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**A gloss to the decision of the Court of Appeals in
Katowice of 3 October 2011, V ACz 624/11
(Re: A claim for information under
industrial property law)**

The regulation of Article 286¹ of Industrial Property Law to the extent it grants the subject, whose rights as regards industrial property were infringed, the right to obtain detailed information about the violator's actions presents a specific processual demand, distinct from the code-based construction of securing the claims. The decision of the Court of Appeal in Katowice from 3 October, 2011, V ACz 624/11, Lex 1120408.

The significance of the voted decision of the Court of Appeal in Katowice manifests itself in the fact that it is the first and so far the only judicature's utterance concerning the legal nature of so called claim for information. It is also the first judicial opinion where it was admitted that the claim for information presents a separate processual demand. It should be emphasized that although the decision was issued in accordance with the Article 286¹ of the Act on Industrial Property Law of 30 June 2000 (hereinafter referred to as IPL),¹ it will also be applicable to other intellectual property regulations where the same claim was included i.e. Article 80 of the Copyright and Related Rights Act of 4 February 1994 (hereinafter referred to as CRRA),² Article 11a of the Database Protection Act of 27 July 2001 (hereinafter referred to as DPA),³ and Article 36b of the Plant Variety Legal Protection Act of 26 June 2003 (hereinafter referred to as PVLPA).⁴ These regulations are the result of the implementation of Article 8 of the Directive 2004/48/EC of the Euro-

¹ Consolidated text, "Journal of Laws" 2003, No. 119, Item 1117, as amended.

² Consolidated text, "Journal of Laws" 2006, No. 90, Item 631, as amended.

³ "Journal of Laws" 2001, No. 128, Item 1402, as amended.

⁴ "Journal of Laws" 2003, No. 137, Item 1300, as amended.

pean Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights⁵ into the Polish legal order.

The purpose of the introduced regulation is to increase the efficiency of the protection of the person authorized under intellectual property rights, whose rights were infringed. The damage which the person authorized under intellectual property rights as a consequence of infringement of their rights sustains or the benefits the violator acquires as a result of infringement, due to the specific character of the protected goods i.e. their intangible character on the one hand, and the technological possibilities of using someone else's intellectual property on the other hand, are, in the great majority of cases, difficult to determine. The authorized person does not have any knowledge of the created number of copies of the protected products, their selling price or the expenditure for their production. The lack of such information prevents the authorized person from defining the damage they suffered or the benefits the violator acquired and hence, defining the amount of the claim for compensation or returning the groundlessly acquired benefits. The remedy for those difficulties is the possibility for the authorized person of demanding from the violator of the intellectual property (Article 80 para. 1 (2) CRRA, Article 11a para. 1 (2) DPA, Article 286¹ para. 1 (2) IPL, Article 36b para. 1 (2) PVLPA) or from the specified third parties (Article 80 para. 1 (3) CRRA, Article 11a para. 1 (3) DPA, Article 286¹ para. 1 (3) IPL, Article 36b para. 1 (3) PVLPA) the information, which will allow the authorized person to determine the amount of the claim against the violator.

Facts of a case in which the voted judicial opinion of the Court of Appeal was issued are not significant for further analysis. It is only enough to say that the judicial opinion was issued following the petitioner's complaint against the decision of the Circuit Court that dismissed her petition for obligation of the defendant to provide information concerning the number of made and sold windows as well as their selling price. In the grounds for the decision the District Court indicated that, in this respective case, the petitioner did not state any claims for compensation against the defendant, she just insisted that the defendant should be ordered to cease the production and launching of the specified goods in the marketplace and to remove the consequences of those infringements by withdrawing them from the market and their destruction. By evaluating the grounds for the petitioner's complaint, the Court of Appeal recognized that defining the legal nature of the claim for information determines the possibility of finding whether the type and character of the claim, asserted by the authorized person in the progress of a lawsuit, influence the

⁵ Official Journal of the European Union L.04.157.45, as amended.

possibility of obtaining information in the way specified by Article 286¹ IPL, which, on the other hand, might be used to specify the claim and to enable to assert a claim in different proceedings.

First of all, the Court of Appeal validly rejected the dominant position of the doctrine concerning the legally substantive character of the norm⁶ in question. The Court of Appeal showed accurately that, above all, the disposition indicating what legal consequences are caused by specifying the hypothesis of the same norm determines the character of the given regulation. Producing effects directly in the sphere of social relationships is the feature of substantive norms, whereas producing effects in the sphere of proceedings characterizes norms of a lawsuit. Legally substantive norms regulate directly social relationships, while norms regulating forms of proceedings in civil cases and norms regulating competence of bodies entitled to cognizance of those cases compose a group of formal norms, i.e. norms of a lawsuit.

The Court of Appeal showed that from the content of Article 286¹ IPL, similarly to other regulations of intellectual property, results that a number of measures supporting assertion of civil law claims were collectively agreed in it. The measures are “securing of evidence” and “securing the claims” defined in Article 287 para. 1 and Article 296 para. 1 IPL which may consist in providing information, minutely described in Article 286¹ para. 2 IPL. According to the Court of Appeal, the structure of the provisions of Article 286¹ IPL, containing regulations of litigation nature and using the notion of securing the claims enables to accept that the claim for information has a litigious character and serves mainly auxiliary purposes in relation to claims set forth in Article 287 para. 1 and Article 296 para. 1 IPL, constituting a significant simplification for establishing the scope of civil law liability of the violator. Using the notion of “securing the claims” by the legislator is associated with the code-based regulation concerning the proceedings to secure the claims, which, undoubtedly, has character of a litigation. Moreover, imposition of an

⁶ See: A. Jakubecki [in:] *System prawa prywatnego. Prawo własności przemysłowej*, Vol. 14B, eds. R. Skubisz, Warsaw 2012, p. 1662; K. Jasińska [in:] *Ustawa o ochronie prawnej odmian roślin. Komentarz*, eds. K. Felchner, Warsaw 2009, p. 252; A. Kołodziej, *Roszczenie informacyjne w prawie własności intelektualnej*, [in:] *Księga pamiątkowa ku czci Profesora Janusza Szwai*, eds. E. Nowińska, M. du Vall, Kraków 2004, p. 150–151, 158; A. Nowak-Gruca, *Roszczenie informacyjne w ustawie – Prawo własności przemysłowej w świetle ekonomicznej analizy prawa*, MoP 2008, No. 15, p. 798; A. Tischner, *Harmonizacja prawa polskiego wymogami dyrektywy w sprawie egzekwowania praw własności intelektualnej – part I*, MoP 2005, No. 13, p. 635–636; idem, *Odpowiedzialność majątkowa za naruszenie prawa do znaku towarowego*, Warszawa 2008, p. 292; A. Tischner, T. Targosz, *Dostosowanie polskiego prawa własności intelektualnej do wymogów prawa wspólnotowego. Uwagi na tle projektu z dnia 24 maja 2006 r. ustawy o zmianie ustawy o prawie autorskim i prawach pokrewnych oraz o zmianie innych ustaw*, PIPWI UJ 2007, No. 97, p. 100.

obligation to provide information and the access to records before instituting an action is balanced by the guarantee of protection of interests of the subject under obligation (Article 80 para. 2 CRRA, Article 11a para. 2 DPA, Article 286¹ para. 3 IPL, Article 36b para. 2 PVLPA) and, also from this point of view, proceedings concerning obligation to provide information is similar to proceedings to secure claims, because the Code of Civil Procedure as regards regulating proceedings to secure claims also contains regulations serving the protection of the debtor (Article 730¹ para. 3 and Article 731 Code of Civil Procedure).

To support the rightness of the position of the Court of Appeal one should raise another argument that the legally substantive claims are settled in the litigation by the final judgment, whereas in non-litigious proceedings they are settled by the decision, which is appealed. Meanwhile, the regulation of Article 80 para. 5 CRRA, Article 11a para. 5 DPA, Article 286¹ para. 8 IPL and Article 36b para. 5 PVLPA indicates, that the petition for information is recognized by means of a decision challenged by a complaint. Therefore, it means that we deal with a processual demand of an auxiliary character in relation to legally substantive claims. This view confirms sustained position of the judicature as regards Article 105 para. 2 CRRA which grants Collective Management of Copyright (and related rights) organizations the demand to provide information and access to the documents, similar to the content of the claim for information, which is necessary to estimate the amount of remunerations and fees vindicated by the organization. It was unequivocally admitted in jurisdiction that this claim has a legally substantive character and, thus, it is settled under litigation by means of the final judgment.⁷

The Court of Appeal also rightly rejected the concept presented in the doctrine⁸ and judicature⁹ opting for direct or adequate application of regulations of proceedings to secure claims with respect to a claim for information. As the Court of Appeal paid attention to actual difficulties connected with possible carrying out the decision of providing information, obtained by the petitioner, especially when such a petition would be submitted before instituting an action and would be used to specify the future claim. In this

⁷ See: in particular the resolution of the Supreme Court of 17 September 2009, III CZP 57/09, OSNC 2010, No. 4, Item. 49, and also the decision of the Court of Appeal in Białystok of 21 October 2009, I ACz 807/08, OSAB 2009, No. 4, p. 28–30 and the decision of the Court of Appeal in Białystok of 15 June 2011, I ACz 619/11, OSAB 2011, No. 2–3, p. 48–51.

⁸ P. Fik, E. Laskowska, *Charakter prawny roszczenia informacyjnego*, MoP 2012, No. 24, p. 1296–1297; A. Jakubecki, *op. cit.*, p. 1664; A. Tischner, *op. cit.*, p. 292; idem, [in:] *Prawo własności przemysłowej. Komentarz*, eds. P. Kostański, Warszawa 2010, p. 1154.

⁹ See: the decision of the Court of Appeal in Lublin of 12 February 1997, I ACz 38/97, Apel.-Lub. from 1997, No. 3, Item 14.

context, the Court of Appeal noticed that by applying the norm of Article 733 of the Code of Civil Procedure directly, which requires the court securing against instituting legal proceedings to assign a date (not later than within two weeks) to institute an action or otherwise injunctive relief shall be cancelled, in the situation when the subject obliged to provide information would be in a delay to carry out a decision and even when considering immediate enforceability of the decision of securing, or if they would complain about the decision of the Court of First Instance, it could result in a complete annihilation of the attempted petitioner's rights when they, in case of the behaviour of the person under an obligation described above, would be unable to submit a petition within assigned by the court date. In such circumstances, the norm of Article 286¹ IPL permitting to submit a petition for information before instituting an action, would be, in fact, an empty norm. In that case, the application of regulations of Article 730–757 of the Code of Civil Procedure to the extent not regulated in the Article 286¹ IPL should be rejected, according to the Court of Appeal, because it would lead to the conclusions inconsistent with the merit and purpose of the discussed solution.

In the opinion of the Court of Appeal, the evidence of the special nature of the regulation of Article 286¹ IPL as regards proceedings to secure claims, regulated in the Code of Civil Procedure, can be found in the fact that the legislator, in spite of using the notion of “securing the claims”, decides, at the same time, on the regulation of matters such as competence of a law court, a time limit of cognizance of a petition, a requirement for a demonstration of a high probability of infringement, a possibility of evasion of an obligation to provide information, which is different than in proceedings to secure claims, and this, in the assessment of the Court, entitles to state that the discussed norm constitutes *lex specialis* in relation to the provisions of Article 730–757 of the Code of Civil Procedure.¹⁰ Hence, the Court of Appeal fell into contradiction. Since the regulation of Article 286¹ IPL constitutes *lex specialis* in relation to the provisions of Article 730–757 of the Code of Civil Procedure, thus the provisions of Article 730–757 of the Code of Civil Procedure should be applied to the extent not regulated in Article 286¹ IPL, which was previously rejected by the Court of Appeal.

According to the Court of Appeal, in favour of releasing a petition for information from securing the claims speaks the fact that prerequisites of obligation of the violator to provide information were defined precisely otherwise than code-based prerequisites of securing the claims. The Court noticed that the legislator, in accordance with IPL, does not use the notion of “substantia-

¹⁰ The same as in: A. Nowak-Gruca, *op. cit.*, p. 798.

tion of a claim”, as it takes place in accordance with the regulation of Article 730¹ of the Code of Civil Procedure, and such law requires from the petitioner to demonstrate “high probability of patent infringement, additional protection right, protection right or the right to register.” This wording of prerequisite of providing information is justified, according to the Court of Appeal, considering that when submitting a petition for providing information, there is no possibility to specify the claim precisely, with the exception of pointing its actual ground, referring sometimes to the circumstances of infringement of the law, which is particularly significant in case of the claim for compensation, the amount of which, as a rule, will remain unknown to the authorized person at this stage of proceedings, although its grounds (the sole fact of infringement of the law) are unquestionable.

The Court of Appeal agreed with the position presented in the doctrine¹¹ that the norm of Article 286¹ para. 1 (2) and (3) IPL, according to which providing information constitutes a form of securing the claims, is exceptionally awkwardly defined. Such a connection of both measures i.e. the right to provide information with securing the claims, provided for in Article 287 para. 1 and Article 296 para. 1 IPL, is illogical due to the fact that a petition for information may be submitted before instituting an action, earlier than the claims of the authorized person were defined. In addition, this wording which does not appear in Article 80 para. 1 (2) and (3) CRRA, Article 11a para. 1 (2) and (3) DPA and Article 36b para. 1 (2) and (3) PVLPA, anticipating similar claims, misleads as far as the legal nature of the petition for information is concerned.

The reasoning of the Court of Appeal should be extended by the observation that the purposes of the petition for information and the petition for securing the claims are fundamentally different, although associated with pursuing the legally substantive claims. The purpose of the right to obtain information is to enable the person authorized from the intellectual property, whose rights were infringed, to define the content and the extent of the claims arising from the exclusive rights infringement, whereas the purpose of the petition for securing is to ensure executability or effectiveness of the future judgment¹².

As a result of their analysis, the Court of Appeal took an approvable position on the regulation of Article 286¹ IPL to the extent in which it grants the subject, whose rights as regards industrial property or, even further, intellec-

¹¹ A. Tischner, *op. cit.*, p. 291; *idem*, [in:] *Prawo...*, p. 1153.

¹² Also the Court of Appeal in Warsaw in the judgment of 20 September 2012 took note of it. I ACa 251/12, Lex, No. 1246920.

tual property, were infringed, the right to obtain detailed information about the violator's actions, which constitutes a specific litigation demand, different from a code-based structure of securing the claims. To complete the position of the Court of Appeal, one ought to demonstrate that the petition for information should not be examined in compliance with provisions of securing the claims applied either directly or respectively, but in compliance with the regulations of litigation included in the Code of Civil Procedure, applied to the extent not regulated in Article 286¹ IPL in compliance with Article 13 para. 1 of the Code of Civil Procedure which introduces a presumption of cognisance of the case in the proceedings. Since the legislator in Article 286¹ IPL and also in other provisions anticipating a claim for information, did not show the type of proceedings, based on which the petition is examined, it takes place by means of litigation.