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Trade Marks 2022

Poland: Law & Practice

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Law and Practice

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1. GOVERNING LAW AND TYPES OF TRADE MARKS

1.1 Governing Law

Trade mark rights in Poland are regulated by:

- the Industrial Property Law (30 June 2000) (IPL);
- Directive (EU) 2015/2436 (the “EU Trade Marks Directive”); and
- EU Regulation 2017/1001.

Case law only interprets these statutes.

Moreover, Poland is a party to, among others:

- the Paris Convention;
- the Madrid Agreement and Protocol;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- the Nice Agreement.

1.2 Types of Trade Marks

A trade mark can be any sign that allows one to distinguish the goods or services of one entity from the goods or services of another, and that can be presented in the trade mark register in a way that allows the unambiguous determination and precise subject of protection granted on the mark. There are many types of trade marks: word, figurative, device, shape, positional, pattern, sound, colour, movable/multimedia, hologram, and others. It is also possible to protect a collective mark or guarantee mark if the holder(s) submit(s) to the Polish Patent Office (PPO) regulations concerning the terms and conditions for the use of such mark. The equivalent of certification marks is the collective guarantee mark.

In Poland, the use of a surname as a trade mark is not regulated in any special way. The surname must meet the general conditions in order to be registered.

1.3 Statutory Marks

Poland is a member of the Paris Convention, which, in Article 6ter, protects flags, state emblems, official signs and hallmarks, names of international organisations, etc, against unauthorised registration and use as a trade mark. Consequently, the unauthorised use of such signs (names) – including the Olympic name and Olympic symbols – is illegal (see also **4.9 Refusal of Registration**).

1.4 Well-Known Foreign Marks

If a well-known trade mark is not used in Poland or registered as a national or EU trade mark, no protection is afforded. Well-known marks must be recognised as a trade mark in the whole of, or a significant part of, Poland. The issue of whether they must be used in Poland is controversial. The burden of proof of recognition of a trade mark among Polish recipients lies with the trade mark owner.

1.5 Term of Protection

The protection is granted for ten years, counting from the date of application with the PPO. The protection may be extended for ten-year periods.

1.6 Exhaustion of Trade Mark Rights

The requirements of an exhaustion of trade marks in Poland are identical to those of all EU members, which means that: “the use of the trade mark cannot be prohibited in relation to goods which have been put on the market in the EEA under that trade mark by the proprietor or with his consent.”

Consequently, rights are not infringed by, eg, the importation of goods bearing the trade mark, if the goods were previously (legally) introduced in the EEA by the holder or with the holder’s consent.

1.7 Symbols to Denote Trade Marks

Once a trade mark is registered, the owners can use the symbol ®. However, before obtaining registration, the use of this symbol is a criminal offence punishable by a fine.

2. ASSIGNMENT AND LICENSING

2.1 Assignment Requirements or Restrictions

The assignment of a trade mark must be concluded in a written form under the pain of nullity. Moreover, such written assignment is effective in respect of third parties upon being entered into the PPO register. The recording is done via official letter with the original or certified copy of the assignment agreement attached.

2.2 Licensing Requirements or Restrictions

The holder of a trade mark may authorise another party to use the trade mark under a licence agreement. A trade mark licence may be sole, exclusive or non-exclusive. A trade mark licence must be concluded in a written form on pain of nullity. A licensee may grant a sub-licence for the use of the trade mark within the scope of authorisation granted to them.

2.3 Registration or Recording of the Assignment

The agreement may be registered with the PPO upon the request of each party to the agreement. The holder of an exclusive licence recorded in the register may, in the same way as the trade mark holder, enforce their claims in the event of infringement, unless the parties agreed otherwise.

The IPL does not stipulate any obligations to register the licence. However, registration makes the licence effective against third parties.

In the case of a gap between the assignment or the licence taking effect and its registration, the principle of presuming the truthfulness of the data entered into the register must be adopted.

2.4 Other Requirements for Licences or Assignments to be Valid

There are no additional requirements that must be met to validate the licence.

2.5 Assigning or Licensing Applications

A trade mark application can be a subject of assignment or even a licence agreement. However, such licence agreement cannot be recorded in the register.

2.6 Trade Marks as Security

A trade mark can be given as a security, be assigned by way of security, or be levied in execution, etc. The PPO makes an entry into the register on the encumbrance of the right with a security.

3. REGISTRATION

3.1 Trade Mark Registration

To obtain trade mark rights, one must acquire registration. Unregistered trade marks are not recognised in Poland as proprietary rights that confer an exclusive subjective right, with the exception of well-known marks. There are no different standards to register different types of marks. Trade marks devoid of a distinctive character can be registered if they acquire a secondary meaning.

3.2 Trade Mark Register

The decision on trade mark protection is rendered by the PPO, which keeps a trade mark register. There is only one register of trade marks. The register is public, available online (even in an English version) and is free of charge. Trade

mark searches before applying for registration are highly recommended, but are not obligatory.

3.3 Term of Registration

It usually takes between eight and ten months from a trade mark application to registration if no opposition has been lodged. The trade mark can be renewed within a six-month grace period after the deadline. The owner must pay an extra fee for late payment/renewal. There is no restoration procedure.

3.4 Updating or Refreshing Registrations

Any ownership changes or changes of the owner's address must be updated in the register.

4. APPLYING FOR A TRADE MARK REGISTRATION

4.1 Application Requirements

A natural or legal person can apply for a trade mark. The application can be filed by the applicant or its professional representative. However, persons whose place of residence or registered office is not within the territory of the EU must act through professional representatives; eg, patent attorneys, attorneys-at-law and advocates. One application may cover one trade mark exclusively. However, multi-class applications are allowed.

The application must include:

- the name and address of the applicant;
- the number from the National Commercial Register (if applicable) as well as the excerpt;
- graphical representation of the trade mark;
- the list of goods and services in accordance with the Nice Classification; and
- the signature of the applicant or representative, and proof of payment of the application fee.

If a trade mark application is filed by a representative, a written power of attorney is required, together with documents confirming authorisation of the person who signed the document.

As to what can be registered as a trade mark, see **1.2 Types of Trade Marks**.

4.2 Use in Commerce Prior to Registration

The use of a trade mark is not a condition for registration. A trade mark must be put to genuine use before the lapse of a five-year grace period for non-use commencing with registration. Otherwise it may be revoked. However, a trade mark application with no real intent to use may indicate the applicant's bad faith and lead to invalidation of the mark.

4.3 Series Mark Registrations

One application may cover only one trade mark.

4.4 Consideration of Prior Rights in Registration

During the examination procedure, the PPO does not examine relative grounds for refusal (collision with earlier rights), which may only be raised by third parties in opposition proceedings and after registration, in cancellation proceedings. It is possible for a trade mark owner to provide a letter of consent to permit subsequent registration.

4.5 Consideration of Third-Party Rights in Registration

Third parties have the right to participate in trade mark registration proceedings through filing an opposition proceedings or by submitting third-party observations. The right to file an opposition is limited to earlier trade mark owners, the proprietors of earlier personal (moral) or economic rights, eligible to be infringed by trade mark registrations. A demonstration of no legal/commercial interest is needed.

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4.6 Revocation, Change, Amendment or Correction of an Application

Until the final PPO decision, the applicant may withdraw the application. Changes of, or modifications to, the application are allowed; however, this cannot result in changes of the essence of the trade mark or an extension of the list of goods and services. However, restrictions in the list of goods and services are allowed.

4.7 Dividing a Trade Mark Application

Dividing a trade mark application is possible. To perform a division, an application should be submitted to the PPO by the co-owners, indicating the conversion of the trade mark to a collective trade mark and enclosing a declaration on the use of the collective trade mark by the co-owners, granting each of them the right to use the trade mark in relation to particular goods and services.

4.8 Incorrect Information in an Application

Providing incorrect information in connection with a trade mark application may constitute grounds to refuse the trade mark. Decisions on this matter are rendered by the PPO. However, the applicant may correct information until the final decision is issued. The changes/corrections cannot affect the essence of the trade mark, and cannot extend the list of goods and services.

4.9 Refusal of Registration

The IPL distinguishes absolute and relative grounds of refusal. However, examination of relative grounds is conducted by the PPO only in the case of an opposition submitted by the interested party; eg, a prior trade mark or other personal (moral) or economic rights owner.

Refusal on absolute grounds relates to signs that:

- cannot constitute a trade mark;

- are not capable of distinguishing, in trade, the goods for which they have been applied;
- consist exclusively of elements that may serve in trade to designate, in particular, the kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function, or usefulness of the goods (services);
- consist exclusively of elements that have become customary in the current language and are used in fair and established business practices;
- constitute the form of the goods, are dictated exclusively by their nature, are necessary to achieve a technical result, or significantly increase the value of the goods;
- have been applied for protection in bad faith;
- are contrary to public order or morality;
- incorporate an element that is a symbol, especially of a religious, patriotic or cultural nature, incorporate the symbol of the Republic of Poland (emblem, national colours or national anthem), the insignia of the armed forces, etc;
- contain a symbol (armorial bearings, flag or emblem) of another country, name, its abbreviation or symbol (armorial bearings, flag or emblem) of an international organisation or is adopted in another country's official sign, hallmarks indicating control and warranty, if such prohibition follows from international agreements, unless the applicant produces the authorisation of a competent authority that permits the use of such sign in the course of trade;
- contain officially a recognised sign adopted to be used during trade, especially a safety sign, quality label or hallmark of legalisation to the extent that the sign may mislead the public as to its nature unless the applicant may prove their right to use the sign;
- may mislead the public as to their nature; in particular, as to the nature, quality or geographic origin of the product; or

- constitute a protected name of plant variety and relate to a plant variety of the same or related species.

4.10 Remedies against the Trade Mark Office

Once a trade mark is refused, the applicant may file for the re-examination of the decision with the PPO within two months of receiving the Office's decision. If the Office upholds the refusal, it may be appealed to the Administrative Court in Warsaw within 30 days (of receiving the decision). The Polish legal system allows for a cassation appeal to the Supreme Administrative Court (NSA) against the judgment of the Administrative Court.

4.11 The Madrid System

Poland has been a member of the Madrid system since 18 March 1991 and adopted both the Madrid Agreement and Protocol. There are no specific requirements for international registration processing. Poland made a declaration under Article 5(2)(b) of the Protocol and extended the refusal period to 18 months.

5. OPPOSITION PROCEDURE

5.1 Timeframes for Filing an Opposition

Within three months from the date of the publication about the trade mark application, or designation in the case of international registrations, in the PPO Bulletin, the holder of an earlier right may file an opposition. The term is not extendable.

5.2 Legal Grounds for Filing an Opposition

The legal grounds for opposition are as follows:

- the use infringes a third party's personal (moral) or economic rights;

- the trade mark applied for is identical to a trade mark registered with earlier priority for identical goods and/or services;
- the trade mark applied for is identical or similar to a trade mark registered with earlier priority for identical or similar goods and/or services and there is a likelihood of confusion on the part of the public; this includes, in particular, the risk of association between the opposing marks;
- the trade mark applied for is identical or similar to a renowned trade mark registered with earlier priority, irrespective of whether the goods or services are not similar, and the use of a subsequent trade mark without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier trade mark;
- the trade mark applied for is identical or similar to a trade mark that, before the priority date of the subsequent mark, was well known in the Republic of Poland and commonly used for identical or similar goods and/or services, and there is a likelihood of confusion on the part of the public; this includes, in particular, the risk of association between the opposing marks; and
- if, under the national legislation or the EU law providing for the protection of geographical indication or designation of origin, the person authorised to exercise the rights arising from prior application – as long as such indication or designation has been registered – may prohibit using the trade mark at a later date.

5.3 Ability to File an Opposition

An opposition can be filed by any entity that is the owner of the prior trade mark or the proprietor of earlier personal (moral) or economic rights eligible to be infringed by trade mark registrations. Representation by professional representatives is not obligatory.

The opposition fee is PLN600.

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5.4 Opposition Procedure

The opposition must be submitted within three months of the publication of an application for registration in the PPO Bulletin. The term is not extendable.

The opposition must:

- designate the parties; and
- raise relevant earlier rights that may be affected by the registration of the subsequent mark.

Once the opposition is lodged, the PPO will notify the parties of the possibility of settling the matter amicably within two months of receiving the notification (cooling-off procedure). The term may be extended to six months. If no amicable settlement is forthcoming, the applicant is invited to submit their observations together with supporting evidence.

The applicant is entitled to request the opponent to provide proof of use of its earlier trade mark.

The party that disagrees with the PPO decision can submit a request to re-examine the case or appeal to the Administrative Court in Warsaw once the decision is final (within 30 days from receiving the final decision).

5.5 Legal Remedies against the Decision of the Trade Mark Office

The party that disagrees with the PPO decision can submit a request for the PPO to re-examine the case, then appeal to the Administrative Court in Warsaw once the decision is final (within 30 days from receiving the final decision).

The timescale is as follows:

- the re-examination takes approximately four to eight months; and

- the appeal procedure before the Administrative Court takes approximately ten to eighteen months.

6. REVOCATION / CANCELLATION PROCEDURE

6.1 Timeframes for Filing Revocation/ Cancellation Proceedings

Revocation actions cannot be filed within a five-year grace period for non-use commencing with the registration.

The invalidation of a trade mark cannot be filed – due to a collision with an earlier trade mark or violation of earlier personal (moral) or economic rights, eligible to be infringed by trade mark registrations – if, for a period of five years of the use of the registered mark, the applicant, being aware of its use, did not take any legal actions against the trade mark owner (acquiescence).

6.2 Legal Grounds for Filing a Revocation/Cancellation Proceeding

A trade mark may be invalidated on request of, in whole or in part, the proprietor of earlier rights with regard to relative (see **5.2 Legal Grounds for Filing an Opposition**) as well as absolute grounds (see **4.9 Refusal of Registration**).

The trade mark can be revoked:

- on the failure to put the trade mark to genuine use for the goods (services) covered by the registration for a period of five successive years after the registration was completed;
- on the loss of distinctive features for the reason that, in consequence of the owner's acts or negligence, it has become, in the course of trade, a customary mark consisting exclusively of elements that may serve to indicate the goods; the process, time or place of its

manufacturing; or the composition, function or usability of the goods, in respect of the goods for which the trade mark has been registered; or

- as a consequence of the right-holder's actions or by a third-party's actions with the right-holder's consent, where the trade mark is likely to mislead the public as to, in particular, the nature, quality, characteristic features or origin of the goods.

6.3 Ability to File a Revocation/ Cancellation Proceeding

The application for the invalidity of a trade mark may be filed by any person as long as it is based on absolute grounds. However, if relative grounds are invoked, only the entitled person may submit the request. Anyone may file to revoke a registered trade mark without the need to prove its legal/commercial interest or other entitlement.

6.4 Revocation/Cancellation Procedure

A trade mark may be cancelled in proceedings before the PPO as well as based on a counterclaim in infringement proceedings before the IP court (see **7.7 Lawsuit Procedure**).

6.5 Partial Revocation/Cancellation

Partial cancellation or revocation is possible. There are no special circumstances to file for partial cancellation/opposition.

6.6 Amendment in Revocation/ Cancellation Proceedings

Amendments are possible only with respect to the list of goods and services.

6.7 Combining Revocation/Cancellation and Infringement

The above-mentioned legal actions cannot be heard together before the PPO. However, if the defendant in the counterclaim raises both invalidity and revocation grounds, the court would

first examine the former (see also **7.8 Effect of Trade Mark Office Decisions**).

The timings for revocation and cancellation procedures are similar and take approximately 12 to 18 months.

6.8 Measures to Address Fraudulent Marks

The trade mark may be invalidated if it was applied for in bad faith. This also applies to a trade mark filed by a dishonest agent.

7. INITIATING A LAWSUIT

7.1 Timeframes for Filing Infringement Lawsuits

The period of prescription for claims of infringement is three years, counted separately in respect of each individual infringement, from the date when the right-holder became aware of the infringement and about the infringer's identity. However, in any case, the claims would become time-barred after five years from the date on which the infringement occurred. In practice, a claim for injunctive relief is not subject to the statute of limitations as long as the infringement continues. Claims arising from infringements occurring prior to the trade mark registration have their limitation period suspended until the registration date.

7.2 Legal Grounds for Filing Infringement Lawsuits

Enforcement of registered and unregistered trade marks is mainly pursued through civil proceedings. The protection of registered trade marks and well-known marks is based on the provisions of the IPL, which are harmonised to the extent required by the EU Trade Marks Directive.

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Preliminary and interim injunctions are available in registered and unregistered trade mark infringement cases. The claimant must substantiate their claims and legal interest to acquire the court order (see **9.1 Injunctive Remedies**).

Registered Trade Mark

Infringement actions can lead to obtaining the prohibition of the use of the sign in trade for identical or similar goods and services based on earlier trade mark rights. Except for double identity, where the use of that sign by the defendant must affect, or be capable of affecting, the functions of the trade mark, the trade mark is protected against the risk of public confusion. Reputable trade marks are also protected in the case of the use of identical or similar marks for dissimilar goods (services) where the use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

Enforcement can also be initiated in the case of a threat of infringement. The right-holder seeking protection may demand that the defendant's activity that threatens to infringe their right be ceased.

An owner of a registered trade mark is also allowed to prohibit the transit of goods from third countries, which will not be offered in Poland unless the right-holder is not entitled to prohibit the placing of the goods on the market in the country of final destination.

Poland has also introduced provisions that allow a right-holder to pursue the indirect infringement of trade mark rights against third parties whose services were used, or allowed another party, to infringe those rights.

Unregistered Trade Marks

Unregistered trade marks are not recognised in Poland as proprietary rights that confer an

exclusive subjective right and, thus, allow their owner to exclude or prevent others from unlawfully using the sign. Thus, protection of unregistered trade marks is based on the provisions of the Act on Combating Unfair Competition (16 April 1993), which expressly prohibits, inter alia, such designation of goods or services, or absence thereof, that might mislead customers as to their commercial origin. Protection against acts of unfair competition confers with the first use in trade and requires the claimant to demonstrate the use of their trade mark also at the time the proceedings are initiated. Polish doctrine and jurisprudence also recognise, as an act of unfair competition, "parasitic" free-riding on the reputation of someone else's unregistered trade mark. This is understood as reaching for someone else's market place to unlawfully build up one's own position.

Cybersquatting

Polish law does not set forth any specific provisions relating to cybersquatting. Therefore, the claimant must demonstrate that holding, or the use of, the domain name under the contested sign leads to an infringement of the trade mark or constitutes an act of unfair competition as set out above. Thus, it is often not easy to take action against cybersquatting due to the often missing content of the website linked to the domain. Furthermore, the holding of domain names for speculative purposes without the intention of using them would most likely not be considered as an unlawful action. However, the act may become abusive if the domain owner offers such unused domain name to the earlier trade mark owner. Moreover, the owners of reputable or well-known trade marks are in a better position in such situations.

Criminal Offence

In parallel to civil infringement actions, the claimant may initiate criminal proceedings to obtain criminal sanctions (see **8.9 Trade Mark**

Infringement as an Administrative or Criminal Offence). In the case of infringements of a limited scale – eg, the sale of counterfeit goods – this is often the preferred course of action due to the lower costs of proceedings.

7.3 Parties to an Action for Infringement

Trade mark infringement actions can be initiated by the trade mark owner as a claimant and at least one third party as an alleged infringer. Unless otherwise provided for in the licence agreement, the licensee may bring an action for trade mark infringement only with the consent of the trade mark owner. However, the exclusive licensee may bring such action if the trade mark owner, despite prior notice, does not bring an action for trade mark infringement within the relevant time limit. To obtain compensation for the damage suffered, the licensee may join a trade mark infringement case initiated by the right-holder.

7.4 Representative or Collective Actions

A claim for damages arising from an act of unfair competition is capable of being pursued in collective proceedings in Poland. Although there is no current legal practice in terms of collective actions regarding the unlawful use of a third party's trade mark, it is theoretically possible that at least ten consumers may initiate such proceedings against the party that designated its goods or services in such a way (or in absence thereof) that it misled recipients as to their commercial origin.

7.5 Prerequisites and Restrictions to Filing a Lawsuit

Trade Mark Registration

Claims arising from the infringement of a trade mark may be enforced only after registration. Claims for trade mark infringement, if the infringer acted in good faith, may be brought for the period starting after the day on which the PPO

publishes information on the application. If the infringer was notified beforehand, from the day of such notice.

Notice of Infringement

Serving a notice of infringement prior to a lawsuit is not a condition sine qua non for filing a lawsuit. However, if the defendant immediately concedes the claims as justified, the trade mark owner usually has to bear the legal costs of the proceedings.

Attempt at Voluntary Settlement

The claimant is not obligated to negotiate a voluntary settlement before the lawsuit. However, in the statement of claim it is required to declare whether such an attempt was made, because the lack of such declaration will trigger the return of the lawsuit.

Furthermore, there are restrictions on the trade mark owner asserting their rights according to specific trade mark law rules and restrictions based on general principles under Polish civil law (see **8.6 Defences against Infringement**).

Prior User Rights

Any third party conducting a small local business that used in good faith, in a priority date, a mark subsequently registered as a trade mark is still entitled to use this marking free of charge to an extent not greater than previously. This right on the request of an interested party may be entered into the trade mark register. Additionally, this right may be transferred to another person only together with an enterprise.

Abuse of Rights

The assertion of rights under trade mark registration is also subject to review from the perspective of legal provisions prohibiting the abuse of rights (acting in bad faith or contrary to good morals). In such circumstances, the court may refuse to enforce the claim.

7.6 Initial Pleading Standards

Statement of Claim – General Requirements

The structure of a statement of claim does not differ from the structure applicable in general civil or commercial proceedings. A claim must contain the description of facts (which should show that the claimant owned the IP right and it was infringed by the defendant), a description of the evidence proving such facts, and specific remedies demanded from the defendant. For monetary claims, this means a fixed amount of claim must be entered into the statement of claim. Additionally, the general formalities required by Polish civil procedure must be met. Theoretically, legal arguments are not an obligatory part of the statement of claim but, in IP matters, the requirement to show the existence of the IP rights being enforced, and by what action it can be infringed, blurs the line between legal and factual arguments.

Evidence

Motions to admit evidence must describe the facts that the claimant intends to prove, and evidence by which they want to prove it. The main types of evidence are documents and similar evidentiary means (printouts, photos, etc), testimonies of witnesses, and expert opinions. The statement of claim should assert the existence of all elements of the infringement and all facts supporting the specific remedies claimed in the claim, and put forward all evidence necessary to prove those assertions. This, in particular, pertains to disputes where the claimant is considered to be a business (eg, a company). In such litigation (called “commercial proceedings”), the claimant may only provide additional evidence if it has become possible or necessary after filing the statement of claim and not later than 14 days from the day when such possibility or need arose. The statement of claim also, generally, cannot be modified in such proceedings.

7.7 Lawsuit Procedure

Specialised IP Courts

Actions for the infringement of IP rights, including trade mark cases, are brought before the specialised IP divisions of four District Courts in Warsaw, Poznań, Gdańsk, Katowice, and Lublin. Only the Courts of Appeals in Warsaw and Poznań are competent to decide in the second instance. Judgments of the Courts of Appeals are binding and enforceable, but can be challenged by way of an extraordinary means of appeal; notably, a cassation appeal on points of law or errors of procedure to the Supreme Court. The cassation appeal may only be filed if the judgment of the second-instance court is obviously erroneous, subject to grave procedural errors qualifying it as an invalid judgment in Polish procedure, or if the matter involves a material legal issue, or gives rise to serious doubts or differing judgments of lower-instance courts.

Compulsory Representation

A party in an IP dispute must be represented by an advocate, attorney-at-law or patent attorney, unless the value in dispute is less than approximately EUR4,500 or a court waives such obligation if the circumstances do not require professional representation.

Attorney and Court Fees

Attorney fees and court fees are subject to the value in dispute and the activities of the attorney (see **8.10 Costs of Litigating Infringement Actions**).

Invalidity and Revocation Counterclaims

In a defence against infringement actions, a defendant may file a counterclaim for the invalidity or revocation of the earlier trade mark.

7.8 Effect of Trade Mark Office Decisions

If a request to declare the invalidity or revocation of an earlier trade mark is pending before the

PPO, the court may suspend the infringement case until the final conclusion of the proceedings before the PPO. Furthermore, the court deciding in an infringement case cannot completely deny the distinctiveness of a registered trade mark.

7.9 Declaratory Judgment Proceedings and Other Protections for Potential Defendants

Declaratory Judgment of Non-infringement

Polish law allows for an action to declare non-infringement specifically if the trade mark owner declares that an activity by another party infringes its rights or remains silent on the issue, having been requested in writing to make such declaration in respect of specific actions described in the request and having been given a deadline of at least two months in which to respond.

Protective Briefs

Protective briefs are not regulated by Polish law or procedure. Yet parties fearing an adverse interim injunction by another party do, from time to time, file protective briefs to the courts. Commonly, such brief contains a request for the potential interim injunction application to be reviewed at an open hearing or for the defendant to be given time to respond to it in writing. It is in the court's discretion whether to take the protective brief into account when deciding on the motion for an interim injunction or to ignore it entirely.

7.10 Counterfeiting

There are no specific remedies in civil proceedings for counterfeiting. In particular, the trade mark owner is entitled to injunctive relief, the destruction of the counterfeits, and damages, and may request information on the origin, quantities and prices of the counterfeits.

A trade mark infringement may also constitute a criminal offence and may be prosecuted in criminal law proceedings (see **8.9 Trade Mark**

Infringement as an Administrative or Criminal Offence), which can be initiated ex officio by customs authorities.

8. LITIGATING TRADE MARK CLAIMS

8.1 Special Procedural Provisions for Trade Mark Proceedings

The differences in procedure applicable to IP disputes are mainly limited to such cases being heard in specialised courts (see **7.7 Lawsuit Procedure**), where parties must be represented by professional representatives, and special means of requesting evidence (see **8.7 Obtaining Information and Evidence**).

Otherwise, IP disputes follow the standard procedural rules of typical civil or commercial disputes. This can be summarised as follows.

- The claimant files a statement of claim and pays the court fee.
- The defendant is obliged to file a statement of defence (a minimum deadline of two weeks).
- The parties may file additional writs, subject to the court's consent.
- Hearings are called mainly to hear witnesses (several, usually months apart); instead of an oral testimony, the court may request affidavits.
- An expert will be appointed after hearing witnesses or in parallel with the scheduling of evidential hearings. The opinion usually takes several months to be drafted. Then the parties provide comments and usually the expert has to provide a supplementary opinion or several opinions.
- After all evidence is conducted, the court will schedule the final hearing. Often, parties file summary writs, in which case, the oral final statements are brief.

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- The court delivers the judgement, either after the final hearing or within two weeks.

The average time of proceedings is 1–1.5 years in each instance. IP matters are decided by professional judges alone, one judge in first instance and usually three judges in appeals. The parties have no direct influence on who hears their case. However, in certain specific situations, a party may reject a judge because of concerns of bias.

8.2 Requirement to Establish Use of a Sign as a Trade Mark

See 8.3 Factors in Determining Infringement.

8.3 Factors in Determining Infringement

The trade mark infringement is assessed according to prerequisites set out in relevant provisions and interpretative rules established in case law. The following factors are of particular importance when assessing trade mark infringement:

- in principle, the subsequent mark must be used in the course of trade;
- the mark at issue must also be used in respect of the goods and services and must affect, or be capable of affecting, the functions of the earlier trade mark;
- the identity or similarity of the goods and services;
- the relevant public and their degree of attention;
- the distinctiveness of the earlier trade mark; and
- the identity or degree of similarity of the signs.

By conducting an overall assessment, it must then be established that these combined factors lead to a likelihood of confusion.

8.4 Elements of Other Trade Mark Claims

In particular, the trade mark owner may take action against the use of a sign identical or similar to the trade mark for goods or services that are dissimilar if the trade mark has a sufficient reputation in Poland and the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark that has such reputation.

8.5 Effect of Registration

A registered trade mark is presumed valid and enforceable unless proven otherwise in an invalidity or revocation counterclaim or separate proceedings before the PPO. Moreover, the owner of a registered trade mark benefits from a five-year grace period from the date of registration, where it cannot be subject to a revocation action based on non-use.

8.6 Defences against Infringement

The defendant may invoke, inter alia, the following grounds as a defence:

- prior user rights;
- the use of the family name or address;
- the use of a mark that is descriptive or devoid of a distinctive character;
- the lack of the genuine use of the trade mark registered for over five years;
- a counterclaim to declare the invalidity (on relative or absolute grounds) or to revoke the earlier trade mark;
- the prescription of claims and acquiescence;
- the abuse of rights and due cause if the infringement of a trade mark with reputation is considered; or
- defences based on general civil law principles are applicable as well, such as *res judicata*.

8.7 Obtaining Information and Evidence

Polish civil procedure sets out three kinds of legal actions for the disclosure of information and evidence that are available to the parties (mostly claimants), specifically in IP cases:

- a motion to secure the means of evidence;
- a motion to hand over or disclose evidence; and
- a motion for information.

Motion to Secure the Means of Evidence

This motion aims to procure items and documents that can be used as evidence in an IP dispute and are the defendant's or third party's possession. An item of evidence should be placed in the case files, if necessary, by the court bailiff following its seizure from the person who had it in their possession.

Such motion can be filed before filing the lawsuit or when the proceedings are pending. Also, the list of actions whereby the evidence is "secured" is open. This includes seizing goods, materials, tools or documents, or the bailiff making an official description of facts, taking samples or preparing an expert opinion. Evidence is made available to the claimant only after the decision to secure becomes final.

For the motion to be awarded, the claimant must substantiate its claims and legal interest in securing the evidence (the risk of the inability or serious difficulty in asserting or proving facts material to the case, the risk of destruction of evidence, etc). Such decision may be appealed.

This measure is particularly useful before the start of litigation on the merits, as it allows the claimant to assess the chances of success based on actual evidence, while there are alternative, less complicated legal measures to obtain evidence when the litigation is already ongoing. If such motion is granted before filing the statement of

claim, the court obligates the claimant to file a statement of claim within the time set, between two weeks and a month from the date when the decision to secure evidence becomes final. Failing that, the claimant will be liable for the damage suffered by the defendant.

Motion to Hand Over or Disclose Evidence

The motion to hand over or disclose evidence may only be filed during the main proceedings, by the claimant against the defendant. This pertains to evidence in the form of an item or document that can be handed over or otherwise disclosed to the court.

It is sufficient that the claimant identifies the evidence sought and substantiates their claims and it is probable that the evidence is in the defendant's possession. The defendant may file a response to the motion within two weeks. The decision on the motion may be appealed.

If the decision to hand over or disclose was not performed voluntarily, it can be enforced by a bailiff taking the evidence and depositing it with the court. Alternatively, the court may adopt a presumption that the non-disclosed evidence was favourable to the claimant and consider the claimant's assertions proven in that way.

Order to Provide Information

The request for an order to provide information aims to oblige the defendant or third parties to provide certain information concerning infringement (not items of evidence).

The third parties who can be addressees of the motion are persons who are, in various ways, connected with the infringement; eg, they possess allegedly infringing goods, provide allegedly infringing services in commercial quantities, provide services to the infringer, or are nominated as persons involved in the trade of infringing goods or provision of services, also as their recipient.

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The requested information may concern the names and addresses of manufacturers, distributors, previous possessors, wholesalers and distributors from whom, or to whom, the goods were sold or purchased; volumes of goods, services and prices for them; or, in particular circumstances, other information necessary to calculate the quantum of claim.

The claimant must provide credible information indicating that their rights were infringed, that the addressee or addressees of the request have the requested information, and that it is needed to establish the source or value of the infringement. The addressee of the request may respond to the motion within the time set by the court, but not shorter than two weeks. The decision on the motion for information is subject to appeal.

The motion may be filed before filing the statement of claim, in which case, the successful claimant will be obligated to file the statement of claim within one month from the date when the requested information was provided. Failing that, they will be liable for the damage suffered by the addressees.

8.8 Role of Experts and/or Surveys

Court-Appointed Experts

The claimants usually apply to the court to appoint an expert in their statement of claims. Defendants may also apply for a court-appointed expert in reply to a statement of claim and may also comment on and challenge the claimant's proposals in this respect. The court-appointed expert's role is not to determine the trade mark infringement (which is vested exclusively with the court) but rather to equip the judge with objective information necessary to examine and decide on a case.

Private Experts

In many cases, claimants and defendants submit opinions prepared specifically for such liti-

gating party by an expert who is not appointed by a court. However, such evidence offered by a litigating party may not substitute a court-appointed expert's opinion.

Surveys

Surveys can be submitted to establish, notably, the distinctiveness (inherent or acquired through use) of a sign or the lack thereof, the reputation of a trade mark, its well-known status, actual cases of confusion, or relevant public degree of attention.

8.9 Trade Mark Infringement as an Administrative or Criminal Offence

According to applicable regulations, anyone who, for the purpose of placing on the market, marks counterfeit goods with a trade mark or a registered trade mark, while not being entitled to use or distribute goods bearing such marks, will be subject to a fine, restriction of freedom, or imprisonment for up to two years. Additionally, if the perpetrator makes themselves, by committing such offence, a permanent source of income or commits the offence in relation to a good of significant value, they will be subject to imprisonment for between six months and five years.

8.10 Costs of Litigating Infringement Actions

Currently, the structure of fees involves a fixed fee per claim per defendant for non-monetary claims (the equivalent of approximately EUR70) and a value-dependent fee generally of 5% calculated on the value of monetary claims. Regarding multiple claimants, the fee is not multiplied if the co-claimants are pursuing a claim that is their joint claim or arises from the same factual and legal basis. Otherwise, each of the claimants pays the full fee.

9. REMEDIES

9.1 Injunctive Remedies

The claimant may demand that the infringer cease the infringement, surrender the unlawfully obtained profits and, for infringement caused by fault, redress the damage. Moreover, the claimant may request a publication of the judgment in full or in part. The court may order, at the infringer's request, where the infringement is inadvertent, to pay a relevant sum of money to the claimant if the cessation of infringement or seizure would be incommensurately severe to the infringing party and the payment of the sum of money duly takes into account the holder's interests.

Grounds for an Interim Injunction

An interim injunction can be granted to secure a claim that the claimant has made probable, and further, if the grant of the interim injunction is necessary to ensure the future enforcement of judgment in the matter or to ensure that the aim of the proceedings is met. In IP cases, it is usually accepted that an injunction would be necessary to ensure the aim of infringement proceedings. Such injunctions are only granted on the motion of a party.

Procedure

Interim injunctions may be granted *ex parte*. However, the court may also allow the defendant to file a written response to the motion for an interim injunction or call for an open hearing. Calling for a hearing or giving leave for a written response is fairly common in IP disputes as the security measures requested by claimants in such cases – eg, the prohibition of the allegedly infringing activity – are often far-reaching.

Interim injunctions can be applied for:

- before filing the statement of claim on the merits of the infringement;

- as part of the statement of claim; or
- after the statement of claim is filed and the proceedings on the merits are pending.

If an interim injunction is granted in advance of the statement of claim, then the claimant in receipt of the injunction will be obligated to file the statement of claim within a time set by the court, not longer than two weeks from the delivery of the interim injunction decision.

Common types of interim injunction granted in Polish practice in connection with a breach of IP include the prohibition of the allegedly infringing activity for the duration of the proceedings on the merits, and the seizure of the allegedly infringing goods.

Reply to the Motion for an Interim Injunction

A party may become aware of a pending motion for an interim injunction by monitoring court dockets (this is practical if that party already expects an interim injunction motion to be filed against it). In such case, it may be possible to review the files of the interim injunction action and file a response to the motion, present the defendant's arguments, and request that the motion for an interim injunction be dismissed.

Appeal against the Decision on the Interim Injunction

A court decision refusing an interim injunction can be appealed by the unsuccessful claimant, and the grant of the injunction by the defendant. In the case of a partial award, each party can appeal such ruling in the appropriate part. The appeal is reviewed by judges from the same court that issued the interim injunction decision, excluding the judge who issued it.

9.2 Monetary Remedies

The claimant may demand that the infringing party surrenders the unlawfully obtained profits and, in the case of infringement caused by fault

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(acting wilfully or negligently), redress the damage, by:

- paying the sum adjudicated under general principles of law (to cover the actual loss and loss of profit); or
- paying a lump sum corresponding to the hypothetical licence fee.

As claiming damages on general principles of law is associated with considerable evidentiary difficulties, in practice, in most cases, the parties claim a lump sum. As the typical market rates of the licence fee is only one of the factors influencing the amount of the lump-sum fee determined by the court, the following may also be taken into account:

- the market share of the trade mark proprietor;
- trade mark recognition and reputation;
- the causal relationship between the sales volume and use of the contested trade mark; and
- the degree of similarity of the compared marks.

9.3 Impoundment or Destruction of Infringing Articles

On the trade mark owner's request, the court may adjudicate on unlawfully produced and marked products, and on the means and materials used to produce or mark them. The court may, in particular, order their withdrawal from the market, that the proprietor be awarded monetary compensation, or said products, or that they be destroyed. When adjudicating, the court will take into account the seriousness of the infringement and the interests of third parties.

9.4 Attorneys' Fees and Costs

With regard to the initial court fees, see **8.10 Costs of Litigating Infringement Actions**. Initially, the claimant pays the fee. Then, if a party requests the actions of the court that involve

costs (appointing experts, hearing witnesses entitled to the reimbursement of travel expenses and wage equivalents, translation, etc), the party requesting the action may be required to make an advance on the appropriate costs. The costs are finally accounted when giving a judgment on the merits in each instance, and apportioned accordingly to the proportion in which they fall on each party. Generally, each party is obliged to bear costs pro rata to the proportion in which it lost the case (eg, in the case of an award of 70% of the claim, the claimant bears 30% of the costs, and the defendant 70%). The appellant party pays the full court fee calculated in accordance with the above rules in relation to the claims it pursues in appellate proceedings, and the account of costs is repeated at the time of the appellate judgment.

In general, attorneys' fees follow the same rules, except they are subject to severe caps. However, they can be increased above those caps in particularly difficult cases, and may be lower in appellate proceedings.

9.5 Ex Parte Relief

As a rule, interim injunctions are granted in ex parte proceedings. However, there are exceptions (see **9.1 Injunctive Remedies**).

9.6 Rights and Remedies for the Prevailing Defendant

A successful defendant is, in principle, entitled to a reimbursement of the costs of proceedings (however, attorneys' fees are capped at a very low level). If an interim injunction was issued, a successful defendant is entitled to damages covering the loss arising from the enforcement of the injunction.

9.7 Customs Seizures of Counterfeits or Criminal Imports

The customs protection of trade marks is regulated under Regulation (EU) No 608/2013 con-

cerning the customs enforcement of intellectual property rights, etc. To obtain customs control, an application for action (AFA) has to be filed with the customs authorities. Once an application has been processed and control measures have been granted, the customs authorities will seize goods entering or leaving the territory of Poland or the EU that are found to be infringing. Typically, the customs authorities directly contact the right-holders to confirm that the goods are counterfeit, which, in turn, may apply to start criminal proceedings. Even if the criminal proceedings are discontinued – eg, in the case of importing a small number of counterfeit products for personal use – the prosecutor may apply for the forfeiture of these goods.

9.8 Different Remedies for Different Types of Trade Marks

Remedies do not vary according to the different types of trade marks under the IPL. Remedies available for the infringement of unregistered trade marks follow a slightly different pattern than those applicable to unfair competition cases; however, they essentially coincide with those available for registered marks. In addition, the claimant may demand:

- the remedying of the effects of the infringing activities;
- making an appropriate public statement or statements; or
- if the defendant was at fault, payment of an appropriate sum to a charitable cause connected with the support of Polish culture or national heritage.

10. RESOLVING LITIGATIONS

10.1 Options for Settlement

Parties may settle the case amicably at any moment of the dispute; however, an amicable

settlement entered into during later stages must take into account the events that previously occurred in the proceedings; eg, the burden of costs already incurred. An amicable settlement may be made before the court (at a court hearing, where the parties sign a settlement agreement placed on court files) or out of court. A court may direct the parties to mediation but each of them has the option to disagree.

A settlement agreement made before the court, the withdrawal of a suit and the admission of a claim are controlled by the court, which may refuse to consent if the court finds those actions contrary to law or good morals, or aim to circumvent the law, which happens on rare occasions.

10.2 Prevalence of ADR

There is no ADR forum envisaged for settling disputes over trade marks. However, the parties may settle the case within mediation proceedings regulated by Polish procedural laws or during the hearing in the main case.

10.3 Other Court Proceedings

An infringement case may be stayed by the court if a parallel cancellation/revocation proceedings before the PPO is pending; however, the court is not obliged to do so (see **7.8 Effect of Trade Mark Office Decisions**).

11. APPEAL

11.1 Timeframes for Appealing Trial Court Decisions

The appeal procedure for IP disputes is similar to that in other civil and commercial disputes. The appeal has to be filed within two weeks from receipt of the first-instance judgement with a written statement of reasons and the opposing party may file a response to the appeal, also within two weeks. The matter is usually decided in one appellate hearing and, during the COV-

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ID-19 pandemic, it may be decided at a closed hearing without the parties present or the hearing may be conducted online. The court usually decides the case on the merits and the court's ruling is binding and enforceable, although it may be subject to special appeals (notably, a cassation appeal to the Supreme Court).

11.2 Special Provisions for the Appellate Procedure

There are no special provisions that would apply specifically for trade mark matters in the appellate procedure.

11.3 Scope of the Appellate Review

The Court of Appeals is not bound by pleas concerning infringement of substantive law presented in the appeal and is required to make a full review within that scope. On the other hand, without raising an appropriate plea in law, the Court may not take into account infringements of procedural law unless they are connected with the invalidity of the proceedings. Thus, without the appellant's initiative, the Court may not review the facts of the case as their erroneous assessment is most commonly connected to the infringement of procedural law. Moreover, the supplementary evidence at the appeal stage is only permitted subject to certain restrictions.

12. TRADE MARKS AND OTHER INTELLECTUAL PROPERTY

12.1 Copyright and Related Rights

In general, a trade mark might also be protected in parallel by other rights (eg, a copyright or a design for a logo) if the respective protection requirements are met. However, it is generally accepted that a word trade mark is not protected by copyright because it does not meet the statutory conditions for protection.

12.2 Industrial Design

A trade mark might also be protected in parallel as a registered design.

12.3 Rights of Publicity and Personality

Personality rights may constitute relative grounds for refusal of trade marks, both in opposition and invalidity proceedings. Moreover, the trade mark owner cannot prohibit a third party from using their own name in the course of trade (this applies only to physical persons).

12.4 Unfair Competition

With regard to unfair competition, see 7.2 Legal Grounds for Filing Infringement Lawsuits.

13. ADDITIONAL CONSIDERATIONS

13.1 Emerging Issues

On 18 May 2021, the Polish Supreme Court issued a much-awaited ruling (case III CZP 30/20) to resolve doubts concerning the national limitation period of non-pecuniary claims in trade mark matters. The Court ruled that if the infringement of an EU trade mark is recurring and continues at the time of filing a non-monetary claim (including injunctive relief), the five-year limitation period runs from each day on which the infringement occurs. However, there are still doubts as to the relationship and effectiveness of the national statute of limitations with the EU institution of acquiescence.

13.2 Trade Marks and the Internet

The Polish Act of 18 July 2002 on Electronically Supplied Services classifies different types of actors and their respective levels of liability. As regards publishers, hosts and internet service providers, they may be required to block counterfeiting content in court proceedings and be liable for damages if the request in a notice

and takedown procedure would be unlawfully denied.

13.3 Trade Marks and Business

Polish trade mark law does not require that the applicant must run a business; however, the mark must be put to genuine use in the course of trade.

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Sołtysiński Kawecki & Szlęzak is an independent Polish law firm with a team of over 170 lawyers, including one of the largest patent commercial and litigation teams in Poland, offering legal services to businesses from Poland and abroad. SK&S has over 30 years of experience in providing comprehensive advisory services in all aspects of trade marks: conduct of disputes before the court or arbitration panel connected with IP rights infringement and combating acts of unfair competition; registration of IP rights at the Patent Office of the Republic of Poland,

EUIPO and WIPO; conduct of opposition proceedings and proceedings regarding the declaration of invalidity and expiry of IP rights before the Patent Office of the Republic of Poland and EUIPO; representation of clients in proceedings before the CJEU regarding EU trade marks and industrial design; drafting, issuing opinions on and negotiation of agreements regarding various IP rights; IP audits ordered by potential purchasers and with the purpose of improvement of legal security; and IP rights management.

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