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Poland

INTELLECTUAL PROPERTY

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This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Poland.

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POLAND

INTELLECTUAL PROPERTY



1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

In Poland, the following intellectual property rights protection is provided:

1. patents, utility models; industrial designs, trade marks¹, geographical indications (GIs), integrated circuit topographies; additionally supplementary protection certificates (SPCs) are available for pharmaceutical and plant protection products (main governing act: Industrial Property Law (IPL) of June 30, 2000);
2. copyrights and related rights, including performers' rights, rights to phono- and videograms; broadcasting rights, rights to previously unpublished works and rights to scientific or critical publications (main governing act: Act on Copyrights and Related Rights (Copyright Act) of February 4, 1994);
3. plant breeder's rights (main governing act: Act on legal protection of varieties of plants (PVP) of June 26, 2003).

Furthermore, other rights and interests such as rights to trade names, unregistered trade marks, trade secrets and know-how or rights to internet domain names may

be protected based on the Law on counteracting unfair competition of April 16, 1993 (UCL).

Footnotes: ¹ including: service marks, collective marks, certification marks, well-known marks; reputed trade marks.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

Patents may be protected for up to 20 years from the date of filing provided that the renewal fees are duly paid. Similarly, subject to payment of renewal fees, the protection may last – in case of –

1) utility models – for up to 10 years,

2) industrial designs – for up to 25 years,

3) trade marks – for an indefinite number of 10-year periods,

– starting from the date of filing with the Polish Patent Office (the “PPO”).

Supplementary protection certificates may provide for an additional five-year term of protection for selected, previously-patented products.

Protection of GIs is not limited in time and lasts from the date of mention in the register.

Protection of integrated circuit topographies expires, in principle, ten years after the end of the calendar year in which topography was marketed or the application for topography was filed with the PPO, depending on which of the periods expires first.

With respect to economic copyrights, such rights expire, in principle, 70 years after the death of the creator or the date of dissemination.

Plant breeder's rights last for 25 years, exceptionally 30 years – in the case of vine, tree and potato varieties, starting from the date of issuing a decision on grant.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

As a general rule the right to obtain a patent for invention, protection rights for a utility model as well as registration rights for industrial design and integrated circuit topography, lies with the creator(s) of a particular IPR. However, in case an invention, utility model, industrial design or integrated circuit topography was made as a result of the performance by a creator of her/his employment duties or in the execution of any other contract (e.g. service provision agreement, specific work agreement or other civil law agreements) – the relevant rights shall – by virtue of law – belong (initially vested in) to the employer or the commissioner, unless the parties agree otherwise in contract. The first owner of the SPC is the owner of the patent right.

For copyrights, the economic rights and moral rights belong, as a rule, to the author (co-authors). Similarly to industrial property rights – if a copyrightable work was created by an author as a result of the performance of her/his employment duties – the economic rights to such works are assigned, by virtue of law, to the employer upon acceptance of the work by that employer. A similar rule applies to “employee-created” copyrightable works such as computer programs; however, in such cases the economic rights to software are initially vested in the employer. Importantly, with respect to all copyrightable works only employment relationship enables assignment (vesting in) economic rights to the employer. Civil law contracts do not trigger such an *ex lege* assignment of economic rights.

For trademarks, the first owner is the entity for whom the trademark is registered. In case of geographical indications, a party whose products satisfy the conditions for the use of the geographical indication shall have the right to use it in the course of trade and may also request the Patent Office to mention it in the register as being a party authorised to use that indication.

The first owner of a plant breeder's right, as a general rule, is the breeder who applied for the right.

4. Which of the intellectual property rights

described above are registered rights?

The following are registered rights: patents (and SPCs), utility models; industrial designs, trade marks, geographical indications, integrated circuit topographies, plant breeder's rights.

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

The creator(s) or person(s) entitled on the basis of the statutory provision or a relevant contract (e.g. employer, or other entity being an assignee), may apply for registration of these IPRs. In case of GIs it must be noted that the application for a GI (i.e. for establishing a GI) may only be filed by an organisation entitled to represent interests of the producers running their business activities in a given territory or a state or local administration agency competent in respect of the territory to which the GI relates.

The registration procedure before the PPO involves (at least) the following steps:

- 1) filing of a relevant request and payment of fee(s);
- 2) examination (the type of the examination varies depending on the type of right; e.g. patents are subject to searches and substantive examination by the PPO while trade marks are registered within the opposition procedure);
- 3) registration.

The registration procedure of a plant breeder's rights is conducted by the Research Centre for Cultivar Testing (COBORU) with its seat in Słupia Wielka at the request of a plant breeder, subject to a fee.

6. How long does the registration procedure usually take?

Patents & utility models	Usually 2-5 years depending on the type of invention and filed of invention (2-3 years for utility models). Exceptionally, the respective periods may be, however, much shorter and last e.g. 8 months only from the date of filing to the date of grant of a patent or a utility model.
SPCs	Usually approx. 20 months.
Trade marks	Usually approx. 6-10 months.
Industrial designs	Usually approx. 6-10 months. However, the right may be granted even as soon as a couple of days after the date of filing.
Geographical indications	Usually approx. 13 months.
Integrated circuit topographies	Approx. 2 months.
Plant breeder's right	Usually approx. 2-3 years. The procedure is dependent on the plant examination and necessary growing seasons (usually 2-3 growing seasons).

7. Do third parties have the right to take part in or comment on the registration process?

As a rule, third parties may provide comments on the registration process of: patents, utility models (re: circumstances preventing the grant) and trade marks (re: absolute grounds for refusal).

Additionally, in case of trade marks, up to 3 months after a trade mark application is published, an opposition may be filed by earlier trade mark owners, the proprietors of earlier rights which may be infringed by the later trade mark registrations.

8. What (if any) steps can the applicant take if registration is refused?

In case of refusal, an applicant may file:

- 1) a request for re-examination with the PPO;
- 2) an appeal before the Voivodeship Administrative Court followed by a cassation complaint to the Supreme Administrative Court.

Additionally, up to 2 months from the date on which a decision refusing a grant of a patent became final, an applicant may file a request for conversion of a patent application to a utility model application.

9. What are the current application and renewal fees for each of these intellectual property rights?

The fees of the Polish Patent Office are governed by the Regulation of the Council of Ministers of 29 August 2001 on fees relating to the protection of inventions, utility models, industrial designs, trade marks, geographical indications and topographies of integrated circuits (as amended).

The current application fees for:

- 1) patents and utility models start from 500 PLN, SPCs: start from 550 PLN. The fees are available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/wynalazki-i-wzory-uzytkowe/wynalazki-i-wzory-uzytkowe-procedura-krajowa/oplaty-zgloszeniowe>
- 2) trade marks start from 450 PLN. The fees are available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/znaki-towarowe/procedura-krajowa/oplaty-zgloszeniowe>

3) industrial designs start 300 PLN. The fees are available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/wzory-przemyslowe/wzory-przemyslowe-procedura-krajowa/oplaty-zgloszeniowe>

4) geographical indications start from 300 PLN.

5) integrated circuit topographies start from 250 PLN. The fees are available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/topografie-ukladow-scalonych/procedura-krajowa/oplaty-zgloszeniowe>

The current renewal fees for:

1) patents (480 PLN per first period – up to 1550 PLN per year), utility models (250 PLN per first period – up to 1100 PLN per last period), SPCs (6000 PLN per year) are available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/wynalazki-i-wzory-uzytkowe/wynalazki-i-wzory-uzytkowe-procedura-krajowa/oplaty-za-ochrone>

2) trade marks (starting from 400 PLN for a single class) are available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/znaki-towarowe/procedura-krajowa/oplaty-za-ochrone-przedluzenie>

3) industrial designs (up to 150 PLN per first period – 2000 PLN per last period) are available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/wzory-przemyslowe/wzory-przemyslowe-procedura-krajowa/oplaty-za-ochrone>

4) geographical indications: 1000 PLN. The fee is available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/oznaczenia-geograficzne/oznaczenia-geograficzne-procedura-krajowa/oplaty-w-postepowaniu>

5) integrated circuit topographies: 550 PLN for the first period, 800 PLN for the second period. The fees are available at: <https://uprp.gov.pl/pl/przedmioty-ochrony/topografie-ukladow-scalonych/procedura-krajowa/oplaty-za-ochrone>

The current application fee for plant breeder's right is 500 PLN. The fees for growing seasons vary from 500 PLN to 1040 PLN. The renewal fees vary from 200 PLN to 400 PLN. The fees are available at: https://coboru.gov.pl/pl/ko/ko_oplaty and are governed by the Regulation of the Minister of Agriculture and Rural Development of 17 February 2004 on fees for filing an application for the right to protect a variety bred or discovered and derived, as well as for its commercial exploitation, examination of distinctiveness, uniformity and stability, granting and maintenance of exclusive

rights (as amended).

10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?

Late payment of fees may lead to an expiration of a given right.

The IPL provides for an additional period of six months after the expiry of the deadline for payment of the fee, in which the fee may still be paid though subject to a surcharge of 30% of the fee due. This additional deadline (grace period) cannot be reinstated. However, under extraordinary circumstances (*vis maior*) this additional period may be stayed.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

As a rule, assigning IPRs under the IPL and Copyright Act requires a written form under the pain of nullity. Assigning a plant breeder's right requires a written form, for evidentiary purposes (however, the relevant provision does not express it directly and there are also diverging views in this regard).

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Under the IPL, there is no such requirement per se. However, for the assignment to take effect *vis-à-vis* third parties, it must be registered with the PPO (please note that this does not apply to geographical indications).

Neither Copyright Act, nor PVP provide for a procedure of registering assignment of rights.

13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

Under IPL and PVP a licence must be concluded in a written form on pain of nullity. Under Copyright Act, the written form requirement applies to exclusive licences only.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

There is no such requirement in Poland.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

Yes. Under IPL, as a general rule, an exclusive licensee is allowed to enforce a right, equally with a right holder, provided that such an exclusive licence is entered into the register maintained by the PPO and a licence agreement does not state otherwise. However, in case of trade marks, a trade mark exclusive licensee is allowed to initiate enforcement proceedings only if the trade mark owner does not bring an action, despite receiving a relevant request from the licensee.

Under the Copyright Act, unless otherwise provided for in an agreement, an exclusive licensee may pursue claims for infringement of economic copyrights, to the extent covered by the licence agreement.

In turn, non-exclusive licensees cannot initiate infringement actions as such.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

Under IPL, the following acts are subject to criminal sanctions:

- 1) attributing authorship / misleading as to the authorship / other infringement of author's rights to an inventive project (i.e. this refers to protection of projects related to inventions, utility models, industrial designs, integrated circuit topographies, rationalisation projects);
- 2) applying for the protection of someone else's invention, utility model, industrial design or integrated circuit topography, as well as disclosing information about thereof or in any other way preventing the obtaining of protection therefor;
- 3) trade mark counterfeiting;
- 4) marking items which are not protected by a patent, SPC, utility model, industrial design, integrated circuit

topography, or geographical indication, for the purpose of marketing, with writings or drawings in order to create a false impression of an existing protection;

5) marketing goods or services bearing a trademark with a marking suggesting protection – to create a false impression that said goods or services enjoy such protection.

Under the Copyright Act, the following acts are subject to criminal sanctions:

- 1) plagiarism;
- 2) unlawful distribution;
- 3) unlawful fixation or reproduction;
- 4) trading unlawful copies;
- 5) manufacturing devices (or their components) intended for unlawful removal or circumventing of safeguards against copying;
- 6) preventing / obstructing the exercise of the right to control the use of a subject of copyright or related right.

In turn, under PVP, the following acts are subject to criminal sanctions:

- 1) infringement of variety right;
- 2) designating with the name of the variety protected by the exclusive right the seed or harvested material of a different or unknown variety;
- 3) preventing an inspection of the preservation of a variety, documents on the preservation of the variety,
- 4) failure to deliver the seed of a variety for testing or to the entity to which a compulsory licence has been granted,
- 5) failure to provide the information on preparing a harvest material for propagation,
- 6) preventing a breeder or breeder's organisation from carrying out the inspection of the above-mentioned information.

Depending on the legal basis, the sanctions may involve a fine, restriction of freedom or imprisonment. Under particular circumstances, goods involved in an act may be subject to forfeiture. Depending on the type of act, the sanctions may be invoked ex officio or at the request of the injured party.

17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

Civil court proceedings are available for all the IPRs described in Section A. In July 2020 specialized IP courts were established in Poland and specific IP-related civil procedures have been introduced.

Except for disputes over domain names, there is no alternative dispute resolution forum envisaged for settling disputes over IPRs. However, the parties may settle the case within mediation proceedings regulated by Polish procedural laws or during the hearing in the main case.

18. What is the length and cost of such procedures?

The length of civil proceedings may vary a lot depending on the particular case background, type of IPR infringed, complexity of evidence measures etc.

Interim injunction proceedings usually last from a couple of days to several months (counted from filing a request to obtaining an injunction order). However, due to recent amendments (July 2023), which as a rule envisage hearing an obliged party (and grant of *ex parte* orders only as an exception), the interim injunction proceedings are expected to take longer.

Main action proceedings (first instance) usually take from 1 to 3 years

The costs include:

- 1) costs of representation;
- 2) court fees:
 - fixed-fee per claim per defendant for non-monetary claims (equivalent of approx. EUR 70);
 - value-dependent fee of 5% calculated based on the value of monetary claims –
- 3) other costs e.g. costs of court appointed expert opinions (if required) or translations

19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

Actions for the infringement of IPRs are generally brought before the specialised IP divisions of five Polish courts: Warsaw, Poznań, Gdańsk, Katowice and Lublin. There are two appellate courts: in Warsaw and Poznań. The technical matters are exclusively decided by the IP court in Warsaw.

Additionally, in some specifically listed situations a cassation appeal may be filed with the Supreme Court.

The Polish system is bifurcated, and actions concerning the validity of rights falling within the competence of the PPO are being decided by the PPO. Decisions of the PPO can be appealed to the administrative courts.

As a rule, claims arising from the infringement of a right subject to registration may be enforced only after the right is granted. However, for several type of rights, e.g. patents, utility models, industrial designs, integrated circuit topographies, the pursued claim can cover periods prior to the grant.

Under IPL, as a rule, claims arising from infringement become limited by time after three years from the day the right-holder became aware of the infringement and the identity of the infringing party, but not later than after five years after the infringement occurred. Time limitation is calculated separately per each infringing event.

Copyright Act does not contain any specific provisions on time limits for pursuing claims. Referring to the Civil Code and case law, the particular time limits may vary depending on the type of claim pursued. As an example: for damages – usually three years after the damaged party learned (or could have learned) about the infringement (max 10 years after the event causing damage occurred), for other claims it is usually six years (three years in cases of commercial disputes).

The IP disputes, as a rule, have the obligatory representation of lawyers and special means of requesting evidence. The IP disputes may be summarised in the following points:

1) The claimant files a statement of claim and pays the court fee.

2) The defendant files a statement of defence (a minimum deadline of two weeks). The parties may file additional writs, subject to the court's consent.

3) Hearings are scheduled, including those to hear witnesses. Instead of an oral testimony, the court may request affidavits. In patent or other cases which require special knowledge (e.g. infringement of rights to advanced technical know-how or software) – an expert is appointed by the court either after hearing witnesses or in parallel with the scheduling of evidential hearings. The opinion usually takes several months to be drafted, after which the parties provide comments. In complex cases it is quite often that the expert has to provide a supplementary opinion or several opinions.

5) After all evidence is processed, the court will schedule the final hearing. Often, parties file summary writs or comments to the minutes of the last hearing with their summary of evidence and arguments brought.

6) The court delivers the judgment, either after the final hearing or within the next two weeks.

As of early 2022, the average time of proceedings was 12-18 months in each instance. Patent infringement proceedings usually last longer, up to two-three years, in the first instance.

20. What customs procedures are available to stop the import and/or export of infringing goods?

In Poland, customs procedures are based on EU Regulation 608/2013.

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

There are no such mandatory options or mechanisms. However, it must be noted that in the statement of claims, the claimant shall disclose information as to whether the parties have attempted mediation or other out-of-court resolution of the dispute and, where such attempts have not been made, an explanation of the reasons for not doing so. A lack of such attempts may impact on the recovery of the costs of court proceedings.

22. What options are available to settle

intellectual property disputes in your jurisdiction?

A settlement may be reached by the parties amicably at any moment of the dispute. Such amicable settlement may be concluded both out of court and before the court. In the latter case a settlement is reached during a court hearing and parties sign a settlement agreement which is subsequently deposited in court files. A court may also direct the parties to mediation but each party has the option to disagree.

Under exceptional circumstances (on rare occasions), a court may refuse to consent to a settlement agreement made before the court, the withdrawal of a lawsuit or the admission of a claim, if it finds those actions contrary to law or good morals, or aimed at circumventing the law.

23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

To establish infringement, a claimant should, in principle, demonstrate:

1) existence of the right – this is of particular importance for unregistered rights such as copyright or trade secrets, in case of registered rights a simple reference to a relevant register or certificate should be considered sufficient;

2) performance by the defendant of any of the unauthorised actions – depending on the type of right e.g. copying, distributing, using manufacturing, offering, marketing, importing / exporting products / copies being the subject of a protected IPR.

In relation to a particular right, the following factors are of particular importance:

Patents

Presence in the disputed product or process of the technical features of a protected invention as set out in an independent patent claim.

Utility Models

As with patents, a disputed product must reproduce features described in the protection claim.

Industrial Designs

Infringement assessment should be made by examining the overall impression the product produces on an

appropriately identified (depending on the type of product) informed user.

Trade Marks

Establishing the identity or similarity of the goods and services between the earlier mark and the disputed mark; the relevant public and their degree of attention; the distinctiveness of the earlier mark; and the identity or degree of similarity of the signs. This should allow the court to determine the existence of a risk of confusion. Specific prerequisites are required to demonstrate infringement of a renowned trade mark.

Geographical Indications

Establishing that a certain good does not meet the criteria stipulated in the registration of a GI, both in the event of an indication expressed in its original language and translations, as well as other derived forms.

Integrated Circuit Topographies

Reproduction of a topography in an integrated circuit.

Copyrights and Related Rights

Transfer of elements being the result of creative activity of an individual character.

Plant Breeder's Rights

Unlawful use of a protected variety. Additionally, it is worth mentioning in this context unlawful use of a protected name of a variety.

The Code of Civil Proceedings contains an open catalogue of evidence and mentions so, by a way of examples of several of them. In IP-related matters, the most significant are evidence from: court-appointed expert opinions, private expert opinions, visual inspections, hearing of the parties, evidence from film, television, photocopies, photographs, plans, drawings, plates, audio tapes, surveys, laboratory reports, acts witnessed in the presence of notary public.

24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are

available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence?

The Polish judicial system does not provide for technical judges (i.e. with technical education) in IP courts. Opinions prepared by experts in infringement cases often play a critical role in proceedings involving technical subject matters. In such cases, a court-appointed expert opinion would be most relevant to the court. However, in complex matters, finding a court-appointed expert from an official court list may be difficult. Then it is not uncommon for the parties to agree on an expert.

It is also worth noting that filing private expert opinions is very common.

In patent proceedings and other cases of a technical nature, claimants and defendants often submit opinions prepared specifically for such litigating 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.

b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

Polish civil procedure sets out three types of legal actions for the disclosure of information and evidence which are available for parties (mostly claimants) specifically in intellectual property cases. These are: a motion to secure means of evidence, a motion to hand over or disclose evidence, or a motion for information.

25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

The court assesses the credibility and strength of evidence according to its own conviction, on the basis of a comprehensive consideration of the material gathered.

In civil proceedings, cross-examination is also available, besides other methods of questioning – spontaneous account and directed questions. The frequency depends entirely on the particularities of a case. Importantly, in IP

court proceedings having a so-called commercial (economic) character, hearing of witness by court is limited.

The court may also assess the weight to be given to a party's refusal to produce evidence or to obstacles placed by a party in the way of its production contrary to a court order.

26. What defences to infringement are available?

Defendants may bring a broad range of defences against infringement claims, both on the grounds of procedure and on the merits, depending on the particular IPR invoked. Just to mention a few: lack of right or challenging a registered right before a competent authority, prior use, failing to prove the occurrence in a questioned matter of features protected by a given IPR, abuse of a right; exhaustion of a right, fair use, personal use, non-use of right invoked for a particular period (e.g. lack of the genuine use of the trade mark registered for over five years) and many others. Defences based on general civil law principles are applicable as well.

27. Who can challenge each of the intellectual property rights described above?

Anyone can challenge: patent, utility model, SPC, industrial design, integrated circuit topography in a relevant proceedings before the PPO.

Similarly, anyone may request trade mark invalidation. However if a basis for the invalidation is an earlier right of geographical indication, designation of origin, traditional term for a wine or a traditional speciality guaranteed, infringement of personal or property rights, identical or similar trade mark with an earlier priority in favour of another person, only a right holder or person authorised to exercise the right may invoke such basis. Additionally, anyone may file a request for termination of a trade mark due to lack of genuine use, loss of distinctiveness, capability of misleading the public and other particular reasons.

The geographical indications may be revoked at the request of any person with a legitimate interest in doing so.

The Attorney General of the Republic of Poland or the President of the Patent Office may, in the public interest, request the revocation (in particular cases termination) of a patent, utility model, SPC, industrial design, trade mark, geographical indication or join the pending

proceedings in the case.

Copyright protection may also be challenged; however, due to their nature it rather occurs as a defendant's position during civil proceedings initiated by a person invoking said rights.

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

All of the discussed IPRs may be challenged, as a rule, at any time during the subsistence of the right.

Additionally, please see our response to question 7.

29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

The forum for challenging rights registered before the PPO, is the PPO itself, whose decision in opposition / revocation / invalidity proceedings may be appealed to administrative courts.

The main grounds for challenging discussed rights is the failure to fulfil protection requirements. However, additional circumstances may also constitute grounds for challenging (e.g. lack of genuine use, loss of distinctiveness etc.).

Additionally, in trade mark and industrial design infringement actions, a defendant may file a counterclaim for the revocation or invalidation of the earlier trade mark or for the invalidation of the industrial design. In such cases the appropriate forum is an IP court (common court).

30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

Since 2020, it is possible to file an action for declaration of non-infringement. A claimant may bring an action to establish that the acts undertaken or intended to be undertaken by the claimant do not constitute an infringement of a patent, utility model, SPC, trade mark, industrial design, integrated circuit topography or

geographical indication, provided that there is a legal interest. The Code of Civil Procedure adopts that a legal interest exists if the defendant: 1) has deemed the acts to which the action relates to be an infringement of a given right; 2) has failed to confirm, within the time limit duly set by the claimant, that the acts to which the action relates do not constitute an infringement.

Additionally, the PPO may grant a compulsory licence:

1) when it is necessary to prevent or remove a threat to state security;

2) when a patent is abused, in particular by preventing the use of the invention by a third party, when it is necessary to meet the needs of the national market, in particular when the public interest requires it and the product is available to the public in insufficient quantity or quality or at excessively high prices; and

3) when it is established that the holder of an earlier patent prevents, by not agreeing to a licensing agreement, the use of the patented invention (dependent patent), the use of which would encroach upon the scope of the earlier patent, from satisfying the needs of the domestic market.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

With respect to all types of IPRs – a motion for interim injunction can be filed by the right holder to secure their claim (during the course of the main infringement proceedings) in case the claimant is able to demonstrate to the court that: (i) its claim is probable (corroborated) and (ii) it enjoys a “legal interest” in obtaining a preliminary relief. The claim is considered probable by the court examining the preliminary relief motion if, prima facie, there is a significant chance of its existence. In turn, legal interest was defined in the CPC and is deemed to exist in those cases where the lack of a preliminary relief would prevent or significantly hinder the enforcement of a judgment issued or otherwise prevent or seriously hinder satisfying the purpose of the proceedings.

Since July 2023, a time limit for initiating an interim injunction action has been introduced. The court shall dismiss the motion for injunction if it is filed more than six months after the day on which the party or participant in the proceedings became aware of the infringement of its exclusive right.

In principle, in the main proceedings, a claimant in IP

cases may demand the following:

- 1) cessation of infringement;
- 2) surrender of profits;
- 3) redress of damages (here, in case of industrial property rights, as a rule, this claim may be invoked only in the case of infringement caused by fault);
- 4) publication of a judgment in the press;
- 5) withdrawal from the market / grant to the right holder / destruction of the infringing items.

In particular cases, an alternative measure may be provided: if a given claim would be disproportionately severe for the infringer and the infringer was not at fault, at the infringer's request, the court may order the infringer to pay an appropriate monetary sum to the right holder.

In case of trade marks, the court may also: prohibit preparatory acts, order the indication of the fact of registration of the trade mark in a dictionary, encyclopaedia or other publication, or prohibit the introduction into the territory of the Republic of Poland of goods in external transit.

32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

The final litigation costs (including attorney fees and proceedings costs) depend on the complexity of the case, number of hearings scheduled by the court in each

instance, the number of pleadings prepared and filed by the parties and the possible engagement of a court-appointed expert (e.g. where technical know-how is involved), etc.

Reimbursement of the costs of legal proceedings includes: the court fee incurred by the party, the costs of travel to the court of the party or its representative; and the equivalent of earnings lost as a result of appearing in court as well as mediation costs (if conducted). Such costs also include attorneys' fees.

As a general rule, the unsuccessful party is obliged to reimburse the opponent, at its request, for the costs necessary to assert and defend itself (litigation costs).

Considering securing the costs, a claimant who does not have his or her domicile or habitual residence or seat in the Republic of Poland or in another Member State of the European Union shall be obliged, at the defendant's request, to give a security deposit for the costs of the proceedings.

33. The Unified Patent Court ("UPC") [came into] [will come into] existence in certain European states on 1 June 2023, as did the introduction of European patents with unitary effect ("unitary patents"). Have industry-specific trends developed in your country in terms of the number of patent applicants seeking unitary patent protection and/or enforcing European patents or unitary patents before the UPC?

Poland is not a party to the UPC Agreement, so currently there have been no industry-specific trends developed in this regard in Poland.

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