



CHANGES IN TRADEMARK REGULATIONS

better protection

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Changes to trademark law from 16 March 2019

ANNA POMPE

An amendment to the Industrial Property Law took effect on 16 March 2019, transposing into Polish law the Trademark Directive (2015/2436). The amendment is not revolutionary but will certainly have huge practical implications.

The changes have been made primarily to better align the EU and national trademark systems. The main changes include:

- Removal of the graphical presentation requirement from the definition of a trademark
- Modification of the list of marks that are not registrable, i.e. the “absolute” grounds preventing registration of a trademark, in particular:
 - There is now an option of registering trademarks containing religious, patriotic, or cultural elements. Now the only elements that cannot be registered are elements of high symbolic value, in cases where using a trademark of that kind could offend religious or patriotic feelings or national tradition.
 - Now, during the registration process, it is not only the shape of the mark that will be examined, as has been the case. Other features will also be examined to determine the extent to which they follow from the nature of the product itself, are necessary to achieve a technical effect, or substantially increase the value of the product.
- Extension of the catalogue of relative grounds preventing registration of a trademark by adding a new relative ground, namely that a proprietor with a registered geographical indication or designation of origin can prohibit subsequent use of the trademark
- Changes relating to collective marks
- Replacement of the term “collective guarantee mark” with the term “guarantee mark”
- Mechanisms making it easier to renew a trademark—where a written application and issuance of a decision were required to renew a trademark, now the only requirement is payment of the fee for the subsequent protection period

- An obligation for the authority to notify proprietors of exclusive rights of an impending deadline for payment of the fee for the subsequent period
- More precise provisions for registration of a mark by an agent or representative of the proprietor, acting without the proprietor's consent
- Modification of provisions on invalidation proceedings (additional requirements that have to be met by the party seeking invalidation of a trademark)
- Abolition of restrictions on transfer of protection with respect to certain types of products and abolition of the previous restrictions on partial transfer of protection
- Broader rights of a licensee, specifically with respect to a licensee's claims for trademark infringement
- Expansion of the range of entities liable for trademark infringement to include intermediaries whose services are used by a third party when infringing a trademark
- Giving trademark holders additional claims for trademark protection when for instance the following are infringed:
 - The right to prohibit preparatory activities connected for example with use of packaging, labels, elements of the product, protective measures on a product, or other measures
 - Rights in cases where registered trademarks are featured (reproduced) in dictionaries, encyclopaedias, or other such reference works
 - The right to prevent transit of products bearing a counterfeit trademark.

The amendment of 20 February 2019 can be found [here](#).

This publication discusses selected aspects of the recent changes. We hope you find it useful.

Anna Pompe, adwokat, Intellectual Property practice, Wardyński & Partners

Abolition of the graphical presentation requirement for national trademarks

MARZENA BIAŁASIK-KENDZIOR, MONIKA DYNOWSKA

One of the changes in the amendment of the Industrial Property Law is that there will no longer be a graphical presentation requirement for trademarks. From 16 March 2019, it is possible for trademarks to be presented in any form using generally available technology, provided that they are presented in a clear, precise, independent, understandable, durable, objective, and easily accessible manner.

The definition of a trademark used in the past has been changed, and now the graphical presentation requirement no longer applies. Under the amended wording of Art. 120 of the Industrial Property Law, a trademark is now any mark whereby the products of a business can be distinguished from those of another business, provided that it can be presented in a trademark register in a manner definitively and precisely identifying the protected item.

In particular, a trademark can be a form of expression (including a person's name), drawing, letter, digit, colour, or shape (including the shape of a product or packaging), and also a sound.

The graphical presentation requirement that existed in the past did not cause major problems in filings for registration of conventional trademarks such as word, figurative, or shape marks. For those who wished to make their products or services distinguishable using a characteristic tune, hologram, or moving image, on the other hand, the graphical presentation requirement could be problematic.

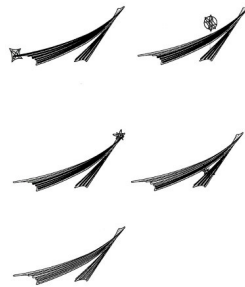
The graphical presentation requirement has been abolished due to implementation into Polish law of Directive 2015/2436. Abolition of this requirement now means that certain types of trademarks can be presented more easily and more precisely. It also means that new types of trademark can be applied for in formats not previously recognised in the Polish legal system.

A change of this nature was in fact made with respect to EU trademarks some time ago, on 1 October 2017. Examples taken from the practice of the European Union Intellectual Property Office (EUIPO) suggest what practical importance these changes in Polish law will have.

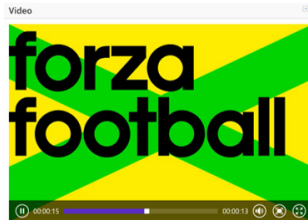
A moving target: motion marks

Motion marks comprise specific movements or a constantly changing layout of elements. Marks of this kind include animated marks, gestures, and frequently holograms (although under some classification systems these are a separate kind of mark). Before the graphical presentation requirement was abolished, these marks were often presented frame by frame, with a description of how the items moved.

EUTM-005338629



Under the amendment, a motion mark must be presented in the form of a video file (MP4 of up to 50 MB) or a series of consecutive still images showing movement or change in layout (JPEG). If still images are used, they can be numbered, or listed in the order of appearance. .



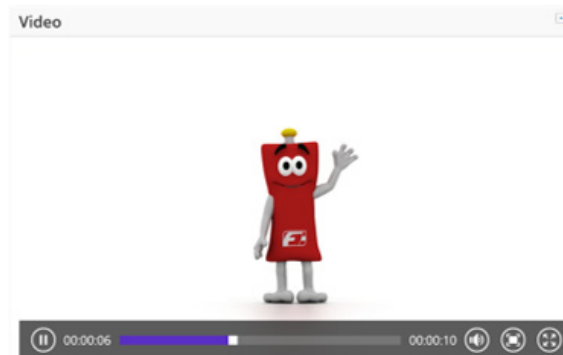
EUTM-017912571

(see <https://euipo.europa.eu/eSearch/#details/trademarks/017912571>)

A world of possibilities: multimedia marks

Multimedia marks are a novelty among unconventional trademarks. The first time it became possible to apply to register trademarks of this kind was at the EUIPO on 1 October 2017, when a new definition of a mark was formulated. A multimedia mark is a combination of image and sound, or becomes a combination of image and sound. Essentially, a multimedia mark and a motion mark differ in only one aspect, which in fact is significant, namely that in a multimedia mark the moving image is accompanied by sound. A mark of this kind must be submitted to the Polish Patent Office in an audiovisual file containing a combination of images and sounds. This means that only an MP4 file (maximum 50 MB) can be enclosed with the application.

EUTM-017451816

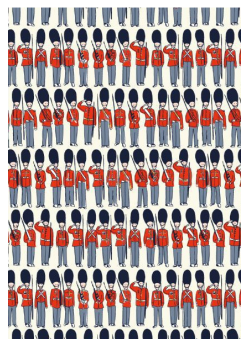


(see <https://euipo.europa.eu/eSearch/#details/trademarks/017451816>)

Fashionable patterns

The new categories of marks include patterns on material. A mark in the form of a pattern consists solely of a set of elements that repeat regularly. It must be presented to the Polish Patent Office as a reproduction or JPEG file. With respect to this category of marks, the application must contain a description stating how the elements are regularly repeated and the colours used.

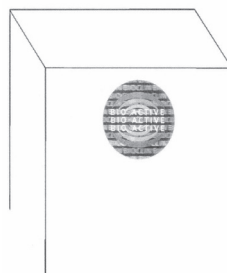
EUTM-017421827



Back to the future: holograms

In the past, filings to register hologram marks were centred around traditional holograms of the type known from perfume packaging or CDs.

EUTM-001787456



Although the notion of hologram marks is nothing new, they did not become a separate category of trademark until the definition of a trademark was changed.

Under the amendment, a mark of this kind can be presented as a video file (MP4 up to 50 MB), or in graphical or photographic form adequately capturing the overall holographic effect.

EUTM-017579491



(see <https://euipo.europa.eu/eSearch/#details/trademarks/017579491>)

Technical aspects of filing for registration of a mark under the new rules

The amendment does not affect the word mark application process. Other types of trademarks (figurative, figurative with word elements, shape, position, pattern, colour, colour combination) can be presented in graphical form (pasted into the filing) or enclosed as a JPEG file. Unconventional marks can be presented in graphical form (for example sheet music in the case of a sound mark, or a series of images in the case of a motion mark). In most cases, however, electronic files (JPEG, MP3, MP4) will probably be used. A description of the trademark can be enclosed with any kind of trademark. It is particularly advisable to include a description in cases of a position mark which is a design on material or colour, a motion mark, and other marks. The descriptions of these trademarks are listed in the Polish Patent Office's online database (Trademark Register Plus dla Znaków Towarowych).

The amendment paves the way for registration of any trademark that can be presented in appropriate form using generally available technology. It could also in the future enable registration of marks that today cannot be registered due to technological constraints, such as scents and flavours. It will be possible to register any type of trademark, including those not yet known today, if technological advances allow them to be reproduced in the register in a clear, precise, separate, easily available, understandable, durable, and objective manner, so that the competent authorities and the public are able to determine clearly and precisely the item registered by the trademark owner.

The amendment applies to trademarks applied for with the Polish Patent Office from 16 March 2019, and also marks applied for before that date if the registration proceedings were not concluded prior to that date.

Summary

The Polish Patent Office's website provides information in digestible form regarding the new definition of a trademark and the ways trademarks are to be presented, especially unconventional trademarks, in the publication "Collective statement on ways in which new types of trademark are to be presented" and in a guide for people filing for new types of trademarks. These materials discuss how the EUIPO and the Polish Patent Office approach this issue. The Polish Patent Office also tries to accommodate proprietors who are unable to determine by themselves the type of mark being applied for. If the type of mark is not stated in the filing, the Polish Patent Office will ascertain the type of mark according to how it is represented and notify the applicant. An applicant that does not classify its mark correctly will be notified of the Polish Patent Office's assessment and given a specified time to state its position on the assessment.

Due to advances in technology, the graphical presentation requirement for every trademark began to hamper businesses' potential. Easing the regulations and abolishing this requirement will make it easier to register the marks they actually use when trading. It may also play a role in increasing the number of unconventional trademarks registered. The changes to the Industrial Property Law mean a huge range of possibilities for businesses operating above all in the gaming, phonographic or film industries, or for example in marketing.

Marżena Białasik-Kendzior, Monika Dynowska, Intellectual Property practice, Wardynski & Partners

Collective mark and guarantee mark

MONIKA WIECZORKOWSKA

An amendment to the Industrial Property Law has led to changes regarding particular types of trademarks such as collective marks and guarantee marks. Collective marks were included in the previous version of the act, but the guarantee mark is something new, replacing the collective guarantee mark. This will have certain implications for businesses.

Collective marks

Most trademarks are “individual” trademarks, which means that they are owned by a single proprietor and are mostly used solely by the proprietor. There are also less common types of trademarks. These might also be owned by a single entity, while a number of businesses have the right to use them. A collective mark is an example of a mark of this kind. Under the new law, a collective mark can be granted to:

- An organisation that has the capacity to acquire rights and contract obligations on its own behalf, set up to represent the interest of businesses,
- or
- A legal person operating under public law.

The following are entitled to use a collective mark:

- In the case of an organisation, the organisation or members of the organisation
- In the case of a legal person operating under public law, that person, or persons entitled to use the mark under the terms of use of the mark.

Thus the amendment expands the range of entities that can apply to register trademarks of this kind. Before, only organisations that are legal persons created to represent the interests of businesses could be proprietors. Now, for example, local government authorities and their associations, residents’ associations, political parties, and municipal authorities can own a collective mark.

This means that a collective mark can be used at the same time by multiple entities that do not own it. On the other hand, businesses and proprietors can use a collective mark provided that they comply with the terms of use for the mark laid down by the organisation.

The terms of use must state in particular:

- The persons entitled to use the mark
- The requirements for membership of the organisation
- The conditions for using the mark, and
- The consequences of breaching the terms of use.

A collective mark can, but does not have to, attest to the quality of products. The terms of use for a collective mark can be worded to guarantee the quality of the organisation’s products and services.

As such, collective marks are not a new institution. One example of a collective mark is “Junge Polnische Hafermastgans” (for “young Polish oat-fed

geese”). This is a mark owned by the National Poultry Council Chamber of Commerce in Warsaw, of which more than 80 businesses in the poultry industry are members, including agricultural universities, poultry breeder and producer associations, poultry meat processing plants, fodder manufacturers, and individual poultry breeders and producers.



The mark of the Polish Optometric Association, of which people and institutions in optometrics are members, is another example of a collective mark:



The Szczecin Private Transport Association also has a collective mark. The member groups provide passenger services, offering competitive prices and high-quality services.



This shows that a collective mark enables members of an association to promote their products and find customers and distributors jointly. This is a much less expensive and more effective method than registering and promoting individual trademarks.

In some cases, collective marks can resolve issues relating to rights to use trademarks owned by business associations that operated in communist times. One example of this is the well-known Herbapol trademark, registered in the name of PPHU Herbapol sp. z o.o. based in Warsaw. The Herbapol trademark was created in the 1940s for state-owned producers of herbs,

owned by the Herbapol Herbal Industry Association in Warsaw. Today it is used collectively by a number of entities operating under the Herbapol name.

Herbapol

The word mark Pollena is another example. It continues to be registered in the name of Ciech SA in Warsaw. Another is Polmos (distilleries), registered in the name of Przedsiębiorstwo Usługowe Znaki Wspólne sp. z o.o. in Warsaw.



Guarantee mark

The amendment also addresses the guarantee mark. This is defined as a mark that distinguishes products that are certified by the proprietor (for example due to the material, manufacturing process, quality, precision, or other attributes) from non-certified products. Guarantee marks have now replaced collective guarantee marks.

A guarantee mark can be registered in the name of a natural or legal person, and this includes institutions, authorities, and entities operating under public law, that does not supply products of the same type as the certified products.

A guarantee mark can be used solely by persons eligible under the terms of use specified by the proprietor. In this case, the holder of the mark has the power to monitor the method and quality of manufacture of products bearing that mark. At the same time, the proprietor cannot deny entities eligible under the terms of use the right to use the trademark without good reason.

Guarantee marks are intended to assure consumers of specific properties of products that bear the mark. The standard for these properties is specified in the terms of use. The terms of use must state clearly and precisely the following in particular:

- The persons eligible to use the mark
- The properties attested to by the mark

- The manner in which testing for those properties is conducted
- The manner in which use of the mark is monitored
- The conditions for using the mark, and
- The consequences of breaching the terms of use.

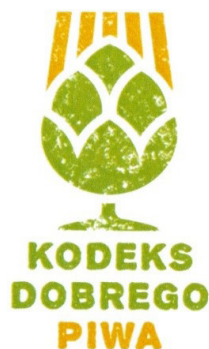
An explicit provision stating that a guarantee mark can consist of elements identifying the geographical origin of products is a new development. Unlike other trademarks, a guarantee mark can be registered even if it consists solely of elements identifying the geographical origin of products. This is not possible with respect to other types of trademarks. Importantly, a statement of geographical origin in a guarantee mark must be true.

Meanwhile, the holder of a trademark of that type cannot forbid third parties from using marks containing geographical elements if they do so according to fair industry and commercial practice.

Under the previous act, reference was made accordingly to trademark laws in matters that were not regulated. The amendment states specifically that neither a collective mark (discussed above) nor a guarantee mark can be registered if there is a risk of consumers being misled as to the nature or meaning of the mark, especially if it could be mistaken for a mark other than a guarantee mark.

New guarantee marks can be applied for from 16 March 2019. Below are a number of examples of collective guarantee marks existing at the moment.

The trademark of the Association of Polish Regional Breweries in Olsztyn, created by 10 local breweries, is used for beer produced according to brewing rules established by the association:



The mark Produkt Tradycyjny z Malopolski (“traditional product from Malopolska”) is another example. It is owned by the province of Malopolska:



The right to use this trademark is granted to entities that manufacture products placed on the List of Traditional Products maintained by the Ministry of Agriculture and Rural Development with their geographical origin in the province of Małopolska.

The National Association of Building Materials Manufacturers in Zaklików also holds a collective guarantee mark (literally, “Polish Brick”):



Products bearing this mark have a favourable price and are of high quality; they are often products of small, family-owned businesses rather than large-scale ceramics plants.

Polskie Centrum Badań i Certyfikacji SA also holds a collective guarantee mark:



This mark confirms that a product complies with eco-agriculture requirements, and is used to label and advertise eco-products.

Another well-known guarantee mark is the symbol of the Polish Regional and Local Product Chamber in Warsaw, used to label grocery products produced using natural materials and traditional methods:



Why are the changes necessary?

The answer to this question can be found in EU trademark laws. Since 1 October 2017, it has been possible to apply for certification marks with the EUIPO. Since that date, 156 marks of this kind have been applied for and 22 have been registered. Examples include:



In fact it was the possibility of registering certification marks with the EUIPO that was the grounds for Polish lawmakers to amend the Industrial Property Law. Guarantee marks are intended to afford Polish businesses similar protection without their having to apply for certification marks with the EUIPO, which entails higher costs. Such businesses may only intend to use the marks in Poland.

The only difference between guarantee marks and certification marks is that the ones now included in the Industrial Property Law can be used to attest to geographical origin of products. In this respect, Polish law provides broader protection than EU certification marks.

A comparison of laws on collective guarantee marks used previously in the Polish legal system and new guarantee marks reveals that essentially the only change is in the name, and the fundamental nature of the mark is the same. Therefore, Polish businesses were not unable to obtain trademarks of this type in the past.

Loss of a collective mark or guarantee mark

As in the case of other types of trademarks, a collective mark or guarantee mark can be invalidated if the relevant requirements are not fulfilled. The amendment specifies clear prerequisites for invalidation of these two kinds of trademarks.

Collective marks and guarantee marks can be invalidated if:

- The terms of use for the mark breach principles of public order or good customs
- There is a risk of misleading consumers as to the nature or meaning of the mark, particularly if it could be considered to be a mark other than a collective mark or guarantee mark.

The types of marks described above would not be invalidated on these grounds, however, if the proprietor made appropriate changes to the terms of use.

The amendment also modifies the prerequisites for expiry of a collective or guarantee mark. Apart from the standard grounds that apply to all trademarks (mainly with respect to non-use of the mark), a collective mark or guarantee mark will also expire:

- When the proprietor does not take measures to prevent use of the collective mark or guarantee mark in breach of the terms of use of the mark
- When the proprietor uses the collective mark or guarantee mark in a manner that is misleading for consumers as to the nature or meaning of the mark, particularly if it could be considered to be a mark other than a collective mark or guarantee mark
- The terms of use of the collective mark or guarantee mark are amended so that the terms of use no longer meet the requirements specified in the relevant laws—but this will not occur if the proprietor makes essential amendments to the terms of use to remedy this non-compliance before a decision is issued confirming that the mark has expired.

The new legislation is intended to encourage holders of trademarks to exercise control over the requirements for and manner of use of the marks by parties entitled to use them. This serves the interests of all of these entities. Failure to comply with this obligation can lead to a true loss of these rights. The introduction of new grounds for expiry is also intended to protect consumer interests. The aim is to ensure that collective marks and guarantee marks that are used in breach of the terms of use (for example not guaranteeing the product's special properties) or are misleading as to the nature or meaning of the mark are eliminated from the market.

Transitional provisions

Under the new law, proceedings for registration of collective guarantee marks commenced and still in progress as of the effective date of the act become proceedings for registration of guarantee marks.

Meanwhile, as of the effective date of the new law, 16 March 2019, filings for a collective guarantee mark become filings for a guarantee mark.

Importantly, a proprietor can apply to transform a collective guarantee mark into a guarantee mark up to six months from the effective date of the law, i.e. by 16 September 2019.

View regarding the changes

The changes are a good thing, especially with respect to the enlarged list of entities that can hold these two types of marks. This will certainly lead to an increase in the number of filings for collective marks and guarantee marks. Experience shows that Polish firms are interested in registering marks of this kind. The volume of applications is not large, as on average there are between ten and twenty per year. However, for some entities, this is an important form of protection. Also, unlike individual trademarks, a single collective mark or guarantee mark can be used by multiple entities.

Both of these types of marks are an effective marketing instrument. Guarantee marks are also especially important for consumers because they guarantee particular properties of the products that bear the marks.

The amendment has made rules on obtaining and forfeiting collective marks and guarantee marks more substantial and precise, and this is definitely good news for applicants.

Monika Wierzchomska, patent attorney, Intellectual Property practice, Wardynski & Partners

Licensee as claimant: A significant new entitlement

DR MONIKA A. GÓRSKA

A licensee's right to bring a legal action in proceedings for infringement of a trademark was introduced by the amendment to the Industrial Property Law. So far, in the case of national trademarks, only an exclusive licensee entered in the register could pursue claims for trademark infringement on an equal footing with the proprietor. This has changed from 16 March 2019.

A licensee may be a claimant in a trademark infringement case

The amended Industrial Property Law provides that, with the consent of the trademark proprietor, the licensee may bring an action for infringement, unless the licence provides otherwise. Both exclusive and non-exclusive licensees are entitled to bring an action, as the provision does not differentiate between categories of licensees, using the general term “licensee.” This change is significant. Previously, this right was granted only to an exclusive licensee, and only one entered in the register (second sentence of Art. 76(6) of the Industrial Property Law). The circle of entities with standing to sue for trademark infringement was therefore limited. An exclusive licensee not entered in the register did not have standing, and neither did a non-exclusive licensee, and therefore they could not successfully bring an action for infringement of a national trademark. In this respect, the new Trademark Directive (2015/2436) and the new provisions of the Polish Industrial Property Law implementing it clarify the legal situation of a national trademark licensee and put it on an equal footing with an EU trademark licensee.

Bringing an action by the licensee is subject to the consent of the proprietor (new Art. 163(11) of the Industrial Property Law). The parties will be able to provide for such consent in the agreement and will also be able to expressly exclude such a right of the licensee. If the parties did not include provisions on bringing actions for trademark infringement when executing the licence, the proprietor may give its consent at a later stage. Although the new Art. 163(11) of Industrial Property Law does not specify whether the consent of the proprietor must be in writing under pain of invalidity, it seems that since the licence agreement (regardless of whether it concerns an exclusive licence or a non-exclusive licence) requires that form, the consent of the proprietor requires that form too.

The amended Industrial Property Law also provides that an exclusive licensee may bring an action for infringement of the right of protection if despite being summoned, the proprietor does not bring such an action within a reasonable time. It seems that this provision is intended to enable the exclusive licensee to take legal action even if the licence agreement does not contain the proprietor’s prior consent. The exclusive licensee should then call upon the proprietor to act and set a reasonable time in this respect, after which it will be able to pursue an action for trademark infringement itself.

Licensee may join litigation to seek damages

Under the new wording of Art. 163(12) of the Industrial Property Law, if the licensee does not bring an action itself, it has the right to join a trademark infringement action initiated by the proprietor in order to seek damag-

es. This provision applies to any licensee, whether exclusive or non-exclusive, as there is no such distinction in the wording and the general term “licensee” is used.

Entry of licences in the trademark register

A licence shall be entered in the trademark register at the request of the interested party. The amended Art. 163(5) of the Industrial Property Law clarifies the existing situation. Since this provision does not make a distinction, it must be assumed that both exclusive and non-exclusive licences can now be entered in the trademark register. Entry of a licence in the trademark register will, for example, confirm the licensee’s standing in trademark infringement proceedings.

Summary

The amendment of the Industrial Property Law is desirable. It introduces the same rights for licensees of national trademarks as exist for licensees of EU trademarks (see Art. 25 of the [EU Trademark Regulation \(2017/1001\)](#)). The consistency between the solutions in the two legal orders will improve legal certainty and the case law, as well as unify the practices applied by the EU and national offices.

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Trademarks in dictionaries and encyclopaedias

LENA MARCINOSKA

Can a trademark owner require the publisher of a dictionary to indicate alongside the colloquial definition of a word that the word is a registered trademark?

Some trademarks are so strongly established in the language that they begin to function not only as a designation of origin from a particular trader, but also as a colloquial or generic name for a particular category of goods or services.

Older generations remember that, for years, “electrolux” was a synonym for a vacuum cleaner in Poland, regardless of the brand. This meaning has become a thing of the past, and today Electrolux is seen as a brand of

household appliances. However, the word “pampers” is sometimes used to denote a disposable diaper, “lycra” is the colloquial name of a fabric with added elastic, and “teflon” is a term for a slippery, non-stick material. Yet all these words also indicate the origin from a specific source and are registered trademarks, for Procter & Gamble, Invista Technologies, and Chemours, respectively.

The point is that the authors of dictionaries and trademark proprietors are interested in completely different issues: the first in the words used by speakers of the language, the second in the rights embodied in words which on the market serve primarily to designate the origin of goods or services. Unfortunately, some dictionaries only give the colloquial meaning of such words, ignoring the fact that they are also, and perhaps above all, registered trademarks. Proprietors often incur enormous costs building the recognition and value of their trademarks. Inclusion of a trademark in a dictionary or similar publication indicating only its colloquial or generic meaning, without mentioning its original meaning (i.e. as a trademark), may weaken the distinguishing power of the trademark, which is its most important feature and a factor influencing its value and sense of protection.

Trademark owners have the right and obligation to take care of the mark and its distinctive character, and must therefore have the tools to do so. One of these is the right to require a publisher of a dictionary, encyclopaedia or similar publication to indicate that the term is a registered trademark.

New old protection measure

For a long time, EU law has clearly regulated matters related to the inclusion in dictionaries, encyclopaedias and similar publications of the meanings of trademark words, and practice in this area is well established. Such regulations have also been in force in Poland for a long time with regard to EU trademarks, pursuant to Art. 12 of [EU Trademark Regulation \(2017/1001\)](#) (and previously Art. 10 of Regulation 207/2009 and Regulation 40/94). The regulation is directly applicable in Poland, without the need for implementation here, and the owners of EU trademarks may invoke the regulation.

However, these provisions were not yet implemented in the Polish Industrial Property Law. The latest amendment to the Industrial Property Law, dated 20 February 2019 and in force since 16 March 2019, changes this state of affairs and gives the same right to those who hold only national marks. (Poland was required to introduce such a provision under Art. 12 of the new Trademark Directive (2015/2436).)

The new Art. 296(1(3)) of the Industrial Property Law provides that if the reproduction of a trademark in a dictionary, encyclopaedia or similar ref-

erence work, in print or electronic form, gives the impression that it is a generic name of goods or services, the publisher shall, at the request of the proprietor of the trademark, ensure that the reproduction of the trademark is accompanied by an indication that it is a registered trademark.

What can the trademark proprietor demand?

This new right of the trademark owner may be asserted when the publisher has included the word in a dictionary or encyclopaedia but omitted to mention that it is a registered trademark, restricting the term to a generic definition or colloquial meaning. The trademark owner may then request the addition of information that the word in question is a trademark.

However, the trademark owner may not request the publisher to remove the entry from the publication altogether. Nor can it require the publisher to eliminate the generic or colloquial meaning of the entry and replace it with information that it is only a registered trademark. A dictionary or other reference work should be a source of reliable and verified knowledge, and publishers have the right to record the actual behaviour of language users, if that is how they really use the word.

What should a publisher do?

This obligation is addressed to publishers of dictionaries (both general and specialist), encyclopaedias and other reference works. Therefore, this provision applies, in the broadest sense, to all publications constituting a source of knowledge. It does not matter whether the publication is in print or electronic form. The form of the publication affects only the time when the publisher must comply with the trademark owner's request. For print publications, the publisher should make a change no later than the next edition of the publication, and for publications in electronic form should do so "without delay."

It may pose a challenge to exercise the rights of trademark owners in the case of digital dictionaries or encyclopaedias involving user-generated content from the community, and thus lacking a central publisher who could satisfy the request. Nevertheless, it is difficult to imagine that such "knowledge platforms" would remain outside the scope of the provision, especially given their current significance. Their administrators or responsible entities, for example, should supervise the fulfilment of obligations under this regulation.

The Polish Parliament did not include in the new provision recommendations for publishers on how to indicate that a word constitutes a registered trademark, and neither have most countries that have already implemented Directive 2015/2436. Only a few regulations (e.g. [in Norway](#)) give guidance

on how the obligation can be fulfilled. Usually the trademark owner specifies in the request how the publisher should provide information about the trademark. Some proprietors ask for the word to be accompanied by an indication that it is a trademark registered to a given company. Others ask for inclusion of the ® sign.

It would be optimal if the publisher and the trademark owner worked out together a method for reflecting the fact of registration. The demands of the owner, the provisions of the law, and the editorial conventions adopted by the publisher should all be taken into account. Undoubtedly, however, when including an entry for a trademarked word, the publisher should take into account how the trademark was registered. If, for example, the mark is written in lowercase, it should be displayed that way in the publication. It is reasonable for the trademark owner to request that the meaning of a word as a trademark be given first—after all, that is usually the original meaning of the word.

What if the publisher fails to grant the trademark owner’s request?

Practice shows that publishers are willing to cooperate and respond with full understanding and professionalism to requests of trademark owners. Therefore, as in other countries, no litigation should be expected on the basis of this provision.

Purely theoretically, a publisher who fails to comply with the request of the trademark owner and does not publish information about its registration may be exposed to civil proceedings. The trademark owner could demand that the court order the publication of the relevant information about the registration of the word as a trademark. It would be a bit more complicated for the owners to raise other claims, e.g. to order the destruction of new print publications which, despite the request, do not include the information about the mark, or to order the publisher to publish information about the ruling.

Summary

The new right of national trademark owners offers a special protective tool. The reproduction of a registered trademark in a dictionary or encyclopaedia is, after all, not part of the typical “use of the mark” referred to in other provisions on trademark infringement.

Although one may wonder whether the implementation of the provision should be more precise and adapted, for example, to the current level of digitalisation, it should undoubtedly be assessed positively. This right is neither new nor revolutionary, and it certainly supports trademark owners who have

only national registrations in their portfolio. Finally, it also equates the rights of national trademark owners with those of EU trademark owners. There are no grounds for them to be different. The implementation also codifies the best practice already followed by publishers in Poland in the field of trademark reproduction.

Today, the set of proprietors impacted by this new provision of the Industrial Property Law may seem quite small. However, language is constantly evolving, and a trademark owner who does not see such a need today may face a challenge of ensuring that its trademark is properly included in a dictionary or encyclopaedia tomorrow.

The appearance of trademarks in dictionaries is closely related to the issue of degeneration, but this is a topic for a separate article. There is no doubt, however, that national trademark owners can add monitoring of the use of marks in dictionaries, encyclopaedias and other reference works to the existing catalogue of measures against degeneration (such as combating infringement, opposing conflicting notifications, promotion of marks, and advertising) and reacting when dictionary entries discussing the meaning of a reproduced word mark do not meet the requirements discussed above.

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Liability of intermediaries for trademark infringement

KATARZYNA PIKORA

The amendment to the Industrial Property Law in force since 16 March 2019 provides that a person whose services were used in an infringement is also liable for infringement of the protected right to a trademark. A trademark owner may demand that such a person refrain from infringing the trademark, turn over unjustly obtained benefits and repair the damage (where the infringement is culpable). Thus the new regulations introduce the intermediary's own liability for trademark infringement.

Who are intermediaries?

According to the explanatory memorandum to the amendment, the introduction of liability for persons whose services are used in infringement results from the need to take into account the ruling of the Court of Justice of the European Union of 7 July 2016 in *Tommy Hilfiger Licensing LLC v Delta Center*

a.s. (Case C-494/15). The court found that a lessee of market halls subleasing commercial stands to sellers, some of whom sell counterfeit goods, is an intermediary whose services are used by a third party for infringement of intellectual property rights. Such an intermediary may be subject to the same injunctions as those imposed on the direct infringer.

Therefore, the new Art. 296(3) of the Industrial Property Law applies to owners and lessors of halls, shopping centres and market places who make commercial stands available to persons trading in counterfeits. This should also cover entities providing other services used in trademark infringement. It seems that a condition for considering a service to be “a service used in trademark infringement” should be whether the provision of the service is accompanied by trademark infringement by the direct infringer.

Among other things, it is trademark infringement to place a counterfeit mark on goods, to offer and sell such goods, as well as to import, export or store such goods for the purpose of offering them for sale. Therefore, the rental of warehouses and halls where counterfeit goods are stored or produced could be considered a service used in the infringement, and the persons renting warehouses and halls as well as various online purchasing platforms to offer and sell products may be considered intermediaries. Courier or postal services should not be considered services used in infringement, since the transport of goods in principle does not constitute trademark infringement. However, the catalogue of intermediaries who can be held liable for trademark infringement is open.

Have intermediaries gone unpunished so far?

The inclusion in the Industrial Property Law of liability of intermediaries for trademark infringement does not mean that they have not incurred any liability so far. They could have been held liable under general rules set out in the Civil Code, i.e. as an accessory to infringement or as a person who knowingly benefited from the damage caused by the infringement. However, the trademark owner could only demand compensation for the damage it suffered. In practice, the liability of the intermediary was difficult to prove.

The main problem was to demonstrate the amount of damage caused by the intermediary and to prove a causal link between its activities (e.g. renting shop space) and the trademark infringement. In such a case, it was necessary to convince the court that a normal consequence of renting the shop space was trademark infringement.

Trademark owners who wished to attribute liability to the intermediary for the damage caused by trademark infringement could also have difficulty proving that the service provider benefited from the trademark infringement.

In practice, this meant that it was necessary to prove that the sellers in rented trade stands sold only counterfeits, so that the rent was a benefit for the property owner from such a sale.

It seems that these difficulties of proof, and in particular the very limited number of available claims (compensation only), have been effective in preventing trademark owners from suing intermediaries. The new rules give proprietors the opportunity to enforce their exclusive rights more easily and effectively. They supplement the implementation of the [IP Enforcement Directive](#) (2004/48/EC) (Art. 11, third sentence).

What will the owner of a trademark have to prove at trial?

The new rules essentially eliminate the previous difficulties in holding liable intermediaries whose services are used in trademark infringement. There will be no need to prove a causal link between the intermediary's action and the trademark infringement. The law establishes such a link.

The trademark owner will have to prove that the trademark has been infringed, e.g. that counterfeit goods are sold at the market stalls. Although the new regulations do not set out the grounds for exclusion of liability of an intermediary (lack of knowledge of the infringement), it seems that the mere sale of infringing goods on its premises will not automatically result in the liability of the hall owner or lessor. Under the current legislation, it is difficult to defend the claim that the owner of a market hall or shopping centre is obliged to supervise the activities of all persons running market stalls on its real estate and react to infringements found.

As the court pointed out in the *Hilfiger* case, the intermediary cannot be required to exercise general and continuous supervision over its customers. On the other hand, the intermediary may have to provide for measures to avoid further infringements of the same type by the same trader. Therefore, it seems reasonable to take the approach that the trademark owner will have to notify the intermediary (e.g. the owner of the hall) of the infringing activities of its customers (e.g. sellers) and call upon the intermediary to prevent the sellers from further infringing, or otherwise demonstrate that the owner was aware of such activities. At trial, the trademark owner will try to show that despite such knowledge, the intermediary did not take steps to end the trademark infringement. However, it is clear that the decisions by the courts will ultimately determine the conditions that will have to be demonstrated.

Effects on the digital world

The new provision states that it does not apply to a person whose liability is excluded under Art. 12–15 of the Electronic Services Act of 18 July 2002.

This means that if they meet the conditions set out in that act, persons providing services by electronic means will not be liable for the transmission or storage of data infringing a trademark. However, if service providers do not meet the conditions for exclusion of liability under the Electronic Services Act, it should be assumed that they may be held liable under the new regulation.

Summary

The premises for liability of intermediaries for services used in trademark infringement are not clear. Undoubtedly, these premises should be determined taking into account the indications of the Court of Justice of the European Union and the objectives of the IP Enforcement Directive. Although it is only the practice that will ultimately determine how the new provisions should be applied, their introduction should be assessed positively.

The new rules eliminate the existing evidentiary difficulties and should be a more effective tool in combating infringements where suing the direct infringer is difficult or completely ineffective. The new regulations may also encourage the service providers most frequently used in trademark infringement to tighten their policies towards such customers.

This particularly relates to owners of shopping centres or market halls, who can no longer be indifferent to what the people who rent from them actually sell at their commercial stands. This may mean introducing appropriate rules (or taking decisions under existing rules) prohibiting trade in infringing goods and introducing sanctions for such violations, as is already the case for many intermediaries providing electronic services (e.g. owners of online shopping platforms).

The upcoming year should show whether the new rules change the approach of providers of services used in trademark infringement.

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Amendments to the rules on transit of counterfeit goods

EWA GÓRNISIEWICZ-KACZOR

The amendment to the Industrial Property Law extended the rights of trademark proprietors. From 16 March 2019, on the basis of domestic regulations, they may prevent transit of counterfeit goods.

Counterfeit goods often have to travel a long way. China remains the principal producer of counterfeit goods entering the EU market, which means that these goods must cross the borders of the European Union during transport.

Due to Poland's geographical location, the customs and tax services pay attention to inspections of goods coming from outside the EU and entering the EU, also in terms of infringement of intellectual property rights. There are reasons why they must be particularly vigilant. Traders in counterfeit goods use various measures to reduce the risk of detection. Declaration of goods in transit is one of the methods. The assumption is that goods under this procedure are only transported through the territory of a given country and are not placed on the market there.

Reports published by EUIPO and Europol confirm the use of the transit procedure, among other ruses, to create complex trade routes camouflaging the place of origin of the goods (e.g. [2017 Situation Report on Counterfeiting and Piracy in the European Union](#)). There are also confirmed cases where goods declared under the transit procedure have never left Poland.

A long way to changes

Originally, goods in transit were treated as “invisible” to the European Union market. The Court of Justice of the European Union took the view that a trademark is not infringed if goods are not released for free circulation in the EU, including when there is no evidence that they are intended for this market. Evidence that goods in transit are in fact destined for the EU market could be provided by documents proving the likelihood of the goods being addressed to EU consumers.

However, the proprietor of the trademark could only prohibit the transit if the goods were subjected to measures intending to place them on the market. The theoretical risk of such placement was considered insufficient (e.g. CJEU judgments in [C-281/05 *Montex Holdings*](#) and [joined cases C-446/09 *Koninklijke Philips Electronics NV*](#) and [C-495/09 *Nokia Corp.*](#)) However, over time, it has been noticed that goods from such transports are not irrelevant to the EU market and may appear on that market.

In view of numerous demands to strengthen trademark protection and combat counterfeits more effectively, the work on amending EU trademark law also covered the issue of transit. The experience of member states with regard to the detention of counterfeit goods at the borders where the transit procedure was declared confirmed that changes were necessary. This is why the changes were assessed positively both during the preparation stage and after their entry into force.

This work was completed in December 2015. The package of amendments included the EU Trademark Regulation (formerly the Community trademark) and a directive to approximate the laws of the member states relating to trademarks. For both of these legal acts, twin provisions are foreseen in the part relating to transit. However, the regulation has direct effect, and thus from 23 March 2016, when it entered into force, EU trademark owners could apply for a transit ban. On the other hand, the changes introduced by the directive were to be individually incorporated by each member state into its legal order.

Poland has transposed these requirements through the amendment of 20 February 2019 to the Industrial Property Law, and the change entered into force on 16 March 2019. Currently, a national trademark owner may prevent a third party from bringing goods in the course of trade into the territory of Poland, bearing the trademark without authorisation, which are in transit and come from a third country. This provision also applies to other customs procedures which do not lead to the release of goods for free circulation, including temporary storage.

However, in court proceedings, the defendant can still defend himself by proving that the trademark is not protected in the country of destination. In such a case, the trademark owner cannot effectively prevent the transit of counterfeit goods.

When are the provisions on preventing transit applicable?

The right to prevent transit applies to goods bearing a sign:

- Identical to the registered trademark, or
- Similar to the registered trademark, i.e. one that cannot be distinguished in terms of its essential aspects from the registered mark.

An identical mark is to be understood as a mark that reproduces, without any alterations or additions, all the elements that make up the given protected trademark, or a mark that, taken as a whole, contains differences so slight that the average consumer may not perceive them (*C-291/00, LTJ Diffusion SA*). On the other hand, a similar mark is one used on goods which cannot be distinguished from a registered mark.

Practice of implementation of the transit rules

Every year, the Polish customs and tax services discover and detain counterfeit goods declared under the transit procedure. Often, such transports arrive in Poland by land from Ukraine or by sea from China. The recent amendment will not fundamentally change anything in the practice of the

customs and tax offices. On the other hand, it will strengthen the position of trademark proprietors, giving them broader rights in enforcing protection.

Under EU trademark law, such cases have already been brought in Poland before the Court for EU Trademarks and Community Designs (i.e. Division XXII of the Warsaw Regional Court). As mentioned, such a possibility for EU trademarks arose from March 2016. In one such case, the court had no doubts and, at the request of the EU trademark owner, granted an interim injunction to secure the claim to prevent transit in EU territory, including by seizure of goods detained by customs officers (Warsaw Regional Court order of 30 June 2016, Case XXII GWo 62/16). Thus it may be assumed that in the near future, not only cases relating to transit of EU trademarked goods, but also goods with national trademarks, will be considered by Polish courts.

The changes increase the level of trademark protection and give holders a new tool in the fight against counterfeits. However, it is already being pointed out that these rules are not perfect and have loopholes. For example, what should happen if the documents do not make it clear which country is the country of destination for a given transport? In such a situation, it may not be certain that there are grounds for banning the transit. Notwithstanding these loopholes, the changes should have a real impact on reducing the number of counterfeit goods in the European Union.

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Intellectual Property practice

For many years we have been providing legal support for clients—mostly companies, but individuals as well—in management and enforcement of their portfolio of intellectual property rights.

Intellectual property law protects intangible assets, primarily works, patents, trademarks and industrial designs—assets of an “intellectual” nature which when incorporated into material objects become the subject of trade. They are of vast economic importance and often are crucial to the commercial success of an enterprise. Laws govern in detail the manner in which rights to these assets are obtained and how they may be exploited, and also define what actions of third parties constitute infringement of IP rights. There is a separate legal regime for combating unfair competition. It complements the protection afforded to specific types of intellectual property but also provides separate grounds for protection of business interests.

We advise clients and represent them in court in civil and criminal cases concerning infringement of IP rights and unfair competition. We cooperate with customs authorities in proceedings involving seizure of infringing goods. Thanks to our extensive experience over more than two decades, we are one of most highly specialised teams in Poland in this field of law. When required for the specific case, we establish interdisciplinary teams made up of lawyers specialising in different fields of law, and we also work closely with distinguished scholars in this area.

We provide legal assistance in obtaining and maintaining protective rights to trademarks, patents, industrial designs, utility models and geographical designations.

We draft and advise on various contracts involving transactions in intellectual property rights.

We combat infringements of industrial property rights and unfair competition.

We assist clients in protecting intellectual property on the internet.

We advise on how to protect personal interests and how to effectively and safely conduct transactions involving such interests.

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