

# The Trademark

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## Lawyer

## Looking to the future



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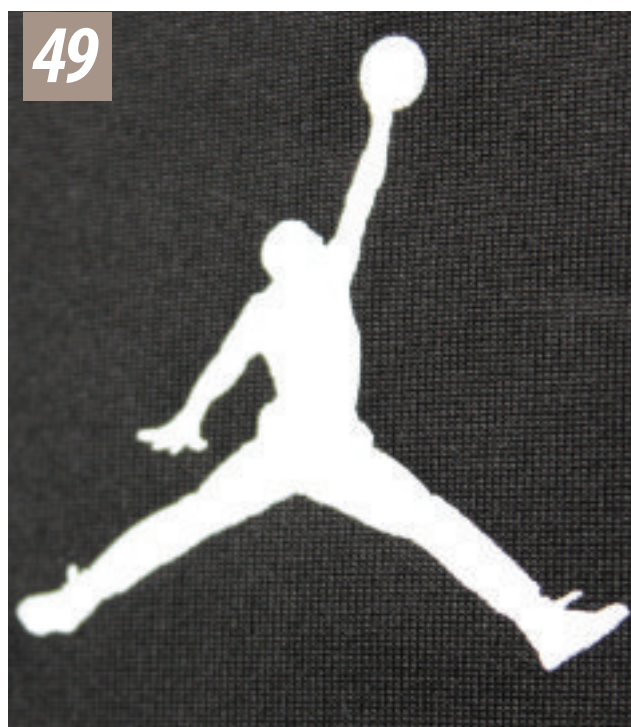
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# Intellectual property law in Poland – latest developments

**Attorney at law and patent attorney for ZM Legal, Klaudia Błach-Morysińska, discusses the latest developments in intellectual property law in Poland, including new trademark and patent regulations, and the introduction of IP courts.**

**T**he past twelve months have brought important amendments to industrial property regulation in Poland. On 16 March 2019, the amendment to the Polish Industrial Property Law adapting Polish law to the provisions of Directive 2015/2436, thus harmonizing the laws of the Member States regarding trademarks, came into force. On 27 February 2020, the next amendment aiming to unify Polish law with the Convention on the Grant of European Patents of 5 October 1973 came into force. Moreover, regulations implemented from Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004, on the enforcement of intellectual property rights, were improved. The next amendment refers to the Polish Code of Civil Procedure and



Klaudia Błach-Morysińska

the creation within the Polish common court of separate organizational units that will deal with intellectual property issues. According to the deadline set in the amendment, the Intellectual Property Court will start its operation on 1 July 2020.

## **1. Amendments to trademark regulations**

The significant change made to the trademark regulation by the implementation of Directive 2015/2436 is the abolition of the requirement of graphical representation of the trademark submitted for registration. Under the new provisions, a trademark may be any indication if it is possible to present it in a register in a manner allowing the competent authorities and the public to determine the clear and precise



subject matter of the protection afforded to its proprietor. This opens up an easier way to register many unconventional characters, such as holographic trademarks, sound trademarks, and multimedia trademarks.

The amendment also introduced new regulations regarding collective trademarks and guarantee trademarks, further specifying the method of obtaining protection for such trademarks, the manner of their use, and their cancellation. It shall be noticed that in Poland the rules of use of the trademark must be filed together with collective trademarks and guarantee trademark applications.

Another important change concerns the trademarks renewal procedure. Until now, it was necessary to submit a written request and pay a fee. From now on, no motion is needed, and it is enough to pay the fee for the next period of protection. This change will therefore facilitate the process of renewing the protection of trademarks.

The amendment gives the possibility of pursuing claims for infringements of trademark rights not only to the owners of those rights, but also, to a greater extent than before, to licensees. Under the new provision, the licensee, unless the license agreement provides otherwise, will be able, with the consent of the rightsholder, to bring an action for infringement of the trademark. In turn, the exclusive licensee will also be able to bring an action if the person entitled under the protection right, despite the summons, does not bring an action in due time. The licensee, in order to obtain compensation for the damage suffered, will also be able to join the proceedings for infringement of the trademark.

The amended bill expands the protection of trademarks. The trademark owner has the right to prohibit preparatory activities related to the use of packaging or other means. Moreover, the rightsholder has the right to prohibit the reproduction of registered trademarks in dictionaries, encyclopedias, or other similar information collections. There is new regulation

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on allowing the seizure of counterfeit goods in transit.

The rights of trademark owners are also extended, as the group of entities that will be responsible for trademark infringement has grown. In addition to the producer and distributor of goods, liability may also be applied to entities whose services were used in the infringement of the trademark.

## 2. Patent amendment regulation

The main purpose of the amendments implemented in accordance with the Convention on the Grant of European Patents of 5 October 1973, and Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004, was the streamlining of proceedings before the

## Résumé

**Klaudia Błach-Morysińska**

Klaudia is an advocate, patent attorney and European Trademark and Design Attorney. She specializes in intellectual and industrial property law, copyright, advertisement, and unfair competition law, and provides expert-level legal assistance in courtroom litigations and in administrative disputes involving IP. She has a vast expertise before the Polish courts and authorities and international authorities. Klaudia has authored numerous publications in the field of industrial and intellectual property law and gives lectures in intellectual and industrial property rights. She is the Disciplinary Proceedings Representative of the Polish Patent Attorney Chamber, AIPPI (Board Member of Polish Group, Design Committee Vice-Chair), PTMG, INTA, ECTA (Law Committee Secretary, EUIPO Link Committee Member), and AIPLA (Vice Chari IP Practice in Eastern Europe and Central Asia).

Polish Patent Office, including the speeding up of procedures.

As to patent opposition and invalidation proceedings before the Polish Patent Office, the crucial amendment refers to abolition of the obligation to demonstrate legal interest. Moreover, a patent opposition will no longer be reviewed by a board of experts acting in adjudicating colleges; instead, it will be examined by one expert.

Another change is the new option to demand that the Polish Patent Office carry out an international investigation and to prepare a proper report. Its purpose is to make an assessment at the application stage of the current state of technology in a given area on an international level.

The new provision enables the limitation of patents by patent claims amendment, as well as in the course of ongoing opposition proceedings and patent invalidation proceedings. Before the amendment, a patent-holder was entitled to request a limitation of his patent only with regards to the European patents, but this was uncommon. This change is a step towards harmonization with European law and eliminates the discrepancies between the rights derived from European and Polish patents respectively.

The new legislation extends renewal fee exemption to support start-up entrepreneurs. Small and medium entrepreneurs may apply for exemption from renewal fees for designs and trademarks within three years of starting a business.

Moreover, the amendment, *inter alia*:

- Clarifies the solutions that do not constitute an invention, and the requirements of the patent description. This change unifies national and European regulations.
- Specifies the factors of patent invalidation, clarifies the catalog of activities that constitute a patent infringement, and thus expands the content of the rights of the patent owner.
- In cases re: designs and geographical indications, attorneys at law and legal advisers can be proxies. Patent attorneys keep their monopoly on patent and industrial design proceedings.

### 3. IP courts regulations

Finally, there is the creation within the Polish common court of an Intellectual Property Court, due to begin operation on 1 July 2020.

At present, intellectual property cases are examined by common and administrative courts. There is only one specialized court – for the European Union Trademarks and Community Designs. However, the increasing number of IP cases, and their specific character, requires the creation of specialized IP courts.

Pursuant to the amendment, it is the plan to create four departments for intellectual property

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matters at District Courts in Gdansk, Lublin, Poznan and Warsaw, as well as two specialized departments in the Courts of Appeal in Warsaw and Poznań. All newly created departments will have the competence to hear a dispute on matters relating to intellectual property including copyrights, patents, utility models, designs, trademarks, geographical indications, topographies of integrated circuits, unfair competition, personal rights in so far as it concerns the use of personal rights for the purpose of individualizing, advertising or promoting an enterprise, goods or services, and in connection with scientific or rationalizing activities. Additionally, these courts will be entitled to examine cases regarding European Union trademarks and Community designs. Moreover, it is planned that the IP department in the Warsaw court will have exclusive competence in intellectual property matters of a technical nature, i.e. regarding computer programs, inventions, utility models, topography of integrated circuits, plant varieties, and business secrets.

The amendment sets forth mandatory representation of the parties by professional representatives in IP proceedings. The presence of professional representatives shall assure that the legal basis of claims is defined, and evidence proceedings are vigorous. The aim of the proposed regulation is to improve the speed of intellectual property proceedings. In uncomplicated matters, where, without prejudice to the efficiency and quality of the proceedings, the party can stand alone, the court will be able to release the parties from the obligatory replacement.

In addition, provisions are proposed to clarify the rules of proceedings in intellectual property matters which, in particular, introduce and/or determine the following:

- a request for preserving evidence;
- a request for disclosing or issuing evidence; or
- a request for ordering information.

These measures, which are planned to be an effective tool in obtaining information on facts necessary to make a claim, differ in the manner and scope of judicial protection provided. The motion on secure evidence will assure the rightsholder by gaining information on the facts of the infringement of their rights. The request to disclose or release evidence shall allow the rightsholder to obtain evidence from the infringer for the needs of the case, which it is impossible to obtain in a legal manner outside court proceedings. Based on the information request, the rightsholder can obtain information on the defendant's co-operators, and the quantity and prices of counterfeit products.

New regulations settle two specific types of court actions, i.e. counterclaims and actions to determine whether certain activities infringe



upon intellectual property rights. As regards the counterclaim solutions, the draft is based on Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark. Currently, cases regarding the invalidation of trademarks or designs, or cancelation of trademarks due to non-use, are run before the Patent Office of the Republic of Poland. Pursuant to the amendments, the above charges can be raised in the counterclaims and court shall examine them. The new mechanism requires cooperation between IP courts and the Polish Patent Office.

The new legislation therefore allows for special proceedings to determine whether certain actions constitute a breach of intellectual property rights. The new regulations describe certain circumstances in which this kind of claim may be filed.

#### 4. Conclusion

As regards trademarks, Polish Industrial Law is consistent and coherent with the main provisions of the Trademark Directive. The amendment fully harmonized the law with the Trademark Directive. The regulations aiming to speed up the procedures, simplify renewals, or strengthen the protection, shall make both registration and protection more efficient.

As to patent regulation, the amendments were dictated by the need to adapt Polish standards on inventions to European Union standards. Harmonizing these two legal systems will undoubtedly contribute to removing a number of the discrepancies Polish and European patent holders have, until now, had to face. The new regulations will not only streamline the opposition procedure and allow for the limitation of patents by their owners but will also ensure equal opportunities for Polish entrepreneurs applying for computer-assisted inventions in relation to foreign entities.

Bearing in mind the procedural issues, Polish IP practitioners postulated the need for the creation of IP courts for many years. As of 1 July 2020, the specialized IP courts will start to work in Poland. It will take some time to see how that works in practice.

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The new  
mechanism  
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the Polish  
Patent  
Office.”

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