

Poland

Administrative procedure

The applicant may apply for re-examination of any matter decided by the Polish Patent Office (hereinafter “PPO”) in accordance with Article 244 of the Industrial Property Law (hereinafter “IPL”). A case will be re-examined by an expert appointed by the President of the PPO.

The time limit for submitting a request for re-examination of the case for which a decision has been made or an order issued is two months or one month, respectively, from the day on which the party is served with a decision or an order.

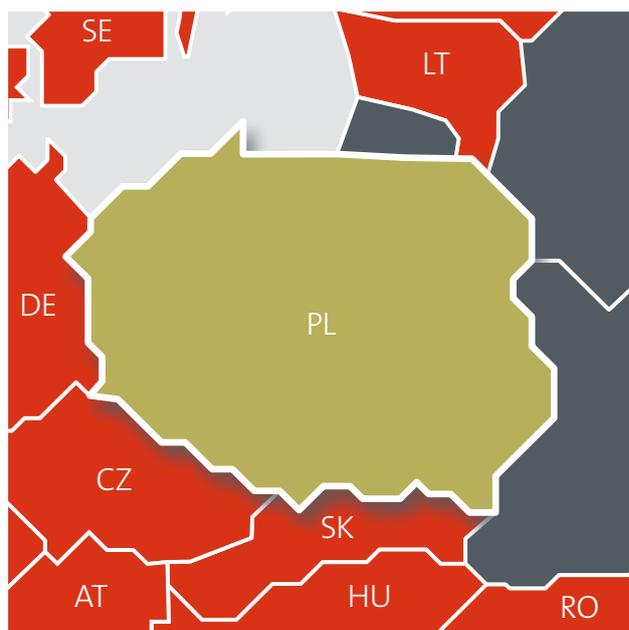
Following the re-examination of the matter, the PPO takes a decision whereby it:

- a) sustains the appealed decision, or
- b) reverses the appealed decision in whole or in part and in that scope decides on the merits; or
- c) reverses the appealed decision in whole or in part and in that scope discontinues the proceedings; or
- d) discontinues the proceedings in part and sustains the remaining scope of the appealed decision, or it reverses the appealed decision and decides on the merits; or
- e) discontinues the appeal proceedings.

Opposition

Post-grant opposition is available. It may be filed within six months from the date of publication of the mention of the grant in the *Biuletyn Urzędu Patentowego*, the official bulletin of the PPO. Any interested party may file a reasoned opposition to a final decision of the PPO on the grant of a patent, a right of protection for a utility model or a right in registration (Art. 246 IPL).

The right holder is informed by the PPO that an opposition has been filed and that he may submit his observations within a fixed time limit (Art. 247 IPL). The right holder may, upon inspection, agree with the claims raised and accept the opposition as justified. The proceedings will then be closed and the decision to grant a patent or other relevant right as provided by the IPL will be revoked. If the right holder considers the opposition to be without grounds, the opposition procedure will be settled in litigation proceedings



before the PPO (Art. 247(2) IPL). A complaint against the decision may be filed with the Administrative Court in Warsaw within 30 days.

Appeal

Pursuant to the IPL, judicial review proceedings may be instituted as follows:

- a) For decisions made and orders issued by the PPO on issues explicitly set out in Arts. 255 and 257 IPL, a party may file a complaint through the PPO with the Administrative Court in Warsaw (contentious administrative appeal).
- b) All other decisions made and orders issued by the PPO are subject to complaint to administrative courts (Art. 248 IPL, non-contentious administrative appeal). There is no need for re-examination proceedings before the PPO, however such a possibility exists.

The President of the PPO appoints an expert to examine whether or not the complaint lodged is justified. Following the examination of the complaint, the PPO either admits the complaint in whole or refers the reply to the complaint together with the case file to the Administrative Court (Art. 249 IPL).

The complaint must be made within 30 days from the service of the decision.

Rulings of the Administrative Court may be subject to annulment proceedings (“cassation appeal”) before the Supreme Administrative Court.

Revocation

A patent may be declared invalid in whole or in part at the request of any person having a legitimate interest and who is able to prove that:

- a) the statutory requirements for the grant of a patent have not been satisfied; or
- b) the invention has not been disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; or
- c) the patent has been granted for an invention not covered by the contents of the application or of the original application.

There is no restriction on the time limits for any requests (Art. 89 IPL).

Additionally, the General Prosecutor or the President of the PPO may, acting in the public interest, request that a patent be revoked or intervene in a pending revocation action (Art. 89(2) IPL).

The decision will be taken in the litigation proceedings before the PPO. Partial revocation is available.

The IPL does not provide for the possibility of modifying the scope of the granted patent through modification of the patent claims. It does not provide for a procedure analogous to Art. 105a EPC. It is possible for the patent to be revoked in part (Art. 89 of the IPL) or for the patent holder to surrender the patent with the consent of the parties having rights in the patent (Art. 90(1)(2) of the IPL).

The surrender in part is possible only in cases in which the protected solution is divisible.

Civil procedure

Infringement

A civil action must be brought by the patentee, or exclusive licensee entered in the register, to the Regional Court (*sąd okręgowy*). Jurisdiction is mainly determined by the defendant’s place of residence or its registered office (Art. 27

and 30 CPC).

The procedure is governed by provisions of the CPC on litigation.

Claims for patent infringement become statute-barred after three years from the date of infringement, with the limitation period running separately for each individual infringement from the date where the right holder has learned about the infringement of his patent and the infringing person. However, in any case, the claim will become barred by prescription five years after the date on which the infringement has occurred (Art. 289(1) IPL).

In the first instance court the case is heard by one judge (legally qualified, no technical background required).

Nullity/counterclaim for revocation

Nullity may be used as a defence in infringement proceedings, but invalidation of the patent is subject to separate litigation proceedings before the PPO.

Remedies

The court may impose recalling goods from the channels of commerce, destruction of goods, preservation of evidence or claims, publication of judicial decisions, desistance from infringement, handing over unjustly obtained benefits, pecuniary compensation.

Other actions

It is possible to request the court to establish *inter alia* the authorship of the inventive project, to establish the right to the patent, to establish the right to use the invention or to transfer the patent obtained by an unauthorised party.

Appeal

An action should be filed with the Court of Appeal (court of second instance) (Article 367 CPC). The Court of Appeal will hear a case only within the limits of the appeal. However the court may decide on the invalidity of proceedings, if any, on its own initiative (Article 378 CPC).

New evidence may be adduced if it was not possible before the first instance court or the need to adduce the same arose at a later date.

The appeal is heard by a panel of three judges (all legally qualified).

Further appeal filed with the Supreme Court is restricted to breaches of substantive law or violation of procedural regulations (Art. 398 et seq. CPC).

Parallel proceedings

The court may stay proceedings *ex officio* if the resolution of the case depends on the outcome of other civil proceedings pending or on a prior decision to be issued by a public administration body. It is at the discretion of the court to decide whether in a given case the proceedings should be stayed (Art. 177 CPC).

Arbitration/mediation

There are several forms of alternative dispute resolution for proceedings in Poland.

Mediation

Mediation or settlement agreement is possible in proceedings before the courts on matters of industrial property. Mediation is voluntary. It is conducted on the basis of an agreement to mediate or a court order referring the parties to mediation (Art. 1831 CPC).

The minutes of mediation proceedings will be drawn up. If the parties enter into a settlement agreement before the mediator, such agreement must be included in or attached to the minutes. By signing the settlement agreement, the parties agree to request the court to approve it (Art. 18312 CPC).

If the parties enter into a settlement agreement before the mediator, the court will take, at the party's request, prompt action to approve such agreement. The court will refuse to make the settlement agreement enforceable or to approve all or part of the settlement agreement made before the mediator if the agreement is contrary to the law or principles of social co-existence, or if it seeks to circumvent the law, or if it is incomprehensible or contradictory (Art. 18314 CPC).

Once approved by the court, a settlement agreement made before the mediator has the legal effect of a settlement agreement made before the court. A settlement agreement made before the mediator, to which a writ of execution has been issued, is an enforcement title (Art. 18315 CPC).

A natural person having full capacity to make acts in law and

enjoying full public rights may serve as a mediator. A judge may not serve as a mediator.

As part of their statutory duties, non-governmental organisations and higher education institutions keep lists of mediators and establish mediation centres.

Details of the lists of mediators and mediation centres are made available to the President of the Regional Court (*sqd okręgowy*) (Art. 1832 CPC).

Conciliation

Conciliation proceedings, which may result in a settlement agreement, are conducted by a court.

A motion for a summons to a conciliation session may be filed with a district court (*sqd rejonowy*) of general jurisdiction over the opposing party. The motion should briefly describe the case. As in mediation proceedings, minutes are taken and, if the parties enter into a settlement agreement, the content of such agreement will be noted in the minutes or in a separate document forming part thereof. The parties sign the agreement (Art. 184 et seq. CPC).

Arbitration

The Arbitration Tribunal is governed by Arts. 1154 to 1217 CPC.

Disputes involving industrial property cases may be resolved before an arbitral tribunal (Art. 1157 CPC). In order to submit a dispute to arbitration, the parties must enter into an agreement specifying the matter at issue or the legal relationship from which a dispute has arisen or may arise (arbitration agreement) (Art. 1161 CPC).

An arbitration agreement must be made in writing (Art. 1162 CPC). If an action is lodged with the court in a matter which is the subject of an arbitration agreement, the court will reject a statement of claim if the defendant invokes an arbitration agreement before defending on the merits of the case (Article 1165 CPC).

The arbitral tribunal resolves a dispute in accordance with the law applicable to a given relationship or, if expressly authorised to do so by the parties, in accordance with general rules of law or equity. In all cases, however, the arbitral tribunal will take into consideration the terms of the contract and trade customs applicable to the legal relationship concerned (Art. 1194 CPC).

If the parties settle a dispute during arbitration, the arbitral tribunal terminates proceedings. The terms of the settlement agreement is noted in the record or separate document forming part of the record. If so requested by the parties, the arbitral tribunal may record the settlement

agreement in the form of a consent award. Such award produces the same effects as any other award (Art. 1196 CPC).

An arbitral award issued in the Republic of Poland may only be set aside by the court in proceedings initiated by the filing of an application to set aside the award (Arts. 1205 to 1211 CPC).

An award or settlement agreement made before an arbitral tribunal have legal effect equal to a court judgement or a settlement agreement made before the court, after it is recognised or declared enforceable by the court (Arts. 1212 to 1217 CPC).

A natural person with full capacity to perform acts in law, irrespective of his or her nationality, may serve as an arbitrator. A state judge may not serve as an arbitrator. However this does not apply to retired judges (Art. 1170 CPC).

officers operating thereat, except for matters reserved for courts. This applies both to the enforcement of final judgments in legal proceedings and for instance to decisions on securing the claim (Article 758 et seq. CPC).

Compulsory licence

A compulsory licence may be granted by the PPO only under certain circumstances, in cases of national emergency and abuse of patent rights or dependent patents (Article 82 IPL).

Relevant national law

Act of 30 June 2000 – Industrial Property Law (Journal of Laws of 2017, item 776, as amended) [cited as: IPL];

Civil Procedure Code [cited as: CPC].

Enforcement

Enforcement proceedings fall within the competence of district courts (*sądy rejonowe*) and court enforcement

Competent authorities or courts

