use and it is well known in Poland.

Service marks, jointly owned marks, collective marks and certification marks (collective guarantee marks) can also be registered as trademarks.

The rights of protection cannot be granted on absolute grounds for the following:

- (i) signs that cannot constitute a mark;
- (i i) signs that are not capable of distinguishing in trade the goods or services concerned;
- (i iv) signs that consist exclusively or mainly of elements that may serve, in trade, to designate the kind, origin, quality, quantity, value, intended purpose, mode of manufacture, composition, function or usefulness of the goods;
- (iv) signs that have become customary in the current language and are used in fair and established business practices;
- (v) signs constituting the form or another feature of the goods or their packaging, which is dictated exclusively by their nature or which is required to obtain a technical result or which gives substantial value to the goods;
- (vi) signs that were filed in bad faith;
- (vii) signs that are contrary to law, public order or morality;
- (viii) signs incorporating elements, such as, in particular, symbols of a religious, patriotic or cultural nature, insofar as these could hurt religious feelings, a sense of patriotism or national tradition;
- (ix) signs incorporating the symbol of Poland (emblem, national colours or national anthem), insignia of the forces, paramilitary organisation or security services, reproduction of Polish decorations, honorary distinctions or medals, military medals or military or other official or generally used distinctions and medals, in particular those of the government administration, local

self-administration or social organisations performing activities in the vital public interest where the activities of these organisations extend to the entire territory of the state or a substantial part of that territory, except if the applicant for registration can furnish evidence of his or her right to use the sign in the course of trade, in particular in the form of an authorisation issued by the competent state agency or a permission given by the organisation concerned;

- (x) signs incorporating the symbol (emblem, flag, armorial bearings) of other country, name, abbreviated name or symbol (emblem, flag, armorial bearings) of international organisations, and official signs or hallmarks indicating control and warranty adopted in other countries, if the prohibition of registration of these follows from international agreements, except if the applicant can furnish an authorisation issued by the competent authority and allowing him or her to use the sign concerned in the course of trade;
- (xi) signs incorporating officially recognised signs accepted for use in trade, such as safety marks, quality marks, hallmarks of legalisation, insofar as this could mislead the public with regard to the nature of such signs, unless the applicant can prove his or her right to use the sign; and
- (xii) signs that may mislead the public, in particular with regard to the nature, characteristics and geographical origin of the goods.

Grounds mentioned under numbers (ii)–(iv) do not apply if the trademark acquired distinctiveness through its use prior to the filing date.

Protection cannot be granted either for the following:

- signs that are protected name of plant variety and refer to the plant variety of identical or related plant species;
- signs intended for alcohol products, containing a geographical indication, where the alcohol product does not originate in the place indicated by that indication;
- signs containing geographical elements that, although being literally true as to the territory, region or locality in which the goods originate, are of such a nature as to mislead the public because they falsely represent that the goods originate in another territory famous for certain goods (in the case of homonymous geographical indications for wines and beers, protection may be accorded provided that the subsequent applicant who has later filed its application modifies its mark at the Patent Office's invitation so as to make it distinguishable from the mark earlier registered or applied for); and
- marks identical or similar to registered geographical indication, designation of origin, traditional expression for wine or geographical indication for spirits, if they are protected by law, if the marks are filed in respect of identical or similar goods.

3 Common law trademarks

Can trademark rights be established without registration?

The Polish legal system does not recognise a notion of 'common law trademarks'. In general, trademark rights are established by registration. The exception from this rule refers to 'well-known trademarks'. Such trademarks acquire protection not by means of being registered but through the actual use of a given trademark. In order to claim the right deriving from a well-known trademark, it is necessary to prove that a trademark has become well known among the public in the

territory of Poland, which appears very often to be complicated, time and money consuming process. Hence it is recommended a trademark registration be obtained even for well-known trademarks.

4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

It typically takes eight to 12 months from the date of application before a trademark becomes registered.

The official fee for filing a trademark application in up to three classes is 550 zlotys. The fee for electronic filing of trademark application in up to three classes is 500 zlotys. Where a trademark application covers more than three classes, there is an additional fee of 120 zlotys for each class. The official fee for trademark registration in one class of goods is 490 zlotys. The fee for additional second and third classes is 400 zlotys each, and the fee for each class over three is 450 zlotys. To sum up, the official fee for obtaining trademark registration in one class is 1040 zlotys.

In addition to the above, to calculate the full cost of obtaining a trademark registration, it is necessary to add the costs of a patent attorney representing the owner of the mark before the Polish Patent Office.

It is also required to file Power of Attorney signed by a person duly authorised to represent the Applicant in the application procedure. The Polish Patent Office also requires to present documents indicating that the person who signed the power of attorney was entitled to sign on behalf of the applicant at the date of signing power of attorney. This could be an extract from Court Register or Companies Register. Foreign entities that do not have such registers, must provide other documents that show the correct representation. It can be a written declaration of the person who signed the power of attorney of possessing execution abilities to sign on behalf of the company. Such declaration should be notarised by a notary public.

5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The applicable classification system is the International Classification under the Nice Agreement. Poland has been a party to the Nice Agreement concerning the international classification of goods and services for the purposes of the registration of marks (1957) since 4 March 1997. Since 2012 the 10th edition of the Nice Classification has been effective in Poland. Multi-class applications are available.

6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

Once the application has been filed, filing date and application number are accorded and fulfilment of formal requirements for filing trademark application are checked. Trademark application is disclosed on the Polish Patent Office website within two months from filing date. The following is disclosed to the public: trademark, priority date, application date and number, list of goods, applicant and place of applicant's residence.

At the next stage the Polish Patent Office examines classification and the list of goods or services, and absolute grounds for refusal, for example, whether the trademark is capable of distinguishing in trade the goods or services concerned, whether it is not descriptive, but also if it was not filed in bad faith. If the Polish Patent Office finds that an absolute ground for refusal exists, informs the applicant accordingly and invites to submit comments within one month (Polish parties) or

within two months (foreign parties). This period may be extended once by two months upon a written request of the applicant, filed before the end of the fixed period. If the objection is not overcome by the applicant's comments, the Polish Patent Office refuses the application.

Also third parties are allowed to file observations relating to the existence of an absolute ground for refusal. Observations can be made by third parties as long as the application is pending. The Patent Office issues a receipt to the party that submitted the observations, confirming that the observations have been received and have been forwarded to the applicant, however the observer does not become a party to the proceedings before the Polish Patent Office and have to inspect the Polish Patent Office website in order to check the status of the application. All observations are forwarded to the applicant, who is invited to submit comments within one month (Polish applicants) or within two months (foreign applicants). This period may be extended once by two months upon the applicant's written request filed before the end of the fixed period. The Patent Office considers whether the observations are well founded, that is, whether an absolute ground for refusal exists. If so, the Patent Office issues an objection and may refuse the application if the objection is not overcome by the applicant's comments.

Applications are not examined for potential conflicts with other trademarks; however, the Polish Patent Office sends to the applicant a report identifying earlier trademarks, protected in the territory of Poland, that could conflict with the application. The results of the search report are for information purposes only. Any surveillance letters informing holders of earlier trademarks about new, similar trademark applications, are not sent.

If the trademark is found registrable on absolute grounds, the application is published for opposition purposes. If any opposition is not filed within three months from publication date, or all oppositions filed are dismissed, the Polish Patent Office issues a decision granting the right of protection for the trademark and sets a three-month deadline for payment of the fee for trademark registration and for the first 10-year protection period. If the fee is paid on time, a certificate of protection is issued and trademark registration is published.

7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Use of a trademark is not required to obtain a right of protection in Poland. However once the mark has been registered it has to be used within five years of the registration date. Trademark use is not required to maintain the registration, but if the mark is not used within five years of the registration date, it will become vulnerable to cancellation on the ground of non-use upon request of a third party.

As from 15 April 2016 the party filing request for declaring lapse of a trademark registration due to non-use does not have to present a legitimate reason for filing such request.

8 Appealing a denied application

Is there an appeal process if the application is denied?

The motion for reconsideration of the matter can be filed with the Polish Patent Office against a decision refusing to grant the right of protection. The time limit for filing the motion is two months from the date of receiving the decision.

In the course of reconsideration, the Patent Office issues a decision, by which it either maintains the appealed decision, or reverts it in whole or in part, deciding the matter on its merits.

A final decision issued by the Patent Office is subject to a complaint with the District Administrative Court within 30 days of receiving the decision in writing.

9 Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Applications are published for opposition and third parties may oppose the application prior to registration. Oppositions are filed on relative grounds and must be based on earlier rights held or she by the opponent – owner of earlier mark or owner of earlier personal or economic rights. The primary bases of such challenges are:

- identity both between goods or services and between marks (likelihood of confusion is presumed, and need not be proved);
- identity or similarity between marks and identity or similarity between goods or services (there must be a likelihood of confusion);
- identity or similarity of the mark to earlier reputed trademark registered for any goods or services, if use of the filed mark, without due cause, would bring unfair advantage to the applicant or be detrimental to the distinctive character or the repute of the earlier (likelihood of confusion is not a condition for the application of this base);
- identity or similarity of the mark to a trademark that, before the priority date of the filed mark, has been well known in Poland and used as a trademark in respect of the identical or similar goods or services of another party (there must be a likelihood of confusion); and
- collision with earlier personal or economic rights (eg, company name).

Opposition has to be filed in Polish Patent Office in written form within the opposition period, namely within three months from the publication of the contested trademark application. Absolute admissibility requirements are:

- identification of the contested trademark (name and application number);
- identification of the parties to the proceeding (opponent and applicant);
- identification of grounds;
- identification of the earlier marks or rights;
- signature of the opponent or its representative; and
- payment of the fee for opposition.

The Polish Patent Office checks admissibility of the opposition and once the opposition has been found admissible, the Patent Office sends a notification to the parties informing them about possibility to settle the case amicably within two months of receipt of the communication. If both parties submit requests for an extension before the period expires, the Polish Patent Office grants an extension of six months at maximum. The parties must inform the Polish Patent Office about the outcome of negotiations before the expiry of the time limit for settlement.

After ineffective expiry of the time for settlement, the Polish Patent Office invites the applicant to submit a response to the opposition within one month (Polish applicants) or within two months (foreign applicants). This period may be extended once by up to three months upon the applicant's written request filed before the end of the fixed period. At this stage the applicant may demand that the opponent presents evidence of use of the earlier trademark on which the opposition is based.

Response filed by the applicant is sent by the Polish Patent Office to the opponent, who is invited to submit comments and to complete evidence supporting arguments raised in the opposition, including evidence on trademark use, if non-use claim was raised by the applicant. Opponent's comments are sent to the applicant, who is invited to submit last comments. The Polish Patent Office takes decision basing on submissions and materials filed.

The motion for reconsideration of the matter can be filed with the Polish Patent Office by any of the parties to the opposition procedure within two months of receipt of the decision in writing. In the course of

reconsideration, the Patent Office issues a decision by which it either maintains the appealed decision, or reverts it in whole or in part, deciding the matter on its merits. A final decision issued by the Patent Office is subject to a complaint with the District Administrative Court within 30 days of receiving the decision in writing.

A brand owner may oppose a bad-faith application in the way of filing observations against pending trademark application (see question 6) or a cancellation action against registered trademark.

The official fee for filing opposition is 1,000 zlotys. It is necessary to add the costs of a patent attorney representing the owner of the mark before the Polish Patent Office.

10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

Protection of a registered trademark begins on the date on which the application is filed and it lasts for 10 years from the date of application. The registration may be renewed for further 10-year periods. Use of the trademark is not required for its maintenance.

Applications for renewal must be accompanied by payment of the official fee and must be made 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 during the six-month period after the expiration of the renewal period). The Patent Office issues decisions on renewal of the right of protection for another 10-year protection period.

11 The benefits of registration

What are the benefits of registration?

Registration gives the exclusive right to use the mark in commerce for goods and services covered by registration in Poland. The owner of a registered mark may enforce its claims against infringers in proceedings before the Patent Office (opposition or cancellation action), the court (preliminary injunction, filing the statement of claim, civil or criminal proceedings, etc), or Customs Authorities (request for granting customs authority protection enabling the authorities to seize counterfeit goods on the border).

12 Licences

May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?

A licence agreement may be recorded against a registered trademark. Recordation of a licence in Trademarks Register is optional. Pursuant to provisions of the Industrial Property Law, the proper use of registered trademark is also the use of trademark by a third party with the right holder's consent. In case of cancellation action due to non-use, non-registered licence agreement between trademark owner and the party using the mark on the Polish market, should be sufficient document evidencing that the registered trademark is in use in Poland upon the registered owner's consent, so the trademark is properly used. The advantage of having the licence contract recorded in the Register is that the licensee of the exclusive licence may, to the same extent as the trademark owner, sue an infringer, unless the licence contract stipulates otherwise. The licence agreement must be in writing to be valid.

13 Assignment

What can be assigned?

Assignment of a trademark (whether registered or applied for registration) 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. After partial assignment the right of assignee will be treated as independent of the right of the assignor. Assignment agreement must be in writing to be valid. Any assignment must be recorded in the Register of the Patent Office to be effective against third parties.

14 Assignment documentation

What documents are required for assignment and what form must they take?

The documents required for recording assignment of a trademark registration or pending trademark application are:

- deed of assignment, signed by both parties; and
- power of attorney, signed by the assignee.

The deed of assignment must be signed by persons duly authorised to represent the parties to the agreement. The Polish Patent Office requires to present documents indicating that the persons who signed the assignment agreement were entitled to sign on behalf of the parties at the date of concluding the agreement. This could be an extract from Court Register or Companies Register. Foreign entities that do not have such registers must provide other documents that show the correct representation. These can be a written declaration of the person who signed the deed of assignment of possessing execution abilities to sign on behalf of the company. Such declaration should be notarised by a notary public.

15 Validity of assignment

Must the assignment be recorded for purposes of its validity?

The trademark assignment agreement must be in writing to be valid. It becomes effective against third parties from the date of being recorded in the Trademark Register. If it is not recorded in the register, it is exclusively binding upon the parties to the agreement.

16 Security interests

Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

The right of protection for a trademark may be the subject of a security interest agreement. Security interests are recorded in the Register of Pledges run by district courts. The request for recording a security interest in the register should be filed within a month of the date of signing the security interest agreement or the request may be annulled. It is required to record a security interest in the Trademark Register of the Polish Patent Office in the part regarding the trademark being the subject of the security interest as a limitation to the right deriving from registration of that trademark. To record a security interest in the relevant part of the Trademark Register regarding the subject trademark, it is necessary to file a security interest agreement or a notarised copy; however, such recordal does not affect validity or enforceability of security interest agreement.

17 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Marking is not compulsory. The owner of the protection right may use the symbol ‘®’ near the mark to indicate that the mark is registered. Using the symbol ‘®’ for an unregistered mark to give a false impression that it obtained protection is an offence subject to a fine. There is no risk if the symbol ‘®’ is not used. The benefit can be infringement prevention because of the indication that the trademark is registered. It also eliminates potential arguments on the lack of knowledge that the trademark is protected in the case of trademark infringement.

18 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

The Polish legal system provides the necessary instruments for the effective protection and enforcement of IP rights, including

trademarks. Rights holders mainly protect their rights through civil and criminal proceedings. Such proceedings can be taken in relation to actions raised in the marketplace, including online. Moreover, in order to extend the scope of protection against an alleged infringer rights holders may rely on administrative proceedings before the customs authorities and can use the border enforcement mechanism in accordance with Regulation (EU) 608/2013 of the European parliament and of the Council of 12 June 2013 concerning customs enforcement of IP rights. Customs protection is granted for one year, with a possibility of renewal.

Referring to marks registered before Polish Patent Office – national trademarks, it should be stated that there are no specialised courts for enforcing such trademark rights and cases concerning trademark infringement are handled by common civil courts. Regional courts are regarded as the courts of first instance for handling civil trademark cases. As to the European Union trademarks, based on the relevant EU Trademark Regulation, the specialised court the Community Trademark Court in Warsaw was established which deals with infringement cases as well as with invalidation counterclaims for infringement. This court examines cases on the basis of the EU Trademark Regulation and the relevant Polish law provisions (eg, the Code of Civil Proceedings). In these civil proceedings the motion for interim injunction may be filed to the court.

Regarding the criminal instruments of trademark protection, the Law provides a legal definition of a ‘trademark’ and a ‘counterfeit trademark’, and sets forth the criminal provisions on counterfeiting.

The owner of an infringed trademark is entitled to commence criminal action.

A party that either affixes a counterfeit trademark to goods with the intention of introducing them onto the market or commits acts resulting in the turnover of such goods may be subject to a fine, restriction of liberty or imprisonment for a maximum of two years.

The criminal regulations do not apply in situations where infringement has taken place in respect of an unregistered trademark, including unregistered famous and commonly known trademarks.

19 Procedural format and timing

What is the format of the infringement proceeding?

In infringement proceedings, the plaintiff submits all the relevant evidentiary materials to prove that the infringement has taken place. As a rule, the court does not consider any evidence ex officio. In a lawsuit or statement of claim the plaintiff should produce all the relevant evidence along with the statement of claim. As a general rule the parties may indicate facts, evidences to prove the claims or to defence the claims, requests or statements of the opposite party till the end of a trial. However, the court may disregard late statements or evidences, unless the party proves he or she failed to indicate them due to no fault of his or her own or that filing the late statements and evidence into consideration will not delay examination of the case, the parties may also refer to other exceptional circumstances. The court also disregards statements and evidence if they are only filed for the purpose of delay in examination of the case or disputable circumstances of the case have already been sufficiently clarified.

It should also be noted that the court may oblige the plaintiff and the defendant to file further pretrial pleadings, determine the time and order for filing them, and the circumstances and facts that should be clarified. In such situation the court may also disregard late statements or evidence, unless the party proves he or she failed to indicate them in the statement of claims, statement of defence or further pretrial pleadings due to no fault of his or her own, or that filing the late statements and evidence will not delay the examination of the case. The parties may also refer to other exceptional circumstances.

Documents, depositions of witnesses or depositions of the parties can be used as evidentiary materials. The court is allowed to appoint independent experts to submit written or oral opinions when specialist knowledge is necessary. The expert may be appointed from among the registered Polish patent attorneys or other highly qualified specialists in the relevant field. The opinions of private experts instructed by the parties will not be regarded as official documents.

As to the criminal proceedings only after filing a motion for prosecution an investigation can be started; it can then be continued ex officio. The exception is when ongoing profits are obtained from criminal

activity against a registered trademark, or when criminal acts result in the turnover of counterfeit goods bearing a trademark with significant value. In such case, the infringer is subject to more serious criminal penalties and an investigation may be started by the police or the public prosecutor ex officio. However, the party committing such criminal acts will be punished only if it is proved that the action was intentional.

A 'standard' infringement case is now usually handled before the court of first instance within less than one year from the date of filing the statement of claim. The appeal proceedings are usually handled within six to nine months of filing the appeal. In any event the timing of the case depends on the complexity of the matter, the strategy taken by the parties and the number of pending cases at the court.

20 Burden of proof

What is the burden of proof to establish infringement or dilution?

The burden of proof of establishing infringement rests on the plaintiff. As a rule, the plaintiff has to prove his or her rights to the trademark and that infringement has taken place, as well as other necessary circumstances, depending on the kind of the enforced claims. Additionally, as far as trademarks with reputation are concerned, it has to be proven that the use of the infringing mark may result in taking unfair advantage of the reputation of the mark in question, or may be detrimental to its reputation or distinctive character. The fact that a trademark is a mark with reputation, or it is well known, has to be proven by the plaintiff.

21 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

The trademark holder or an exclusive licensee recorded in the Trademark Register are lawfully entitled, unless it is stipulated otherwise in the licence agreement, to institute infringement proceedings. Criminal proceedings may generally be commenced upon a motion filed by the party suffering from infringement, usually the trademark owner.

22 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

Generally, only the acts performed in the territory of Poland will be regarded as significant in infringement or dilution proceedings. However, when the goods or packaging are marked with the infringing trademark, and are subsequently exported from, or imported to, Poland, that kind of use is deemed to be the use of the trademark in Poland and may infringe the rights to that trademark. The issue of exporting or importing the goods bearing confusingly similar designation to a given trademark is connected with the customs protection of trademarks

23 Discovery

What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

Pursuant to the Polish Code of the Civil Proceedings, there are some special means of obtaining evidence, in particular:

- the court may order any person (an adverse party or a third party) to submit any documents relevant to the proceedings that are in that person's possession, unless the document contains state secrets;
- if any party refers to trade books, the court may require them to be surrendered to the court; or
- security of evidence is possible if there is a risk that producing the evidence may be impracticable, may be impeded, or if it is necessary to ascertain the relevant facts for any other reasons.

The trademark owners have been able, in separate proceedings (apart from the main civil proceedings), to ask the court to impose on the defendant or a third party an obligation of delivering information, in particular the following:

- the origin of counterfeit goods;

- the distribution network of counterfeit goods;
- names and addresses of manufacturers and suppliers; and
- the amount of goods that were manufactured, sold and put in trade, etc.

With regard to collecting evidence from parties outside Poland, the Hague Convention of 18 March 1970 on the taking of evidence abroad in civil and commercial matters will apply. In relation to EU member states, Council Regulation (EC) No. 1206/2001 of 28 May 2001 on cooperation between the courts of the member states in the taking of evidence in civil or commercial matters will apply.

24 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

Court proceedings last between two and three years (including proceedings before the Court of Appeal), depending on the complexity of the matter, the strategy taken by the parties and the number of pending cases at the court. There is no general rule, however, and in some cases it can take longer to complete the proceedings.

25 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

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 litigation. The costs of representation, or the costs connected with entering and handling the court proceedings, and the costs of preparing and filing the relevant documents, also have to be taken into account. As a rule, the losing party bears the costs of the court proceedings, but only to a certain extent. In practice the losing party will recover only a part of the costs actually incurred. Recoverable costs are the costs necessary for the purposeful enforcement of rights and purposeful defence: incurred by the legal costs – such as the payment of a fee to the lawsuit, appeal or complaints as well as the costs of participation in the court case especially connected with the court representation by the professional lawyer. But in any case the amount cannot be higher than the remuneration resulting from the Regulation of the Minister of Justice on fees for lawyers (legal counsel).

26 Appeals

What avenues of appeal are available?

A decision of the court of first instance is subject to appeal before the court of second instance. The appeal should be filed with the court of first instance that issued the appealed decision within two weeks of the date of delivery of that decision, along with the reasons in writing to the interested party. From there it will be passed on to the court of second instance. The court of appeal reviews the case within the limits of appeal. Only nullity of the appealed decision is considered ex officio. In some circumstances, explicitly set out by law, a decision of the court of second instance may be subject to further appeal (cassation) at the Supreme Court. The cassation should be filed within two months of the date of delivery of the decision of the second instance court to the interested party along with the reasons in writing.

27 Defences

What defences are available to a charge of infringement or dilution, or any related action?

Different defences are available depending on the particulars of the case. The usual step is to begin litigation before the Polish Patent Office, where one can claim cancellation of the opposite party's trademark or its lapse due to non-use. Pending action before the Patent Office may be used as a protective measure against an action before the court. As the actions are handled by two different institutions (trademark infringement by civil courts; trademark cancellation or lapse by the Patent Office), often starting the proceedings before the Patent Office triggers suspension of the proceedings before the court until the Patent

Office issues a decision on the cancellation or lapse of the mark in question. Another way is to prove to the court that the alleged infringer has its own rights to exploit the trademark, for example, as a prior user, or that the sign is not identical or similar to the registered trademark and neither are the goods or services, and there is no likelihood of confusion. Using a sign to indicate the kind, quality, quantity, intended purpose, value, geographic origin or date of production of the goods is not deemed to be infringement of another party's trademark. Thus, such circumstances may challenge the infringement claims. The alleged infringer can also set forth a claim for exhaustion of rights. It can be raised objection of limitation claims. In dilution cases, the alleged infringer additionally contests the reputation of the subject trademark.

28 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc?

The trademark holder (or any other person entitled by law) whose rights have been infringed – the trademark right will be deemed to have been infringed when the infringer has used the trademark unlawfully in the course of trade – may demand from the infringer:

- cessation of the infringement;
- surrender of the unlawfully obtained profits; and
- if the infringement was deliberate, compensation for damages:
 - in accordance with the general principles of the Civil Code; or
 - by payment of a lump sum equivalent to a licence fee, or any other remuneration, which would have been due to the patent holder at the date of the demand if the infringer had been authorised by the patent holder to use the invention.

At the request of the plaintiff, the court may decide on the infringing products or other means and materials that were used for manufacturing the infringing products. In particular, the court may decide on withdrawing them from the market.

When judging on the infringement of a trademark the court may also, at the holder's request, decide to publish the judgment in full or in part, or the mention of the judgment, in a manner and at the scope as specified by the court.

Compensation for damages includes actual lost earnings as well as any profits that the trademark holder would have achieved if the infringement had not occurred. A readily applicable method of measuring damages is licence analogy. Thus, lost profits can result in possible lost royalties or in a decline in sales. It is worth emphasising that the plaintiff has to prove a direct causal relationship between the damage that he or she has suffered and the infringing activities.

At the request of the infringer and in case of non-deliberate infringement, and provided that cessation of the infringement and a sentence regarding the unlawfully obtained products or the means used in their production would be unsuitably and excessively painful to the infringer, or both, the court may sentence the infringer to pay a duly suitable amount of money on behalf of the trademark owner.

The monetary remedies are of a compensatory rather than punitive character.

A request for a preliminary injunction may be filed before the commencement of infringement proceedings, at the moment of filing the statement of claim or once the court proceedings have begun. If the request for a preliminary injunction is filed before starting of the proceedings before the court, upon issuing a decision to grant the preliminary injunction, will set 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. To obtain a preliminary injunction it is necessary to prove the legal interest in requesting such injunction, justify the grounds for filing the request for an injunction and indicate the way in which the injunction should take place (seizure of goods in the infringer's warehouse, ban on further sale, etc).

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 judgment, the alleged infringer is entitled to demand compensation for the damages arising from the preliminary injunction order.

As a result of criminal proceedings, the party committing a crime in the form of introducing goods onto the market bearing a counterfeit trademark may be sentenced to a fine, limitation of liberty or up to two years' imprisonment. The court will also decide on the forfeiture, for the benefit of the State Treasury, of the goods which have been the subject of crime, or any materials, instruments and technical means that were used or were intended for the commission of the crime, even if they are not the perpetrator's property.

29 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

ADR techniques for resolving of trademark disputes (arbitration and mediation) are available, but they are not so commonly used in Poland. But this is changing. The institution of mediation in civil proceedings has been significantly strengthened from 2016. Mediation gives the parties greater than arbitration discretion in determining the rules of procedure and the shaping of mutual relations. Not to be underestimated is also the fact that in the context of the mediation procedure the parties manage existing conflict between themselves and it is only down to them whether the conflict can be solved. The role of the mediator here is not of a judge but a kind of impartial adviser, not that of a party and judge, but to create a situation in which the parties find common ground. In addition, mediation is not public and the mediator is obliged to keep secret everything he or she has learned in the course of the mediation. When assessing the benefits of mediation generally also it indicates that sides reconciled through mediation more often voluntarily perform obligations owed to the development of co-settlement than is the case in court judgments.

The arbitration court verdict or settlement are equally binding as the judgment or settlement concluded before a common court after

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their recognition by the common court or after finding their feasibility. The informal character of those proceedings enables the parties to avoid lengthy and time-consuming court proceedings and helps the parties reach a satisfactory and amicable settlement.

30 Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

Under the Polish regulations, protection of unregistered trademarks is possible. The Polish regulations do not provide for a separate category of famous marks, yet the provisions relating to renowned trademarks may also be applied to these marks. Their protection is broader than protection deriving from a regular trademark registration as it is not limited to the goods or services covered by the registration, but covers

any goods or services, if trademark use could bring undue profit or be detrimental to the distinctive character or renown of a trademark.

In the case of renowned marks, it is necessary to prove the renown of the trademark in Poland, namely to submit the materials demonstrating the duration, methods, range of use in Poland, promotion expenditures, public opinion polls showing the brand awareness and indicating which positive associations the mark evokes, trademark value assessments, market share in terms of quantity and value of the goods sold, etc.

The protection of famous marks not used in Poland may be enforced on the basis of the provisions of Law on Combatting Unfair Competition, which defines an act of unfair competition as 'any activity in violation of the law or good practice if it threatens or impairs the interest of another entrepreneur or customer'.