

Major changes concerning intellectual law property which are planned in the Civil Procedure Code

The Ministry of Justice in Poland proposed to enter into force a separate procedure concerning intellectual property matters in the Polish Code of Civil Procedure. The provisions are partially based on **Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights.**

New definition of intellectual property matters

It is proposed to make a new definition of intellectual property matters. These are issues for the protection of copyrights and related rights, as well as for inventions, utility models, industrial designs, trademarks, geographical indications, topography of integrated circuits and protection for other intangible property rights (intellectual property matters) and cases concerning unfair competition, protection of personal rights, in so far as it concerns the use of personal good for the purpose of individualising, advertising or promoting an enterprise, goods or services, and for the protection of personal rights in connection with scientific or rationalizing activities.

New departments in the District Courts in IP matters

Four departments will be appointed in cases regarding intellectual property matters (in Gdańsk, Katowice, Poznań, Warszawa), however intellectual property matters concerning computer programs, inventions, utility models, topography of integrated circuits, plant varieties and confidential business information of a technical nature, a competent court will be one of those courts - District Court in Warsaw. There will be also two departments in the Court of Appeal in Katowice and Warsaw, which will be responsible to recognize appeals from the above-mentioned District Courts. Nowadays there is one court - the District Court in Warsaw XXII Division of the District Court in Warsaw – the European Union Trademarks and Community Designs however after change the above-mentioned courts will be entitled to examine cases regarding European Union trademarks and Community designs.

Mandatory representation in IP matters

It is proposed a mandatory representation of the parties in court proceedings regarding intellectual property issues by advocates and attorneys at law, as well as in industrial property matters by patent attorneys. The court may release a compulsory replacement if the complexity of the case does not justify the need for mandatory replacement. The parties can be represented in such uncomplicated cases, as is currently done, by the employee.

The opportunity to adjudge damages at the discretion of the court

When it is impossible or extremely difficult to strictly prove the demand, and despite the measures that would make this demand more precise (like protection of the evidence, requesting disclosure or issuing evidence, request for information) it will allow the court to adjudge the appropriate sum according to the court's assessment, based on considering all the circumstances of the case.

Separate procedure for securing the evidences

It is proposed to enter into force a separate procedure for secure the evidences. The proposed change is aimed at enabling at the stage both before starting the proceeding and in its course, providing evidence protection, if there is a risk of damaging the evidence or if the delay may make impossible to achieve the objective of evidence and the lack of required protection makes it difficult or difficult to quote or proving the essential facts. The court would specify the scope of access to the person entitled to the protected evidence and the detailed scope of use and get acquainted with the evidence. It may also limit or disable the copying of evidence or its recording in a different way. The decision of the court in this matter would be enforceable upon its issuance.

The methods of protection would, in particular, take away the goods, materials, tools used for the production of distribution, documents, as well as a detailed description of these items prepared in the form of a protocol by the bailiff, combined, if necessary, with the collection of their samples. Until the order on securing the evidence is not final, the person entitled would not have access to the evidence.

The legislator also predicted that the execution of the order on securing the evidence may be made conditional upon the deposit by the entitled person to secure the claims of the person obliged or defendant arising as a result of enforcement of the order and there is a priority to satisfy from the deposit before other claims after the enforcement costs.

It is planned that there could be appointed an expert or experts in connection with protecting evidence, however, there is no information in the project for what purpose experts should be appointed.

The legislator set up provision for a separate procedure for the disclosure or issuing of evidence by the defendant who has it in his possession. The purpose of this is to disclose or prove facts in a given case, if the plaintiff has sufficiently demonstrated his claim. Moreover, if this infringement is made in a way that proves the actual conduct of business, the request may concern, in particular, bank, financial or commercial documents. If the defendant invokes the protection of business secrets, the court may lay down specific rules on the use of evidence and familiarization with it as well as introduce additional restrictions. The decision of the court in this matter would be enforceable upon its issuance.

New regulations of issuing information of the origin and distribution networks of goods or services

It is proposed to enter into force issuing information of the origin and distribution networks of goods or services, if this is necessary to determine the source or extent of the infringement. In such case, the entitled person should indicate that his claim is sufficient proved. Such request may be made before beginning of proceedings in the case of infringement of intellectual property right or in progress until the hearing at first instance is closed. If the court has called for information prior to the beginning of the proceedings, it should be initiated not later than within one month from the final conclusion of the information procedure. Otherwise, the entitled person will be obliged to pay to the person obliged to provide information in the amount corresponding to the value of the goods or services to which the information pertained. A request for information would relate to information on the names, designations and addresses of producers, manufacturers, distributors, suppliers and other legal predecessors from whom or for the acquisition or sale of goods, the use or provision of services and the quantities produced, manufactured, sent, received or ordered goods or services provided, as well as prices received in return for goods or services.

The court may determine specific, for the protection of business secret information, the rules of use and familiarization with the information provided, as well as may introduce additional restrictions.

At the request of the defendant or the person obliged, the rightholder is obliged to reimburse the costs and expenses incurred in connection with the provision of information.

New regulations concerning counterclaims and declaratory actions

It is planned to introduce provisions to regulate specific proceedings. These include a counterclaim for the invalidation or revocation of the right of protection of the trademark, protection right for a collective trademark, guarantee trademark, the recognition of the

protection of an international trademark, and to claim recognition of the protection of an international industrial design. In addition, it is also proposed to introduce a complaint to determine that certain actions taken by the plaintiff or intended by him do not constitute a breach of a patent, an additional right of protection, a right of protection or a right of registration vested in the defendant.

Conclusions

Most of the proposals aim to a good direction. Particularly noteworthy are the proposals for the creation of specialized 4 court departments where judges will be specialized in matters of intellectual property. This proposal will certainly result in the speed and merit quality of proceedings in intellectual property matters.

In addition, changes regarding obligatory representation in intellectual property matters should be considered as reasonable. However this proposal should be changed in the way that patent attorneys should have also the rights to carry out all intellectual property matters (including copyright cases). Presently patent attorneys are well prepared and have competences to conduct intellectual property matters. They conduct i.e. proceedings before the Polish Patent Office in cases trademark applications applied by third parties, where the legal basis for applying for an opposition to the trademark applications or revocation request may be the personal or economic right of a third party (such as, inter alia, copyrights or the rights to the name of the company).

At present the project will be discussed in public consultation in which we will take part.

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