



Mind the trap

A completely new trademark examination and opposition procedure has entered into force in Poland. Sławomir Mazur of Polservice reports

Until recently, Poland was one of few countries in which the patent office examined both absolute and relative grounds for refusal for each trademark application. The result was that the examination by the office was time consuming and, in most of the cases, at least one year passed between a trademark filing and the registration decision. Additionally, quite often the patent office cited earlier rights even if there was no real conflict between the companies. Moreover, in Poland there used to be a post-registration opposition system, which meant that an opposition could only be filed after the full examination and registration of a trademark (the opposition deadline was six months after the

publication of the registration). If the opposition was successful, the trademark registration was invalidated.

The new changes in trademark regulations have totally redesigned the trademark examination procedure, which has been switched from the full examination system to the opposition system. Briefly, the basic rules of the new system are as follows:

- Within two months after receiving a new trademark application, the patent office discloses it in an online database. The disclosure is not deemed as the official publication.
- After the disclosure, anyone can file so-called third-party

observations, where the letter of observations may be based only upon absolute grounds for refusal, including bad faith.

- The letter of observations does not start any proceeding and is not binding on the office. It is for informative purposes only, but it may have an influence on the final decision.
- A trademark application is officially published in the patent office's bulletin only if no absolute grounds for refusal are found. If the office finds absolute grounds, it notifies the applicant who may respond to the examiner's objections.
- An opposition may be filed within three months of the official publication in the bulletin.
- The opposition may be based only on relative grounds for refusal. The opponent may evoke only its own earlier rights. The opposition shall already contain a statement of grounds.
- Once the applicant receives the opposition from the office, a two-month cooling-off period starts, which may be extended only once for four additional months. If the parties do not reach an agreement within this period, the opposition (inter partes) phase begins.
- All arguments and evidence need to be provided by the parties within the deadlines appointed by the office, otherwise they will be disregarded. In defence to the opposition, the applicant may bring up a claim of non-use of the trademarks on which the opposition is based.
- The general rule is that the opposition procedure is only in writing, however, at second instance a hearing may be ordered under certain circumstances. At first instance one expert ponders the opposition, while at second instance it is a panel of three experts.

It is also worth noting that some important changes to trademark-related inter partes proceedings were also introduced. Apparently the most important one is that it is no longer necessary to prove so-called legitimate interest to start trademark invalidation or trademark non-use cancellation proceedings.

The premise of a legitimate interest used to be another peculiarity of the Polish trademark system. The notion of a legitimate interest was not legally determined and the definition was elaborated by case law and scholars. In brief, one had a legitimate interest to start (and go through) an invalidation or non-use cancellation action if the challenged trademark was an impediment to freely exercise one's rights. It could be observed over years that relevant criteria were becoming less and less severe and eventually it was sufficient to base a legitimate interest on the principle of economic freedom. But still a legitimate interest had to be real, individualised, concrete and existing throughout the whole proceeding. If the party that initiated an invalidation or non-use cancellation action failed to prove its legitimate interest (or the interest ceased to exist), the patent office rejected the request.

The new examination and opposition system, which entered into force on 15 April 2016 (the border date), applies only to

trademarks filed for registration starting from the border date, whereas trademarks filed prior to that date, as a general rule, shall be subject to the old regulation.

However, the real life and practice have proved to be different from what was expected and the aforesaid general rule regarding the trademarks filed under the old regulation has been given one very significant exception. This results partially from the fact that the transition provisions are not complete or clear enough.

The transition provisions clearly state that all opposition proceedings initiated before the border date shall be continued according to the old regulations. However, an opposition proceeding is initiated when the opposition is filed with the patent office. Thus, there appeared a problem with the 'old' trademarks which were granted registration before 15 April 2016 and were open for opposition with the deadline after the border date, as well as with 'old' trademarks, which will be granted registration and would be open for opposition after 15 April 2016.

It was expected that for such marks the 'old opposition system' would apply, ie, the system of post-registration oppositions. This would actually mean that for the next few years there would be a dual opposition system in Poland: application-phase oppositions for trademarks that have been applied for since 15 April and post-registration oppositions for trademarks applied for before 15 April. This seemed to be a natural and reasonable temporary situation that accompanies any system change.

However, the patent office applied quite a rigid interpretation of this issue. Since the present legislation does not allow post-registration oppositions, no opposition can be filed for such 'old' trademarks. Such a rigid approach, though to some extent can be based on the present regulation and transition provisions, actually means that in Poland there are trademarks against which no opposition can ever be lodged. Since the institution of oppositions was not deleted from the Polish trademark law, the fact that no opposition is admissible for certain trademarks creates a serious gap in the whole trademark system and may be confusing for IP specialists.

There is however quite a simple solution to this irrational situation. An invalidation action can be started against such trademarks. The legal grounds for an opposition and invalidation are actually the same and it is no longer necessary to prove the legitimate interest to start an invalidation proceeding. Also, the result of the invalidation action is the same as it was in the old opposition system.

To summarise, although the issue discussed above may cause some problems and confusion for the next several months, it will gradually disappear over time and become just a memento that system changes tend to bring unexpected complications. [IPPro](#)

