I. Introduction

Since October 17th, 1997 in Poland the new Constitution entered into force replacing the Constitution of 1952. The new Constitution brought of course a lot of changes into the Polish legal system. For enforcement of industrial property laws the provision of the Article 91 seems to be of greatens importance. This Article provides for in Subsection 1 that international convention after its publication in the Official Gazette of Polish Republic constitute part of Polish domestic legal system and shall be directly executed, unless its execution depends on passing a bill. So this provision is transferring international conventions ratified by Poland into Polish domestic legal system. It creates constitutional basis for executing ratified and published international conventions by courts and other Polish institutions like for instance Patent Office without a need for legislative intervention.

So after entry into force the Constitution of 1997 in the field of protection of industrial property the term "Polish law" means "international conventions ratified by Poland plus domestic legislation".

As far as TRIPS provision are concerned this rule was applied by Polish Patent Office and courts. The most illustrative case in this respect are three cases in which the owners of patents in Poland, which has expired after maximum 15 years of protection (so called old patents filed before 1993), were asking Polish Patent Office to prolong protection emerging form these patents to 20 years since the date of filing. The legal base for prolongation of these patents is the Article 33 of TRIPS, which is providing for that the term of patent protection available shall not end before the expiration of a period of twenty years counted from the filing date. Two of the above reported cases were launched by pharmaceutical companies. These companies asked the Patent Office for restoration of protection of expired after 15 years patents. Both cases were dismissing by the Polish Patent Office. However in one of the cases the patent owner has appealed from the decision of Patent Office to the Administrative Court and this court overturned the decision of the Patent Office and ruled that patent protection, which has expired after entry of TRIPS in relation to Poland, should be restored till the expiring of 20 years period. In the justification to this decision the administrative court has said that provisions of TRIPS must be applied before the Polish domestic law, which provided shorter term of protection. The Patent Office has the right to appeal from the decision of Administrative Court to the Highest

1 Dz. U. No 78, item 483.
Administrative Court, so the case still is pending, however it is highly possible that the HAC will approve the AC decision, and will not share the view of Polish Patent Office.

One must observe that there is a problem with implementation of Article 91 of Polish Constitution to EU directives, namely how the above principles are implemented to the directives, as directives should implemented in domestic regulation of Member States within two years since their adoption. Till now there is no court decision addressing this problem. It seems that till the expiry of the two years period of adoption the provisions of a directive will not be directly applied, as Poland still has the time to adopt the directive. But after expiry of the two year term in the lack of relevant Polish legislation transferring the directive into Polish legal system or in case when Polish domestic legislation is contrary to the provisions of the directive, the directive will be directly implemented in Poland, as it is binding international law.

So TRIPS provisions including Article 43 now are applicable directly in Poland. It seems that the Article 6 of IP Directive may not be directly implemented in Poland by courts till April 29, 2006, as till that date Poland is not obliged to implement Article 6 in its legislation.

II. Article 43 TRIPS Agreement and Article 6 of the IP Directive

Article 43 “Evidence” (TRIPS)

1. The judicial authorities shall have the authority, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party, to order that this evidence be produced by the opposing party, subject in appropriate cases to conditions which ensure the protection of confidential information.

2. In cases in which a party to a proceeding voluntarily and without good reason refuses access to, or otherwise does not provide necessary information within a reasonable period, or significantly impedes a procedure relating to an enforcement action, a Member may accord judicial authorities the authority to make preliminary and final determinations, affirmative or negative, on the basis of the information presented to them, including the complaint or the allegation presented by the party adversely affected by the denial of access to information, subject to providing the parties an opportunity to be heard on the allegations or evidence.

Article 6 “Evidence” (IP Directive)

1. Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support
its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information. For the purposes of this paragraph, Member States may provide that a reasonable sample of a substantial number of copies of a work or any other protected object be considered by the competent judicial authorities to constitute reasonable evidence.

2. Under the same conditions, in the case of an infringement committed on a commercial scale Member States shall take such measures as are necessary to enable the competent judicial authorities to order, where appropriate, on application by a party, the communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information.

Questions to be answered regarding content, requirements and extent:

a) Does your country already provide for a mechanism in compliance with Article 43 (1) of the TRIPS Agreement and/or Article 6 (1) of the IP Directive?

Civil litigation in Poland is governed by provisions of Polish Code of Civil Procedure (CCP) (Kodeks postępowanie cywilnego) of 1964, which was amended many times since its passing. The Code of Civil Procedure is a very complex regulation of civil litigation and has 1153 Articles.

According to Article 248 § 1 of CCP if the court requests everybody is obliged to present in specified time and place a document, which it possesses and which constitutes an evidence of important fact in the case, unless the document contains state secret. According to Article 248 § 2 refrain from fulfilling the above obligation may only the person, who in relation to facts covered by the document could refuse to testify as the witness or who posses the document in name of a third person, who for the same reason could object presentation the document. However even in such situation such person may not refuse to present the document if the document was made in the interest of the party, who has asked for delivery of the document. Under Article 248 a party may not refuse to present of the document too, if the damage, which the party could suffer consists of loosing the case.

In a case of not justified refusal of presenting a document, the court may impose on the party after hearing the party explanation relating to reasons of refusal, a fine (Article 251). The unjustified refusal of presenting a document may be taken by a judge into account during evaluation of evidence and may be used against the party, however there is no presumption or obligation imposed on judge to do so.

An interested party may ask for information or a document before or after the launching the case into the court.
If the party is asking for information or a document before the launching the petition than the provisions relating to temporary measures are applied, namely Article 730 CCP and following. One should observe that in court enforcement proceeding there is a limitation of a possibility of presenting new evidence after launching the petition. According to the Article 479 CCP in a petition the claimant must present all statements and evidence supporting them. The new evidence during the case may be presented only if the party proves that it was not possible to present these evidences in the petition, or that the need to present given evidence emerged later, during the case.

a) How does your system work and what are its specific requirements?

- Are these mechanisms arranged differently as to the different types of IP (i.e. patents, utility models, design models, trademarks, copyright)?

There mechanisms are common for all types of IP with exemption to copyright, as industry property law of 2000 governing the protection of patents, utility models, design models, trademarks does not regulate court enforcement proceedings. Exemption is provided for in Article 80 of copyright law and related rights of 1994 which provides detailed regulation of the right for asking the information or securing the evidence in a copyright enforcement case. Especially the interested party having the legal interest may ask for preserving the evidence or delivery by the defendant specified by the court information of documentation related to copyright infringement, and such motion should be decided by the court within three days.

- According to Article 43 (1) of the TRIPS Agreement and Article 6 (1) of the IP Directive, the claimant must present reasonable evidence sufficient to support the claim: Is there a comparable requirement in the laws of your national system? If yes, it will be interesting to know the extent to which the infringement must already be proven beforehand by the claimant.

If the motion emerging from the Article 43 (1) of the TRIPS is launched before petition is launched than provisions relating to temporary measures regulated in the Articles 730 and following are applied. In such a case the claimant does not have to prove that infringement took place, but only that the luck of temporary measure relating to secure the evidence will make it difficult or even impossible execution of the decision in a case or in other way will make it difficult to achieve the goal of proceedings in an infringement case.

In a case of copyright infringement cases the Article 80 of copyright law and related rights does not require to prove by the claimant that securing the evidence later will not be possible or difficult. The same relates to delivery of information or document in possession of opposite party. However the court may ask the claimant to make a deposit for securing future would be damage claims of the defendant.

- How (clearly) and to what extent must the claimant “specify” the means of evidence to be produced that is within the control of the opposing party?
The answer to this question is governed by the general provisions of CCP relating to presenting the evidences. According to the Article 312 CCP in the motion for preserving the evidence the claimant must specify facts and evidences supporting the facts and reasons justifying the preserving the evidences.

- **Are there other requirements which must be fulfilled?**

  The motion must fulfil the common requirements for court letter.

**b) Regarding the extent and enforcement of the order:**

- **Is it possible to get such an order only in view of proving the infringement or can the order also be focused on evidence which may be relevant for the determination of the extent of damages?**

  In Poland in case of IP enforcement the claimant may separately launch at the beginning the injunction case and after successful completion of injunction case start the damage redress case. The claimant may also in one proceeding ask for injunction and redress of damages. Usually the claimant is starting with injunction case, as the court fees are much lower than in a case of redress of damage. Having the injunction decision, in which the question if the infringement exist is finally decided, the claimant is starting redress of damage case, in which roughly speaking court fee is equal to 5% of the claimed sum, but no more than 25,000 EUR.

  So depending on a case in Polish law an order for preserving an evidence or information may be get in both cases, namely only in view of proving the infringement or also order may be focused on evidence relevant for the determination of the extent the damages.

- **Can such order also be used to identify the possible existence of evidence, i.e. are there any means in your system that enable the claimant to search for evidence?**

  Within the general rules of collecting and preserving the evidence described above there is a possibility that the claimant will ask for conducting a search for evidence of infringement.

- **How can the order be enforced? Is it possible by means of such an order to effectively enter the private sphere of the opposing party (for instance premises)? What are the consequences if the order is not complied with by the opposing party. For example: Shift of burden of proof, or a solution comparable to the solution of Article 43 (1) of the TRIPS Agreement?**

  According to Article 233 § 1 the court is evaluating the credibility and value of evidences according to its own conviction, which should be based on all-round consideration of collected evidences. On the
same basis the court should evaluate, what meaning should be given to the refusal of a party to present an evidence or hindering of carry out the evidence contrary to court order (Article 233 § 2). So according to this provision the court may consider that given fact was proved, due to luck of cooperation in carry out of court order by a given party. In fact the result of this regulation is to some extend stronger for the claimant than shift of burden of proof.

This regulation corresponds with regulation contained in Article 230, which provides for that if the party did not comment the statements of the other party regarding the facts, the court taking into consideration the results of whole proceedings, may consider the facts as admitted by the other party. Also the court may consider as settled the facts having important meaning to the decision it such a conclusion is emerging from the other settled facts. It is so called presumption regarding facts provided for in Article 231 CCP.

Can such order be obtained in your country based on an IP right registered in another country but not registered or even applied for in your country?

That is a very complicated question and the answer to it is not easy. First of all one must observe that claims emerging from certain IP rights, like inventorship or repression of unfair competition law of 1993, sometimes are not connected with existence of registered IP rights. For instance selling pirated copy of a product is unfair competition act, if it misleads a consumer as to the origin of good despite the fact if the product is protected or not by a patent or design.

If the aim of such order is to secure evidence for infringement committed in another country (for instance patent infringing products were produced in a country where a patent is in force and than were exported to Poland and in Poland the invention covering the product is not protected by a valid patent) than usually the court of the country in which infringement case is taking place is asking for such order. Polish court in such a case is executing this order within framework of so called legal assistance.

c) Does your system provide for legal presumptions comparable to the stipulation of the second sentence of Article 6 of the IP Directive. This provision apparently refers to a problem arising in cases where a large amount of infringing items such as optical discs are to be seized. Requiring detailed proof of copyright for each infringing item would lead to loss of time, effort and money by the right holder.

There is no specific such regulation in the Polish law, so general rules of evaluation of evidence will apply, which give the court the power to evaluate the value of evidences presented by parties. For sure finding even one copy of infringing product is enough to find that infringement has occurred. However for determining the scope of infringement it would be not enough to say that because the defendant has produced some copies of infringing
item, so the defendant has produced all infringing items and that is why he should pay damages for all infringing items, which were discovered on the marked by the claimant. Under general rules of civil liability in Polish law there must be a proved link between the defendant and the infringing product and this is emerging from the Article of 415 of Polish Civil Code.

The Polish Group would like to point out that the regulation contained in the second sentence of Article 6 of the IP Directive is not precise. This sentence is authorising the Member States for providing in a domestic legislation a kind of presumption of reasonable evidence of infringement, but is unclear what is the aim of introducing such kind of presumption.

d) Questions regarding procedural aspects:
What is the competent court? Who makes the decision, an administrative or a judicial body?

The competent court is a court competent to a place, when the evidence or information is placed or the court competent to hear the case under general rules.

IP infringement cases are heard in first instance by one of the 27 commercial district courts in Poland. Local jurisdiction is determined by the domicile or business establishment of the defendant, Secs. 27, 30 CCP. In addition, jurisdiction can be based on one of the following factors:
- A claim for monetary compensation can be launched before a court in which district the defendant has a business enterprise to the extent that the claim is linked to the enterprise’s activity, Sec. 33 CCP;
- Claims related to the existence, execution or nullification of an agreement at the court of the place where performance is due, Sec. 34 CCP;
- In cases arising from a tort, the court of the place where such unlawful act took effect, Sec. 35 CCP;
- In case several rules of jurisdiction apply, the plaintiff has the right to choose the forum, Sec. 43 CCP.

Since in IP matters often one of the special rules of jurisdiction mentioned above will apply, the plaintiff has a choice of forum.

The decision is made by a one person judge panel in ex-parte court hearing, or by the court dealing with the case.

- How costly and time-consuming are these proceedings?

The proceeding related to secure the evidence are not costly. Evaluation of the time needed to receive the court order is difficult to assess. The Polish courts have big delays in dealing with increasing number of cases. In the provisions it is provided that these proceeding should be very fast. For instance the said Article 80 of copyright law provides that the motion for securing the evidence or providing the information should be decided within 3 days since filing a motion, and the appeal within 7 days. However in the practice these terms, as it seems, are not observed. In complicated cases the temporary measures may be decided within months or longer.
- **Is the order subject to appeal?**

Yes the order is subject to appeal to the appeal court.

- **What kind of counter-arguments may successfully be asserted against such an order, or what counteractive measures can be taken by the respondent in order to lift the order?**

All kind of arguments may be asserted against such an order, namely that infringement has not occurred, the evidence was not relevant to infringement, so securing it makes no sense, the information constitutes commercial secrets, etc.

- **What are the implications if either claimant or respondent or both parties are foreigners?**

There are no special implications in such a case. One should observe however that the proceeding will be conducted in Polish language and all documents in a foreign language must be translated into Polish language by a sworn in court translator.

**Questions to be answered regarding limits:**

**a)** **Whether and how and through what procedures can secret information (business information, know-how, etc.) of the opposing party be protected in the laws of your system? In particular, are there in your system procedural possibilities to restrict the access to the information to specific persons involved in the proceedings (attorney only, neutral expert)? If so, how is this restriction legally implemented and ensured? How can abuses be prevented?**

There are some safeguards for protecting secret information of opposing party during the infringement proceedings in Polish law. According to Article 479 the court may order close doors hearing in a case, when production or commercial secrets may be disclosed. However there is no definition of a term *production or commercial secrets*.

**b)** **Is it possible for the opposing party to rely on privileges such as attorney/client privilege?**

In Polish law exists attorney/client privilege. All kind of legal advisors, namely attorney at law, legal advisors and patent attorneys may not be called as witnness’s or testify in the court on matters, in which they provided legal advice to a client.
c) What are the consequences if it turns out that the order was unjustified?

In such a case the claimant must redress to the defendant the damages caused by imposing the order. The value of damages covers not only the direct damage, but also lost profits. However the defendant must sufficiently prove the scope of damages and their link with imposing the order.

d) Is the order subject to a security bond?

Yes, the order may be subject to a security bond, which value will determine the court.

Future improvements:

The Polish Group would like to point out that major obstacle in enforcing IP rights in Poland, and perhaps in other countries too, is long term of obtaining IP protection and luck of temporary protection before the exclusive right is granted. For instance in a case of patent the time needed to obtain protection in Poland now it is at least some four years since filing the application. In a case of PCT applications this term is started from motion for starting national phase in Poland, what in practice means that it will be additional up to 30 month delay. During that time the owner has no legal remedies to stop infringement, even if the fact of infringement is obvious and patent application is strong, it is the invention demonstrates big inventive step in comparison with state of art. He can only send a warning letter and after the patent is granted claim the damages for the period starting from warning letter or publication of application (Article 288 industry property law of 2000).

Improvement of IP enforcing system should be linked with improvement of the procedure for obtaining the rights and perhaps with introducing the possibility to obtain temporary protection before the patent is granted, at least in some specified cases.

Future improvements should concentrate on determination too, what kind of information is considered as justified secret of the defendant, which should be not disclosed, and to what information the claimant should have access without limitation.

II. Article 50 TRIPS Agreement and Article 7 of the IP Directive

Article 50 (TRIPS)

1. The judicial authorities shall have the authority to order prompt and effective provisional measures:
   (a) (...)
   (b) to preserve relevant evidence in regard to the alleged infringement.
2. The judicial authorities shall have the authority to adopt provisional measures inaudita altera parte where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.

3. The judicial authorities shall have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.

4. Where provisional measures have been adopted inaudita altera parte, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable period after the notification of the measures, whether these measures shall be modified, revoked or confirmed.

5. The applicant may be required to supply other information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

6. Without prejudice to paragraph 4, provisional measures taken on the basis of paragraphs 1 and 2 shall, upon request by the defendant, be revoked or otherwise cease to have effect, if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period, to be determined by the judicial authority ordering the measures where a Member’s law so permits or, in the absence of such a determination, not to exceed 20 working days or 31 calendar days, whichever is the longer.

7. Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.

8. To the extent that any provisional measure can be ordered as a result of administrative procedures, such procedures shall conform to principles equivalent in substance to those set forth in this Section.

Article 7 “Measures for preserving evidence” (IP Directive)

1. Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a party who has presented reasonably available evidence to support his/her claims that his/her intellectual property right has been infringed or is about to be infringed, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement,
subject to the protection of confidential information. Such measures may include the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the materials and implements used in the production and/or distribution of these goods and the documents relating thereto. Those measures shall be taken, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the rightholder or where there is a demonstrable risk of evidence being destroyed. Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed.

2. Member States shall ensure that the measures to preserve evidence may be subject to the lodging by the applicant of adequate security or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant as provided for in paragraph 4.

3. Member States shall ensure that the measures to preserve evidence are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if the applicant does not institute, within a reasonable period, proceedings leading to a decision on the merits of the case before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar days, whichever is the longer.

4. Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures.

Member States may take measures to protect witnesses' identity.

Questions to be answered regarding content, requirements and extent

a) Do you have in your national law measures which could be deemed analogous to or comparable with the measures described above? If so, what are the differences?

As was mentioned above provisions of the TRIPS are directly applied in Poland so now there is no problem for implementing these measures in Poland.
b) Regarding content, requirements and extent:

- Are there differences as to the types of IP?
  
  No, see above.

- To what extent must the infringement already be proven beforehand by the claimant?
  
  In the discussed situation it was long established practice that measures for preserving evidence were available as temporary measures and in such situation claimant was obliged only to prove, that infringement was probable.

- How can the order be enforced? For instance, is it possible by means of such an order to enter the private sphere of the opposing party (for instance premises) and/or to effectively seize suspected “infringing” products? Who is entitled to enter the respondent's private sphere? What are the consequences if the opposing parties refuse access?
  
  Till the TRIPS determination the way of enforcing the order was in the discretion of the court, which should specify this in the order. There was no special regulation regarding private sphere of the defendant.

Questions to be answered regarding limits:

Future improvements:

III. Article 47 TRIPS and Article 8 of the IP Directive

Article 47 (TRIPS)

Right of Information

Members may provide that the judicial authorities shall have the authority, unless this would be out of proportion to the seriousness of the infringement, to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.

Article 8 “Right of Information” (IP Directive)
1. Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or any other person who:

(a) was found in possession of the infringing goods on a commercial scale;
(b) was found to be using the infringing services on a commercial scale;
(c) was found to be providing on a commercial scale services used in infringing activities;

or
(d) was indicated by the person referred to in point (a), (b) or (c) as being involved in the production, manufacture or distribution of the goods or the provision of the services.

2. The information referred to in paragraph 1 shall, as appropriate, comprise:

(a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services, as well as the intended wholesalers and retailers;
(b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.

3. Paragraphs 1 and 2 shall apply without prejudice to other statutory provisions which:

(a) grant the rightholder rights to receive fuller information;
(b) govern the use in civil or criminal proceedings of the information communicated pursuant to this Article;
(c) govern responsibility for misuse of the right of information;

or
(d) afford an opportunity for refusing to provide information which would force the person referred to in paragraph 1 to admit to his/her own participation or that of his/her close relatives in an infringement of an intellectual property right;

or
(e) govern the protection of confidentiality of information sources or the processing of personal data.

Questions to be answered regarding requirements, extent and enforcement

a) It would be interesting to know whether and how Art 47 of the TRIPS Agreement is implemented in the laws of your system?

As mentioned earlier TRIPS are directly implemented in Poland so the holder may rely on TRIPS.

b) Do you think that the right holder must first prove that his property right is infringed in order to be entitled to assert this right?
No, the holder of the right should have access to the information even if he only suspect infringement.

c) Do you think that this right should also be enforceable in preliminary injunction proceedings?

Yes, the holder of the right should have the right to information also in injunction proceedings.

Questions to be answered regarding limits and future improvements

It seems that it will be hard to give precise answer to the question of the limits in exercising the right to information. For sure in each case the balance of interest of the claimant and the defendant should be found. For sure always the real intention of the parties should be investigated. It should be not allowed that a dominant party is using the enforcement procedures only for making the competitors life hard. Also the safeguards for defendant in the enforcement proceedings should not create save haven for infringement.