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Anti-counterfeiting 2012

Poland

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Patpol – Patent & Trademark Attorneys



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Legal framework

Rights holders in Poland can protect their rights through both civil and criminal proceedings. Moreover, in order to extend the scope of protection against other potential threats, rights holders can rely on customs procedures.

Poland is a signatory to several international treaties relating to trademarks and anti-counterfeiting, which have the same legal effect as regulations directly established by the Polish Parliament. These treaties include:

- the Paris Convention;
- the Madrid Agreement and Protocol relating to the Madrid Agreement concerning the International Registration of Trademarks; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights.

Since May 1 2004, when it acceded to the

European Union, Poland has been bound by EU legislation, including the EU Community Trademark Regulation (207/ 2009).

The main legislation on trademark protection is the Industrial Property Law of June 30 2000, which came into effect on August 22 2001, with further amendments. Other Polish and EU acts regarding anti-counterfeiting or piracy include the following:

- the Code of Criminal Proceedings;
- the Penal Code;
- the Civil Code;
- the Code of Civil Proceedings;
- the Act on Combating Unfair Competition Practices;
- the Copyright Law;
- the Pharmaceutical Law;
- the EU Community Trademark Regulation;
- the EU Regulation on Customs Action against Goods Suspected of Infringing IP Rights (1383/2003); and
- the Ministry of Finance Regulation on the Destruction of Goods under Article 11 of EU Regulation 1383/2003.

Border measures

As an EU member state, Poland is bound by EU Regulation 1383/2003. This establishes that rights holders may file a request for customs protection with the main Customs Chamber in Warsaw; such protection prohibits the import or export of counterfeit goods. Once such protection is granted it remains valid for one year and is renewable. Under it, Customs has the right to seize and hold any suspected counterfeit goods for 10 working days (which can be extended by 10 further days, if justified). Rights holders can then contact the customs office where the goods are being held and request more detailed information about the entity or person who signed the customs declaration, as well as data concerning the recipient of the goods, the amount seized or samples of the suspect goods.

In case of seizure, a rights holder must provide customs authorities with evidence that it has filed a motion for prosecution, a request to secure the claim or a statement of claims.

In practice, this means that rights

holders should file the motion for prosecution (with the police, the Public Prosecutor's Office or the appointed customs offices), or the request to secure the claim or the statement of claims, with a civil court within 20 working days of the customs seizure (this includes the initial statutory 10 days and then a 10-day extension, which may be justified on the basis that the motion for prosecution, the request to secure a claim or the statement of claim is being prepared for filing). The 10-day period starts from the date on which the rights holder is notified in writing about the seizure.

Another option is for rights holders to obtain consent from the importer for the seized goods to be destroyed and then provide Customs with a copy of this (a so-called 'simplified procedure', as provided under the Ministry of Finance Regulation on the Destruction of Goods).

Otherwise, the goods will be released.

According to EU Regulation 1383/03, Polish Customs can seize goods *ex officio*, even if customs protection has not yet been applied for or granted. Customs may hold goods for up to three working days to enable the rights holder to file the above-mentioned request for customs protection. Otherwise, the goods must be released.

Criminal prosecution

Trademark protection under the Penal Law is guaranteed by the following acts:

- the Industry Property Law;
- the Code of Criminal Proceedings; and
- the Penal Code

The Industrial Property Law provides a legal definition of a 'trademark' and a 'counterfeit trademark', and sets out criminal provisions with regard to counterfeiting.

According to the Industrial Property Law, a 'counterfeit trademark' is any mark that is identical to or indistinguishable in the course of trade from a registered trademark that is unlawfully used in respect of goods covered by the registration.

A party that affixes a counterfeit trademark to goods with the intention of introducing them onto the market or that commits acts resulting in the turnover of such goods may be subject to:

- a fine;
- restriction of liberty; or
- imprisonment for up to two years.

The owner of an infringed trademark is entitled to commence a criminal action. Only after filing a motion for prosecution

can an investigation be started and further continued *ex officio*. The exception is when permanent profits are obtained from criminal activity involving a registered trademark, or when criminal acts result in the turnover of counterfeit goods bearing a valuable trademark. In such cases the infringer is subject to more serious criminal penalties and an investigation may be started by the police or public prosecutor *ex officio*.

However, anyone committing such criminal acts will be punished only if it can be proved that the action was intentional.

In general, trademark protection is broader under civil than under criminal law. The criminal regulations of the Industrial Property Law do not apply in situations where infringement has taken place in respect of an unregistered trademark, including unregistered famous and well-known trademarks.

Investigation against criminal infringement is conducted by the following authorities:

- the public prosecutor;
- the police; and
- Customs.

Pursuant to the Code of Criminal Proceedings, the owner of an infringed mark is considered the injured party during investigation and trial. Consequently, the rights holder may act before the court as an auxiliary prosecutor together with the public prosecutor.

Evidence obtained in criminal proceedings may be admitted for use in civil proceedings and vice versa. However, the Civil Court is obliged to recognise the established facts that were the grounds for any verdict issued by the Criminal Court.

Civil enforcement

The implementation of the EU IP Enforcement Directive (2004/48/EC) into the Polish Industrial Property Law came into effect on June 20 2007. The amendments revised the provisions on the civil enforcement of trademarks and anti-counterfeiting efforts.

Under the amended law, the following remedies are now available to rights holders:

- cessation of the infringement;
- surrender of unlawfully obtained profits;
- compensatory damages, in accordance with the relevant principles of the Civil Code, or payment of a lump-sum equivalent to a licence fee or any other remuneration that would have been due had the infringer been authorised to use

the trademark;

- publication of the court verdict – either in whole or in part – or publication of information about the verdict;
- disposal, at the rights holder's request, of the unlawfully manufactured or marked products, as well as the means used to manufacture them (ie, by removing them from the market or destroying them); and
- the court may order the infringer (in case of unintentional infringement) to pay the relevant sum to the benefit of the rights holder if the cessation of infringement or forfeiture of the goods would be disproportionate and the above-mentioned sum would fulfil the rights holder's interest.

As for pre-trial discovery and obtaining evidence, the court will oblige defendants or third parties to provide it with relevant evidence (ie, documents confirming the scope of sale of counterfeit products). Since June 20 2007, rights holders have been able to request the court, in separate proceedings, to order defendants or third parties to deliver information regarding the following:

- the origin of and distribution networks for counterfeit goods;
- the names and addresses of manufacturers and suppliers; and
- the amount of the goods that were manufactured and then sold.

In civil proceedings, a rights holder may seek a preliminary injunction. Requests for injunctions must be filed with the court, together with evidence of:

- the rights holder's legal interest in requesting the injunction – this is deemed to exist where a failure to impose an injunction would seriously impede enforcement of the court's decision;
- the rights holder's ownership of the infringed trademark; and
- the fact that the infringement was committed in respect of goods under the relevant trademark.

A request for a preliminary injunction may be brought before filing the statement of claim or during the trial once it has started.

If the request is filed before the trial commences, the court, upon issuing a decision to grant a preliminary injunction, will designate a deadline for filing the statement of claim. If the plaintiff misses this deadline, which cannot exceed two weeks, the

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entire claim is liable to cancellation. The decision on a preliminary injunction may also be treated as grounds for seizures and raids conducted by court bailiffs.

Under current regulations, a request for a preliminary injunction should be examined immediately. However, in practice, court decisions on preliminary injunctions usually take between 10 and 14 days.

Trademark infringement cases are handled by common civil courts; there are no separate special IP courts.

If a case concerns a dispute between two companies on the grounds of their business activity, it will be examined by a civil court in commercial proceedings. This distinction can have a crucial impact on the parties, as the formal requirements in commercial proceedings are much stricter. In particular, there are restrictions regarding the filing of evidence (the principle of so-called ‘evidence preclusion’).

It is thus necessary for the plaintiff to mention in the statement of claim all statements relevant to the case and to attach all evidence to support those statements, under penalty of being precluded from serving the court with further evidentiary materials after the proceedings have started.

Legislative works to repeal the principle of ‘evidence preclusion’ in commercial proceedings are pending. At the time of writing, a bill is being drafted and the legislative process is expected to be completed in 2012.

The main kinds of evidence are witnesses, documents and the opinions of court-appointed or private experts. The burden of proof rests with the plaintiff.

Disputes involving Community trademarks are handled by the Community Trademark Court in Warsaw. This examines cases on the basis of the provisions set out under EU Regulation and the relevant

provisions of Polish law (ie, the Code of Civil Proceeding).

Anti-counterfeiting online

There are no separate regulations for dealing with IP infringement in e-commerce. Rights holders have the same measures available to them to combat infringers as in all other offline cases. Depending on the specific facts, individuals engaged in the online trade of counterfeit or pirated goods may be subject to civil or criminal liability on the same grounds as for offline trading in counterfeit or pirated goods. As in ordinary cases, it is necessary for rights holders to collect evidence of potential online infringement before initiating civil or criminal proceedings.

If action is necessary, the burden of proof will rest on rights holders. Therefore, they should undertake relevant security measures, such as internet investigations, to detect infringing activity and ensure the easy collection of evidence. Those measures should also include online monitoring, in particular online auctions. The leading Polish auction services offer programmes designed to monitor and eliminate trading in counterfeit or pirated goods. Those programmes require significant efforts on the part of the rights holder or its representative in Poland. Usually, the monitoring requires the purchase of a counterfeit or pirated product in order to collect evidence for civil or criminal proceedings.

Despite the fact that liability of internet service providers (ISPs) is significantly limited, existing programmes show that ISPs are more aware of the problem of online trading in counterfeit and pirated goods. ISPs cannot be held responsible for the fact that rights are infringed on the Internet, as they are not responsible for content. However, under Polish criminal law, ISPs

may be held liable as accessories, under specific conditions.

Preventive measures/strategies

Undertaking preventive measures in Poland, as in any jurisdiction, requires the involvement of local counsel who are not only familiar with the local law and practices, but also have a good working relationship with the relevant authorities (eg, the police, Customs or ISPs). Local counsel usually cooperate with local investigators who are entitled to collect the evidence necessary to initiate enforcement.

Proper licensing and/or manufacturing contracts – usually reviewed by local counsel – can be an effective tool to enforce IP rights. Properly managed licensing programmes, also at the local level, are a significant part of IP enforcement. The appropriate performance of a licence contract can be monitored by a local investigator, who will then report breaches to the owner. Licensing or manufacturing schemes often include authentication measures (eg, bar codes, holograms or bubble codes) that allow products to be traced and verified easily and quickly.

Rights holders are advised to cooperate with national anti-counterfeiting agencies, Customs, the police and the appropriate ministries. Rights holders should provide the authorities with adequate training, together with information necessary for them to distinguish between genuine and counterfeit goods and to protect IP rights. In order to enhance IP awareness, the interested parties should play an active role in campaigns addressed to the public. A well-balanced combination of these measures will provide the best protection for IP rights. [WTR](#)

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Jaromir Piwowar is a legal adviser in the legal department of Patpol and a member of the Regional Council of Legal Advisers in Warsaw since 2006. Mr Piwowar graduated from Warsaw University's Faculty of Law and Administration (LLM, 2002) and has also completed postgraduate studies in intellectual property there. His practice includes the enforcement of IP rights in the field of civil and criminal law, including domain name disputes, protection against unfair competition practices and cases related to customs seizures of counterfeit goods at the border.



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Bartek Kochlewski is an advocate and a graduate of Warsaw University, admitted to the Warsaw Bar in 1997. Since 2009 he has headed the IP enforcement team at Patpol. His practice includes the enforcement of IP rights, domain name disputes, protection against unfair competition practices and copyright litigation. Mr Kochlewski represents clients before the Polish courts, including the Supreme Court, in many IP and IT-related cases, and advises clients on criminal law aspects of IP enforcement. He has experience in counselling clients on contractual and licensing aspects of information technology and intellectual property. In addition, Mr Kochlewski contributes articles to IP magazines.