

ARTYKUŁY

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Opposition to a trade mark application in amended Polish law and EU law

Sprzeciw wobec zgłoszenia znaku towarowego w znowelizowanym prawie polskim i unijnym

Abstract

A purpose of the article is the analysis of legal solutions concerning opposition proceedings on a trade mark application adopted by the legislator in the Industrial Property Law and their comparison to the Union procedure for opposition. The provisions of both substantive and procedural law on opposition proceedings in trade mark law in relation to several recent amendments of the Industrial Property Law have been assessed herein. The following aspects of legal solutions contained in the Polish Law and the Union procedure for opposition have been compared herein: entities who have standing to file a notice of opposition, grounds and time limits to file a notice of opposition, examination of admissibility of the opposition, a course of opposition proceedings, and the procedure for the examination of the opposition that has been deemed unfounded by the applicant. Furthermore, the article has voiced some criticism against certain solutions adopted by the Polish legislator which refer, among others, to incomplete regulation of opposition proceedings in trade mark law, a narrowed group of entities empowered to file a notice of opposition, a need to make the content of an opposition more precise, and unjustified abolition of the examination of an opposition in the course of adversarial proceedings. The considerations made herein resulted in the formulation of conclusions *de lege ferenda*.

Keywords: opposition to a trade mark application, the Union procedure for opposition, the opposing party, the applicant, binding Polish Patent Office by the limits of opposition

JEL: O30, O31, O34

Introduction

A trade mark plays a key role in trade as a factor affecting entrepreneurs' innovativeness, who need to distinguish

Streszczenie

Celem artykułu jest analiza przyjętych przez ustawodawcę rozwiązań prawnych dotyczących postępowania w sprawie sprzeciwu wobec zgłoszenia znaku towarowego w ustawie — Prawo własności przemysłowej i ich porównanie z unijną procedurą sprzeciwową. Poddano ocenie zarówno przepisy prawa materialnego, jak i procesowego dotyczące postępowania sprzeciwowego w prawie znaków towarowych na tle kilku ostatnich nowelizacji ustawy — Prawo własności przemysłowej. Porównano rozwiązania obowiązujące w polskiej ustawie z unijną procedurą sprzeciwu w zakresie takich zagadnień, jak: podmioty legitymowane czynnie do wniesienia sprzeciwu, podstawy sprzeciwu i terminu jego wniesienia, badanie dopuszczalności sprzeciwu, przebieg postępowania sprzeciwowego i tryb rozpoznania sprzeciwu uznanego przez zgłaszającego za bezzasadny. Sformułowano uwagi krytyczne w odniesieniu do niektórych rozwiązań przyjętych przez polskiego ustawodawcę dotyczących m.in.: niekompletnej regulacji postępowania w sprawie sprzeciwu w prawie znaków towarowych; zawężonego kręgu podmiotów legitymowanych do wniesienia sprzeciwu; potrzeby uszczegółowienia treści sprzeciwu; nieuzasadnionego zniesienia rozpoznania sprzeciwu w trybie postępowania spornego. Poczynione rozważania pozwoliły na sformułowanie wniosków *de lege ferenda*.

Słowa kluczowe: sprzeciw wobec zgłoszenia znaku towarowego, unijna procedura sprzeciwu, wnoszący sprzeciw, zgłaszający, związanie Urzędu Patentowego RP granicami sprzeciwu

themselves from other competitors with regard to goods and services they offer, which brings on continuous improvement and development of the products and their importance in trade. The essence of a trade mark as an intangible asset is,

above all, the connection between a sign and a product, which is retained in our memory and becomes a part of buyer awareness (comp. Promińska, 2005, p. 203; Skubisz, 1988, p. 235–236; Włodarczyk, 2001).

In the course of works on the harmonization of trade mark law on a national level, the European Commission obliged Member States to adopt the system of an opposition. Such a system is currently binding in most EU Member States and EUIPO¹. Opposition proceedings on a trade mark application were incorporated into the Polish law under Art. 1(34) of the Act of 11 September, 2015 amending Industrial Property Law (Journal of Laws of 2015, item 1615; hereinafter referred to as "p.w.p. amendment of 11 September, 2015"). These proceedings were regulated in Title III, Section I, Chapter 4² titled "Opposition proceedings", including provisions ranging from Art. 152¹⁷ to Art. 152²³ of the Act of 30 June, 2000 — Industrial Property Law (i.e. Journal of Laws of 2020, item 286 as amended; hereinafter referred to as p.w.p.). Regulations on opposition proceedings in trade mark law came into force on 15 April, 2016. This way, Polish entrepreneurs were granted a right to file a notice of opposition already at the stage of a trade mark application being submitted by a competitor and not just after the issue of a final decision by the Polish Patent Office² providing protection for a trade mark. Before 15 April, 2016, i.e. before the amended p.w.p. of 11 September, 2015 came into effect, entrepreneurs could file a notice of opposition only against a final decision of the Patent Office providing protection for a trade mark. Hence, after 15 April, 2016, an opposition in trade mark law is filed at another stage, i.e. after publication of a trade mark application by the Polish Patent Office in the "Patent Office Bulletin" (see more: Sięczyło-Chlabicz, 2020, p. 943–944).

A purpose of the article is the analysis of regulations on opposition proceedings on a trade mark application in the Industrial Property Law with reference to the amended Industrial Property Law, including changes introduced by the Act of 20 February, 2019 amending Industrial Property Law (Journal of Laws of 2019, item 501; hereinafter referred to as "p.w.p. amendment of 20 February, 2019") as well as the Act of 16 October, 2019 amending Industrial Property Law and the Law on Litigation Costs in Civil Cases (Journal of Laws of 2019, item 2309; hereinafter referred to as "p.w.p. amendment of 16 October, 2019"). Moreover, the article evaluates normative solutions adopted by the national legislator in the context of compliance with the provisions of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December, 2015 to approximate the laws of Member States relating to trade marks (Official Journal of the EU, L 336/1 as amended; hereinafter referred to as "Directive 2015/2436"). Additionally, the article compares the Union procedure for opposition to an application for the European Union trade mark regulated in Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June, 2017 on the European Union trade mark (Official Journal of the EU, L 154/1; hereinafter referred to as "Regulation 2017/1001"), and Commission Delegated Regulation (EU) 2018/625 of 5 March, 2018 supplementing

Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430 (Official Journal of the EU, L. 2018.104.1 of 24 April, 2018; hereinafter referred to as "Regulation 2018/625"). The considerations made herein resulted in the formulation of conclusions *de lege lata* and *de lege ferenda*.

Sources of regulations on opposition proceedings in the EU law

The p.w.p. amendment of 11 September, 2015 on the incorporation of opposition proceedings resulted from the need to implement Directive 2015/2436 whereas its transposition to the laws of the European Union Member States was to take place by 14 January, 2019 at the latest. A model of proceedings adopted in the Intellectual Property Law was developed in accordance with the example of the Union procedure for opposition. Taking into account guidelines set forth in the reasons to the draft of the p.w.p. amendment of 11 September, 2015³, the present examination procedure applied by the Polish Patent Office had to be changed into the system of an opposition because the provision of protection granted in a national course did not guarantee authorized entities that EUIPO would not register within the territory of the European Union an identical or similar Union trade mark which may mislead consumers. What is important, the opposition system is binding in most EU Member States, among others in Germany, Great Britain or Austria, whereas the examination system operates in 10 countries, among others in Greece, Portugal or Malta (Demby-Siwiek, 2015, p. 5). The introduction of this system should considerably intensify harmonization of national patent offices' operation, enhance the system of trade marks registration in the entire European Union, and reduce the costs of its operation. Pursuant to point 38 of the Preamble to Directive 2015/2436, to ensure effective trade mark protection, Member States should make available an efficient administrative opposition procedure, allowing at least the proprietor of earlier trade mark rights and any person authorised under the relevant law to exercise the rights arising from a protected designation of origin or a geographical indication to oppose the registration of a trade mark application.

The Union procedure for opposition, which had been in force before 1 October, 2017, was regulated in Title II "Procedure for opposition and proof of use", embracing the rules 15–22 of Commission Regulation (EC) 2868/95 of 13 December, 1995 implementing Council Regulation (EC) 40/94 on the Community trade mark (Official Journal of the EU, L 303/1 as amended). Regulations on the opposition and examination of the opposition were included in Section 4, Art. 40–42 of Council Regulation (EC) 207/2009 of 26 February, 2009 on the Community trade mark (Official Journal of the EU, L 78/1). Next, from 1 October, 2017 to 14 May, 2018 the procedure for opposition was regulated in

Title II "Procedure for opposition and proof of use", Art. 2–10 of Commission Delegated Regulation (EU) 2017/1430 of 18 May, 2017 supplementing Council Regulation (EC) 207/2009 on the European Union trade mark, and repealing Commission Regulations (EC) 2868/95 and (EC) 216/96 (Official Journal of the EU, L. 2017.205.1 of 8 August, 2017).

Currently binding Regulation, which came into force on 1 July, 2018, is Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark. Provisions regulating the Union procedure for opposition, i.e. filing a notice of opposition to registration of the Union trade mark, are included in Section 4 "Observations by third parties and opposition", Art. 46–48 of Regulation 2017/1001. This regulation encompasses substantive and procedural issues concerning, among others, standing to file a notice of opposition, grounds for an opposition, mandatory content of a notice of opposition and its form, examination of the opposition, and proof furnished by the parties to the proceedings, by the opposing party in particular. The procedure for opposition was supplemented in details in Commission Delegated Regulation (EU) 2018/625 of 5 March, 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430 (Official Journal of the EU, L 104/1; hereinafter referred to as "Regulation 2018/625"), which came into force on 14 May, 2018. Procedural law provisions are contained in Title II "Procedure for opposition and proof of use", Art. 2–10 of Regulation 2018/625.

Entities having standing to file a notice of opposition and substantive grounds for opposition

The parties to the opposition proceedings are the applicant and the opposing party (Art. 152¹⁷ of p.w.p.). The applicant is an entity applying to the Polish Patent Office for protection. On the other hand, the legislator initially granted standing to file a notice of opposition to the following entities exclusively: the holder of an earlier trademark and the holder of an earlier personal or property right. Then, under the p.w.p. amendment of 20 February, 2019, the standing was extended to embrace a person authorised to exercise the rights under the protected designation of origin or geographical indication. Pursuant to the currently binding Art. 152¹⁷(1) of p.w.p., there are three categories of entities having standing to file a notice of opposition: 1) the holder of an earlier trademark; 2) the holder of an earlier personal or property right; or 3) a person authorised to exercise the rights under the protected designation of origin or geographical indication. Standing to file a notice of opposition was extended in effect of the implementation of Art. 43(2)(1) of Directive 2015/2436, according to which at least two entities should be entitled to file a notice of opposition: the proprietor of an earlier trade mark and the

person authorised under the relevant law to exercise the rights arising from a protected designation of origin or geographical indication.

Analysing the issue of standing to file a notice of opposition, it should be noticed that the Polish legislator should have expressly specified entities entitled to file a notice of opposition to a trade mark application, in a manner provided for in Art. 46(1) of Regulation 2017/1001, instead of using the term "authorised". Hence, a group of entities having standing to file a notice of opposition should embrace licensees authorised by the proprietors of earlier trade marks. Furthermore, if an earlier trade mark has more than one proprietor (co-ownership) or if an earlier right may be exercised by more than one person, it would be relevant to follow Art. 2(1) of Regulation 2018/625 and assume that an opposition may be filed by any or all of the proprietors or authorised persons. Moreover, it should be considered *de lege ferenda* if this group should not embrace the so called previous users, who are mentioned in Art. 160 of p.w.p. It is further justified by the fact that one of relative grounds for refusal to register a trade mark application that is explicitly set out in Art. 5(4) of Directive 2015/2436 are the rights to a non-registered trade mark or to another sign used in the course of trade provided they were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and if non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark. The Union legislator envisaged analogical regulation in Art. 8(4) of Regulation 2017/1001.

Substantive grounds for opposition have been provided for in Art. 152¹⁷(1) of p.w.p. by reference to Art. 129¹(4) or Art. 132¹(1–3) of p.w.p. The Union legislator has also specified substantive grounds for opposition by using reference in Art. 43(1) of Directive 2015/2436 to Art. 5, and in Art. 46(1) of Regulation 2017/1001 to Art. 8.

A catalogue of prerequisites that constitute the grounds for opposition is closed. Undoubtedly, relative impediments to register a trade mark constitute the grounds for opposition, as it is set out by Art. 43(1) of Directive 2015/2436 and Art. 46(1) of Regulation 2017/1001 with regard to the opposition to registration of the Union trade mark.

Relative impediments to register a trade mark regulated in Art. 132¹(1–3) of p.w.p. have been appropriately specified therein as the grounds for opposition. Trade mark applications with an earlier priority date, which are mentioned in Art. 132¹(1)(2–4) of p.w.p., may also constitute the grounds for opposition if they are granted a right of protection. Moreover, the Polish legislator included the violation of third parties' personal or property rights in the grounds for opposition, which a Member State may provide for under Art. 5(4)(b) of Directive 2015/2436. This embraces, in particular, the following rights of third parties: a right to a name, a right of personal portrayal, a copyright, and an industrial property right.

On the other hand, it is not appropriate to specify a reason resulting from Art. 129¹(4) of p.w.p., which is embraced by

the catalogue of absolute impediments to a trade mark registration, as a ground for opposition. Pursuant to this provision, rights of protection shall not be granted for a trade mark which has been excluded from registration pursuant to national law, the European Union law or international agreements providing for protection of geographical indications, designations of origin, traditional descriptions of wines or traditional specialities guaranteed to the extent specified therein. Under p.w.p. amendment of 20 February, 2019, this provision was added to Art. 152¹⁷(1) as a ground for opposition. An indication of this provision as a ground for opposition is an obvious mistake made by the legislator because it belongs to the catalogue of absolute impediments to a trade mark registration, which may not constitute substantive grounds for opposition. An indication of Art. 129¹(4) of p.w.p. as a ground for opposition is contrary to Art. 43(1) of Directive 2015/2436, which explicitly stipulates that opposition to the registration of a trade mark application may only be administered on relative grounds provided for in Article 5 of the cited Directive.

Regulation on determination of a time limit to file a notice of opposition should be approved of. Entities having legal standing to file a notice of opposition may do so within 3 months — pursuant to Art. 152¹⁷(1)(1) of p.w.p. This time limit starts to run from the date of publication of a trade mark application by the Polish Patent Office. A period of three months has also been provided in Art. 46(1) of Regulation 2017/1001, wherein it is counted from the date of publication of an EU trade mark application.

Considering a nature of the time limit to file a notice of opposition, it should be stated that it is a statutory time limit set out for the opposing party. For this reason, it may neither be shortened nor extended by the Polish Patent Office (comp. Hauser, Wierzbowski, 2020). Additionally, it results from Art. 152¹⁷(1)(2) of p.w.p. that this time limit may not be reinstated, i.e. when the opposing party fails to comply with it, it may not be reinstated. As a statutory time limit, it is preclusive (limited). Therefore failure to comply with a time limit results in ineffectiveness of a procedural act (Jaškowska, Wróbel, 2011, p. 405; Adamiak, Borkowski, 2011, p. 277). Moreover, significantly enough, a nature of the time limit to file a notice of opposition is substantive. Hence, failure to comply with a time limit to file a notice of opposition to a trade mark application will effect in the expiry of this right.

A course of opposition proceedings

Opposition proceedings are initiated upon a request submitted by an interested party, i.e. when a notice of opposition is filed, never *ex officio*. The parties to the proceedings are the applicant and the opposing party (Art. 152¹⁸(1) of p.w.p.). Even if other persons have a legal interest in granting a right of protection, e.g. an author of a trade mark, they do not enjoy such a status and they may not be a party to the proceedings (see: Szewc, 2017, p. 337). Apparently, the applicant is an entity who has filed an

application for granting a right of protection for a trade mark.

The opposing party is obliged to pay a fee for an opposition (Art. 152¹⁷(2) of p.w.p.). This fee was determined in Annex No. 3 to the Council of Ministers' Regulation of 8 September, 2016 amending Regulation on protection fees for inventions, utility models, industrial designs, trade marks, geographical indications and topography of integrated circuits (Journal of Laws, item 1623), and it amounts to PLN 600. It should be assumed that the fee should be paid when an opposition is filed or, at any rate, before the end of a time limit to file an opposition specified in Art. 152¹⁷(1) of p.w.p.). Significantly enough, the legal effects of failure to pay a fee for an opposition have not been provided. Namely, should it be treated as a formal deficiency which can be remedied within a time limit designated by the Polish Patent Office, i.e. pursuant to Art. 152¹⁷(7) of p.w.p., or should it be treated as a deficiency mentioned in Art. 152¹⁷(6) of p.w.p. which results in non-examination of the opposition?

The analogical obligation to pay a fee for an opposition results from Art. 46(3) of Regulation 2017/1001. However, in the EU law, this obligation decides about efficiency of an opposition being entered. Namely, pursuant to Art. 5(1) of Regulation 2018/625, where the opposition fee has not been paid within the opposition period, the opposition shall be deemed not to have been entered. It seems that it would be justified *de lege ferenda* for the Polish legislator to treat failure to pay the fee as a significant deficiency resulting in non-examination of the opposition.

Art. 152¹⁷(3) of p.w.p. specifies the obligatory content of an opposition. In accordance with this provision, the opposition must: 1) specify the parties, 2) indicate the factual and legal grounds, 3) justify these grounds and indicate the extent of the opposition, and 4) include a signature of the opposing party. However, such content of an opposition is not coherent with Art. 152¹⁷(6) of p.w.p., according to which the Polish Patent Office shall not examine an opposition which: 1) has been filed after the expiry of the time limit, or 2) does not specify the trademark application in regard to which it has been filed, or 3) does not specify an earlier right referred to in Art. 132¹(1–3) of p.w.p. Hence, beyond a doubt, the elements of the obligatory content of an opposition should *de lege ferenda* be supplemented by the indication of a trade mark application in regard to which the opposition has been filed as well as the indication of earlier rights which are stipulated in Art. 132¹(1–3) of p.w.p. and which are the grounds for the opposition.

Furthermore, comparing obligatory content of an opposition specified in Art. 2(2) of Regulation 2018/625, it should be postulated *de lege ferenda* to provide in details significant elements of the content of an opposition embracing, at least, an indication of the earlier trade mark or right the opposition is based on, an indication of the goods or services on which each of the grounds of the opposition is based, and an indication of the goods or services against which the opposition is directed.

The Polish legislator included the examination of admissibility of the opposition in Art. 152¹⁷(6–7) of p.w.p.,

providing for two types of deficiencies related to the opposition: significant deficiencies, which must be remedied so the Polish Patent Office may substantively examine the opposition, and formal deficiencies, which should be remedied by the opposing party within the time limit designated by the Patent Office. Where there are no significant deficiencies, the Polish Patent Office does not call the opposing party to remedy them and does not furnish a relevant time limit for this purpose. The Patent Office shall only commence substantive examination of the opposition if the opposing party remedies deficiencies within 3 months following the publication of a notice of a trade mark application. If these deficiencies are not remedied within the statutory period of 3 months, the Office shall not examine the opposition (Art. 152¹⁷(6) of p.w.p.).

If the opposition is correct or its deficiencies have been remedied by the opposing party within a due time set by the Polish Patent Office, the Office shall immediately notify the applicant that an opposition has been filed and inform the parties to the proceedings about the possibility of an amicable settlement of the dispute (Art. 152¹⁹(1) of p.w.p.). The adoption of a possibility of an amicable settlement of the dispute is a normative solution consistent with Art. 43(3) of Directive 2015/2436, which also provides the parties to the proceedings with a friendly settlement of the dispute at their joint request. This manner of dispute settlement has also been provided for in Art. 47(4) of Regulation 2017/1001.

A change introduced by the legislator under the p.w.p. amendment of 11 September, 2015 which abandoned the settlement of an opposition in trade mark law in the course of adversarial proceedings should be disapproved of. It was effected in result of the changed content of Art. 225(1) that involved deleting the institution of an opposition in trade mark law from the catalogue of cases settled by the Polish Patent Office in the course of adversarial proceedings (point 9 thereof). This essential change itself was not justified at all in the draft of the p.w.p. amendment of 11 September, 2015. Until the cited amendment came into force, i.e. before 15 April, 2016, an opposition to a final decision on granting industrial property rights, including a right of protection for a trade mark, was referred to a settlement in adversarial proceedings after it had been deemed unfounded by the authorised (entitled) entity. In accordance with the currently binding regulation, if the applicant finds the opposition unfounded, the case is not referred for settlement in adversarial proceedings. In consequence, opposition proceedings are conducted as part of application proceedings. This is confirmed by references contained in Art. 152²²(1) and Art. 152²³(1) of p.w.p., which refer to the provisions used in application proceedings accordingly.

Renouncing the institution of referring a case to adversarial proceedings after the applicant found the opposition unfounded, the legislator has not followed a model of the Union procedure for opposition in any way. Pursuant to Art. 6(1) of Regulation 2018/625, the EU law provided for the adversarial part of the opposition proceedings. It seems that it would be justified *de lege ferenda* if the opposition that has been deemed unfounded is

examined in the course of adversarial proceedings, this way assuring effective and expeditious opposition proceedings above all.

The Polish Patent Office shall examine opposition within the limits thereof and shall be bound by the legal grounds indicated by the opposing party (Art. 152²⁰ of p.w.p.). After the opposition has been examined, the Patent Office shall issue a decision dismissing the opposition or a decision deeming the opposition to be well-founded, either in whole or in part (Art. 152²¹ of p.w.p.). The Polish Patent Office refuses to grant a right of protection for a trade mark to the extent the opposition has been found justified, whereas the Office grants a right of protection for a trade mark as to the remainder (see more: Szewc, Mazurek, 2017, p. 610).

Appeals against a decision of the Patent Office made in opposition proceedings. A complaint filed with the administrative court

The parties to the proceedings, i.e. the applicant and the opposing party, may contest a decision issued by the Polish Patent Office after the examination of the opposition and file a motion for the case to be re-examined (Art. 152²²(1) of p.w.p.). A motion for re-examination of a case is a counterpart of the regulation contained in Art. 127(3) of the Act of 14 June, 1960 — the Code of Administrative Procedure (i.e. Journal of Laws of 2020, item 256 as amended; hereinafter referred to as k.p.a.), which departs from the principle wherein the right of appeal is a basic remedy in administrative proceedings. Pursuant to Art. 152²²(1) of p.w.p. in its original wording, a motion for re-examination of a case was settled by Adjudicative Boards. The content of this provision was changed under Art. 1(24) of the p.w.p. amendment of 20 February, 2019, and since 16 March, 2019 cases in adversarial proceedings have been examined by experts.

It should be emphasized that the provisions of the Code of Administrative Procedure (Art. 252 in connection with Art. 152²³(1) of p.w.p.) are applied to adversarial proceedings accordingly to the extent not regulated by the Industrial Property Law. For this reason, a party to the proceedings may waive the right to file a motion for re-examination of a decision of the Polish Patent Office which was issued after the examination of the opposition and after the Act of 7 April, 2017 amending the Code of Administrative Procedure and some other Acts (Journal of Laws of 2017, item 935) came into force, that is after 1 June, 2017, and file a complaint with the Provincial Administrative Court in Warsaw (Szewc, Mazurek, 2017, p. 609). Moreover, pursuant to Art. 52(3) of the Act of 30 August, 2002 on Proceedings before Administrative Courts (i.e. the Journal of Laws of 2019, item 2325; hereinafter referred to as p.p.s.a.), if a remedy, i.e. a motion for re-examination of a case, may activate the so called horizontal course of jurisdiction exclusively, a party may decide at its discretion whether to

take advantage of this remedy or initiate a judicial review of the decision issued in the first instance (see also the ruling of Provincial Administrative Court in Rzeszów of 9 May, 2018, II SA/Rz 213/18, LEX no. 2504620). Pursuant to Art. 52(3) of p.p.s.a., if a party has the right to apply for reconsideration to the body who issued a decision, the party may appeal against the decision without exercising the aforementioned right. The provision of Art. 52(3) of p.p.s.a. in the procedural system regulated by the content of Art. 127(3) of k.p.a. allows a party, not a body, to renounce the principle of two-instance administrative proceedings proclaimed in Art. 15 of k.p.a. (Sieńczyło-Chlabicz, 2020, p. 956).

Incorporating the regulation concerning opposition proceedings to a trade mark application into the Industrial Property Law, the legislator did not initially provide for the right of the parties to challenge the Polish Patent Office's decision with an administrative court. Therefore, we could notice the existence of a legal loophole caused by a lack of autonomous regulation or provision referring to the appropriate application of Art. 248 of p.w.p. Despite the existence of a legal loophole to this extent, a decision issued by the Polish Patent Office in result of the examination of a motion for reconsideration of a case could obviously be appealed to an administrative court under general rules. It results from administrative courts' cognition which, under Art. 3(2)(1) of p.p.s.a., review public administration activities embracing, among others, adjudicating on complaints against administrative decisions, including the Polish Patent Office's decisions issued in adversarial proceedings.

The right of the parties to adversarial proceedings to file a complaint with an administrative court was provided for in the p.w.p. amendment of 20 February, 2019 by reference in Art. 152²²(1) of p.w.p. to apply Art. 248 of p.w.p. accordingly. The application of Art. 248 of p.w.p. has evoked a dispute in Supreme Administrative Court's jurisprudence wherein it has been considered what entities have standing to file a complaint with Provincial Administrative Court in Warsaw. Namely, whether this right serves solely the parties to the proceedings before the Polish Patent Office or also third parties who have not taken part in these proceedings. Adjudicating on the scope of standing to file a complaint with an administrative court in the proceedings on the extension of a right of protection for a trade mark, Supreme Administrative Court ruled that under Art. 235(2) of p.w.p., the party entitled to file a complaint with an administrative court is the applicant, in accordance with Art. 248 of p.w.p. respectively. Hence, the term of a party to the proceedings should be understood here in respect of Art. 235(2) of p.w.p. (see: Supreme Administrative Court's rulings of: 8 July, 2015, II GSK 874/15, Legalis no. 1332830; 21 November, 2006, II GSK 227/06, OSP 2008, No. 2, item 20; and Supreme Administrative Court's decision of 15 May, 2008, II GSK 389/07, Legalis no. 128230). It results from the above that an entity entitled to file a complaint with an administrative court against the Polish Patent Office's decision is solely the applicant and not other entities having a legal interest thereto. Therefore, the norm contained in Art. 248 of p.w.p. is *lex specialis* in relation to Art. 50(1) of p.p.s.a. Considering

this opinion expressed in Supreme Administrative Court's jurisprudence, it may be claimed that the right to file a complaint against settlements issued in opposition proceedings will benefit the parties to these proceedings, i.e. the applicant and the opposing party (see: Sieńczyło-Chlabicz, 2020, p. 956–957; *idem*, 2017b, p. 239).

Conclusions

The analysis of regulations contained in the Industrial Property Law concerning opposition proceedings to a trade mark application has led to a conclusion according to which, some normative solutions adopted by the Polish legislator certainly do not fulfil the postulate of harmonization of the Polish and Union procedure for opposition. What is more, they do not lead to the fulfilment of objectives expressed in the reasons to the draft of the p.w.p. amendment of 11 September, 2015 related to considerable acceleration and simplification of the procedure for granting rights of protection for trade marks.

A substantial drawback of the adopted regulation on opposition proceedings in trade mark law is its incompleteness, which has been a result of references to the provisions of other Acts which, undeniably, does not contribute to clarity and transparency of legal solutions shaping these proceedings (see more: Nowacki, 1964, p. 367). Opposition proceedings to a trade mark application are not entirely regulated because they contain numerous references in Art. 152²² and Art. 152²³ of p.w.p. both to the respective application of provisions relevant to application proceedings, adversarial proceedings, provisions of the Code of Administrative Procedure, and the Code of Civil Procedure. The provisions of Art. 152²² and Art. 152²³ of p.w.p. refer to the respective application of other provisions to the extent of: 1) setting official time limits by the Polish Patent Office (Art. 242(1–2) of IPL); 2) proceedings initiated by a motion for re-examination of a case and settlements made in these proceedings (Art. 244 — Art. 245 of p.w.p.); 3) appealing against the Polish Patent Office's settlements to an administrative court; 4) appointing an expert to examine the opposition by the President of Polish Patent Office; 5) respective application of the provisions of the Code of Administrative Procedure in cases that have not been regulated in adversarial proceedings (Art. 252 of p.w.p.); and 6) excluding the application of the k.p.a. provisions on time limits to settle a case (Art. 253(1) of p.w.p.). The reference to the respective application of Art. 249 of p.w.p. is incomprehensible because examination of an opposition by an expert appointed by the President of Polish Patent Office is regulated in Art. 152¹⁸(2) of p.w.p.

In Art. 152¹⁷(1) of p.w.p., the legislator should have precisely specified entities who have standing to file a notice of opposition. It would have been reasonable to regulate this issue following the example of Art. 46(1) of Regulation 2017/1001 and Art. 2(1) of Regulation 2018/625, and in effect thereof, provide licensees authorised by the proprietors of

earlier trade marks with this standing too. On the other hand, where an earlier trade mark has more than one proprietor (co-ownership) or if an earlier right may be exercised by more than one person, each such entity has standing to file a notice of opposition. Accurate specification of entities who may be a party to opposition proceedings is of vital importance because if an opposition has been filed by an entity who is not the party thereto, the Patent Office should issue a decision refusing the initiation of proceedings — under Art. 61a(1) of k.p.a., which is applied under Art. 252 in connection with Art. 152²³ of p.w.p.

The Polish legislator has made a mistake by indicating Art. 129¹(4) of p.w.p. as the ground for opposition because this provision concerns absolute impediments to a trade mark registration whereas only relative impediments of registration may be the grounds thereof. To this extent, norms adopted in 152¹⁷(1) of p.w.p. are inconsistent with Art. 43(1) of Directive 2015/2436, which solely specifies relative grounds for the refusal of the registration, which are mentioned in Article 5 of the cited Directive as the grounds for opposition. A postulate *de lege ferenda* addressed to the Polish legislator is to provide more accurate specification of the opposition's content and explicitly indicate legal effects resulting from deficiencies in the opposition's content. Regulations included in Art. 152¹⁷(6–7) of p.w.p. cannot be accepted as sufficient to this extent. For instance, unlike the Union lawmaker, the Polish legislator has not defined legal

effects of failure to pay an opposition fee. It seems that it would be justified *de lege ferenda* for the Polish legislator to treat failure to pay the fee as a significant deficiency resulting in non-examination of the opposition.

I negatively assess deleting the opposition deemed unfounded in trade mark law from the catalogue of cases examined in the course of adversarial proceedings, which was effected under the p.w.p. amendment of 11 September, 2015. In consequence, opposition proceedings are conducted as part of application proceedings. Renouncement of the course of adversarial proceedings will certainly not contribute to more effective procedures connected with granting a right of protection for a trade mark, as it was assumed by the legislator in the reasons to the draft of the p.w.p. amendment of 11 September, 2015. Furthermore, this does not reflect the Union procedure for opposition which, pursuant to Art. 6(1) of Regulation 2018/625, provided for the adversarial part of the opposition proceedings. It appears that the introduction of adversarial proceedings after the opposition has been deemed unfounded would contribute to considerable acceleration of the procedure for opposition. At the same time, it would be a solution harmonized with the EU law. Additionally, it would be further justified by the fact that the legislator has retained many solutions typical for an adversarial course such as, e.g., binding the Polish Patent Office by the limits of opposition and legal grounds specified by the opposing party.

Przypisy/Notes

¹ The EU Intellectual Property Office, seated in Alicante (Spain). Since 1993, this Office has had jurisdiction in the European Union trade marks cases, and since 2003 — in Community designs cases as well.

² Hereinafter referred to as UPRP or "Office".

³ Reasons to the draft of the Act amending Industrial Property Law, the Sejm of the 7th term, paper no. 3685.

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Akty prawne/Legal acts

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Act of 11 September, 2015 amending the Act — Industrial Property Law (Journal of Laws of 2015, item 1615).

Act of 20 February, 2019 amending the Act — Industrial Property Law (Journal of Laws of 2019, item 501).

Act of 16 October, 2019 amending the Act — Industrial Property Law and the Act on Litigation Costs in Civil Cases (Journal of Laws of 2019, item 2309).

Act of 14 June, 1960 — the Code of Administrative Procedure (i.e. Journal of Laws of 2020, item 256 as amended).

Act of 7 April, 2017 amending the Act — the Code of Administrative Procedure and some other Acts (Journal of Laws of 2017, item 935).

Act of 30 August, 2002 on Proceedings before Administrative Courts (i.e. the Journal of Laws of 2019, item 2325).

Commission Delegated Regulation (EU) 2018/625 of 5 March, 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430 (Official Journal of the EU, L.2018.104.1 of 24 April, 2018).

Council of Ministers' Regulation of 8 September, 2016 amending Regulation on protection fees for inventions, utility models, industrial designs, trade marks, geographical indications and topography of integrated circuits (Journal of Laws, item 1623).

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December, 2015 to approximate the laws of Member States relating to trade marks (Official Journal of the EU, L 336/1 as amended).

Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June, 2017 on the European Union trade mark (uniform text) (Official Journal of the EU, L 154/1).

Orzecznictwo/Judgments

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Ruling of the Provincial Administrative Court in Warsaw of 14 December, 2010, V SA/Wa 1750/10, LEX no. 759311.

Supreme Administrative Court's ruling of 8 July, 2015, II GSK 874/15, Legalis no. 1332830.

Supreme Administrative Court's ruling of 21 November, 2006, II GSK 227/06, OSP 2008, No. 2, item 20.

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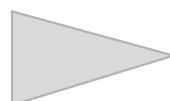
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