

Law on Trademarks of January 31, 1985

(Dziennik Ustaw 1985, No 5 item 17)

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Part I General Provisions

1.—

This Law regulates legal relations and procedure in respect of the protection and use in economic activities of trademarks for goods and services.

2.—

The provisions of this Law shall be without prejudice to the provisions of international agreements.

3.—

Foreign natural and legal persons shall enjoy the rights afforded by this Law in accordance with the international agreements to which the Republic of Poland is party or under the principle of reciprocity.

4.—

(1) For the purposes of this Law, a trademark shall be any sign capable of distinguishing the goods or services of a given enterprise from similar goods or services of another enterprise.

(2) The following, in particular, are considered as trademarks: words, designs, ornaments, combinations of colors, plastic forms, melodies or other acoustic signals, and a combination of such elements.

5.—

References in this Law

- i) to an enterprise shall mean any natural or legal person entitled to carry on economic activities in the field of production, trade or the provision of services,
- ii) to goods shall also mean services,
- iii) to trademarks shall also mean service marks.

Part II

Registration of Trademarks

6.–

(1) A trademark shall be registrable on behalf of a specific enterprise, but only in respect of goods falling within its field of economic activity.

(2) The registration of a trademark for specific goods shall not prevent registration of other trademarks on behalf of the same enterprise in respect of the same or different goods falling within its field of economic activity.

(3) The registration of a trademark for specific goods shall not prevent registration of the same trademark on behalf of the same enterprise in respect of other goods falling within its field of economic activity.

7.–

(1) The only signs that shall be eligible for registration as trademarks are those that possess sufficient distinctiveness in ordinary economic activity.

(2) A sign shall not possess sufficient distinctiveness if it simply constitutes the generic designation of the product, if it simply makes a statement as to the properties, quality, number, amount, weight, price, purpose, manufacturing process, time or place of production, composition, function or usefulness of the goods or any similar information that does not enable the origin of the goods to be determined.

8.–

A trademark shall not be registrable if:

- i) it is contrary to law or to the principles of society;
- ii) it infringes the personal or economic rights of third parties;
- iii) it contains incorrect statements;
- iv) it contains the name or abbreviated name of the Republic of Poland or its symbols, emblem, national colors or national anthem, the insignia of the armed forces, the national hallmark of quality or the safety mark;
- v) it contains the name or armorial bearings of a Polish voivodship, town or community, the reproduction of a Polish decoration, a distinction, an honorary or military medal or military insignia; in cases where this is justified, such a mark may be registered if the competent State organs or authorities have given their approval;
- vi) it contains the name, abbreviated name or symbols (armorial bearings, flags, emblems) of a member State of the Paris Union for the Protection of Industrial Property or the name, abbreviated name or symbols of an intergovernmental organization to which one or more of the member States of the above-mentioned Union belong, or the Olympic symbol, where the applicant is unable to establish that he is authorized to use such mark in his economic activities.

9.–

(1) Registration of a trademark for goods of the same kind shall not be permissible where:

- i) it resembles a mark registered on behalf of another enterprise to such an extent that it could mislead purchasers as to the origin of the goods in ordinary economic activity;
- ii) it is similar to a trademark that is well known in Poland as a trademark for goods of another enterprise to an extent that it could mislead purchasers as to the origin of the goods in ordinary economic activity;
- iii) it is similar to a trademark previously registered in Poland of which the protection has expired, if less than three years have lapsed between the date of expiry of the right deriving from the registration of such trademark and the date at which the similar mark is filed by another enterprise;
- iv) it constitutes the protected denomination of a plant variety;

v) it contains the reproduction of an official stamp or an official control or warranty sign, unless the applicant can establish that he is authorized to use it.

(2) A trademark shall not be registrable if it contains geographical or other elements that refer to or designate a member State of the Paris Union for the Protection of Industrial Property or a region or community within such State, in respect of goods that do not originate in such State, and if the use of the trademark may mislead purchasers as to the origin of the goods, and if the exclusion of the trademark from registration derives from an international treaty.

Part III

Inception and Content of the Right Deriving from the Registration of a Trademark

10.–

(1) Protection for a trademark is obtained by registration.

(2) A certificate of protection shall be issued for each trademark that is registered.

(3) The Patent Office of the Republic of Poland, hereinafter referred to as “the Patent Office”, shall be responsible for registering trademarks and issuing certificates of protection.

11.–

Subject to section 12, priority for obtaining the right deriving from registration of a trademark shall be determined on the basis of its regular filing for registration with the Patent Office.

12.–

(1) In the Republic of Poland priority for obtaining the right deriving from registration of a trademark shall be available to any natural or legal person of a member State of the Paris Union for the Protection of Industrial Property and to any natural or legal person of another State if that person has his place of residence, business offices or a real and effective industrial, commercial or service establishment in a member State of the Paris Union for the Protection of Industrial Property:

i) as from the date of the earlier regular filing of the mark for registration in respect of the stated goods in a member State of the above-mentioned Union, on condition that the application for registration of the same trademark is filed with the Patent Office for the same goods within a period of six months as from that date; or

ii) as from the date of prior showing of the goods bearing the trademark at a public exhibition held in the Republic of Poland or in a member State of the above-mentioned Union, on condition that the application for registration of that trademark is filed with the Patent Office for the same goods within a period of six months as from that date.

(2) The priority right shall be transferable.

(3) The President of the Patent Office shall determine, on request or in agreement with the minister concerned, those public exhibitions and the conditions to be satisfied as regards the showing of the goods bearing a trademark in order to enjoy the priority right under subsection (1)ii).

13.–

(1) An enterprise on whose behalf a trademark has been registered shall have the exclusive right to use that trademark throughout the national territory in its economic activities for the goods covered by the registration.

(2) The use of a trademark shall consist, in particular, of affixing the mark to goods of the type registered or to their packaging, of marketing goods marked in that way, or of affixing the mark on documents relating to the marketing of such goods or for the purposes of advertising in the Polish mass media.

(3) The right deriving from registration of a trademark shall last for 10 years as from the regular filing of the application for registration of the trademark with the Patent Office. The term of protection for

trademarks may be extended for a further 10-year period at the request of the owner of the right deriving from registration.

(4) The owner may indicate that his trademark has been registered by adding the letter R within a circle next to the trademark.

14.–

(1) The protection of a trademark in respect of specific goods shall not prevent another enterprise from registering or using a similar trademark for goods of the same kind where such mark contains the designation of the enterprise, its name, its emblem or the name of the owner of the enterprise, insofar as there exists no risk of misleading purchasers as to the origin of the goods.

(2) In the case referred to in subsection (1), the owner of the right deriving from registration of the trademark may require the user of a mark or the applicant for a mark to make the necessary alteration to the trademark that has been used or is applied for in order to prevent any risk of misleading purchasers as to the origin of the goods.

(3) Section 9 (1) iii) shall not apply to the case referred to in subsection (1).

15.–

(1) The right deriving from registration of a trademark may be assigned.

(2) The contract of assignment of the right deriving from registration of a trademark shall be in writing and shall bear a definite date.

(3) The contract of assignment of the right deriving from registration of a trademark may be invoked in respect of third parties as of its entry in the Trademark Register.

16.–

(1) The right deriving from registration of a trademark may only be assigned without the enterprise or a part of the enterprise if there is no risk that purchasers may be misled as to the origin of the goods.

(2) The right deriving from registration of a trademark may not be assigned without the enterprise or a part of the enterprise if other similar trademarks have been registered on behalf of the assignor for goods of the same kind.

17.–

(1) The owner of the right deriving from the registration of a trademark may authorize another enterprise to use the mark for goods covered by the registration under a license contract.

(2) Where not otherwise stipulated by the license contract, the licensee may use the trademark in the same way as the owner of the right deriving from registration of the trademark.

(3) The license contract shall be in writing. Section 15(3) shall apply *mutatis mutandis*.

18.–

The provisions of the Civil Code concerning liability for legal defects relating to selling activities shall apply to the liability of the assignor and licensor of the right deriving from registration of a trademark.

Part IV
Protection Provided by the Right Deriving
from Registration of a Trademark
and the Right in a Well-Known Mark

19.–

Any person who, without being authorized to do so, uses a registered trademark or a similar mark for goods of the type registered or for similar goods in such way that there is a risk of the purchaser being misled as to the origin of the goods shall be liable in accordance with the provisions of this Part.

20.–

(1) The owner of the right deriving from registration of a trademark may require the cessation of acts that infringe or are likely to infringe his right deriving from registration of the trademark.

(2) The owner of the right deriving from registration may require, under the general principles of law, payment of damages, surrender of the unlawful profits made from the infringement of the right deriving from registration and also publication of an appropriate statement.

(3) In the event of infringement of the right deriving from registration, the court or arbitration tribunal may order the seizure of goods, packaging and any other objects to which the registered or similar mark is affixed or the seizure of any means used for advertising and for marking the goods with such sign in accordance with the right to removal of the signs before the objects referred to can be placed on the market and also to prevent advertising for such goods.

(4) The limitation period for actions based on the infringement of the right deriving from registration of a trademark shall be three years; that period shall also apply in the relationships between units of the national economy.

21.–

(1) The actions referred to in section 20 may be instituted by the owner of the right deriving from registration of a trademark as from the time the user of the trademark has been notified of the filing of an application for registration of the mark.

(2) Actions under section 20 cannot be instituted until the trademark has been registered.

22.–

(1) The licensee shall be required to advise the owner of the right deriving from registration of any acts by third parties that infringe the right deriving from registration of the trademark.

(2) Actions under section 20 may be instituted by the licensee.

23.–

Anyone having a legitimate interest therein may require the Patent Office to determine in litigation that no similarity exists between the registered trademark and the mark that he already uses or intends to use such that the right deriving from registration of that mark could be infringed.

24.–

(1) The user of a mark that is well known in the Republic of Poland may require, where such mark has not been registered:

- i) the annulment of the right deriving from a registration obtained in violation of section 9(1) ii);
- ii) that the use of the mark or of a similar mark by other enterprises for the same goods be prohibited if there exists the risk of purchasers being misled as to the origin of the goods.

(2) The user of a well-known mark may institute an action under subsection (1) within five years of the registration of that mark or of a similar trademark or as from the date on which the use of that mark or of the similar mark by the other enterprise began, whichever period expires last.

(3) After expiry of the period laid down in subsection (2), the user of a well-known mark may only require that the necessary alteration be made in order to exclude any risk of misleading purchasers as to the origin of the goods.

(4) Where the infringer of the right in a trademark that is well known in the Republic of Poland has acted in bad faith, actions under subsection (1) may also be instituted after the expiry of the five-year period.

Part V

Lapse and Annulment of the Right Deriving from Registration of a Trademark

25.–

The right deriving from registration of a trademark shall lapse:

- i) on expiry of the term of protection;
- ii) on relinquishment of the right by the person entitled under the registration of the trademark;
- iii) on failure to use the mark;
- iv) on loss of sufficient distinctiveness of the trademark;
- v) on termination of economic activity on the part of the owner of the right deriving from registration of the trademark.

26.–

In those cases referred to in section 25, items ii) to v), the Patent Office shall cancel the right deriving from registration of the trademark.

27.–

The owner of the right deriving from registration of the trademark may relinquish his right in whole or in part by filing a written declaration with the Patent Office. Where relinquishment of the right deriving from registration of the trademark would imply a disadvantage to persons whose rights are entered in the Trademark Register, the written consent of those persons shall be required.

28.–

(1) The right deriving from registration of a trademark shall expire if the person entitled has not used the mark within a period of three consecutive years in the Republic of Poland.

(2) Where a trademark that is registered for a number of goods is only used for some of them, the right deriving from registration of the trademark shall expire only in respect of those goods for which the mark has not been used.

(3) The right deriving from registration of a trademark shall not expire if the owner of the right can prove that he was unable to use the trademark for a justified reason.

(4) The onus of proof of use of a trademark or the existence of grounds justifying its non-use shall lie with the owner of right deriving from registration.

29.–

The right deriving from registration of a trademark may be annulled in whole or in part if the statutory requirements laid down in sections 4, 6 to 9 and 32 in respect of registration are not met.

30.–

(1) Any person having a legitimate interest may submit a request for confirmation of lapse or a request for annulment of the right deriving from registration of a trademark.

(2) The Public Prosecutor of the Republic of Poland or the President of the Patent Office may, in the public interest, request that a decision on the expiry of the right deriving from registration be taken or that the registration of a trademark be annulled, or may intervene in an action on this matter already in progress.

(3) An entry in the trademark register shall be made in respect of the lapse or annulment of a right deriving from registration of a trademark.

31.–

The request for annulment of a right deriving from registration of a trademark may be filed within five years of the date of registration. After the expiry of that period, such request may only be filed in respect of an owner who has obtained registration in bad faith.

Part VI Collective Marks

32.–

Any organization constituted in order to represent the interests of enterprises in the Republic of Poland or in a member State of the Paris Union for the Protection of Industrial Property and whose existence is not contrary to the laws of the State in which it undertakes its activities, may obtain registration of a collective trademark, hereinafter referred to as a “collective mark”.

33.–

(1) The conditions for using in economic activity a collective mark that is used by an organization referred to in section 32 and by enterprises that are members of the organization shall be determined by rules promulgated by that organization.

(2) The rules referred to in subsection (1) shall determine, in particular, the type of use of the mark, the common properties of the goods for which the mark is intended, the principles for verifying those properties, the consequences of failing to comply with the rules and a list of the enterprises entitled to use the mark.

(3) A collective mark may only be entered in the Register after deposit of the rules referred to in subsection (1).

34.–

(1) Where the right deriving from registration of a collective mark is infringed in respect of specific goods, action may be instituted only by the organization in whose favor the collective mark has been registered unless, in compliance with the rules, actions may also be instituted by enterprises that are members of the organization.

(2) An enterprise may institute an action under subsection (1) only after notifying the organization of the infringement of the right deriving from registration of the collective mark and only if the organization does not itself institute such action within a period of two months of notification.

35.–

The right deriving from registration of a collective mark may only be assigned to an organization of the type defined in section 32.

36.–

No mark that is similar to a collective mark may be registered for the same goods on behalf of any other party within five years of the lapse of the right deriving from registration of a collective mark for specific goods.

Part VII Procedures, Registers, Fees

37.–

Where not otherwise stipulated by this Law, the Code of Administrative Procedure shall apply to procedural matters before the Patent Office in respect of trademarks.

38.–

The time limit for filing an appeal against a decision of the Patent Office shall be two months as from notification of the decision to the party concerned and the time limit for objecting to a determination made by the Patent Office shall be one month as from notification of the order to the party concerned.

39.–

(1) An application for registration of a trademark shall be deemed to be made on the day on which it is filed with the Patent Office or is handed in at a Polish post office bearing the address of the Patent Office.

(2) The application for registration of a trademark shall state the name of the applicant, the trademark and the goods for which the trademark is intended.

(3) Priority between applications submitted on the same day shall be determined by their order of receipt at the Patent Office.

(4) The President of the Patent Office shall determine the requirements for a regular application and shall decide on the classification of goods to be applied to trademarks.

40.–

(1) Only one mark may be contained in each application for registration.

(2) Where an application for registration contains more than one mark, the Patent Office shall process the application only as regards the first-mentioned mark and shall at the same time invite the applicant to file applications for the other marks within a period of three months. The date of such applications shall be deemed to be the date of the first application. If no such separate applications are filed, the Patent Office shall discontinue the procedure concerned.

41.–

During the examination procedure, the Patent Office may direct the applicant to remedy any omissions or defects in the application within a period of three months, failing which the procedure shall be discontinued. The time limit may, at the request of the applicant, be extended for a further three months and, in cases where this is justified, for two additional three-month periods, after payment of the appropriate fees.

42.–

Once an application has been filed, the applicant may not alter the essential characteristics of the mark filed nor extend the list of goods for which the mark is intended.

43.–

(1) During the procedure, the Patent Office shall ensure that the mark filed satisfies the statutory requirements for registration and that it does not infringe third party rights.

(2) Where the mark filed does not satisfy the statutory requirements for registration or infringes third party rights, the Patent Office shall notify the applicant and those persons whose rights are infringed and shall invite them to submit their comments within three months.

(3) The Patent Office shall inform the applicant of any comments from third parties and shall invite him to comment thereon within three months.

(4) Where the applicant does not submit comments within the period laid down in subsection (3), the Patent Office shall refuse registration of the mark.

(5) The time periods laid down in subsections (2) and (3) may be extended at the request of the applicant in accordance with the conditions stipulated in section 41.

44.–

(1) After ascertaining that no obstacles to the registration of the mark exist and that the fees laid down in section 5 have been paid, the Patent Office shall take the decision to register the trademark and shall enter it in the Register referred to in section 54; where such is not the case, the Patent Office shall issue a refusal.

(2) After entry of the trademark in the Register, the Patent Office shall issue a certificate of protection to the owner of the right deriving from registration.

45.–

(1) A trademark may be filed for registration abroad once it has been filed with the Polish Patent Office.

(2) The Council of Ministers shall lay down by decree the procedure for filing trademarks abroad.

46.–

No changes may be made to a registered trademark nor may the list of goods for which the mark has been registered be extended.

47.–

(1) A request for extension of the term of protection deriving from the registration of the trademark for a further consecutive 10-year period shall be filed prior to expiry of the preceding term of protection, but not earlier than one year before expiry of that term.

(2) In cases where this is justified, the request may be made up to six months after expiry of the term of protection.

(3) When filing a request for extension of the term of protection deriving from registration of the trademark, the owner of the right shall be required to prove that he has used the trademark to the extent required by law. Where the owner of the right is unable to prove that he has used the trademark to that extent or that the trademark could not be used for reasons which are justified, the Patent Office shall refuse extension of the right deriving from registration of the trademark and shall cancel the right.

(4) Extension of the right deriving from registration of a trademark and refusal of extension of such right shall be entered in the Trademark Register.

48.–

The President of the Patent Office shall lay down the requirements for requests filed with the Patent Office in respect of registered trademarks.

49.–

(1) The Patent Office shall give a decision in inter part's proceedings in the following instances:

i) when ascertaining that no similarity exists between a registered trademark and a mark that another enterprise uses or intends to use (section 23);

ii) when recognizing the lapse of the right deriving from registration of a trademark where the mark has lost its distinctiveness or the owner of the right deriving from registration has ceased economic activities (section 25(4) and (5));

iii) when annulling the right deriving from registration of a trademark where the statutory requirements for registration have not been met (section 29) or the right in a mark that is well known in Poland has been infringed (section 24(1)).

(2) The Patent Office shall take its decisions in the matters referred to in subsection (1) according to the procedures and principles laid down in the Law on Inventive Activity.

50.–

Appeals against decisions and objections to determinations made by the Patent Office shall be heard by the Board of Appeals with the Patent Office, hereinafter referred to as the "Board of Appeals", to be composed as stipulated by the Law on Inventive Activity.

51.–

A party having his permanent place of residence or business establishment abroad may only be represented in proceedings before the Patent Office or the Board of Appeals through the agency of a unit approved for that purpose by the Minister for Foreign Trade.

52.–

(1) The President of the Patent Office, the First President of the Supreme Court, the Public Prosecutor of the Republic of Poland and the Minister of Justice may initiate an extraordinary procedure for review in the case of any final decision and any final order given by the Patent Office or the Board of Appeals which terminates the procedure and is clearly contrary to law.

(2) The provisions of the Code of Civil Procedure shall be applicable to such extraordinary procedure.

53.–

Actions concerning claims under section 20 and other civil law claims in the field of trademarks which are not within the competence of the Patent Office shall be heard by the courts or by arbitration commissions.

54.–

(1) The Patent Office shall keep a Trademark Register and a Collective Mark Register in which it shall make the entries required by this Law.

(2) The Registers shall be open to the public. Anyone having a legitimate interest therein may, on payment of the appropriate fee, obtain a copy, an extract or a certificate of a given entry in the Trademark Registers.

(3) Everyone shall be deemed to know the contents of the entries in the Trademark Registers.

(4) The President of the Patent Office shall lay down the rules governing the keeping of the Registers, the conditions and manner of making entries therein, the conditions for consulting a Register and for establishing copies, extracts and certificates of entries in the Registers.

55.–

(1) Fees shall be payable in proceedings before the Patent Office and the Board of Appeals in actions concerning trademarks.

(2) The Council of Ministers shall determine by decree the rules for payment, the amount and the time limit for paying fees.

56.–

The Patent Office shall publish in its official gazette *Wiadomosci Urzedu Patentowego*:

- i) the registration of a trademark;
- ii) the extension of a right deriving from registration of a trademark;
- iii) the transfer of a right deriving from registration of a trademark;
- iv) the grant of a license;
- v) the lapse of a right deriving from registration of a trademark;
- vi) the annulment of a right deriving from registration of a trademark;
- vii) changes in respect of the owner of a right deriving from registration of a trademark;
- viii) changes to the list of goods.

Part VIII

Penal Provisions

57.–

(1) Anyone placing on the market goods or services bearing a trademark he is not entitled to use shall be liable to imprisonment of up to one year, limitation of freedom of up to one year or a fine.

(2) In the case of organizational units, the head of such unit shall be liable within the meaning of subsection (1); however, where another person is responsible for the marketing of goods or services within such unit, that person shall be liable.

(3) Proceedings shall be instituted at the request of the injured party.

Part IX

Amendments to Existing Provisions; Transitional and Final Provisions

58.–

Section 6 of the Law of May 31, 1962 on the Patent Office of the Polish People's Republic (Dziennik Ustaw (Law Gazette) No. 33, text No. 157) is hereby repealed.

59.–

Rights deriving from registration of trademarks existing at the time of entry into force of this Law shall remain in force.

60.–

(1) Legal relationships that existed in connection with the registration of trademarks prior to the entry into force of this Law shall continue to be governed by the previous provisions, subject to the provisions contained in subsection (2), below.

(2) As from the entry into force of this Law, its provisions shall apply to:

- i) legal acts in relation to trademarks undertaken after the above-mentioned time;
- ii) the consequences of non-use of a trademark undertaken after the above-mentioned time;
- iii) the consequences of non-use of a trademark as laid down in section 28.

61.–

Procedures that had begun prior to the time of entry into force of this Law shall be governed by the provisions of this Law.

62.–

The Law of March 28, 1963 on Trademarks (Dziennik Ustaw No. 14, text No. 73) is hereby repealed.

63.–

This Law shall enter into force on July 1, 1985.