



License to use trademark.  
APPROVED  
the sole and exclusive r  
designs f

# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2019

**8th Edition**

A practical cross-border insight into trade mark work

Published by Global Legal Group, with contributions from:

Acapo AS

Advance Partners

Arent Fox LLP

Baptista, Monteverde & Associados,  
Sociedade de Advogados, SP, RL

Bird & Bird LLP

Bolet & Terrero

Borenus Attorneys Ltd

Bouwers Inc.

Camilleri Preziosi Advocates

Clarke Gittens Farmer

Daniel Law

DunnCox

East & Concord Partners

Ehrlich, Neubauer & Melzer (EN&M),  
of Ehrlich Group

ELZABURU

Fross Zelnick Lehrman & Zissu, P.C.

FTCC Studio Legale Associato

Fukami Patent Office, P.C.

Gowling WLG

Hannes Snellman Attorneys Ltd.

HSM IP Ltd.

Hule Bachmayr-Heyda Nordberg  
Rechtsanwälte GmbH

Kadasa Intellectual Property

KOREJZOVA LEGAL v.o.s.

Koushos Korfiotis

Papacharalambous LLC

Law Offices of Patrinos & Kilimiris

Le Poole Bekema

Lee International IP & Law Group

LK Shields

Lubberger Lehment

Lydian

McCullough Robertson

Miller Thomson LLP

Moravčević Vojnović and Partners

in cooperation with Schoenherr

Nater Dallafior Rechtsanwälte AG

OFO VENTURA

OLIVARES

OSH Advocates, Solicitors & Legal Consultants

Papula-Nevinpat

Patentna pisarna d.o.o.

Pham & Associates

PORZIO · RIOS · GARCIA

S. P. A. Ajibade & Co.

Samuriwo Attorneys

Shearn Delamore & Co.

Sołtysiński Kawecki & Szlęzak

Subramaniam & Associates (SNA)

SyCip Salazar Hernandez & Gatmaitan

TIPLO Attorneys-at-Law

United Trademark & Patent Services



**Contributing Editor**  
Nick Aries,  
Bird & Bird LLP

**Sales Director**  
Florjan Osmani

**Account Director**  
Oliver Smith

**Sales Support Manager**  
Toni Hayward

**Editor**  
Nicholas Catlin

**Senior Editors**  
Caroline Collingwood  
Rachel Williams

**CEO**  
Dror Levy

**Group Consulting Editor**  
Alan Falach

**Publisher**  
Rory Smith

**Published by**  
Global Legal Group Ltd.  
59 Tanner Street  
London SE1 3PL, UK  
Tel: +44 20 7367 0720  
Fax: +44 20 7407 5255  
Email: info@glgroup.co.uk  
URL: www.glgroup.co.uk

**GLG Cover Design**  
F&F Studio Design

**GLG Cover Image Source**  
iStockphoto

**Printed by**  
Ashford Colour Press Ltd  
April 2019

Copyright © 2019  
Global Legal Group Ltd.  
All rights reserved  
No photocopying

ISBN 978-1-912509-69-0  
ISSN 2049-3118

**Strategic Partners**



## General Chapters:

1	<b>Ranging Abroad: a Spotlight on Infringements Online, and Where to Fight Them –</b> Nick Aries & Tristan Sherliker, Bird & Bird LLP	1
2	<b>Use It or Lose It: Truer Than Ever in the U.S.A. –</b> Karen Lim & Jason D. Jones, Fross Zelnick Lehrman & Zissu, P.C.	6

## Country Question and Answer Chapters:

3	<b>Australia</b>	McCullough Robertson: Belinda Breakspear & Peter Stokes	11
4	<b>Austria</b>	Hule Bachmayr-Heyda Nordberg Rechtsanwälte GmbH: Emanuel Boesch	19
5	<b>Barbados</b>	Clarke Gittens Farmer: Rosalind K. Smith Millar QC	30
6	<b>Belgium</b>	Lydian: Annick Mottet Haugaard & Blandine de Lange	37
7	<b>Bolivia</b>	Bolet & Terrero: Juan Ignacio Zapata	47
8	<b>Brazil</b>	Daniel Law: Robert Daniel-Shores & Roberta Arantes	56
9	<b>Canada</b>	Miller Thomson LLP: Catherine M. Dennis Brooks & David Reive	67
10	<b>Cayman Islands</b>	HSM IP Ltd.: Sophie Peat & Huw Moses	76
11	<b>Chile</b>	PORZIO · RIOS · GARCIA: Cristóbal Porzio & Marcelo Correa	84
12	<b>China</b>	East & Concord Partners: Charles (Chao) Feng	93
13	<b>Cyprus</b>	Koushos Korfiotis Papacharalambous LLC: Eleni Papacharalambous & Georgia Charalambous	103
14	<b>Czech Republic</b>	KOREJZOVA LEGAL v.o.s.: Dr. Petra de Brantes & Mgr. Ivana Toningrová	112
15	<b>Finland</b>	Borenus Attorneys Ltd: Åsa Krook & Ben Rapinoja	119
16	<b>France</b>	Gowling WLG: Céline Bey & Clémence Lapôtre	126
17	<b>Germany</b>	Lubberger Lehment: Anja Wulff	138
18	<b>Greece</b>	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	146
19	<b>India</b>	Subramaniam & Associates (SNA): Hari Subramaniam & Philip Abraham	154
20	<b>Ireland</b>	LK Shields: Peter Bolger & Jane O'Grady	163
21	<b>Israel</b>	Ehrlich, Neubauer & Melzer (EN&M), of Ehrlich Group: Yehuda Neubauer & Keren Rubinstein	172
22	<b>Italy</b>	FTCC Studio Legale Associato: Filippo Canu & Pierluigi Cottafavi	182
23	<b>Jamaica</b>	DunnCox: Joanne Wood Rattray & Kelly Akin	192
24	<b>Japan</b>	Fukami Patent Office, P.C.: Yoshitake Kihara & Miki Tomii	202
25	<b>Korea</b>	Lee International IP & Law Group: Mi-Cheong Lee & Robert M. Kim	209
26	<b>Malaysia</b>	Shearn Delamore & Co.: Karen Abraham & Janet Toh	216
27	<b>Malta</b>	Camilleri Preziosi Advocates: Steven Decesare & Sharon Xuereb	227
28	<b>Mexico</b>	OLIVARES: Alonso Camargo & Daniel Sanchez	235
29	<b>Netherlands</b>	Le Poole Bekema: Anne Bekema & Laura Broers	245
30	<b>Nigeria</b>	S. P. A. Ajibade & Co.: John Chike Onyido & Oluwasolape Owoyemi	254
31	<b>Norway</b>	Acapo AS: Kjersti Rogne & Kjersti Staven-Garberg	263
32	<b>Philippines</b>	SyCip Salazar Hernandez & Gatmaitan: Vida M. Panganiban-Alindogan	270
33	<b>Poland</b>	Softysiński Kawecki & Szlęzak: Dr. (hab.) Ewa Skrzydło-Tefelska & Karol Gajek	279
34	<b>Portugal</b>	Baptista, Monteverde & Associados, Sociedade de Advogados, SP, RL: Filipe Teixeira Baptista & Joana Cunha Reis	287
35	<b>Russia</b>	Papula-Nevinpat: Annikki Hämäläinen	295
36	<b>Saudi Arabia</b>	Kadasa Intellectual Property: Mohammad Jomoa & Asif Iqbal	302
37	<b>Serbia</b>	Moravčević Vojnović and Partners in cooperation with Schoenherr: Andrea Radonjanin	312

Continued Overleaf ➡

Further copies of this book and others in the series can be ordered from the publisher. Please call +44 20 7367 0720

### Disclaimer

This publication is for general information purposes only. It does not purport to provide comprehensive full legal or other advice. Global Legal Group Ltd. and the contributors accept no responsibility for losses that may arise from reliance upon information contained in this publication. This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.



Country Question and Answer Chapters:

38	<b>Slovenia</b>	Patentna pisarna d.o.o.: Irena Kadunc & Vesna Kovič	319
39	<b>South Africa</b>	Bouwers Inc.: Deon Bouwer & Adele Els	327
40	<b>Spain</b>	ELZABURU: Fernando Iardia & Ana Sanz	334
41	<b>Sweden</b>	Hannes Snellman Attorneys Ltd.: Christopher Tehrani & Nedim Malovic	346
42	<b>Switzerland</b>	Nater Dallafior Rechtsanwälte AG: Dr. Mathis Berger	354
43	<b>Taiwan</b>	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	362
44	<b>Turkey</b>	OFO VENTURA: Özlem Fütman	373
45	<b>Uganda</b>	OSH Advocates, Solicitors & Legal Consultants: Fredrick K. Sentomero & Doreen Mwesige	383
46	<b>Ukraine</b>	Advance Partners: Oleg Zhukhevych & Maksym Kravchenko	389
47	<b>United Arab Emirates</b>	United Trademark & Patent Services: Maria Farrukh Irfan Khan & Sarmad Hasan Manto	400
48	<b>United Kingdom</b>	Bird & Bird LLP: Nick Aries & Daisy Dier James	408
49	<b>USA</b>	Arent Fox LLP: Michael A. Grow & James R. Davis, II	416
50	<b>Vietnam</b>	Pham & Associates: Pham Vu Khanh Toan	424
51	<b>Zimbabwe</b>	Samuriwo Attorneys: Nancy Samuriwo	433

# Poland

Dr. (hab.) Ewa Skrzydło-Tefelska



Karol Gajek



Sołtysiński Kawecki & Szlęzak

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Polish Patent Office (*Urząd Patentowy Rzeczypospolitej Polskiej* – “PPO”) is the relevant Polish trade mark authority.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Industrial Property Law of 30 June 2000 (Journal of Laws of 2017, Item 776, consolidated text – “IPL”) is the relevant trade mark legislation in Poland. The IPL is the basis for a number of executive regulations, including the Regulation of the President of the Council of Ministers on Making and Examining Trade Mark Applications of 8 December 2016, and the Regulation of the Council of Ministers on Fees Connected with the Protection of Inventions, Utility Designs, Industrial Designs, Trade Marks, Geographical Indications and Topographies of Integrated Circuits of 29 August 2001.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any sign capable of being represented graphically may be considered as a trade mark, provided that such signs are capable of distinguishing the goods of one undertaking from those of other undertakings. The IPL specifies that, in particular, words, designs, ornaments, combinations of colours and three-dimensional shapes of goods or of their packaging, as well as melodies or other acoustic signals, may be considered as trade marks.

### 2.2 What cannot be registered as a trade mark?

The IPL distinguishes absolute and relative grounds for refusal of registration. As of 15 April 2016, the examination of relative grounds is conducted by the PPO only in case of an opposition being submitted by an interested party.

Refusal on absolute grounds concerns the following signs:

- signs which are not capable of being represented graphically;
- signs not capable of distinguishing the origin of goods (or services) from a particular undertaking;

- purely descriptive signs;
- signs which have become customary in the current language and are used in fair and established business practices;
- signs applied for in bad faith;
- signs comprising a shape of good which is conditioned only by its nature, is necessary to obtain a technical result, or significantly increases the value of the goods;
- signs that are contrary to public policy or morality;
- signs containing an element which is a symbol – particularly religious, patriotic or of a cultural nature – the use of which could insult religious feelings;
- signs containing state symbols, symbols of international organisations or regulatory symbols;
- signs that may be misleading (especially in case of alcohol); and
- signs containing protected designation of varieties of plants and referring to varieties of plants of the same or a related species.

Refusal on relative grounds concerns the following signs:

- signs that infringe a third party’s rights;
- signs that are identical to prior trade marks registered for identical goods and services;
- signs that are identical or similar to prior trade marks registered for identical or similar goods and services if there is likelihood of confusion on the part of public;
- signs that are identical or similar to a renowned trade mark if use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier trade mark; and
- signs that are identical or similar to well-known trade marks used for similar or identical goods and services if there is likelihood of confusion on the part of public.

### 2.3 What information is needed to register a trade mark?

The application must consist of the indication of a trade mark. The trade mark must be graphically represented and, if not a word mark, described. The application for a sound trade mark must include two carriers with recorded sound. The application must further include:

- 1) the name and address of the applicant;
- 2) the REGON (Polish National Business Registry) and KRS (National Commercial Register) Number, if applicable;
- 3) the name and address of the attorney, if applicable;
- 4) a request to grant protection;

- 5) a declaration of the applicant regarding earlier priority, if it is claimed, and at least the date and country of the original application or the date, place and country where the trade mark was first exhibited;
- 6) a list of goods/services;
- 7) an indication of the person authorised to receive correspondence, if there are several applicants who do not have the same attorney;
- 8) the signature of the applicant or the attorney; and
- 9) a list of attachments.

#### **2.4 What is the general procedure for trade mark registration?**

The procedure of trade mark registration is initiated by filing an application with the PPO. The application may be amended during the proceedings, provided that additions or corrections do not alter the essential characteristics of the trade mark or extend the list of the goods for which the trade mark has been applied. The PPO publishes the application in the trade mark database within two months of its filing date.

The PPO then proceeds with verification of absolute grounds of refusal and, if none are detected, publishes the application in the PPO Bulletin. If the PPO finds an absolute ground of refusal, it issues a decision rejecting the application. However, prior to the issuance of a negative decision, the PPO fixes a time limit within which the applicant is invited to present the statement.

Following the application, third parties have three months to file an opposition against registration of the trade mark. If no opposition is filed, the PPO issues an administrative decision granting the protection right.

#### **2.5 How is a trade mark adequately represented?**

Word marks should be represented in the Latin alphabet. Word-graphic, graphic, 3D and colour trade marks should be represented in the form of images. Sound trade marks should be represented with the use of notation and/or letters allowing the articulation of the sounds.

#### **2.6 How are goods and services described?**

The list of goods and services should be worded with the use of technical terminology and unequivocal terms in the Polish language. The corresponding classes for goods and services should be indicated according to the Nice Classification.

#### **2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

Polish trade marks cover the whole territory of Poland.

#### **2.8 Who can own a trade mark in your jurisdiction?**

A Polish trade mark may be owned by a natural person, a legal person or an organisation which is vested with legal capacity to acquire rights in its own name (e.g. a partnership).

Foreign persons or entities may also acquire protection rights on the basis of international agreements (in particular, the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-

Related Aspects of Intellectual Property Rights (“TRIPS Agreement”). Insofar as it is not contrary to the provisions of international agreements, foreign persons may also acquire the rights on the principle of reciprocity.

#### **2.9 Can a trade mark acquire distinctive character through use?**

Yes; according to the IPL, the trade mark application cannot be denied where, prior to the date of the filing of a trade mark application with the Patent Office, the trade mark has acquired, as a consequence of its use, a distinctive character within the course of trade.

#### **2.10 How long on average does registration take?**

Currently, it takes approximately five to six months from the date on which the trade mark is filed, provided that there are no obstacles or oppositions.

#### **2.11 What is the average cost of obtaining a trade mark in your jurisdiction?**

The fee for application for a trade mark protection right amounts to PLN 450 (or PLN 400 if the application is filed electronically) for the first class of goods (according to the Nice Classification) and PLN 120 for each additional class.

The publication of information upon application is subject to a fee of PLN 90. The registration fee after the trade mark is granted amounts to PLN 400 for each Nice class. Other administrative fees apply.

Apart from the fee for publication of information, all other fees are doubled in case of collective trade marks.

#### **2.12 Is there more than one route to obtaining a registration in your jurisdiction?**

Yes, trade marks effective in Poland may be obtained either through the national procedure or via the Madrid system. Rights to European Union trade marks granted in accordance with the EU Trade Mark Regulation are also effective in the territory of Poland (however, they are regulated separately by EU law).

#### **2.13 Is a Power of Attorney needed?**

An applicant who is an individual may be represented by his or her close relative. In all other cases, only a patent attorney or attorney-at-law may act as a representative of the applicant in registration proceedings. Furthermore, all foreign applicants (including individuals) may only be represented by a patent attorney or attorney-at-law. The Power of Attorney must be in written form and should be submitted to the case file on the performance of the first legal act of the representative. The Power of Attorney granted on behalf of a legal person should be accompanied by documents confirming that the person(s) who executed the Power of Attorney was authorised to act on behalf of this entity (e.g. an excerpt from the commercial register of the company). Appointing an attorney is subject to a stamp duty of PLN 17.

#### **2.14 If so, does a Power of Attorney require notarisation and/or legalisation?**

No, it does not.

### 2.15 How is priority claimed?

An applicant claiming priority with an earlier application is required to include in his trade mark application a relevant declaration of such claim, together with evidence that the trade mark application has been filed in the indicated country or that the product bearing the trade mark has been displayed at a specified exhibition.

The documents may also be furnished within three months from the date of the filing of the application. If the documents are not provided within this time limit, the priority claim is without effect.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Polish law recognises collective trade marks and collective guarantee trade marks (certification marks).

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Please refer to question 2.2 above.

### 3.2 What are the ways to overcome an absolute grounds objection?

Absolute grounds for refusal can be overcome through arguments, evidence collected from the market, acquired distinctiveness through use, proper permissions, etc.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision may be appealed by means of filing a motion for re-examination. This results in the complete re-examination of the application in its entirety.

### 3.4 What is the route of appeal?

A motion for re-examination is filed with the PPO, which then repeats the registration proceedings and issues a new decision.

This second decision may, in turn, be subject to judicial review by the administrative courts. The complaint is examined by a regional administrative court. Its judgment may uphold or revoke the decision (the latter results in the application being examined once again and decided upon by the PPO). The judgment of the regional administrative court may be further appealed in cassation proceedings before the Supreme Administrative Court. Both courts may revoke the decision only if the error was made in law and this error had an impact on the PPO's decision.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Please refer to question 2.2.

### 4.2 Are there ways to overcome a relative grounds objection?

Relative grounds can be overcome by arguments, limitation of the list of goods/services, and cancellation of the earlier mark. It is also possible to obtain the earlier mark owner's consent for registration of the trade mark.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please refer to question 3.3.

### 4.4 What is the route of appeal?

Please refer to question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The holder of an earlier right of personal property is able to oppose a trade mark application on the relative grounds of refusal mentioned in the answer to question 2.2.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A holder of an earlier right is entitled to submit an opposition.

### 5.3 What is the procedure for opposition?

Within three months of the date of the notice of application for the mark, the holder of an earlier right may oppose a trade mark application. The PPO shall promptly notify the applicant to file an objection and inform the parties about the possibility of amicable settlement of the dispute within two months (this can be prolonged to six months) from the date of delivery of information. The PPO shall ask the applicant to respond to the opposition within the settled period. In response to the opposition, the applicant shall submit its observation and all the facts and evidence in support thereof. The PPO then serves the opponent with a response to the opposition and requests him to present his opinion within the settled period. The applicant also has the right to submit another pleading in response. After the pleadings are exchanged, the PPO will then examine the case based on the arguments of the parties, but may also order the parties to submit further observations. After examining the case, the PPO issues a decision reversing the grant of protection right or dismissing the opposition. The decision may be appealed as indicated in the answers to questions 3.3 and 3.4.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The validity of the decision on the granting of the protection right is conditional upon payment of the protection fee within the deadline

set by the PPO (failure to pay results in retroactive revocation of the decision). The grant of the protection right is confirmed by issuing a protection certificate and publication of the corresponding information in the PPO's Gazette.

## 6.2 From which date following application do an applicant's trade mark rights commence?

The right commences retroactively, from the date of the filing of the application with the PPO. However, claims for infringement are enforceable in respect of the period from the day following publication of the application by the PPO or, in the case of the infringer being notified earlier on the filing of the application, from the date of this notice. This limitation does not apply to the infringer acting in bad faith.

## 6.3 What is the term of a trade mark?

The term is 10 years, counting from the date of the filing of a trade mark application with the PPO.

## 6.4 How is a trade mark renewed?

A trade mark is renewed for subsequent 10-year periods at the request of the holder, which should be submitted before the expiration of a running protection period but not earlier than one year before said expiration.

The protection fee is calculated for every class of goods and/or services covered by the trade mark (PLN 400 for each class; moreover, an additional fixed fee of PLN 200 for filing a request is required).

The request for renewal may also be submitted within six months after the expiration; this, however, results in an additional fee of PLN 300 and protection fees are increased by 30%.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Assignment of a trade mark is registered by the PPO. The assignment agreement must be concluded in written form under the pain of nullity and is only effective in respect of third parties upon pertinent changes being made in the PPO registers. The record is done via letter with an original or certified copy of the assignment agreement.

### 7.2 Are there different types of assignment?

Partial assignment of a trade mark is possible in respect of certain goods or services if the goods for which the trade mark remains registered with the assignor are not of the same kind. It is also possible to assign the trade mark to the organisation and, thus, create a common guarantee trade mark (certification trade mark; this may only be registered if the trade mark regulation was filed with the PPO).

### 7.3 Can an individual register the licensing of a trade mark?

A trade mark licence may be registered with the PPO. The record is done via letter with an original or certified copy of the licence agreement.

### 7.4 Are there different types of licence?

A trade mark licence may be sole, exclusive or non-exclusive. Sub-licensing is possible only upon the authorisation of the right-holder; a sub-licensee cannot further sub-license – such agreement is invalid by virtue of law.

### 7.5 Can a trade mark licensee sue for infringement?

Only an exclusive licensee who is entered on the PPO register may sue for infringement (unless the licence agreement provides otherwise).

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not required under Polish law.

### 7.7 Can an individual register a security interest under a trade mark?

A pledge may be registered under a trade mark. The record is done via letter with an original or certified copy of the pledge agreement.

### 7.8 Are there different types of security interest?

No, there are not.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark may be revoked if:

- 1) it was not put to genuine use for a continuous period of five years after the grant of the protection right;
- 2) it lost its distinctiveness and has become the common name in trade for a product or service in respect of which it is registered due to actions or inactivity by its holder;
- 3) it is liable to mislead the public, particularly as to the nature, quality or geographical origin in respect of the goods or services for which it is registered due to the use made of it by its holder or with his consent; and
- 4) the holder of a trade mark, being a legal person, was deleted from the pertinent register (and thus, the holder ceased to exist).

The decision on the revocation of a protection right may also be issued in respect of one of the holders of the joint, collective or guarantee trade mark who does not follow trade mark regulations.

### 8.2 What is the procedure for revocation of a trade mark?

Any entity may file a request for revocation. The procedure includes the examination of grounds, pleadings and evidence submitted by the parties, and a hearing. The PPO then issues a decision revoking a trade mark or dismissing the revocation request. The decision is subject to a judicial review before the administrative courts in respect of error in law (please see the answer to question 3.4 describing the judicial review procedure).

### 8.3 Who can commence revocation proceedings?

Since 15 April 2016, anyone can initiate revocation proceedings. Previously, only a person who had a legal interest could commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

Depending on revocation grounds, defence may consist of demonstration of genuine use, evidence of active use as a trade mark or other evidence and arguments.

### 8.5 What is the route of appeal from a decision of revocation?

There is no administrative recourse. The decision is subject to judicial review before the administrative courts in respect of error in law (please see the answer to question 3.4 describing the judicial review procedure).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The protection right is subject to invalidation if the statutory requirements for the grant of that right have not been fulfilled or due to existence of an earlier right (please see the answer to question 2.2).

### 9.2 What is the procedure for invalidation of a trade mark?

Any person may file a request for invalidation. The procedure includes the examination of grounds, pleadings and evidence submitted by the parties, and a hearing. The PPO then issues a decision invalidating a trade mark or dismissing the request. The decision is subject to a judicial review before the administrative courts in respect of error in law (please see the answer to question 3.4).

### 9.3 Who can commence invalidation proceedings?

As of 15 April 2016, anyone can initiate invalidation proceedings. Previously, only a person who had a legal interest could commence the proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

A right-holder may argue that, despite the conflict with an earlier mark or the infringement of the personal or economic rights of a party requesting invalidation, the party was aware of the use of the registered mark and acquiesced for a period of five consecutive years for such use. This also applies when the earlier mark was a well-known mark. The invalidation request will also be rejected if a period of five years has passed since the granting of a right and the mark has acquired distinctive character through use. None of the above defences can be used if the trade mark protection right was acquired in bad faith.

The PPO will also reject the invalidation action if the opposition, based on the same rights and grounds, has been finally rejected. Furthermore, the defence of acquired distinctiveness will be independent from the good or bad faith of the applicant.

### 9.5 What is the route of appeal from a decision of invalidity?

The decision is subject to a judicial review before the administrative courts in respect of error in law (please see the answer to question 3.4 describing the judicial review procedure).

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Common courts are competent to enforce trade mark protection. The statement of claim should be submitted to the competent regional court according to the place of domicile or seat of the infringer. The enforcement of EU Trade Marks in Poland is carried out by the Court of EU Trade Marks and Community Industrial Designs, constituting a division of the regional court in Warsaw.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The statement of claims should include information on whether the parties attempted mediation or other alternative dispute resolution, or information as to why any such attempts were not taken, as well as an indication of the date, when the claim became due.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

A preliminary injunction may be granted before the main proceedings are initiated or during such proceedings. Obtaining an injunction requires substantiation of the claims and demonstration of a legitimate interest in obtaining the injunction. A legitimate interest exists when the absence of an injunction would make impossible or significantly hinder the execution of a future judgment, or in any other way render impossible or significantly hinder the achievement of the objective of the proceedings.

The motion for a preliminary injunction may be filed as a separate pleading before the main proceedings, during the main proceedings or may constitute a part of a statement of claim instigating the main proceedings. When the motion is granted before the statement of claim is filed with the court, the preliminary injunction order obligates the claimant to file the statement of claim within a period set forth by the court (not exceeding two weeks) under pain of the annulment of the preliminary injunction. When granting the preliminary injunction, the court may make the injunction contingent upon the claimant establishing a deposit to secure the potential defendant's claim for compensation of damage incurred due to the enforcement of a preliminary injunction.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a trade mark holder may file a motion to secure the evidence or



to secure the claims by obligating the infringer to disclose the necessary information regarding the origin and distribution networks of the infringing goods or services. The court may also request the adversary to disclose relevant documents.

#### **10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?**

Written evidence must be presented in the form of original documents or authenticated copies. The author of a written statement can be called as an oral witness by the other party and cross-examined.

#### **10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?**

Yes, infringement proceedings may be stayed for the time of invalidation proceedings before the PPO. However, the decision in this matter is made by the court on a case-by-case basis.

#### **10.7 After what period is a claim for trade mark infringement time-barred?**

The period of prescription for claims for infringement is three years, counted separately in respect of each individual infringement, from the date when the right-holder learned about the infringement of his right and about the infringer's identity. However, in any case, the claim shall become barred five years after the date on which the infringement occurred.

#### **10.8 Are there criminal liabilities for trade mark infringement?**

Yes, the IPL provides for criminal liability for marking goods with a counterfeit trade mark with the purpose of placing them on the market or placing on the market goods bearing such trade mark. The penalties for such a crime are a fine, limitation of freedom or imprisonment for a period of up to two years. A person who has made such an offence his permanent source of proceeds or commits that offence in respect of goods of significant value (above PLN 200,000) is liable for imprisonment for a period of six months to five years.

#### **10.9 If so, who can pursue a criminal prosecution?**

Prosecution is instigated by a motion of an injured party (usually a trade mark holder or a licensee) and is then carried out by the public prosecutor. The motion to prosecute may only be withdrawn with the consent of the public prosecutor.

#### **10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?**

There are no specific provisions in this respect. General provisions on the protection of trade marks or on acts of unfair competition are applicable.

## **11 Defences to Infringement**

### **11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?**

The grounds of defence depend on the grounds of attack and may include, for example: lack of similarity; lack of confusion; no unfair advantages taken out of the use of a trade mark similar to a renowned trade mark; lack of damage to the reputation or distinctiveness of an earlier trade mark with reputation; and lack of use as a trade mark of the later mark.

### **11.2 What grounds of defence can be raised in addition to non-infringement?**

The following grounds may be raised: prescription of claims; lack of use of earlier rights if they are registered for more than five years; acquiescence; and others.

## **12 Relief**

### **12.1 What remedies are available for trade mark infringement?**

The claimant may demand that the infringer cease the infringement, surrender the unlawfully obtained profits and, in the case of infringement caused by fault, redress the damage (this redress may be in the form of the payment of a sum of money corresponding to the licence fee). Moreover, the judge may decide on publishing the judgment in full or in part. If the infringement was committed unintentionally, the court may, in certain circumstances, decide not to order the cessation of infringement, but instead order the payment of an adequate sum of money which properly meets the interests of the holder.

### **12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?**

The losing party shall, upon the request of the adverse party, reimburse any reasonable costs of asserting its rights and defending itself (costs of legal proceedings). Reasonable court costs incurred by a party or its court agent other than an attorney, legal advisor or patent attorney shall include court costs, travelling costs of the party or its court agent to the court, and an equivalent of earnings lost as a result of appearing before the court. The sum of the costs of travel and the equivalent of earnings lost combined must not exceed the fee of one attorney performing his professional activities at the court.

The reasonable costs of legal proceedings incurred by a party represented by an attorney shall include the fee, which shall in no case exceed the rates determined in separate provisions, and costs of one attorney, court costs and the costs of appearing in person before the court, as summoned by the court.

## **13 Appeal**

### **13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?**

The appeal is examined by a court of appeal and is not limited to

error in law. The judgment of the court of appeals may be further subject to a cassation complaint, which is examined by the Supreme Court (the cassation proceedings are limited to error in law).

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New facts and evidence may be added if the party can demonstrate that the submission of said facts or evidence was not possible before the court of first instance, or if the need to add them arose after the first instance proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The customs protection of trade marks is regulated under EU Regulation 608/2013 concerning customs enforcement of intellectual property rights, etc. An application is made to the competent customs authorities to take action with respect to goods suspected of infringing a trade mark.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The IPL provides for the protection of well-known trade marks.

### 15.2 To what extent does a company name offer protection from use by a third party?

A company name (a firm) is protected under the Polish Civil Code and the law of unfair competition.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There are no other rights protected within the scope of trade mark rights in Poland. Book titles and film titles may be protected by copyrights.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name may be owned by a natural or legal person, as well as an organisation which is not a legal person but is vested with the capacity to undertake legal acts (for instance, a partnership).

### 16.2 How is a domain name registered?

The registry for “.pl” country code top-level domains is the NASK Research Institute. The domain name may be registered directly with NASK or through third-party registrars.

### 16.3 What protection does a domain name afford *per se*?

The domain name as such does not confer any monopoly to its holder. The holder can only prevent other persons from registering the conflicting domain name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The Polish Constitutional Tribunal ruled that filing a motion to secure the evidence or to secure the claims by obligating a third party (e.g. party other than the infringer) to disclose the necessary information regarding the origin and distribution networks of the infringing goods or services is unconstitutional.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The following judgments are of particular note:

- Decision of the Supreme Court of 31 January 2018 ref. V KK 297/17.
- Judgment of the Constitutional Tribunal of 6 December 2018 ref. SK 19/16.
- Judgment of Supreme Administrative Court of 7 February 2018 no. II GSK 2781/16.

### 17.3 Are there any significant developments expected in the next year?

Yes; on 17 January 2019, the Parliament passed an act implementing Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks and amend the IPL. The act has come into force on 16 March 2019.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No, there are not.

**Dr. (hab.) Ewa Skrzydło-Tefelska**

Sołtysiński Kawecki & Szlęzak  
Jasna 26  
00-054 Warsaw  
Poland

Tel: +48 22 608 7047  
Fax: +48 22 608 7070  
Email: ewa.skrzydlo-tefelska@skslegal.pl  
URL: www.skslegal.pl

The practice of Dr. (hab.) Ewa Skrzydło-Tefelska focuses on counselling and litigation in patent and trade mark protection law, advertising, unfair competition, marketing and sales promotion law, as well as dealing with cases involving the application of EU law in Poland. She was admitted to the Bar in 1995 and has been associated with SK&S since 1999. She became a partner in 2006. Dr. (hab.) Skrzydło-Tefelska is an author of books and articles on various aspects of EU law, especially involving issues of industrial property protection and advertising. She is a frequent speaker in conferences and seminars devoted to the subjects related to her professional expertise. She also gives lectures on EU law and various aspects of Polish law at French universities. She is a member of the International Association for the Protection of Intellectual Property, the International Trademark Association, and is the member for Poland of the Global Advertising Lawyers Alliance.

**Karol Gajek**

Sołtysiński Kawecki & Szlęzak  
Jasna 26  
00-054 Warsaw  
Poland

Tel: +48 22 608 7388  
Fax: +48 22 608 7070  
Email: karol.gajek@skslegal.pl  
URL: www.skslegal.pl

Karol Gajek is an attorney-at-law and patent and trade mark attorney at Sołtysiński Kawecki & Szlęzak law firm in Warsaw. He graduated in law at Silesian University in Katowice. Prior to joining SK&S in 2009, he worked in the Trade Mark Department of the Polish Patent Office as an examiner granting trade mark rights. He also gained experience at the European Union Intellectual Property Office (EUIPO) in Alicante, Spain. He has lectured in a number of specialised IP seminars. Mr. Gajek specialises in litigation related to trade marks, designs and combatting unfair competition, and represents clients in disputes before common courts, the Polish Patent Office and EUIPO. He is a member of the International Trademark Association and the Pharmaceutical Trade Marks Group.



The Intellectual Property Team at Sołtysiński Kawecki & Szlęzak, headed by Dr. (hab.) Ewa Skrzydło-Tefelska and Szymon Gogulski, has extensive experience in advising in the area of industrial property law. Our lawyers specialise in issues related to the protection of trade marks, industrial designs, patents, utility designs, trade names, geographical designations and combatting unfair competition. The team provides services which ensure the realisation of a coherent strategy of protection of the client's industrial property rights, such as protection of biotechnical inventions, integrated circuit topography, copyrights in the field of electronic exploitation of works (including internet copyright infringements) and databases. The team also advises clients on an ongoing basis on the conclusion of licensing agreements, delimitation agreements, joint research agreements and intellectual property right assignment agreements. The SK&S IP practice is recommended in patent and trade mark matters in Poland by *Chambers & Partners*, the *World Trademark Review* and *Managing Intellectual Property*.

## Current titles in the ICLG series include:

- Alternative Investment Funds
- Anti-Money Laundering
- Aviation Law
- Business Crime
- Cartels & Leniency
- Class & Group Actions
- Competition Litigation
- Construction & Engineering Law
- Copyright
- Corporate Governance
- Corporate Immigration
- Corporate Investigations
- Corporate Recovery & Insolvency
- Corporate Tax
- Cybersecurity
- Data Protection
- Employment & Labour Law
- Enforcement of Foreign Judgments
- Environment & Climate Change Law
- Family Law
- Financial Services Disputes
- Fintech
- Franchise
- Gambling
- Insurance & Reinsurance
- International Arbitration
- Investor-State Arbitration
- Lending & Secured Finance
- Litigation & Dispute Resolution
- Merger Control
- Mergers & Acquisitions
- Mining Law
- Oil & Gas Regulation
- Outsourcing
- Patents
- Pharmaceutical Advertising
- Private Client
- Private Equity
- Product Liability
- Project Finance
- Public Investment Funds
- Public Procurement
- Real Estate
- Securitisation
- Shipping Law
- Telecoms, Media & Internet
- Trade Marks
- Vertical Agreements and Dominant Firms



59 Tanner Street, London SE1 3PL, United Kingdom  
Tel: +44 20 7367 0720 / Fax: +44 20 7407 5255  
Email: [info@glgroup.co.uk](mailto:info@glgroup.co.uk)