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Professional representatives in IP cases
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Poland

Professional representatives in IP cases

Polish law provides that, in principle, a party may perform a legal action either personally or through a professional representative. In specific cases, a person may be represented by a family member, a company employee or another person who professionally represents other persons and companies before courts and public offices – a so-called ‘professional representative’, such as an attorney at law, a legal adviser or a patent attorney

The specific nature or complexity of a case or a particular procedural question may require the services of a professional representative. One area where it is both recommended and necessary to involve a professional representative is IP law, which entails a number of acts within the administrative, civil and criminal systems. Some of these acts may be performed only by specialised professional representatives.

According to Polish law, parties in IP rights cases may be represented by patent attorneys, legal advisers or attorneys at law before the Polish Patent Office (PPO), the administrative, civil or criminal courts and other authorities with the power to decide on IP cases. (The law also allows a specific group of non-professional representatives, which are not discussed here.)

Choosing the correct representative

In specific circumstances, Polish law imposes an obligation on a party to appoint a professional representative specialised in IP law. This is known as ‘compulsory representation by a patent attorney’ and may be absolute or optional.

The scope of the exclusive competence of patent attorneys is determined by two criteria: the type of authority before which the proceedings are held and the type of case. These criteria are cumulative.

The IP Law introduced the principle of optional compulsory representation by a patent attorney, which provides that in PPO proceedings relating to the filing and examination of applications, as well as the maintenance of patents, utility models, industrial

designs, trademarks, geographical indications and topographies of integrated circuits, a party may be represented only by a patent attorney. Thus, unless a party chooses to represent itself, it must appoint a patent attorney as its professional representative.

This limitation of the choice of representative to an IP professional with the necessary technical knowledge applies to both matters requiring in-depth technical knowledge (ie, patents) and other areas of intellectual property (eg, trademarks, industrial designs or geographical indications). The limitation results from the legislature’s belief that only the specialised knowledge of a person skilled in the art, combined with his or her professional responsibility to perform his or her duties properly, can guarantee that the party’s interests will be adequately protected before the PPO. However, this exclusive competence of patent attorneys is limited to proceedings before the PPO. Thus, it does not apply to proceedings before the administrative courts (which deal with appeals of PPO decisions) or the civil courts, where parties may be represented by an attorney at law or a legal adviser and a patent attorney.

The regulations allowing a party either to appoint a professional representative or to represent its own interests before the PPO do not apply to persons who do not reside in or have a registered office in Poland. In such cases the principle of absolute compulsory representation by a patent attorney applies, meaning that such persons must be represented by a patent attorney. This principle also applies in many other countries and is used not only in purely national proceedings, but also in international proceedings before the PPO. For example, the holder of a European patent that is applying for temporary protection of that patent in Poland must appoint a Polish patent attorney. A non-Polish applicant must also be represented by a Polish patent attorney when appealing against a decision of the PPO acting as the authority of an appointed state in proceedings for the registration of an international trademark.

Legal advisers and attorneys at law are admitted in

“ A legal representative may represent his or her client only within the scope of the granted power of attorney ”

cases relating to the invalidation of a patent, a supplementary protection certificate, a protection or registration right, the grant of a compulsory licence or an amendment to a decision to grant a compulsory licence, all of which are decided by the adjudicative board of the PPO acting as a quasi-judicial body. This is vital, particularly in complex cases and where the appointed patent attorney is not a lawyer (but is admissible under the Patent Attorneys Law).

Poland has no specialised patent courts. Decisions of the PPO may be appealed to a regional administrative court, where a party can be represented by a legal adviser or an attorney at law and a patent attorney. The option of joint representation by these professional representatives is highly recommended in cases relating to inventions, industrial designs, geographical indications, the topography of integrated circuits and trademarks.

In administrative IP cases, each of the above-mentioned representatives is authorised to submit a cassation complaint.

IP cases decided through civil proceedings usually relate to:

- infringements of patents, utility models, designs or trademarks;
- the establishment of a right to use in local activity a designation subsequently registered as a trademark on behalf of another party;
- the establishment of a right to use an invention, utility model or industrial design; and
- the assignment of, among other things, a patent, a right to a utility model, a right to an industrial design and a right to a trademark or topography of integrated circuits obtained by an unauthorised person.

According to civil procedure, a professional representative may be an attorney at law or a legal adviser. In IP rights cases an inventor may also be represented by a patent attorney or a representative of an IP rights organisation.

In civil cases an attorney at law or a legal adviser and a patent attorney may act jointly at first and second instances. However, a cassation complaint to the

Supreme Court may be filed only by an attorney at law or a legal adviser.

The criminal procedure sets out completely different requirements. Parties in criminal proceedings are represented by defence counsel, a legal representative or a statutory agent, with the latter being a parent or a guardian who is not usually a professional attorney. The professional representative is the defence counsel or the legal representative.

According to criminal procedure, a defendant may be represented only by an attorney at law (defence counsel). Other participants in the criminal proceedings may be represented by an attorney at law or a legal adviser. A legal representative may represent his or her client only within the scope of the granted power of attorney. The representative is authorised to act at both first and second instance of the criminal proceedings. As in civil proceedings, compulsory representation by a lawyer applies in case of a cassation complaint.

A patent attorney is not authorised to represent parties in IP rights cases decided within the criminal procedure. This principle was laid down by a judgment of the Constitutional Tribunal in 2002. Nevertheless, considering the specific nature of the subject matter and patent attorneys' technical knowledge, they frequently attend to support attorneys at law during criminal proceedings, even though they do not act as legal representatives in the proceedings.

Proving the right of representation before the courts and other authorities

Polish law provides that every representative must prove his or her authorisation to act on behalf of another person, as well as the scope of that authorisation. Authorisation to perform legal acts on behalf of another person may be provided by a declaration of the represented person (ie, a power of attorney).

As a rule, a power of attorney may be granted in any form, not necessarily written. However, there are exceptions to this rule – in some situations the law requires a specific form of power of attorney (eg, a written power of attorney, a notary act or a power of attorney with certified signatures). For example, a general power of attorney to perform all acts should be

granted in writing. A power of attorney for representation in court or PPO proceedings may be given orally by the granting party before the court and is recorded in the minutes. If the granting party does not participate in the trial, its representative should submit a written power of attorney to prove his or her authorisation to act on behalf of the principal.

A written power of attorney should include:

- the actions and matters in which the authorised person may represent the party granting the power of attorney;
- the execution date of the power of attorney; and
- the signature of the grantor.

If the grantor is a legal entity, a power of attorney should be signed by someone who is authorised to sign in the name of the legal entity (usually a board member). In order to prove the right to represent a legal entity (eg, a company), the power of attorney must be accompanied by documents confirming that the person who signed the power of attorney was authorised to do so at the date of its execution. In this respect, the courts require a certified copy of a company register, valid at the execution date of the power of attorney, showing the persons who are authorised to represent the company, and whether such persons are entitled to act alone or must act jointly with another authorised representative. It is therefore essential that a power of attorney be signed by all persons whose common actions are necessary for effective and valid representation of the company.

In the case of foreign entities, the validity of a power of attorney must also be proven by similar documents confirming the right of representation. If there is no way to provide a certified copy of a company register, the Polish courts will accept company documents showing the persons who can represent the company and the scope of their authorisation (eg, articles of association or a shareholders' resolution on the appointment of persons authorised to represent the company). In specific cases, translations of legal acts on the rules of company representation that are binding in the country are also acceptable.

The originals of the documents confirming the right of representation must be provided. A professional representative of a company is authorised to certify copies of the original documents.

In addition, the courts and other authorities may require – particularly on request of other parties to the proceedings – that public documents executed in another country be provided with an apostille. This is a certificate drawn up in the contracting state where the document was executed. It is issued by the competent

authority of that state and certifies:

- the authenticity of the signature;
- the capacity in which the person signing the document has acted; and
- where appropriate, the authenticity of the seal or stamp borne by the document.

An apostille is required with respect to the following documents:

- documents emanating from an authority or a court official;
- administrative documents;
- notarial acts; and
- official certificates placed on documents signed by persons acting in their private capacity.

PPO practice and the Singapore Treaty on the Law of Trademarks

The regulations and rules described above are generally applicable in all proceedings before the courts and other authorities, including the PPO. Consequently, the PPO requires professional representatives to file a power of attorney, as well as other documents confirming the rules and scope of representation.

The Singapore Treaty on the Law of Trademarks and its corresponding regulations entered into force in Poland on July 2 2009. The treaty regulates various procedural matters in proceedings before the PPO relating to an application or registration, with the aim of simplifying them. The provisions of the treaty are applicable to all proceedings before the PPO.

The treaty states that any contracting party (ie, an authority of a signatory state to the treaty) may require the appointment of a representative by means of a separate document (a power of attorney) and specifies the scope of the power of attorney. The power of attorney may relate to one or more applications and/or registrations identified in the power of attorney, or to all existing or future applications and/or registrations of the appointing person. Furthermore, the power of attorney may be limited to certain acts.

Importantly, the treaty provides that a contracting party cannot demand compliance with requirements other than those set out in the treaty. Thus, the treaty requires the filing of no documents other than the power of attorney. Therefore, the PPO's practice in this respect may be considered to be contrary to the treaty. Nevertheless, the Polish courts treat registration documents confirming the rules of representation as a component part of the power of attorney. Thus, the question of how to interpret the treaty's provisions in this respect remains controversial.



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