

Industrial Property Protection

Legal grounds

Issues concerning industrial property in Poland are regulated under the Industrial Property Law Act of 30 June 2000 (unified text in Journal of Laws of 2003, No. 119 item 1117 as amended) (the "IPL").

The IPL in its scope covers almost all areas of industrial property including regulations covering inventions, utility models, industrial designs, rationalization proposals, trademarks, geographical indications, and topographies of integrated circuits as well as their protection. The only provisions that remain outside of its scope are those related to unfair competition (Unfair Competition Act of 16 April 1993) as well as provisions regulating professional activities related to the protection of industrial property (Act on Patent Agents of 11 April 2001).

One of the fundamental functions of the IPL is to stimulate economic development and to protect the rights and interests of author's rights. The first of these functions is met by the IPL by granting certain entities temporary exclusive rights to use protected property, thus giving them the possibility to use such for commercial purposes and, in turn, encourage work on innovations as well as their financing. The second function is fulfilled by regulating the rights of authors of intellectual property as well as the rights and obligations of business entities organising creative work and ensuring material resources, in particular financial resources, for the performance of such tasks.

IPL regulations pertaining to trademarks

Pursuant to the provisions of Article 120 of the IPL, any sign capable of being represented graphically may be considered to be a trademark, provided that such signs are capable of distinguishing the goods of one undertaking from those of other undertakings. A trademark may consist of, in particular:

- words
- designs,
- ornaments,
- combinations of colours,
- the three-dimensional shape of goods or of their packaging,
- melodies or other acoustic signals.

It should be noted that the list contained in the IPL serves solely as a sample. Therefore a trademark may have any of these designations, including designations not listed in Article 120 of the IPL, provided that said designation enables its distinction from other goods or services. Of designations that may be used to distinguish goods, only designations whose rights to registration are explicitly excluded by other provisions of the IPL may not be registered.

Disputes regarding the right to register a colour as a trademark exist in doctrine. A colour is difficult to identify as a distinguishing element

solely on its ability to distinguish a product, however, colour in combination with words that indicate the source of the product acquire distinguishing traits. By way of long-term use of a colour, in combination with extensive marketing of products marked with such a colour, the trademark acquires secondary registration rights. In the case of products having a quality recognised by clients, a trademark in the form of a colour may also become a synonym of reputation. This is because such, in competing for clients, fills the role of a guarantee as well as promotional. However, no obstacles exist for using letters or digits as trademarks.

Trademarks, pursuant to the provisions of the IPL, have to be registered in the **Patent Office** of the Republic of Poland in Warsaw. If a party lacks a residence or a registered office in Poland, such a party may only act through a patent agent. Obtainment of a protection right gives the exclusive right to use the trademark for commercial or professional purposes throughout Poland.

The term of the protection right for a trademark is 10 years from the date of trademark registration with the Patent Office and may be extended for all, or only certain goods, for subsequent 10-year periods.

Trademark protection

Pursuant to the provisions of the IPL, a breach of a trademark protection right consists of the illegal use in business trade of:

1. a mark identical to a registered trademark in the case of identical goods;
2. a mark identical or similar to a registered trademark in the case of identical or similar goods if there exists the risk of misleading customers, including, in particular, the risk of associating the mark with a registered trademark;
3. a mark identical or similar to a renowned trademark registered for any goods if such usage may yield undue benefit to the entity using such or if such usage may effect the distinctive nature or reputation of the registered trademark.

Therefore, the grounds and prerequisite for liability arising from infringement of the protection rights of a trademark are illicit actions. Despite a lack of a unified definition of such illicit acts, it may be deemed that, on the basis of the IPL, a breach of the legal order may be understood in the broad definition of such word and including - outside of restrictions arising from binding law - good customs or principles of social behaviour. The burden of proof of such prerequisite lies with the holder of the right.

The person (entity) whose trademark protection right has been breached may demand:

1. cessation of the breach and remedy of its consequences;
2. the handing over of groundlessly achieved benefits;

3. the remedying of damages pursuant to general principles; or
4. the payment of a pecuniary amount in an amount equal to a licence fee or other appropriate compensation that would have been due in conjunction with the holder of the right giving approval for the use of the invention at the time such amount is being pursued;
5. the publishing of the entire, or part thereof, of the ruling, as well as information regarding such a ruling in a manner and scope defined by the court;
6. the payment of compensation for use of the invention.

Claims for the breach of a trademark protection right - if the culprit acted in good faith - may be pursued for the period commencing from the day on which the Patent Office published news of the trademark's registration. If the person (entity) breaching the right has been notified earlier of such registration, then claims may be pursued from the date of such notification.

Community and international trademark

In the EU, along with domestic trademarks, since 1994 a community trademark has been used as introduced under **Directive 40/94** dated 20 December 1993 (OJ L 94.11.1).

A community trademark is subject to registration with the Office of Harmonisation of the internal market in the Spanish city of **Alicante**. Protection is granted for a period of **10 years with the possibility of its extension**. Registration of a community trademark ensures trademark protection on identical principles across all Member States and is independent of the national systems. Apart from EU and Polish protection, one can also obtain **international trademark protection** under the Madrid agreement of 1891.

Registration is made at **the WIPO office in Geneva** and, generally, this guarantees the status of a domestic trademark in all the signatory countries which do not refuse to grant it in their respective territories within one year's time. Unlike the case of the community trademark, such trademark protection is not uniform and is subject to decisions of the patent offices of the particular countries where one wants to register one's trademark.