

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Poland²

Addendum

INDUSTRIAL PROPERTY RIGHTS

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

1. Specify the courts which have jurisdiction over IPR infringement cases.

Regional courts – as courts of the first instance.

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?

Industrial property rights may be asserted by the creator of an inventive project, the holder of an industrial property right or any other person who acquired the right by right of succession, as well as a social organisation whose activities include the encouragement of inventive activity. The creator may act on his own, may be represented by a patent agent, by an attorney or by a social organisation, as mentioned above. There is no requirement for mandatory personal appearances before the court by the right holder. Nevertheless, the court may demand his personal appearance in case where:

- the court finds the matter necessary for being better clarified, or
- the court rules on taking evidence by hearing the parties, if after having examined other evidentiary material, the facts essential for deciding the case have remained unclear.

In both cases the appearance of the party may not be imposed and failure to appear may not cause adverse effects other than the omission of evidence by hearing the parties.

¹ Document IP/C/5.

² Responses to the Checklist in relation to industrial property rights are being provided below, in addition to the responses to the Checklist in relation to copyright and related rights which have been distributed in document IP/N/6/POL/1.

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?

A court competent to hear a case may demand that a party infringing another's industrial property right provide information and access to documentation that is relevant and essential for the claim, however there are no direct consequences for the party refusing to meet such demand. According to general rules of civil proceedings, it is up to the court to judge the refusal.

4. What means exist to identify and protect confidential information brought forward as evidence?

A court hearing during which evidence containing confidential information is supposed to be disclosed, is conducted, at the party's request, *in camera*, i.e. with no third parties being allowed to be present. Files of the proceeding are only available to the parties taking part in the proceeding. In cases examined with the exclusion of the public no one but the parties and functionaries supervising court proceedings may have access to the files. Officials (judges, court officials, attorneys), who take part in the examination of the case, are obliged to keep secret the information disclosed to them in the course of the proceeding.

The court hearing the case – at the request of an opposing party – may oblige a party to keep confidential information secret.

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

In respect of patents, utility models and topographies of integrated circuits the court may rule on:

- the cessation of an infringing act,
- the redress of its consequences,
- the surrender of unlawfully obtained profits, and
- compensation of damages;
- the infringing party may also be required to publish an appropriate statement in the press and, if he/she acted intentionally, to pay adequate amount of money to one of the social organisations whose activities include the encouragement of inventive activity – for the purpose of encouraging that activity.

In respect of trademarks and geographical indications the court may order the same sanctions and additionally the following:

- the cessation of the use in trade of any sign constituting the evocation, imitation or translation of the holder's trademark or of an essential part thereof, also in respect of the goods, which are not of the same kind as those covered by the protected trademark.

The holder of a patent, a right of protection or a right in registration, or a person entitled under the Industrial Property Law, may demand stopping the acts threatening infringement of the right.

When ruling on the infringement of a right, the court may, at the holder's request, decide as to the disposal of unlawfully manufactured or marked products and of the means used in their manufacturing or marking.

The court may order that the losing party pay attorney's fees of the other party according to the regulations on payment of court fees.

Legislative criteria are the following: good/bad faith; in case of trademarks and geographical indications involved – unlawful use, misleading nature of the use, the use detrimental to the distinctive character or the repute of the trademark.

The general jurisprudential criteria are: the loss (damage) suffered, causal nexus, intentional/unintentional guilt.

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?

In the Polish civil law procedure there is a possibility of obtaining specific information, e.g. on the identity of third persons involved in the production and distribution of the goods and services found to be infringing, by way of hearing the infringer. In the course of the hearing the opposing party may ask questions.

7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

For damages caused by public functionaries the State Treasury is liable, if the damage was caused by the official's fault. The official's fault is involved in case of his transgressing his competence exercised under the provisions of law. However, when the damage is caused by the decision (judicial or administrative), the State Treasury is liable only to the extent to which in taking the decision the provisions of law have been transgressed (by the official) in a way falling under criminal or disciplinary liability and prosecuted under the criminal or disciplinary procedure, and the official's fault has been declared in a decision or recognised by a superior authority. The above prerequisites of liability are equally applicable to damages as may be caused by abuse of means of protection of industrial property rights.

8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

In the usual procedure there are no provisions governing the length of proceedings except the general rule that in a proceeding to secure claims a court competent to hear the case should consider a party's application within three days. Appeal against such an order should be considered within seven days.

In respect of claims ensuing from property rights, a party is required to deposit in advance a specified amount of costs of the proceedings, around 8 per cent of the amount claimed. In respect of other claims, costs of proceedings are relatively small. To these costs attorneys' fees have to be added, which are regulated by a special Act.

No precise data are available on the actual duration of proceedings. The length varies to a large extent between district courts.

(b) Administrative procedures and remedies

9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.

Under the new Industrial Property Law, protection granting procedures and litigation procedure applied by the Patent Office are governed by the provisions of the Code of Administrative Procedure. Consequently, any decisions taken and orders issued by the Patent Office in the course of protection granting proceedings may be subject to complaint to the Supreme Administration Court.

The Patent Office applies the litigation procedure when taking a decision:

- on invalidation of a patent, a right of protection or a right in registration,
- on the lapse of a patent for an invention concerning a micro-organism or for the use thereof in the case referred to in Article 90(1)(iv),
- on the lapse of a right of protection for a trademark in the cases referred to in Article 169(1),
- on the lapse of a right in registration of a geographical indication in the case referred to in Article 192(1),
- on the lapse of a right in registration of a topography in the case referred to in Article 231(2),
- on the grant of a compulsory licence for exploiting an invention, a utility model or a topography,
- on the change of a decision on the grant of a compulsory licence,
- on the ascertainment that a request for the amendment of the conditions for the use of a geographical indication in the case referred to in Article 188(3), is unjustified,
- on the ascertainment that the reasons exist for the deletion of the trade name from the specification at the request of a third party,

- on the invalidation of a patent, a right of protection or a right in registration in consequence of an opposition filed, which is claimed by the right holder to be unjustified.

Decisions taken or orders issued by the Patent Office in the above litigious cases may be subject to complaint to the Supreme Administration Court.

A complaint remitted by the Supreme Administration Court for commenting on whether or not it is justified, the Patent Office directs to the Chamber of Appeals for examination. Following the examination of the complaint by the Chamber of Appeals, the Patent Office either admits the complaint in whole or conveys the reply to the complaint together with the files of the case to the Supreme Administration Court.

In consequence of the complaint execution of the decision or of the order may be suspended by the President of the Patent Office also where the suspension has not been effected by virtue of law or ordered by the Supreme Administration Court.

Provisional Measures

(a) *Judicial measures*

10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.

In cases involving intellectual property rights provisional measures are applied in order to prevent infringement of the right.

Before a suit is brought the court considers a request of a party having legal interest therein within three days from the date of bringing such request before the court for:

- securing evidence;
- demanding the other party to provide information and access to documentation;
- securing claims and ordering the suspension of the goods bearing a counterfeit trademark or geographical indication on the border by way of issuance of a temporary order (Article 309(3) of the Industrial Property Law).

11. In what circumstances may such measures be ordered *inaudita altera parte*?

In all of the cases mentioned above.

12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

An interested party may submit a written request to the court. The court awarding a temporary measure gives the plaintiff a time-limit of up to two weeks for bringing a suit before the court. Failure to bring the suit within the above time limit results in the expiration of the temporary measure. The court may make awarding of temporary measures conditional upon making a relevant deposit. In principle, the temporary measure remains executable pending the whole proceeding. The other party may at any time complain against the measure awarded and demand its revocation. In the

event of the plaintiff losing his case, the other party is entitled to demand the redress of any damage suffered by the application of the temporary measure.

13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

The court is expected to award a temporary measure within three days from a request being submitted. The other party is given a time-limit of seven days for appealing against its decision.

As regards the length of proceedings, there are no precise data available. Costs amount to appr. 1.5 per cent of the overall sum claimed.

(b) *Administrative measures*

14. Reply to the above questions in relation to any administrative provisional measures.

No special provisions on industrial property rights in this respect.

Special Requirements Related to Border Measures

15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

Under the provisions of the new Industrial Property Law suspension by the customs authorities of the release into free circulation may be applied for goods bearing a counterfeit trademark or a counterfeit geographical indication.

Such procedures are not applied to goods which are in transit through the Polish customs area or imported by travellers in quantities allowed under the provisions of the customs law for goods exempted from customs duties.

The customs control may be waived on the border with a country, with which the Republic of Poland forms part of a customs union and has substantially dismantled all controls over movement of goods across that border.

As regards the application of the above procedure to import of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation, there are no special provisions to that effect.

According to the provisions of the Regulation of the Council of Ministers of 24 February 1999 on the procedure and operating principles for Customs Authorities for withholding goods in case of suspected violation of provisions on protection of intellectual, commercial and industrial property it is possible:

- to submit a written application for the protection of intellectual, commercial or industrial property rights;
- to undertake *ex officio* action.

Provisions of the above-mentioned Regulation are applicable to all customs procedures *de minimis* imports and goods usually treated as gifts of which the numbers and types do not denote trade purposes excluded.

16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?

According to the provisions of § 9 of the above-mentioned Regulation the Customs Authorities are allowed to withhold the goods according to the *ex officio* action for 3 working days to enable the right holder to submit an application for the protection. Such activities may be taking only if, in the course of customs control of the goods, it appears evident to the customs authority that the goods are pirated or counterfeited. If the right holder fails to submit an application, the customs authority shall release the goods into free circulation.

According to § 2 of the Regulation, the application for the protection shall include in particular:

- information on the applicant;
- information on the right holder;
- description of goods which is a subject of protection, allowing to identify the goods and including the following data:
 - code number of Customs Tariff,
 - sending country,
 - country of production,
- data on the producer,
- assumed customs value of goods to be withheld,
- requested protection period.

The application shall be appended with:

- an original or an authorised copy of a proof of ownership of intellectual, commercial or industrial property rights:
- an authorisation to request for the protection of intellectual, commercial or industrial property rights, if the applicant is not identical with owner of these rights;
- evidence to allow for the identification of the goods subject to the protection of intellectual, commercial or industrial property rights.

The application shall be submitted in writing. The application may be supplied with information on import into the Polish customs territory of counterfeit or pirated goods. The decision on withholding goods shall be taken by the President of Central Board of Customs.

The customs authority shall release the withheld goods in case, within a period not longer than ten working days after the applicant has been served notice of the suspension, the applicant failed to provide the customs authorities with an appropriate provisional order, issued by a court to secure the applicant's claims or a proper order issued in criminal proceedings. This period may be extended by the customs authorities, following a written application, for no longer than 10 working days, and only in the instance of the court's failure to consider the motion to issue a provisional order or a proper order which is issued in criminal proceedings.

This procedure shall apply only if the right holder is known to the customs authority.

The right holder or a person authorised to make use of such a right, or a person authorised to act on behalf of the right holder, shall submit a written application for the protection of intellectual, commercial or industrial property rights to the President of Central Board of Customs.

The application should contain information indicated above.

Applications shall be decided upon by the President of Central Board of Customs. The decision should include in particular:

- specification of the object of protection
- period of protection
- the amount of security
- the period when the security should be delivered.

The decision on the protection of intellectual, commercial or industrial property rights is issued, if the applicant delivers a security in the amount established on the level of ten per cent of assumed customs value of the goods, however not less than 5000 EURO.

The security is established to cover costs related to customs custody of withheld goods by the time of ascribing to them the customs purpose and to secure claims of persons whose rights have been infringed in connection with withholding goods.

The customs authority shall provide written information on withholding the goods to the person who introduces or removes goods from the Polish customs territory and to the applicant. The customs authority may notify the applicant, at his request, of the name and address of a person who introduces or removes goods from the Polish customs territory and the consignee so as to enable the applicant to provide the authorities competent to launch the proceedings.

If, within a period not exceeding ten working days after the applicant has been served notice of the suspension, the applicant failed to provide customs authorities with an appropriate provisional order, issued by a court to secure the applicant's claims or a proper order issued in criminal proceedings, the customs authority shall release the withheld goods. The period may be prolonged by customs authorities following a written application, for no longer than ten working days, and only in the instance of the court's failure to consider the motion to issue a provisional order or a proper order which is issued in criminal proceedings.

In order to allow the protection of intellectual, commercial, or industrial property, a customs authority may provide the applicant, following a notice to the person who introduces goods or removes them from Poland's customs territory, with a sample of withheld goods in order to conduct tests to determine the characteristics of withheld goods.

- 17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?**

The decision approving an application for protection of intellectual, commercial or industrial property cannot be longer than 12 months; this period may be prolonged for no longer than the next 12 months. The fees for issuing a decision upon the application equal 2.200 PLN. According to the issued application or to *ex officio* action the withheld goods are placed under customs supervision and cannot be released into free circulation before bringing in a verdict of the court.

- 18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?**

See the answer to question 16.

- 19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.**

See the answer to question 16.

Criminal Procedures

- 20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.**

District courts.

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

Criminal procedures and penalties are available in respect of infringements described in Title X (Penal Provisions) of the Industrial Property Law. The respective provisions are the following:

Anyone who usurps another's authorship or misleads another party as to the authorship of another's person inventive project, or otherwise infringes rights of the creator of an inventive project, is liable to a fine, limitation of freedom or imprisonment for a period not exceeding one year.

A person committing the above act for material profit or personal gain, is liable to a fine, limitation of freedom or imprisonment for a period up to two years.

Any person who, not being entitled to be granted the exclusive right, files another's invention, utility model, industrial design or topography of an integrated circuit in order to be granted a patent, a right of protection or a right in registration, is liable to a fine, limitation of freedom or imprisonment for a period of up to two years.

The same penalties incur anyone disclosing information on another's invention, utility model, industrial design or topography of integrated circuit or otherwise preventing another party from being granted a patent, a right of protection or a right in registration.

A person committing the latter act unintentionally is liable to a fine.

Anyone marking goods with a counterfeit trademark for the purpose of placing them on the market or placing on the market goods bearing such trademark, is liable to a fine, limitation of freedom or imprisonment for a period of up to two years. In case of conviction for that offence, the court may order forfeiture, to the fiscus of the goods proceeding from the offence as well as the materials, tools and technical means, which have served or have been intended to serve for the purpose of committing the offence, even if they do not belong to the perpetrator.

A person committing the above acts unintentionally is liable to a fine.

A person who has made the above offence his continuing source of proceeds or commits that offence in respect of the goods of handsome value, is liable to imprisonment for a period from 6 months to five years. In case of conviction for that offence the court orders forfeiture, to the fiscus, of the goods proceeding from the offence as well as the materials, tools and technical means, which have served or have been intended to serve for the purpose of committing the offence; if such materials, tools or technical means do not belong to the perpetrator, the court may order the forfeiture thereof to the fiscus.

In case of ordering the forfeiture, Article 195 of the Executive Penal Code shall apply accordingly, whatever is the value of the goods, the forfeiture of which has been ordered.

Anyone marking goods not protected by a patent, a right of protection for a utility model or a right in registration for an industrial design, for a topography of an integrated circuit, or for a geographical indication, with statements or signs calculated to give the impression that the goods enjoy such protection, is liable to a fine or detention.

Anyone putting on the market, or preparing or stocking for that purpose the above-mentioned goods or providing by announcements, communications or otherwise, information calculated to give the impression that the goods enjoy legal protection, while being aware of their being falsely marked, is liable to the same penalties.

Anyone putting on the market goods bearing a trademark accompanied by a discriminant which is intended to make a false impression that the goods enjoy such protection, is liable to a fine.

In organisational entities, the liability referred to in the above cited provisions incur a person running or managing an entity, unless the allocation of responsibilities implies the liability of another person.

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

The public prosecutor.

Prosecution of persons committing the offences referred to in the provisions cited above is initiated at the injured person's request.

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

An injured party may directly bring a case before the court to initiate proceedings.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

Penalties that may be imposed are listed in the response to question 21.

25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

The public prosecutor is expected to conclude a preparatory proceeding within one month from the date of receiving a complaint, or, in more complicated cases, within two months. There are no specific regulations on the length of court proceedings. There is no charge whatsoever on the plaintiff in the case of public prosecution. If an injured party acts as a private prosecutor, he/she advances costs to the court; the costs however are negligible. An injured party represented by an attorney pays attorney's fees.

No precise data are available on the actual duration of proceedings.
