

Intellectual Property - Poland

Prescription of claims in ongoing industrial property rights infringements

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March 02 2015

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Poland has recently become an important venue for European litigation in industrial property matters, as rights holders become increasingly conscious of the importance of protecting and effectively enforcing their rights in this jurisdiction. This update summarises the position of Polish courts regarding the rules for the prescription of claims for ongoing infringements of industrial property law – in particular, the methods for calculating the prescription period of infringement claims.⁽¹⁾

Background

With regard to the prescription period of infringement claims, the Industrial Property Law states that:

"The period of prescription for claims for infringement of the patent shall be three years. The period concerned shall run, separately in respect of each individual infringement, from the date where the right holder has learned about the infringement of his patent and about the infringing person. However, in any case, the claim shall become barred by prescription five years after the date, on which the infringement has occurred."⁽²⁾

This rule applies to other industrial property rights (eg, trademarks, industrial designs, utility models, geographical indications and topographies of integrated circuits) and means that:

- the three-year prescription period starts to run from the moment that the rights holder learns of the infringement and the alleged infringer's identity;
- the infringement claim is subject to prescription as a consequence of lapse of the five-year period; and
- a prescription period starts separately for each infringement (ie, unlawful acts of exploitation).

General provisions of the Civil Code supplement this regulation with respect to:

- the length of the limitation period;
- the beginning of the limitation period; and
- suspension of the limitation period.⁽³⁾

While the rule causes no concern for single infringements (eg, a single sale of a patented active ingredient), it is unclear how to assess the 'each infringement' prerequisite where exploitation continues for an extended period.

Competing approaches

Polish courts and doctrine have taken several competing approaches regarding the prescription period for claims arising out of ongoing infringement (ie, claims that are not single acts and that cannot be individualised as a sequence of separate infringements). The three main methods of construing the law are as follows:

- Ongoing infringement should be treated as one infringement and thus the prescription period should start to run on the date on which the rights holder learns of the infringement and the identity of the infringer.⁽⁴⁾ In the worst-case scenario, this date will be the date of the first infringement. This severe approach is supported by the argument that rights holders should take care of their rights and stop infringement as quickly as possible.
- Ongoing infringement should be treated as a single infringement, but the prescription period should start no earlier than the date of the last infringement.⁽⁵⁾ This approach is extremely favourable for rights holders because as long as the infringement continues, the issue of prescription does not arise.

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- Ongoing infringement should be treated as a single infringement which is repeated every day. Thus, the three and five-year prescription periods should begin separately, on the date that each infringement starts.

Some commentators assume the first view, while suggesting that the severity of this approach be lessened by differentiating between injunction claims and claims for removal from circulation on one hand and compensation claims and claims to surrender unlawfully obtained profits on the other.

Under this view, injunction claims would be subject to prescription as soon as a rights holder was made aware of the ongoing infringement or, alternatively, from the date on which the infringer failed to comply with the rights holder's request to cease and desist the infringement. Compensation claims would be subject to prescription on each day of infringement. This approach could lead to a paradoxical situation where a rights holder could make claims for damages but could not obtain an injunction from the court.

Comment

Poland is not a case law country and thus previous judgments are not binding in subsequent cases. However, the prevailing position of the courts – supported by majority jurisprudence – is that the prescription period for claims relating to ongoing infringements of industrial property law should be assessed individually, with regard to each separate unlawful act of exploitation and each day of infringement. This means that:

- the prescription period for injunction claims should start no earlier than the date of the last infringement; and
- the prescription period for compensation claims and claims to surrender unlawfully obtained profits should be considered separately for each day of infringement.

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Endnotes

- (1) This analysis is limited to the issue of prescription of industrial property rights. Polish law does not specifically regulate prescription rules pertain to infringement claims in copyright law, as general Civil Code rules of prescription of torts apply.
- (2) See Article 289.1 of the Industrial Property Law.
- (3) See Articles 118 *et seq* of the Civil Code.
- (4) For example, a Warsaw Court of Appeal judgment of April 29 2010 (I ACa 1270/09).
- (5) Supreme Court judgment of April 30 1974 (II CR 161/74).

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