



Trademark Litigation Review

2025

**Poland: Amends to Civil Procedure
Code Act to have Serious Impact on
Enforceability**

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The second edition of the WTR Trademark Litigation Review casts an expert eye on some of the most pressing issues facing those involved in litigation on both sides of the divide, blending analytic insight with on-the-ground expertise from the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa.

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Poland: Amends to Civil Procedure Code Act to have Serious Impact on Enforceability

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IN SUMMARY

The article presents the essential features of court proceedings in cases of trademark infringement and the remedies available to rights holders. Attention is paid to interim injunctions and recent legislative changes. The article also outlines some of the most important judgments and issues with which Polish courts have recently dealt.

DISCUSSION POINTS

- Preliminary injunction in a snapshot
- New procedural rules are not favourable for IP owners
- Generous compensation rules
- Rules for parallel import of medicinal products are still unclear
- Specific statute of limitations on non-pecuniary claims
- Polish referrals to CJEU

REFERENCED IN THIS ARTICLE

- [Polish Supreme Court, Case No. II CSKP 457/22 \(6 May 2022\)](#)
- [Polish Supreme Court, Case No. III CZP 30/20 \(18 May 2021\)](#)
- Polish Supreme Court, Case No. No. II CSKP 104/22 (22 June 2022)
- Polish Supreme Court, Case No. II CSKP 457/22 (6 May 2022)
- [CJEU, Case No. C-355/21 \(13 October 2022\)](#)
- [CJEU, Case No. C-628/21 \(27 April 2023\)](#)
- [Warsaw Regional Court, Case No. C-334/22 \(22 February 2022\)](#)

5 KEY NEED TO KNOWS

Injunctions at a glance	
Preliminary injunctions – are they available, and how can they be obtained?	Preliminary injunctions can be obtained either before or in the course of trademark infringement proceedings. The applicant must demonstrate a high probability of infringement and the threat of non-recoverable losses should the injunction not be granted.
A preliminary injunction is issued for the duration of the trademark infringement proceedings. The court must rule promptly on the injunction request, within one week of receiving it. The injunction may be reversed or changed at any time by the court at the request of the obliged party if the reason for the injunction ceases to exist or changes.	Resale price maintenance; non-competes clauses in joint production agreements

Permanent injunctions – are they available, and how can they be obtained?	Only a final and binding judgment issued by the court can constitute a permanent injunction. A preliminary injunction is issued for the duration of the trademark infringement proceedings. However, it may be reversed or changed at any time by the court at the request of the obliged party if the reason for the injunction ceases to exist or changes.
Is payment of a security/deposit necessary to secure an injunction?	Although payment is not necessary by default, the court may decide otherwise, either on its own initiative or at the request of the obliged party.
What border measures are available to back up injunctions?	The right holder can submit an application to Customs to take action with respect to goods crossing EU borders that are suspected of infringing the applicant's trademark. This is based on EU Regulation 608/2013 (12 June 2013).

WHAT'S NEW?

The most significant policy updates in the past year concern the recent amendment to the Civil Procedure Code Act (17 November 1964), and in particular the regulations on preliminary injunctions in IP cases. These changes do not relate directly to trademark rights, but they have a serious impact on the enforceability of these rights as injunctions play a key role in IP litigation disputes. As of 1 July 2023, the following apply to proceedings on granting preliminary injunctions in IP cases:

- the former ex parte model has been changed to an inter partes model, with a hearing of the obliged party (potential infringer) by the court before issuing a preliminary injunction is now mandatory, with two exceptions to this rule:
 - the court will not be obliged to hear the obliged party if it considers that it is necessary to immediately decide on the injunction; and
 - the requested injunction is to be performed only by the bailiff, for example by seizing the goods;
- the right holder is required to inform the court in the injunction request whether proceedings for invalidation are or have been pending against his exclusive right, and the court deciding on the injunction should take into account the likelihood of invalidation of this right; and
- an injunction request must be submitted no later than six months from the moment of obtaining knowledge about the IP infringement. Otherwise, the request will be automatically dismissed by the court.

It is notable that since these changes have been made, trademark rights infringement cases have been settled in a dedicated procedure before specialist departments of the common courts. Five departments were created in the regional courts of Warsaw, Gdańsk, Katowice, Lublin and Poznań to act as first instance courts, and two departments were created in the

Courts of Appeal of Warsaw and Poznań to act as second instance courts. Cases with more complicated technical matters concerning computer programs, inventions, utility models, topographies of integrated circuits, plant varieties and technical trade secrets fall within the exclusive jurisdiction of the Regional Court of Warsaw.

Furthermore, the IP procedure provides for three types of discovery claims, which implement article 7 of the EU Directive 2004/48 (29 April 2004):

- securing the means of evidence – this refers to certain materials that would demonstrate the scope of the infringement and allow evidence to be produced in any future IP litigation. There is no obligation to specify in the request the facts that are meant to be proven;
- disclosure or issuing the means of evidence – in this case, the claimant must demonstrate that certain means of evidence, in particular banking, financial or commercial documents, are at the defendant's disposal; and
- request for information – the scope of information necessary to pursue an IP claim is limited to data on the origin and distribution networks of goods or services.

The aim of these claims is to discover the circumstances of the IP-related infringements and to secure certain materials that could later serve as evidence in the related infringement litigation.

An IP-specific claim exists that applies in infringement cases regarding trademarks and provides the possibility for a counterclaim based on the invalidation or expiry of the trademark right in civil proceedings. Before the establishment of IP courts, invalidity and expiry requests were reviewed only by the Polish Patent Office in administrative proceedings. Now there are two alternative ways to achieve this. To avoid re-examining the same case, the IP procedure regulations stipulate the conflict rules between the IP courts and the Polish Patent Office (including the obligatory suspension of civil proceedings). By this means, domestic regulations on invalidation or expiry of Polish trademark rights proceedings are now more similar to the regulations on EU trademark rights from the EU Regulation 2017/1001 (14 June 2017).

The establishment of special IP courts in Poland has brought many consequences for trademark rights holders seeking judicial protection. The most important is the concentration of all IP cases to just five regional courts. First, this restricts to a large extent the choice of courts where IP proceedings can be initiated. And second, it may also improve the unification of trademark rights case law: previously, cases were considered by 48 regional courts across the country. Therefore, we can expect more clarity in the judicial interpretation of trademarks rights regulations. This would to some extent make it easier for entrepreneurs to conduct business activity, as it would bring more certainty to the outcome of IP cases. Surprisingly, these changes have not yet resulted in a reduction in the time it takes to obtain a decision at first instance, as measured from the time of the initiation of proceedings. Nevertheless, introducing regulations designed to lead to greater specialism on the part of the courts in IP matters was certainly a good step towards bolstering the level of protection of IP rights holders.

PRELIMINARY INJUNCTIONS

Preliminary injunctions are available to both parties of trademark infringement proceedings. These take the form of securing the claims of each party or participant in the proceedings.

Since specific regulations on evidence are not fully applicable, the applicant need only demonstrate a high probability of infringement, which is a lighter requirement than the burden of proof. Additionally, the applicant must have a legal interest in granting a preliminary injunction, meaning that, without the injunction, the applicant would face a serious threat of non-recoverable losses, or that the enforcement of a judgment would be prevented or significantly hindered.

Nonetheless, the granted injunction cannot satisfy the claim. The applicant can instead request a preliminary injunction to secure a pecuniary claim or a non-pecuniary claim. A pecuniary claim can be secured by, in particular:

- seizure of movable property, remuneration for work, bank account receivables or other receivables or other property rights; or
- encumbrance of real estate with a compulsory mortgage.

In the case of securing non-pecuniary claims there is an open catalogue of available measures, since the court grants whatever injunction it considers appropriate in the circumstances. In disputes concerning the infringement of trademark rights, the defendant is usually prohibited from introducing to the market goods marked with the disputed trademark or conducting advertising activities. A ruling is also often made to seize the stored goods marked with the disputed trademarks, as well as to destroy or remove those marks.

As mentioned earlier, the recent amendment to the Civil Procedure Code Act on preliminary injunctions changed the model of injunction proceedings. Previously, proceedings were carried out *ex parte* so the defendant did not participate in proceedings until the decision to grant a preliminary injunction was served on them. However, there was a way to present the defendant's arguments to the court before the decision was granted. If the defendant learnt that a motion for a preliminary injunction was being submitted to the court, they could file a brief containing their arguments and this should be taken into account by the court. However, this method wasn't based on any applicable regulations and consequently it wasn't accepted by all courts.

Under the present rules, a preliminary injunction cannot be granted before a mandatory hearing of the obligated party (the potential infringer). This substantial change leads to an *inter partes* model of injunction proceedings. However, as mentioned above, there are two exceptions to the mandatory hearing rule: if the court considers it necessary to rule immediately, and if the injunction is to be performed by the bailiff (eg, by seizing property).

There is also a deadline for submitting an injunction request – up to six months from the moment of obtaining knowledge about the IP infringement. Overdue requests will be automatically dismissed. The applicant must also inform the court whether proceedings for invalidation are or have been pending against his exclusive right, and the court should consider the likelihood of invalidation.

The new regulations are certainly beneficial for the defendants as they provide more opportunities to defend against allegations of IP rights infringement. However, the probability of a preliminary injunction being granted is unquestionably lower than before. The surprise effect of an injunction, which has always had a significant role in IP rights enforcement, has been diminished.

If any party is not satisfied with a decision on granting the injunction, they can appeal to the court of second instance. If the injunction was granted by the court of appeal during appeal proceedings, the appeal will be decided by a panel of different judges from the same court. Previously, the injunction appeal was assigned by default to a different judicial panel from the same court that issued the injunction. This was seen as highly controversial and inefficient: doubts arose as to whether judges from the same court were willing to lift injunction decisions made by their colleagues. Fortunately, this regulation has recently been changed such that an appeal against the injunction decision is now assigned to the court of the second instance. This brings more confidence in a just appeal decision.

Once an injunction has been granted, the court may decide, on its own initiative or at the request of the obliged party, that its enforcement depends on the submission of the security or deposit by the entitled party. This typically happens in cases where it is likely that the obliged party will suffer significant damage as a result of the injunction and unlikely that the entitled party will be financially capable of remedying those damages in a potential compensation case.

LATEST JURISDICTIONAL TRENDS

Remedies In Civil Proceedings

The holder of a trademark right may request the infringing party to cease the infringement and claim a monetary amount corresponding to the unfairly obtained benefits. In the case of faulty infringement, following EU Directive 2004/48, the holder of a trademark right can also claim compensation in the form of a lump sum, calculated on the basis of the royalty fee that the infringer of the trademark right would have to pay if they wanted to use the sign lawfully. The choice of whether to claim compensation on general principles or as a lump sum based on the royalty fee belongs to the holder and does not require any further criteria or justification. This solution is appropriate for many national legal systems that have implemented the enforcement directive in their legislation. A particularity of Polish law, however, is that, aside from compensation, the holder can also claim a monetary amount corresponding to the unfairly obtained benefits. Punitive damages are not allowed. Recently, in its judgment of 22 June 2022 (case No. II CSKP 104/22), the Supreme Court confirmed that the amount of unfair benefits that the holder can demand for the infringement of the trademark right is not exhausted by the amount of the saved expense – that is, the royalty fee that the infringer should have paid – but also includes the profits achieved by the infringer as a result of the unlawful infringement of the trademark. Polish law is therefore favourable to the right holder in this respect, because by claiming a lump sum compensation and unfairly obtained benefits, they can in fact demand a double license fee. Since claiming compensation as the equivalent of a license fee is much easier than claiming compensation on general terms, it seems that the possibility of cumulation is an attractive solution for the right holder under Polish law.

In addition, the holder of a trademark right can request the publication of the court judgment or information about the judgment in the form specified by the court.

The Industrial Property Law Act (30 June 2000) permits the holder of a trademark right to make additional claims. These are:

- a right to prevent all third parties from bringing goods, in the course of trade, into Poland, without being released for free circulation there, where such goods, including their packaging, come from third countries and bear without authorisation

a trademark that is identical to the trademark registered in respect of such goods, or that cannot be distinguished in its essential aspects from that trademark;

- if there is a risk that the packaging, labels, tags, security or authenticity features or devices, or any other items to which the trademark is affixed, could be used in relation to goods or services and that use would constitute an infringement, the holder has a right to prohibit:
 - affixing a sign identical with, or similar to, the trademark on packaging, labels, tags, security or authenticity features or devices, or any other items to which the mark may be affixed; or
 - offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other items to which the mark is affixed;
- if there is a reproduction of a trademark in a dictionary, encyclopaedia or similar reference work, in print or electronic form, which gives the impression that it constitutes the generic name of the goods or services for which the trademark is registered, the publisher of the work is obliged, at the request of the holder, to ensure that the reproduction of the trademark is accompanied by an indication that it is a registered trademark.

The abovementioned claims can also be made against a party that offers labelled products that were not obtained from the holder of a trademark right or the person authorised to use the trademark, as well as against parties whose services were used in the course of the infringement.

MAJOR CASE OUTCOMES

Free Movement Of Goods

In its judgment of 6 May 2022 (Case No. II CSKP 457/22), the Supreme Court ruled that it was unlawful to affix a trademark used by a right holder in Poland to medicinal products introduced as part of a parallel import from another EU country if a different trademark was affixed to those goods in the country of export. The Supreme Court thus hinted to trademark right holders on how to limit the admissibility of parallel imports in Poland. This ruling is extremely controversial and was met with great surprise. In reality, the Supreme Court rejected the principle that the use of different trademarks for the same goods within a single market constitutes a disguised restriction within the meaning of article 36 of the Treaty on the Functioning of the European Union, and that such activity by the right holder should not benefit from protection.

Limitation Period

A claim of industrial property rights infringements can be pursued before the court within the limitation period of three years after the right holder learns about the infringement and the infringer, and in no case longer than five years after the infringement. Until recently, it was unclear when the limitation period began in the case of non-pecuniary claims, such as a right to request the infringing party to cease the infringement in situations where the action of the infringer is not a one-off, but of a continuous nature and ongoing at the time of initiation of the proceedings. In its resolution of 18 May 2021 (Case No. III CZP 30/20), the Supreme Court ruled that if an infringement of an EU trademark right is repetitive and is occurring

at the time the non-pecuniary claim is filed, the five-year limitation period starts from each day on which the infringement occurs. Thus, the Supreme Court introduced a distinction between the limitation period for pecuniary and non-pecuniary claims, because in the case of non-pecuniary claims, the limitation period for continuous infringement may theoretically last indefinitely. Consequently, for example, if an infringement continues, the limitation period for a claim for cessation of infringement will not end until five years after the first day of the infringement.

PRELIMINARY REFERENCES FROM THE POLISH COURTS TO THE EUROPEAN COURT OF JUSTICE

Even though the following cases refer to the EU regulations on European Union trademark rights and not to the regulations on Polish trademark rights, the preliminary references issued by the Polish courts are of significance and worth referring to.

Perfumesco Case

In its judgment of 13 October 2022 (case No. C-355/21), the CJEU ruled that if original goods with a legally placed trademark have been placed on the market without the consent of the holder of a trademark right, the EU allows for their destruction under article 10 of the EU Directive 2004/48.

The Polish Supreme Court issued a preliminary reference in a case concerning the Polish company Perfumesco.pl, which was selling Hugo Boss perfumes online. Sales in Poland included, for example, testers, as well as products intended for sale in the European Economic Area. In both cases, Procter & Gamble, the owner of the Hugo Boss brand, opposed such practices. The Supreme Court was not certain whether the goods with a legally placed trademark that were not counterfeited can be destroyed, since the Industrial Property Law Act refers only to unlawfully manufactured or marked goods.

The CJEU stated that article 10 of the EU Directive 2004/48 should be interpreted broadly and should therefore apply to goods that have been found to infringe intellectual property rights in any way. This includes cases where non-counterfeit goods were placed on the market without the consent of the trademark right's holder. The CJEU's judgment is a breakthrough in this regard as the dominant view in Poland was that the article should be interpreted narrowly, that is, only in the case of counterfeit goods. However, the CJEU's interpretation is aimed at full protection of exclusive rights against infringement by third parties. It emphasises that it is the holder of a trademark right who should decide on the first marketing of goods bearing that mark.

Castorama Case

In its judgment of 27 April 2023 (Case No. C-628/21), the CJEU ruled on a case in which a claimant requested from Castorama Polska and Knorr information regarding their distribution network, suppliers, the amount of goods received and ordered, the date of introduction of goods for sale in stationary stores and the online store, the amount of goods sold and the price obtained from the sale. The claimant stated that this information was necessary to pursue their alleged copyright claim. The legal basis was article 479 (113) of the Code of Civil Procedure, which is an implementation of article 8 section 1 of EU Directive 2004/48.

The CJEU ruled that the claimant can pursue the information claim on the scale of use of works for copyright protection if they provide reasonably available evidence to convince the

court that they are entitled to the intellectual property right. Assessment in this regard should be made by the national court. The CJEU stipulated that the request for information cannot be abused and that the national court should assess the merits and proportionality of the request for information. It should consider the circumstances of the case. Where there is an abuse of rights, the court should refuse to exercise the right to information provided for in the EU Directive 2004/48.

Even though the CJEU judgement refers to copyright law, it has a substantial impact on all intellectual property rights (including trademarks) as it concerns the requirements which the claimant must fulfill when submitting a request for information in any IP case.

Audi Case

In its decision of 22 February 2022, the Regional Court in Warsaw (Intellectual Property Division) issued a preliminary reference to the CJEU asking whether it is possible to interpret articles 9(2) and 9(3)(a) of EU Regulation 2017/1001 on trademark – the case of affixing the sign for a trademark that reflects the shape of the trademark or is confusingly similar to it – as including the shape of a car. This would be similar to the interpretation of the repairs clause in article 110(1) of EU Regulation 6/2002, such that the affixed sign cannot be regarded as a designated trademark even if it is identical to the trademark or confusingly similar to it. The issue is that there is no equivalent provision in Regulation 2017/1001 to the repairs clause from the Community Designs Regulation, so there are some doubts as to the legal basis of applying the criteria of the repairs clause to the EU trademark right infringement case. The issues concerned in the preliminary reference have been much debated in the past year as they are highly controversial and in a way revolutionary for trademark rights protection in the EU. We therefore look forward to learning the CJEU's opinion on this matter.

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