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TRADEMARKS IN POLAND – PROTECTION AND ENFORCEMENT

1. Sources of Law

The main Legal Act on trademark protection in Poland is the Law on Industrial Property of June 30, 2000, containing also provisions regarding patents, utility models, industrial designs and topography of integrated circuits, effective as from August 22, 2001 with later amendments.

As far as International Treaties related to trademarks are concerned, Poland accepted the Legal System under several International Treaties which have the same legal effect as the regulations directly established by the Parliament. These Treaties are:

Paris Convention (International Union) 1883- 1967; Madrid Agreement concerning the International Registration of Marks (Madrid Union) 1891- 1967; Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks (Nice Union) 1957-1977 (with effect from March 4, 1997); Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks 1973 (with the reservation provided for in Article 4(5); bound with effect from March 4, 1997); Protocol Relating to the Madrid Agreement concerning the International Registration of Marks (Madrid Union) 1989, with a declaration under Article 5(2)(b) (with effect from March 4, 1997).

Since May 1, 2004 (accession to the EU) Poland has been bound by all “aqui communautaire” including the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trademark. The said regulation is a part of the Polish Legal system and is used by Polish Courts, especially by the Court for the Community Trademarks and Community Designs which is located in Warsaw.

Protection of a mark in Poland may be obtained not only by national registration or, for parties entitled to the benefits of the Madrid Agreement and/or the Madrid Protocol, by international registration of the mark extending to Poland. It is also possible to obtain protection through registration of the mark as a Community Trademark extending at once to all member states of the European Community (European Union) including Poland.

2. Registration of trademarks and related procedures

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.

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 on refusal of protection under the Madrid Agreement within one year. A decision on refusal of protection under the Madrid Protocol, on the other hand, must be announced within 18 months. Following a decision on refusal of protection, 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, 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.

3. 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*.

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 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.