

# Special report: Poland's IP revolution

Specialist courts will be introduced this year to raise standards of professionalism in the judiciary and provide more consistent decisions

By [Gabriella Kane](#) 22 April 2020

## On the panel:

- **Bartosz Krakowiak**, patent and trademark attorney, Polservice
- **Krystian Maciaszek**, counsel, DLA Piper
- **Klaudia Błach-Morysińska**, patent attorney, Zaborski, Morysiński
- **Tomasz Koryzma**, head of IP/TMC Poland, CMS
- **Przemysław Walasek**, partner, Taylor Wessing

The Polish IP community has been waiting a long time for the establishment of specialist IP courts. At last, this year they are set to be introduced.

## What is the current structure for IP cases heard in Poland and what has made the establishment of specialist IP courts necessary?

**Krystian Maciaszek, DLA Piper:** Polish lawyers have been waiting a long time for the establishment of specialist IP courts; this year will see them introduced. So far there is only one specialist Polish IP court, functioning as the European Union Trademarks and Community Designs Court. IP cases related to other issues such as patents, national trademark registrations, industrial designs, and unfair competition are handled by other courts according to general rules – unless they can be joined with a European Union Trademark or Community Design infringement case. As a result, judges with no real knowledge or experience of IP matters often handle highly complex and demanding IP cases. Court decisions can be surprising (both positively and negatively) for those involved and there is a distinct lack of consistency. In addition, these IP cases usually last longer than (already lengthy) standard cases.

**Agnieszka Sztoldman, senior associate, Taylor Wessing:** Furthermore, some cases regarding the decisions of the country's Patent Office – for example, those concerning trademark or industrial designs invalidation – will no longer be heard in the appeal of the administrative proceedings by the Provincial Administrative Court in Warsaw and the Supreme Administrative Court. This will not apply to patent and utility model invalidation proceedings, which due to technical character will only be heard by the Polish Patent Office.



**What have been the largest IP cases heard in Poland over the past year and which ones are coming up in 2020?**

**Klaudia Błach-Morysińska, Zaborski Morysiński:** A cable television operator did not obtain authorisation from a collective management organisation to re-broadcast some programmes. Nevertheless, the operator continued the broadcasts and made non-contractual payments to the collective management organisation. The collective management organisation brought court action against the operator.

The action was based inter alia on Art. 79(1)(3)(b) of the Polish Copyright Act and covered the claim for payment of triple the rate of the operator's revenue. The claimed amount was reduced by the payments already made by the operator. First the district court, and then the appellate court, awarded the requested remuneration.

The operator argued that Art. 79(1)(3)(b) of Polish Copyright Act in a part allowing for triple redress should be found inconsistent with the Polish Constitution. The Constitutional Tribunal held that contested provision violated the right of ownership and the principle of equality under the law, by disproportionately burdening copyright infringers in relation to infringers of other rights.

The Tribunal also found that it constituted an unjustified and too far-reaching preference for copyright owners. The Tribunal noticed that it is often difficult to

estimate the value of damage resulting from the infringement of economic copyright. The idea of compensation based on a lump sum is easier. However, the copyright owner should not have been granted exorbitant compensation derived from the damage suffered.

From the date of the tribunal's judgment, a plaintiff can no longer claim compensation in the form of the triple the value of relevant remuneration in civil proceedings for copyright infringement.

**Tomasz Koryzma, CMS:** An interesting case decided by the Polish Supreme Court on 9 May 2019 related to the disputes between the Swiss luxury watch producer (Omega) and a Polish company producing time-measuring swimming devices. Polish producers started using 'Mega' and 'megatiming' in their internet domain name.

Omega claimed infringement of its renowned EU trademarks, as well as unlawful copying amounting to unfair competition under Polish law. The Supreme Court explained that in the cases relating to the renowned trademarks, the courts should assess the overall similarity of trademarks, including phonetic, graphical or conceptual aspects.

The mere conceptual differences may not be enough to eliminate infringement. More importantly, it stressed that the similarity required for renowned marks has a lower threshold than in the case of ordinary trademarks.

**Will the EU Trademark and Design Court in Warsaw continue to be used and, if so, what will it be used for?**

**Bartosz Krakowiak, Polservice:** The competences of the EU Trademark and Design Court will be now distributed among all the appointed IP courts of the first instance (not only in Warsaw, but also in Gdańsk, Lublin and Poznań). In other words, we will now have four EU trademark and design courts in Poland. Due to the superb quality of the current EU Trademark and Design Court in Warsaw, such a solution (decentralisation of powers) might be criticised.

On the other hand, it will lead to more uniformity of court decisions in matters related to trademarks and designs throughout Poland – both for EU trademarks and designs and for national rights. What is important, the Regional Court of Warsaw, as one of the appointed IP courts, will now have an exclusive competence to hear in the first instance all 'technical' IP cases (i.e. those related to patents, utility models, semiconductor topographies, computer programs, plant varieties and technical know-how).

**What new opportunities and benefits will the specialist courts bring for IP in Poland?**

**Krakowiak:** The specialist IP courts will allow judges to specialise in IP matters, which – in turn – will result in enhanced professionalism and more legal certainty (predictability of court decisions). Of course, this will not be an immediate effect of the reform – further education of the judges appointed to sit in IP courts, especially in ‘technical’ matters, as well as an improved system of independent court experts (the issue, regrettably, not addressed in the reform) will be a must.

In any event, we may expect more clarity from the respective procedures and court decisions, which, on one hand, should allow IP rights holders to more effectively enforce their rights and, on the other, make it possible for other businesses to defend themselves against unjust and abusive legal actions based on alleged IP infringements. The latter aspect may prove to be quite beneficial to Polish industry.



### **What new procedures will be introduced?**

**Błach-Morysińska:** New regulations settle two specific types of court actions; i.e. counterclaims and actions to determine that certain activities do not infringe on intellectual property rights. With regard to 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 invalidation of the trademarks or design or cancelation of trademark due to non-use are run before the Patent Office of the Republic of Poland. Pursuant to the amendments, charges can be raised in the counterclaims and the court shall examine them. The new mechanism requires co-operation between IP courts and the Polish Patent Office.

**Koryzma:** There will also be a new information injunction mechanism. Such mechanisms so far regulated in the various acts, including the Polish Copyright Act and Industrial Property Law, will now gain one unified procedure in CPC. As such, upon the claimant’s request, before or during the commencement of IP infringement

proceedings or until the conclusion of the hearing in the first instance, the court can call upon the infringer to provide information on the origin and distribution networks of goods or services, if this is necessary to pursue the claim. The requested party should, however, first demonstrate – in a credible manner – circumstances indicating an infringement. If the court orders that such information be provided, the infringer should provide it – under pain of criminal liability – either in written or electronic format.

### **How else are lawyers in Poland looking to strengthen IP rights? Are there any further amendments to IP legislation?**

**Maciaszek:** The current wording of the draft of the new law on IP courts, which is part of the Civil Procedure Code, may still be modified. Nevertheless, no substantial changes to the draft are expected. It is probable that the specialist IP courts will be introduced in the second half of 2020. In the meantime, on 27 February a major amendment of the Industrial Property Law came into force, bringing it closer into line with the Patent Co-operation Treaty and the European Patent Convention.

Among some of the other changes, as of 27 February, when filing motion for the invalidation of a patent, there is no longer a requirement to evidence a legal interest. Also, during the invalidation proceedings, the patent owner will be allowed to file a motion to limit its own rights.

Additionally the Polish government is working on the so-called National Strategy of Protection of IPRs, which should increase the current level of protection, and it will probably introduce some additional incentives for innovative companies.

### **Which other IP developments in the EU do you expect over 2020?**

**Sztoldman:** A trend in Poland is the growing importance of alternative dispute resolution of IP disputes. In 2019, the Polish Patent Office kicked off the joint programme with the World Intellectual Property Organisation concerning trademark mediation services provided in the opposition proceedings at the Polish Patent Office. Perhaps we may expect the introduction of a mandatory arbitration or mediation procedure for IP disputes in the future, in particular before hearing the case in a specialist IP court.

**Błach-Morysińska:** As the UK left the EU on 31 January, there will be lot of discussion on Brexit and the withdrawal agreement. For IP practitioners the most important will be withdrawn agreement regulations on IP rights. As the UK is an important market, it may have a great impact on our client's IP strategies.

An interesting thing to observe will be EUIPO Convergence programmes that aim to unify IP law in EU Member States. The CP8 on use of a trademark in a form differing from the one registered comes to an end and the wording of Common practice will be accepted by EUIPO and Member States IP Offices soon. The pending projects refers to new types of trade marks – examination of formal requirements and grounds for refusal (CP11) and Evidence in Trade Mark Appeal Proceedings (CP 12). Both programmes will have impact on IP practice in the EU.