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## Proposed changes to Polish intellectual property laws

### Abstract

This article discusses proposed legislative changes which aim to introduce a special court into the Polish court system to handle intellectual property matters. The main reason for establishing such a court is, undoubtedly, the quite specific nature of proceedings regarding intangible property rights in a broad sense. The bill is part of a vast exercise to amend civil procedure law, but, to a large extent, has an impact on the substantive provisions of Industrial Property Law and the Act on Copyright and Related Rights. A number of the proposed solutions should, therefore, have a consistent influence on intellectual property laws and contribute to increasing the quality of adjudication. A substantial portion of the doctrinal considerations addressed in this article are, however, about selected issues related to new laws on remedies available in intellectual property law proceedings. In particular, they include provisions which enable the disclosure of information on intellectual property right violations. The issue of information disclosure requests has already provoked many reactions, mostly critical, with respect to the current legislation. Therefore, examining the proposed change is all the more justified as it may provide an answer to whether the uncertainties associated with applying this construct will continue to exist.

## Introduction

This article discusses proposed legislative changes which aim to introduce a special court into the Polish court system that would handle intellectual property matters. The main reason for establishing such a court is, undoubtedly, the quite specific nature of proceedings regarding intangible property rights in a broad sense. Amidst cases regarding intellectual property rights, there is also a narrower category of matters, namely those regarding industrial property rights, which concern, in particular, patents and utility models. In these matters the technical aspect, which is at the core of any inventive solution, is often dominant, therefore creating the need for assistance from specialists and experts with specialised knowledge in various technical areas in analysing the material gathered<sup>1</sup>.

The need to introduce a separate adjudication path for cases regarding intangible property rights, and in particular intellectual property rights, seems to be confirmed by the numerous demands from the business community as well as representatives of collective management organisations and jurisprudence<sup>2</sup>. The proposals in the bill should, therefore, be considered a step in the right direction; however, a detailed analysis of its specific provisions in terms of their wording, editing and completeness, leads to the conclusion that the bill requires further work. The proposed changes contain certain issues which warrant the need for systemic regulation of certain provisions in both procedural and substantive law. The bill is part of a vast exercise to amend civil procedure law, but, to a large extent, impacts the substantive provisions of Industrial Property Law and the Act on Copyright and Related Rights. A number of the proposed

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<sup>1</sup> Cf. P. Podrecki, *Organizacja i działanie sądu do spraw własności intelektualnej* [in:] P. Kostański, P. Podrecki, T. Targosz (ed.), *Experientia docet. Księga jubileuszowa ofiarowana Pani Profesor Elżbiecie Traple*, Warszawa 2017, pp. 1228–1243.

<sup>2</sup> Cf. A. Adamczak, M. Kruk, *Perspektywy utworzenia sądu ds. własności intelektualnej w Polsce – obecne realia* [in:] J. Ożegalska-Trybalska, D. Kasprzycki (ed.), *Aktualne wyzwania prawa własności intelektualnej i prawa konkurencji. Księga pamiątkowa dedykowana Profesorowi Michałowi du Vallowi*, Warszawa 2015, pp. 26–39; cf. also a report by Dr. Ż. Pacud, *Innowacyjność w polskim sektorze zdrowia. Analiza jakościowa*, Warszawa 2018, which was prepared on the basis of a sectoral study in which the postulates voiced by businesses included a demand for creating specialised intellectual property courts, stating that “the main problem with the Polish intellectual property protection system is the lack of dedicated courts”. The respondents stressed that intellectual property matters are examined by regional courts whose judges lack the technical background for ruling on such matters. Many respondents criticised that system in comparison with more mature jurisdictions, such as that in Germany or the UK. The substantive law problems indicated by the respondents regard granting injunctions, interpretation of the so-called Bolar exemption and of the SPC manufacturing waiver, which confers no protection against drugs for export outside the EU (cf. p. 28 of the report).

solutions should, therefore, have a consistent influence on intellectual property laws and contribute to increasing the quality of adjudication.

A substantial portion of the doctrinal considerations addressed in this article is, however, about selected issues related to new laws on remedies available in intellectual property law proceedings. In particular, they include provisions which enable the disclosure of information on intellectual property right violations.

The issue of information disclosure requests has already provoked many reactions, mostly critical, with respect to the current legislation. Therefore, looking into the proposed change is all the more justified as it may provide an answer as to whether the uncertainties associated with applying this construct will continue to exist. Analysis of the provisions on information disclosure requests is also important for another reason: it touches upon the essential issue of the extent and balance of protection between the intellectual property right holder and the alleged infringer. In this context, we should also look into the legal situation of persons who are not directly identified as intellectual property right infringers, but may have knowledge of infringements. It should be noted that in the light of Polish legislation, delineating the boundaries of protection for intellectual property right holders has not only become an issue requiring interpretation of the relevant provisions within both the judiciary and the doctrine, but has also given rise to the need to verify the constitutionality of those provisions. In this respect, the Constitutional Court ruling of 6 December 2018 (SK 19/16) is of particular importance.

## New intellectual property court

A new model of adjudicating in intellectual property matters is being introduced as part of a general amendment to the Code of Civil Procedure. The introduction to the government bill, which lays out the reasons for amending the Code of Civil Procedure, says that the main objective of those changes is to create separate organisational units within the common court system that would be tasked with handling cases regarding copyrights and related rights, industrial property rights, as well as the associated unfair competition cases<sup>3</sup>.

Based on existing provisions, cases regarding infringement of intellectual property rights are examined by common courts and by the Supreme Court, in accordance with the general rules of civil procedure law. Also, the Polish system

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<sup>3</sup> On 5 January 2017, the Minister of Justice appointed a *Team for Developing a Proposal for Establishing Intellectual Property Courts* (Dz. Urz. Min. Spraw., item 1, and of 2018, item 188). The outcome of the work done by that Team is the proposed law.

involves procedural dualism, in accordance with which cases that result from complaints against decisions issued by the Patent Office are examined by the Provincial Administrative Court in Warsaw and the Supreme Administrative Court. Cases regarding EU trade marks and Community industrial designs are examined by a dedicated division of the Regional Court in Warsaw (XXII Division of the Regional Court in Warsaw – EU Trade Mark and Community Design Court).

Before proceeding to discuss the form and mode of operation of the new intellectual property court, it should be said that the term “intellectual property court” is used for convenience only to describe an organisational change within the common court system. The essence of changes to the civil procedure law is to introduce a separate track for intellectual property cases. As regards the adjudication system for industrial property cases, where decisions are issued by the Patent Office of the Republic of Poland, the administrative procedure and the administrative court procedure model will continue to apply. However, the bill proposes abandoning the current dedicated court which rules on an exclusive basis in cases regarding EU trade marks and Community industrial designs (XXII Division of the Regional Court in Warsaw – EU Trade Mark and Community Design Court). Those cases will be ruled on, subject to the general provisions of the Code of Civil Procedure regarding proper venue (Article 27 et seq.), by courts with jurisdiction to adjudicate in cases on the intellectual property track<sup>4</sup>. To justify the need for such changes, the bill’s drafters emphasise the fact that the high dispersion of intellectual property cases was certainly not conducive to the emergence of specialised staff; it therefore seems reasonable to provide judges within the existing court structures with the opportunity to gain expertise in intellectual property and to create dedicated units within regional and appellate courts. This objective is to be achieved through aiming at the widest possible scope of cognizance of the specialised intellectual property court.

The authors of the bill refer in that respect to Article 2(viii) of the *Convention Establishing the World Intellectual Property Organization* of 14 July 1967<sup>5</sup>, where the term “intellectual property” is defined as including the rights relating to literary, artistic and scientific works, performances of performing artists, phonograms, and broadcasts, inventions in all fields of human endeavour, scien-

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<sup>4</sup> In accordance with Article 80 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, the Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance (Community design courts) which shall perform the functions assigned to them by the aforementioned Regulation. Due to the fact that the bill proposes establishment of a higher number of Community design courts, there is an obligation to notify the Commission.

<sup>5</sup> Convention Establishing the World Intellectual Property Organization signed at Stockholm on 14 July 1967 (Dz.U. of 1975, No 9, item 49).

tific discoveries, industrial designs, trademarks, service marks, and commercial names and designations, protection against unfair competition, and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields. The phrase “all other rights resulting from intellectual activity”, which concludes this very generous list, is exceptionally prone to wide-ranging interpretation.

The bill is also based on the underlying assumption that because of social, economic and technological changes, and the phenomenon known as commercialisation of certain personal rights, we are witnessing in both legal theory and in case law a tendency to apply the legal constructs typically applied to intangible property rights to personal rights, particularly that of image. Undoubtedly, in many cases licence agreements are signed with respect to certain personal rights, and the permissibility of making unjust enrichment claims<sup>6</sup> and applying constructs aiming at limiting the rigour of non-transferability of personal rights<sup>7</sup> is also being analysed. Those tendencies are reflected in case law<sup>8</sup>.

If we adopt such an approach, the scope of cognizance of the court has been determined without any reference to the precise substantive law classification of a particular product of human intellectual activity and, therefore, without any indication which substantive law constructs should be applied. Practical difficulties which are not uncommon to arise out of uncertainty about the legal nature of tangible property rights are, therefore, to be settled within a specialised branch of the judiciary. According to the bill’s drafters, “in borderline situations, when it is not certain what substantive law basis for protection may be applied (if any), which is particularly evident in the case of protection of ideas and information, specialised courts (divisions of regional and appellate courts) should rule on such matters”<sup>9</sup>. In practice, we can assume that this will apply in particular to the protection of civil law personal rights that are subject

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<sup>6</sup> T. Grzeszak, *Ocena uszczerbku doznanego wskutek przekroczenia granic umownego zezwolenia na reklamowe wykorzystanie wizerunku*, “Ruch Prawniczy, Ekonomiczny i Socjologiczny” 2015, no. 2, p. 47 et seq.

<sup>7</sup> J. Barta, R. Markiewicz, *Wokół prawa do wizerunku*, “Zeszyty Naukowe Uniwersytetu Jagiellońskiego” 2002, no. 80, p. 11 et seq.

<sup>8</sup> Cf. Ruling of the Administrative Court in Warsaw of 29 July 2014, VI ACa 1657/13, LEX No 1537498.

<sup>9</sup> From the bill’s Reasons... To justify that proposal, the bill drafters refer to paragraph (2) of the recitals to Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights [hereinafter: Directive 2004/48/EC]. According to it, “The protection of intellectual property should allow the inventor or creator to derive a legitimate profit from his invention or creation. It should also allow the widest possible dissemination of works, ideas and new know-how. At the same time, it should not hamper freedom of expression, the free movement of information, or the protection of personal data, including on the Internet”.

to commercialisation. According to the authors of the bill, the best solution seems, therefore, to describe in great detail the competence and jurisdiction of intellectual property courts, but in such a way as not to give them jurisdiction over typical cases involving protection of personal rights, which are examined by civil divisions. The bill's drafters have proposed that the premise for jurisdiction of intellectual property courts in cases involving protection of personal rights should be a connection between that protection and commercial use of the personal right or scientific or inventive activity (or, in other words, creative activity) of the person seeking legal protection<sup>10</sup>.

In conclusion to those proposals, in the first part of the Code of Civil Procedure, after Section IV f of Title VII in Book One, Section IV g is added: "Procedure in intellectual property cases".

According to the wording of its first provision, Article 479<sup>89</sup>(1) of the Code of Civil Procedure, "The provisions of this Section shall apply in cases for protection of copyrights and related rights, as well as rights regarding inventions, utility models, industrial designs, trade marks, geographical designations, and integrated circuit topographies, and for protection of other intangible property rights (intellectual property cases). The definition of 'intellectual property cases' is elaborated in paragraph (2): "Intellectual property cases, as defined in this Section, shall also include cases:

- 1) for preventing and combating unfair competition;
- 2) for protection of personal rights, to the extent that they relate to the use of a personal right for the purpose of individualisation, advertising or promotion of a business, goods or services;
- 3) for protection of personal rights in connection with scientific or inventive activity."

By defining the notion of "intellectual property case", Article 479<sup>89</sup> of the Code of Civil Procedure is of essential importance to determining the scope of objects of proceedings in intellectual property cases and will define the cognizance of those specialised courts. The editing of that Article may also invite a discussion about the proposed scope of subject-matter jurisdiction and raise questions as to whether the proposed catalogue of cases listed in Article 479<sup>89</sup>(1) (2) of the Code of Civil Procedure is correct. Further concerns may also be raised by Article 479<sup>90</sup>(2), which designates the Regional Court in Warsaw as having exclusive jurisdiction over intellectual property cases regarding computer programs, inventions, utility models, integrated circuit topographies, plant varieties, and technical trade secrets.

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<sup>10</sup> From the bill's Reasons.



In attempting to comment on the range of cases identified in Article 479<sup>89</sup>(1) of the Code of Civil Procedure, we should, in the first place, refer to the wording of the Code's current Article 17(2). It should be emphasized that the current editing of Article 17(2) of the Code of Civil Procedure has made it possible to include other intangible property rights in its subject-matter range, including in particular the *sui generis* right of database creators, rights arising from additional protection certificates, and rights arising from the plant variety protection system. Therefore, the phrase "protection of other intangible property rights" is sufficiently capacious and may include other cases (e.g. for protection of a business name). It should go without saying, however, that it is impossible to develop a complete closed-ended catalogue of "other intangible property rights."

With the above comments in mind, we should now ask ourselves whether there is any point in introducing a detailed list of cases for protection of personal rights, to the extent that they relate to the use of a personal right for the purpose of individualisation, advertising or promotion of a business, and for protection of personal rights in connection with scientific or inventive activity, in Article 479<sup>89</sup> paragraph (2)(2) and (2)(3) of the Code of Civil Procedure. There is concern that in practice those provisions will lead to ambiguous interpretations as the terms used therein (*individualisation, advertising, promotion*) are not legally defined. Of similar ambiguity when defining the scope of intellectual property cases may be the reference to protection of personal rather than property rights.

It also seems that including all unfair competition cases regulated by the Act of 16 April 1993 on Combating Unfair Competition (hereinafter: "Unfair Competition Act") in Article 479<sup>89</sup> paragraph (2)(1) of the Code of Civil Procedure as intellectual property cases provides sufficient elaboration on the range of objects and will ensure protection of intangible property such as non-registered designations, trade secrets or advertising campaigns. In addition, such incorporation of the provisions of the Unfair Competition Act opens up the possibility of aligning the rules of law with business practice, in particular due to the general clause contained in Article 3(1) of the Unfair Competition Act. In conclusion, abandoning paragraph (2)(2) and (2)(3) in Article 479<sup>89</sup> of the Code of Civil Procedure will also not give rise to concerns that the catalogue of intellectual property cases is enumerated and, in fact, casuistic.

At the same time, we should concur with the assumption that intellectual property cases should include the wider category of cases for protection of intangible property rights, as well as for protection of persons who hold only intangible property itself, without the exclusive rights within an enumeration of those rights. To a significant extent, this function is performed by the above-mentioned protection under unfair competition law. It should be emphasised at this point that the reason why it makes sense to expand the catalogue of intellectual

property cases to include unfair competition cases is that there are many typical elements of protection which are shared by both intellectual property rights and unfair competition law (e.g., assessment of the risk of misleading). It should be noted, however, that unfair competition law also addresses a number of issues which are unrelated to intellectual property rights, and their object is to combat unfair limitation of market access (Article 15 of the Unfair Competition Act) or disruption of the functioning of another entity's enterprise (Article 14 of the Unfair Competition Act). Some unfair competition torts are, therefore, separate from the notion of intellectual property rights (e.g., defamation) or require protection of certain interests of the entrepreneur other than intangible property (protection of fair selling). Furthermore, provisions on limitation of market access, in particular the numerous cases regarding slotting fees (cf. Article 15(1)(4) of the Unfair Competition Act), are also very specific in their nature.

The scope of protection laid down in the Unfair Competition Act means that the creation of an intellectual property court that would examine all unfair competition cases would go far beyond the notion of intellectual property. It should, therefore, be considered whether there would perhaps be an excessively far-reaching expansion to the range of objects of intellectual property cases, examined on the basis of all acts of unfair competition, based on specific factual circumstances and legal foundations not related directly to the protection of intangible property. The inclusion of unfair competition cases as intellectual property cases would lead to greater consistency in rulings, but it would also be worth considering a solution that would provide an alternative jurisdiction for the aforementioned acts of unfair competition which are not related to intellectual property. In other words, the inclusion of all legal bases from the Unfair Competition Act under the umbrella of intellectual property cases should be permissible; however, the plaintiff should still be able to opt for general subject-matter jurisdiction, in particular in cases pursued on the basis of Articles 12, 14, 15 and 17 of the Unfair Competition Act.

While acknowledging the arguments for the need to have a wide understanding of intellectual property cases, an interpretation of the notion of 'intellectual property' or 'intellectual property right' that is excessively expansive should not be applied. In certain senses, a reference can be made to the understanding of 'intangible property rights'; however, this approach is not consistent either, for instance due to the aforementioned specific nature of protection on the basis of unfair competition rules, where the interests of entrepreneurs rather than their exclusive rights are protected. It should also be noted that the aforementioned proposals to establish a wider scope of subject-matter jurisdiction should also take into account cases whose object is related to intellectual property rights, but the bases for the claims sought arise from contractual rather than tort liability. If we follow this train of thought, intellectual property cases



would also include cases regarding claims for non-performance or improper performance of obligations, including claims for payment of fees. In this context, it would be more desirable to elaborate the proposed Article 479<sup>94</sup> of the Code of Civil Procedure by adding after the statement that “whenever an infringement of a right is mentioned, this should also include any threatened infringement of that right” a provision reading: “and, furthermore, any infringement on one’s commitments, and on the obligation to pay the relevant fees, the subject matter of which are intellectual property rights”. We should assume that in this respect it is not sufficient to rely on defining an intellectual property case by the case law formed on the basis of the currently applicable Article 17(2) of the Code of Civil Procedure. Despite existing rulings which lean towards a broad understanding of the notion of ‘case for the protection of copyrights’, treating it as a case ‘for claims under copyright laws’<sup>11</sup>, there may be doubts as to whether a violation of an intellectual property right is required for the case brought before court to be deemed a case for protection of that right. This issue applies in particular to cases for payment of contractual or statutory fees for the use of property protected through absolute rights<sup>12</sup>.

At the same time, assuming that the intention of the bill remains that the division of the Regional Court in Warsaw tasked with the examination of intellectual property cases is to have, in accordance with Article 479<sup>90</sup>(2) of the bill, exclusive jurisdiction over intellectual property cases regarding computer programs, inventions, utility models, integrated circuit topographies, plant varieties, and technical trade secrets, equipping that court with special means that would have a real impact on adjudicating in technical cases should be considered. The bill drafters’ reasoning behind creating a ‘technical’ intellectual property court in Warsaw continues to rest on the assumption that a specialised court should be appointed for those most complicated of cases, which will, in turn, be conducive to the efficiency and speed of the entire process. The fact that cases with a high

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<sup>11</sup> In its interim order of 26 February 2015 (III CZ 6/15), the Supreme Court supported a wide understanding of the notion of “case for the protection of copyrights”, treating it as a case “for claims under copyright laws”.

<sup>12</sup> The scope of cognizance of intellectual property courts proposed in the bill requires interference with the wording of Article 17 of the Code of Civil Procedure. The bill’s drafters adopted a method that involved removing points (2) and (4<sup>3</sup>) from that Article, which referred to those cases which should be within the cognizance of intellectual property courts, and inserting a provision which corresponded to their wording in the more specific part of the Code of Civil Procedure (proposed Article 479<sup>89</sup> paragraph (1) and (2)(1) of the Code of Civil Procedure). In addition, this Article has been given provisions about the cognizance of intellectual property courts in cases regarding protection of personal rights (proposed Article 479<sup>89</sup> paragraph (2)(2) and (2)(3) of the Code of Civil Procedure). That way, all provisions regulating the jurisdiction of intellectual property courts have been placed among provisions regarding specific proceedings before those courts.

degree of complexity will be accumulated at a single site will cause them to be resolved faster. The bill's Reasons emphasise that the idea of creating a single intellectual property court to examine 'technical' cases is of key importance for cases regarding, for example, computer programs<sup>13</sup>.

When assessing the idea of having a separate 'technical' court, we should once again raise the issue of introducing certain means that would ensure more effective adjudication in proceedings before such a court. If the Regional Court in Warsaw is not a special court, in the sense that it does not have the procedural and organisational measures to enable it to include persons with technical qualifications in the adjudication process, then the proposed essential objective may not be achieved. As a result, doubt remains whether the adjudication process should be concentrated at a single site for the entire country. Only the creation of special conditions in which cases with technical elements are examined under separate rules would be a proper justification for the exclusive jurisdiction of such a court.

Modifications to achieve that aim could involve the introduction of permanent technical experts and, as a consequence, deeper changes, in particular to Article 278(1) of the Code of Civil Procedure, which would require introducing a provision that enables the admission of a permanent technical expert by the court *ex officio* in cases that require special knowledge. The court could admit a permanent technical expert at a closed session, without hearing motions of the parties (amendment to Article 279 of the Code of Civil Procedure). Then the court could order that the expert be provided with access to the case files and the object to be inspected and, furthermore, order that the expert participate in the hearing of evidence (Article 284 of the Code of Civil Procedure). The court would indicate whether the expert witness' assessment should be provided orally or in writing. Moreover, it is important to create conditions that would allow sourcing knowledge from a technical expert at court hearings without the need to summon the parties. However, the actions of the expert witness would require supervision, and so the possibility of the parties raising objections to the proceedings against a permanent technical expert's assessment should be considered (appropriate application of Article 162 of the Code of Civil Procedure and of the provisions regarding infringement of substantive or procedural law)<sup>14</sup>.

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<sup>13</sup> For example: ECJ judgement of 3 July 2012 in case C-128/11 *UsedSoft vs. Oracle International*, regarding legal aspects of software licences, judgement of the Administrative Court in Katowice of 17 March 2016 in case I ACa 1028/15, regarding Article 74(3) of the Act on Copyright and Related Rights and the conflict of employer and employee rights in relation to a computer program, and judgement of the Administrative Court in Warsaw of 18 September 2014 in case I ACa 315/14, regarding fields of exploitation and the interpretation of a contract regarding computer program copyrights.

<sup>14</sup> Cf. More on that topic: P. Podrecki, *Organizacja i działanie sądu...*, passim.

## Limiting the power to act personally in intellectual property cases

Introducing a special track for intellectual property cases, due to degree of specialisation in both legal and technical terms, requires the introduction, as a rule, of obligatory representation by attorneys and patent attorneys. It should be conceded that limiting the power to act personally would contribute to speeding up the proceedings – both in terms of better concentration of evidence and of identifying the legal basis for one’s demands<sup>15</sup>. The bill drafters noted that the tendency suggesting a need for mandatory professional representation is supported by case law. In its judgement of 28 February 2002, the Supreme Court stated that the fact that the legal basis for a claim is indicated by a professional representative is important in the sense that it “gives a direction to the entire hearing of evidence”, without, however, being “formally binding on the court”<sup>16</sup>. The obligation to be represented by professional representatives in intellectual property cases is not, however, absolute. The court may exempt the parties, upon application or *ex officio*, from mandatory representation by attorneys if the circumstances, including the degree of complexity of the case, do not warrant such obligatory representation. This exemption may take place at any stage of the case, including at the request of a party made in the pleading initiating the proceedings. The rule of mandatory representation by a professional representative is also sometimes waived in cases where the value of litigation does not exceed PLN 20,000. This leads to the conclusion that in non-property cases, as well as in cases where a temporary fee is established under Article 15 of the Act of 28 July 2005 on Court Fees in Civil Cases, due to the fact that it is impossible to determine the value of litigation when the case is initiated, the exemption in question does not apply<sup>17</sup>.

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<sup>15</sup> Cf. the bill’s Reasons.

<sup>16</sup> Cf. Ruling of the Supreme Court in case III CKN 182/01, LEX No 54471.

<sup>17</sup> Furthermore, the bill’s Reasons say that conferring the power to represent parties also on patent attorneys will remove the doubts which arise in that respect *de lege lata* in specific proceedings. It is worth pointing to the Resolution of the Supreme Court of 26 July 2017 (III CZP 26/17), in which the Supreme Court stated that in an unfair competition case the subject matter of which is also a claim regarding an infringement of copyrights to a copy-rightable work that is simultaneously protected as industrial property, a patent attorney may also act as the representative in litigation.

## Jurisdiction of regional courts

Intellectual property cases will come under the jurisdiction of regional courts. The subject-matter jurisdiction of regional courts is justified by the specialist nature and often high degree of complexity of the cases in question. In order to ensure a separate track for intellectual property cases, in addition to the subject-matter jurisdiction regulation contained in Article 479<sup>89</sup> of the Code of Civil Procedure, the bill also provides for a mechanism which will enable intellectual property courts to shape their own case law. According to the bill's drafters, this will increase legal security and speed up the proceedings, especially in cases in which classifying the object of the proceedings as belonging under the umbrella of intellectual property cases is not that obvious<sup>18</sup>.

The proposed mechanism involves introducing a special regulation in relation to Article 200 of the Code of Civil Procedure. The proposed Article 479<sup>92</sup> of the Code of Civil Procedure says that the court shall not be bound by an interim order to refer the case issued under Article 200(2) of the Code of Civil Procedure. If the court finds itself to lack jurisdiction, it shall refer the case to a different court, but without precluding the referring court. Such an interim order may be issued not later than within two weeks from when the case being referred is received by the court with jurisdiction over an intellectual property case. The court to which the case is referred will be bound by the interim order of the referring court.

The authors of the bill assume that judges at a specialised court will have better competences to decide which cases should be adjudicated under the provisions on proceedings in intellectual property cases. The introduction of such a short time limit for issuing the relevant interim order is intended to prevent any protraction of the proceedings, and the fact that it is non-binding addresses both a situation where the interim order to refer the case to an intellectual property court is issued by a court of the first instance and that order has not been appealed against, and a situation where the referral of the case to an intellectual property court is made by a court of the second instance. In either case, the intellectual property court is not bound by the interim order and may rule to refer the case to another court<sup>19</sup>.

Interim orders to refer the case may be appealed against. They may be complained against with the intellectual property court examining the case in the second instance. It is therefore important that, in the end, the intellectual property court shapes its cognizance on the basis of the proposed provisions of law.

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<sup>18</sup> Cf. the bill's Reasons.

<sup>19</sup> Cf. the bill's Reasons.

In accordance with the new Article 479<sup>91</sup> of the Code of Civil Procedure, provisions on other separate proceedings apply to the extent that they do not conflict with provisions regulating the proceedings in intellectual property cases. Introduction of such a regulation will enable the application of special rules in intellectual property cases which, in the context of the proposed changes to the civil procedure, would not otherwise be permissible. An example may be a counterclaim in intellectual property cases.

## Other procedural suggestions in intellectual property cases

The procedural changes proposed for intellectual property cases are not limited to determining the subject-matter jurisdiction. In the initial passages of the bill, there is, for example, Article 479<sup>93</sup>, according to which “If in an infringement case the court decides that it is impossible to precisely substantiate the amount of the claim or that it is exceedingly difficult or evidently pointless, it may in its ruling order the payment of an adequate sum based on its assessment of all circumstances of the case”. This provision may be *prima facie* considered to be redundant in procedural terms considering the role of Article 322 of the Code of Civil Procedure, and also in conflict with the provisions of substantive law which define strict bases for claims in intellectual property law. The proposed provision may, in particular, create the risk of normative premises, which delineate the boundaries of claims in specific acts, being ignored. Neither are regulations which facilitate such far-reaching pursuit of claims mentioned in the Enforcement Directive.

In that respect, the bill’s drafters are of the opinion that Article 479<sup>93</sup> of the Code of Civil Procedure serves intellectual property right holders. They say that the provision will be applicable, for example, in the case of examining a claim by a computer program creator in a situation where, as a result of passage of time and the development of subsequent versions of the software, it is difficult to determine the shape of the previous version and the creative contribution of the person seeking protection. At the same time, the authors are aware of the possibility of employing the solution laid down in Article 322 of the Code of Civil Procedure. They also acknowledge the exceptional nature of the regulation, which – in accordance with the *exceptiones non sunt extendendae* principle – does not warrant its broad application. Arguments that the fast pace of legal and commercial transactions and the multitude of types of claims available to holders of absolute rights support the validity of the proposed regulation and its purpose, which would not be achieved by referring to Article 322 of the Code of Civil Procedure, are not, however, very convincing.

In the context of the proposed Article 479<sup>93</sup> of the Code of Civil Procedure, it should be noted that it creates the risk of violating the principles of legal certainty and security of transactions. Those principles should not be easily threatened by deficiencies in evidence or investigation into the desirability of protection as such by means of civil procedure provisions which introduce vague and bias-prone premises. That purpose is already achieved by general clauses (e.g. Article 5 of the Civil Code, Article 3(1) of the Unfair Competition Act) as well as by the functional interpretation of the provisions of substantive law. Furthermore, application of the norm in that form may be regarded as a restriction on the balance between the parties to the proceedings, giving excessive preference to right holders. It should also be noted that the remedies listed in enumerations of claims arising out of a violation of intellectual property rights laid down in specific provisions, such as Article 287(1) and 296(1) of Industrial Property Law of 30 June 2002, Article 79(1)(4) of the Act of 4 February 1994 on Copyright and Related Rights, Article 36b of the Act of 26 June 2003 on the Legal Protection of Plant Varieties, and Article 11(1)(4) of the Act of 27 July 2001 on the Protection of Databases, contain specific premises and form a coherent system which gives the right holder a wide range of measures and sufficient basis for the protection of its rights. The wording of Article 479<sup>93</sup> of the Code of Civil Procedure may also give rise to doubts as to whether the new track properly balances the interests of the parties in accordance with the principle of proportionality. The wording of the new Article 479<sup>93</sup> of the Code of Civil Procedure may also lead to the observation that the role of ensuring that the principle of proportionality is observed is played by the proposed Article 479<sup>95</sup> of the Code of Civil Procedure. The need to balance the interests of the parties is very clearly expressed in that provision: “When applying the measures laid down in Article 479<sup>97</sup>, Article 479<sup>106</sup> or Article 479<sup>112</sup>(1), the court shall take into account the interests of the parties to such a degree as to ensure adequate protection for the right holder and not to burden the obligor, or the defendant, more than is necessary, while bearing in mind the burden on the defendant and the obligor that would result from the measures applied and the protection of trade secrets”. The wording of this provision, which is intended to serve the purpose of a thorough assessment of facts, rather than as a key to interpreting the law, suggests that the bill’s drafters acknowledge the need for establishing the boundaries of interests of both plaintiffs and defendants.

One final comment as regards amendments concerning procedural issues may be that there is also no need to introduce into the Code of Civil Procedure a norm which confirms that whenever the provisions of that Section mention an infringement, this should be understood to include any threatened infringement as well (proposed Article 479<sup>94</sup> of the Code of Civil Procedure). The



general meaning of such a norm should be explained in the relevant provisions of specific acts.

To sum up, I believe that the idea of introducing a separate track, which, in turn, leads to the creation of intellectual property courts, proposes valid and desirable changes, regardless of the reservations and suggestions presented above. At the same time, I would stand by the objection that excessive cognizance resulting from vague premises for subject-matter jurisdiction may excessively burden the newly created organisational units, which, as a result, will lead to delays in examining cases. On the other hand, the mechanism which enables the specialised courts to decide about jurisdiction in borderline cases is a welcome solution. It is also difficult to determine *ex ante* whether a single ‘technical’ court, without being equipped with special measures, will be able to resolve complex cases in a correct and speedy manner.

## Information disclosure request

The draft amendment contains provisions which propose to introduce the “right of information” to proceedings in intellectual property cases, which is referred to as “information disclosure request”<sup>20</sup>. It is worth noting at the beginning that the source and normative pattern of the “right of information”, or information disclosure requests, is Directive 2004/48/EC. Upon implementation of the Directive, information disclosure requests became regulated in Article 286<sup>1</sup> paragraph 1 point (2) and (3) of Industrial Property Law and in Article 80 paragraph 1 point (2) and (3) of the Act on Copyright and Related Rights. Those provisions were brought into force by the Act of 9 May 2007 Amending the Act on Copyright and Related Rights and Certain Other Acts<sup>21</sup>.

It should also be noted that, in addition to the work on new regulations in the Code of Civil Procedure regarding copyright, work is also being done on changes to align the provisions of the Industrial Property Law in accordance with the requirement to comply with the obligation to enforce the ruling of the Constitutional Tribunal of 6 December 2018 in case SK 19/16. For that reason, at the time of writing this article, I am able to refer to two proposed pieces of legislation in making general comments on the objective and shape of the construct being amended<sup>22</sup>.

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<sup>20</sup> Sejm Print UD 497.

<sup>21</sup> Act of 9 May 2007 Amending the Act on Copyright and Related Rights and Certain Other Acts (Dz.U., item 662).

<sup>22</sup> Sejm Print 3664.

In attempting to determine the legal nature of information disclosure requests, it should be presumed that although they are auxiliary in relation to proceedings regarding intellectual property right infringement, their procedural function nevertheless has a significant impact on the decision whether to initiate a suit and the scope of claims sought. The importance of this auxiliary measure is closely related to obtaining information on the infringement of an exclusive right. Neither literature nor case law provide an unambiguous understanding of the legal nature of an information disclosure request, and, furthermore, its current regulation in Polish law is believed to be misaligned with EU law<sup>23</sup>. From the very moment those laws were passed, there have been arguments raised that changes to Polish law are necessary because of the fact that the implementation of Directive 2004/48/EC is believed to be defective and systemically inconsistent<sup>24</sup>. Fulfilling the obligation to enforce the ruling of the Constitutional Tribunal of 6 December 2018 (SK 19/16) is, however, of particular importance to changing the current provisions of law. According to that ruling, the current wording of Article 286<sup>1</sup>(1)(3) of the Industrial Property Law of 30 June 2000 (OJ L of 2017, item 776) stands in contradiction to Article 22 in conjunction with Article 31(3) of the Constitution of the Republic of Poland, which deprives the Polish legal system of the possibility of securing a claim by obliging a person other than the infringer to disclose information which is necessary for the purpose of seeking claims related to infringement of exclusive rights (known as a disclosure claim). Moreover, the above ruling stresses that it is important “that there is a connection between the proposed injunction and the proceedings in a case regarding infringement of industrial property rights”. The provisions proposed in the bill amending the Code of Civil Procedure address the ruling of the Constitutional Tribunal by introducing a solution which involves a close connection between the execution of an information disclosure request and the claim regarding infringement of an industrial property right. In the bill to amend

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<sup>23</sup> Disclosure claim is extensively described in the relevant literature – see for example: A. Kołodziej, *Roszczenie informacyjne w prawie własności intelektualnej*, “Prace Instytutu Prawa Własności Intelektualnej UJ” 2005, no. 88, p. 145 et seq., and A. Tischner, *Odpowiedzialność*, p. 292; A. Jakubecki [in:] *Prawo własności przemysłowej*, vol. 14b, Warszawa 2012, pp. 1660–1664; A. Nowak-Gruca, *Roszczenie informacyjne w ustawie – Prawo własności przemysłowej w świetle ekonomicznej analizy prawa*, “Monitor Prawniczy” 2008, no. 15, p. 798; R. Skubisz, *Roszczenie o udzielenie informacji w prawie własności przemysłowej (w świetle dyrektywy nr 2004/48 i prawa polskiego)* [in:] J. Gudowski, K. Weitz (ed.), *Aurea praxis. Aurea theoria. Księga pamiątkowa ku czci Profesora Tadeusza Erecińskiego* vol. 2, Warszawa 2011, p. 2544, P. Fik, E. Laskowska, *Charakter prawny roszczenia informacyjnego*, “Monitor Prawniczy” 2012, no. 24, p. 1293 et seq.; J.R. Antoniuk, *Postępowanie o udzielenie informacji w związku z naruszeniem własności intelektualnej jako rodzaj postępowania cywilnego*, “Przegląd Sądowy” 2014, no. 11–12, pp. 144–163.

<sup>24</sup> Cf. R. Skubisz, *Roszczenie o udzielenie...*, p. 2535 et seq.

the Industrial Property Law, the connection between the information disclosure request and the claim regarding infringement of an industrial property right is also taken into account; however, in a different, somewhat less powerful form, which seems to be a more apt solution. It is worth emphasising that the future shape of that construct should, above all, strike a balance between all interests and maintain adequate proportions between the rights of obligees and the obligations of infringers, as well as other persons who have knowledge of the infringements.

Therefore, the need to amend information disclosure requests seems entirely valid<sup>25</sup>. It should, however, be presumed that the fundamental objective and direction of the proposed changes should be such a wording of the provisions that would make a direct reference to the provisions of Directive 2004/48/EC. With reference to the wording of Article 8 of Directive 2004/48/EC, it should be remembered that the order to disclose certain information is issued in proceedings concerning an intellectual property right in response to a justified and proportionate request of the claimant. Furthermore, paragraph 21 of the recitals to Directive 2004/48/EC says that the right of information allows precise information to be obtained on the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement. Therefore, the Directive provides for quite a broad range of addressees of such a request to include persons infringing exclusive rights and any other person with knowledge of the information necessary for the purpose of seeking claims. The provisions of the Directive also lead to the conclusion that the right of information is a stand-alone demand for specific action, separate from the demand to secure evidence and to secure claims. At this point, it is also worth referring to the legal nature of the Directive, which is a minimum harmonisation Directive and, in principle, allows Member States to grant more far-reaching protection to obligees<sup>26</sup>.

When attempting to formulate provisions which describe the rules for disclosure of information, one should, therefore, be guided by the main objective of the construct in question. In accordance with the assumptions underlying Directive 2002/48/EC, the objective of such requests is to create a legal instrument

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<sup>25</sup> More details: cf. A. Jakubecki [in:] *Prawo własności przemysłowej...*, pp. 1660–1664; A. Tischner [in:] Kostański (ed.), *Prawo własności przemysłowej. Komentarz*, Warszawa 2014, p. 1362, with certain doubts as to the application of Code provisions *per analogiam*.

<sup>26</sup> This nature of the Directive arises from its Article 2(1), which says: “Without prejudice to the means which are or may be provided for in Community or national legislation, in so far as those means may be more favourable for right holders, the measures, procedures and remedies provided for by this Directive shall apply, in accordance with Article 3, to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned.”

which would enable the holder of intellectual property rights [obligee] to obtain information on the infringement of those rights. Obtaining of such information by the obligee is frequently the facts-of-the case-related factor upon which effective seeking of legal protection is conditioned. Referring to a passage from the bill's Reasons, it is, therefore, impossible not to agree that in civil proceedings the claimant must demonstrate the facts from which its claim has arisen (Article 232 of the Code of Civil Procedure and Article 6 of the Civil Code). In cases for protection of intellectual property rights, this means, in particular, circumstances such as the existence of a right, the fact of its infringement by the defendant, and, in the case of pecuniary claims, the amount of unjustifiably obtained gains, or the fact of occurrence and the extent of damage. In practice, invoking and proving those factual circumstances causes fundamental difficulties, because the obligee may not be aware of the extent of the defendant's illegal activity, especially when it comes to the number of unlawfully manufactured or marketed goods<sup>27</sup>. Therefore, the desired shape of the 'information disclosure request' construct should fulfil the aforementioned objective, and its accurate understanding may remove some of the doubts voiced in the doctrine.

In connection with the proposed amendment of the Code of Civil Procedure, there is also an opportunity not only to improve the legislation, but also to achieve the fundamental objective of the bill, beyond information disclosure requests, which is to create a consistent law with specific provisions for procedures regarding protected intangible property in relation to all intellectual property rights. At the same time, it should be noted that the specific nature of civil proceedings regarding disclosure of information conducted under other provisions should be maintained<sup>28</sup>. In those cases, there should be a regulation that provides for accordingly applying the provisions on proceedings in intellectual property cases where the right to disclose information arises from specific provisions.

When describing the legal nature of information disclosure requests, it is a welcome finding that the bill preserves their essence as a special legal measure of procedural nature<sup>29</sup>. An obligee's request to disclose information is not a type of claim, but only a different form with the sole purpose of seeking a claim. When deciding on the subject matter of the request, the court issues an order (Article 479<sup>117</sup>(1)), and orders issued in the course of proceedings are not a form of

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<sup>27</sup> Cf. A. Jakubecki [in:] *Prawo własności przemysłowej*, pp. 1660–1664; R. Skubisz, *Prawo własności przemysłowej*, vol. 14a, Warszawa 2017.

<sup>28</sup> For example, initiated by collective management organisations under Article 48 of the Act of 15 June 2018 on Collective Management of Copyrights and Related Rights, or based on Article 47 of the Act of 2 April 1994 on Copyright and Related Rights.

<sup>29</sup> Cf. A. Jakubecki [in:] *Prawo własności przemysłowej...*, pp. 1660–1664; R. Skubisz, *Prawo własności przemysłowej...*, passim.

resolutions regarding the subject matter of the case. The right of information is, therefore, not of a substantive law nature; however, in certain legal regimes (e.g., Germany) a certain concept of disclosure claims has developed which aims at disclosing the necessary information regarding the infringement of its right to the obligee<sup>30</sup>.

When analysing the key elements of the proposed law in the context of criticism of the current provisions, it may make sense to describe in more detail the main objections voiced to date<sup>31</sup>. This will allow us to establish whether the proposed law removes those flaws.

In the first place, the current provisions do not impose the obligation to initiate an infringement suit after receiving the requested information from the alleged infringer. The lack of obligation to initiate a suit has raised the objection that information disclosure requests do not otherwise ensure the necessary connection to an infringement suit. This objection was, in particular, made in the statement of reasons for the ruling of the Constitutional Tribunal, which emphasised the lack of guarantee that a suit would be initiated and that there was no way of controlling how the information would be used.

With respect to that objection, it should be noted, however, that the provisions of the Directive do not directly stipulate the obligation to initiate a suit by the person who makes an information disclosure request. The Directive requires only that the injunction order is issued in intellectual property right proceedings. It is not, therefore, obvious how to understand the connection between proceedings initiated by the person requesting information and an infringement suit. It can only be presumed that any obligee who proves the circumstances of infringement of its right and makes the request in question is intending to file the actual suit. It is impossible, however, to expect that the information disclosed will absolutely in every situation force the initiation of a suit. It may turn out, for example, that despite the existence of certain circumstances that suggest an infringement, the information disclosed will not provide any grounds for the obligee to seek its claims in an effective manner. For example, the information disclosed may show that the goods in possession of the disclosing person are parallel imports from another EU country, which validates their further marketing. Furthermore, in many cases, information disclosed by a third party will not

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<sup>30</sup> In certain legal regimes (e.g., Germany) a certain concept of disclosure claims has developed which aims at disclosing the necessary information regarding the infringement of its right to the obligee. A. Jakubecki [in:] *Prawo własności przemysłowej*..., pp. 1660–1664.

<sup>31</sup> Such a list is presented by T. Targosz in the article *O zasadności dotychczasowej krytyki roszczenia informacyjnego w prawie własności przemysłowej i propozycji jego zmian* [in:] A. Adamczak (ed.), *100 lat ochrony własności przemysłowej w Polsce. Księga jubileuszowa Urzędu Patentowego RP*, Warszawa 2018, pp. 1016–1071.

warrant the seeking of claims against that party, because their role in connection with the infringement was negligible.

So how do we ensure, on the one hand, delineation of the boundaries of protection of the interests of those who disclose information while, on the other hand, making sure that obligees have the possibility of searching for information on the infringement? It seems that several solutions can be proposed in that respect, none of which would tip the scales towards an absolute necessity to file a suit. In the first place, the proposed wording of the provisions could establish the principle of initiation of a suit, but then introduce precisely defined exceptions which waive the obligation to file a suit. Another solution could be to equip the judge who adjudicates the case with discretionary power to decide whether in connection with the information disclosed the obligee should be obliged to file a suit or not. With that solution, it would also be important to decide at which stage of the information disclosure proceedings the court should order that a suit be initiated. At the time of examining the information disclosure request, there may not be anything yet to warrant the initiation a suit, but once the information disclosed is known, the court may be able to impose the obligation to initiate a suit when the scope of the information disclosed justifies, in its opinion, the taking of further steps.

In that respect, the proposed amendment to the Code of Civil Procedure provides for, unfortunately, a somewhat automatic mechanism, which means that once the information disclosure request is accepted, a suit must be filed. The amendment, therefore, complies with the recommendations of the Constitutional Tribunal, but significantly shifts focus onto the protection of the interest of those who infringe on intellectual property rights, or those who have knowledge of such infringements. A sanction which is to guarantee the performance of such obligation – although the Directive is silent on that matter – is, as mentioned in the bill's Reasons, payments from the obligee to the person obliged to disclose information (proposed Article 497<sup>112</sup> paragraph 3 and 5). The proposed “payments” are financial consequences of failure to initiate a suit in the form of:

- Claim for remedying the damage caused by fulfilling the obligation to disclose information, in accordance with the general provisions of law (or, according to the bill's Reasons, through payment of a pecuniary amount for usage of the information disclosed for a specific period of time), if the obligee fails to submit a pleading to initiate a suit against the infringer within the time limit set by the court, or the pleading to initiate a suit has been withdrawn, or where the pleading to initiate a suit has been returned or rejected, or the statement of claim or the request has been dismissed, or the proceedings have been discontinued. In this case, the bill also introduces a one-year statute of limitations.



- Claim for remedying the damage caused by fulfilling the obligation to disclose information where the obligee has used the information for purposes other than seeking its claim.

An analysis of the proposed solutions leads to the question of whether it would not in fact deprive information disclosure requests of their actual function. Obligees may fear that acceptance of their requests will force them to initiate a suit or will trigger financial sanctions. Such a construct denies the possibility of choosing whether to pursue one's claims or not in a situation where the knowledge about a potential infringement is perhaps insufficient, or where the known extent of the infringement is negligible. The compulsory filing of a pleading to initiate a suit carries a risk of financial consequences arising from the "payments" mechanism, in particular if it has the form of payment of a pecuniary amount for usage of the information disclosed for a specific period of time. If the facts of the case indicate that the scope of the information disclosed may not sufficiently secure the interests of the obligee in a suit, the obligee should be able not to file the suit. Filing a suit would be pointless in certain special circumstances related to the infringement that occur after information disclosure, for example, if the infringing goods had already been marketed and the infringer is insolvent.

In connection with the proposed amendments to the Code of Civil Procedure and the Industrial Property Law, one should compare different solutions concerning a connection between an information disclosure request and the obligation to file a pleading to initiate a suit. In principle, assuming that the obligee did not file a pleading to initiate a suit against the infringer within a period of time set by the court after information had been disclosed to the obligee, the persons who disclosed the information should have the right to file a claim for remedying the damage caused by fulfilling the obligation to disclose information. The factor which warrants the claim for damages is, in this case, the actual damage suffered by the information discloser. If actual damage has been suffered, the information discloser must demonstrate its amount in accordance with general principles of law<sup>32</sup>. Such scope of liability and manner of connecting the information disclosure request to claim seeking is proposed in the amendment of the

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<sup>32</sup> In accordance with Article 286<sup>1</sup>(3) of the Industrial Property Law: "If the obligee fails to submit a pleading to initiate a suit against the infringer of a patent, an additional protection right, a protection right or a registration right within the time limit set by the court, or the pleading to initiate a suit had been withdrawn, or where the pleading to initiate a suit had been returned or rejected, or the statement of claim or the request had been dismissed, or the proceedings had been discontinued, the information discloser referred to in paragraph 1 and 2 shall be entitled to a claim for remedying the damage caused by fulfilling the obligation to disclose information, in accordance with the general provisions of law."

Industrial Property Law. However, the obligation to pay a pecuniary amount for usage of the information disclosed for a specific period of time, as stated in the Reasons of the proposed bill to amend the Code of Civil Procedure, may be questionable. The framework of that payment is based on the principle of 'lump-sum damages'. Such an obligation in the case of information disclosure requests is definitely too far-reaching, because it departs from the function of compensatory measures, the essence of which is to restore the state from before the event that had caused the damage. If the person complying with the obligation to provide information has not suffered any damage in connection with such information disclosure, then there is no justification for payment of 'lump-sum damages'. It is, however, necessary and justifiable to regulate the consequences of a situation where the person who provided information has a claim for remedying the damage caused by fulfilling the obligation to disclose information due to the fact that the obligee has used the information for purposes other than seeking its claim. Those consequences seem to be a reasonable solution which aims to control the abuse of a legal remedy contrary to its intended purpose. In attempting to determine an appropriate guarantee that the information will be used in proceedings concerning an infringement of intellectual property rights, it may be helpful to examine the connection in light of CJEU case law<sup>33</sup>.

There is no controversy, however, about the proposed obligation on the obligee to refund reasonable costs and expenses incurred in connection with disclosing the information if such a demand is put forward by the obligor or the defendant.

Another frequent objection against the current law is that it erroneously permits the use of the measure in question against persons who have not yet been found, or, as a matter of fact, who have not yet been proven, to have infringed any of the industrial property rights protected under the law. This argument has been substantiated in detail by R. Skubisz<sup>34</sup>, who asserts that Polish law contradicts Article 8 of the Directive and also primary law of the EU<sup>35</sup>. To engage in a polemic with that objection, we should, in the first place, refer to the wording of the Directive and once again emphasise that any information disclosure request

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<sup>33</sup> Cf. Judgement of 18 January 2017 in case C-427/15 (New Wave).

<sup>34</sup> R. Skubisz, *Roszczenie o udzielenie...*, p. 2535 et seq., in particular p. 2547 et seq.

<sup>35</sup> If the latter assertion is valid, then there is also a high probability that this law could be accused of being unconstitutional. Cf. T. Targosz and substantiation of the constitutional complaint, which says that the objection of non-compliance with the primary law of the EU and the objection of non-compliance with the Constitution of the Republic of Poland will obviously coincide not where we are dealing with 'Treaty freedoms' (such as the free movement of goods), but where the primary law of the EU embodies the principles laid down, for example, in the European Convention on Human Rights (right to a fair trial, right to own property, proportionality of any derogation from protected rights, etc.).

is accepted in response to the claimant's demand. The terminology adopted in the Directive to describe the procedural roles of the claimant and the defendant should not be read literally in accordance with the procedural and substantive law meaning of those terms, nor should one become strictly bound by the statement that the addressee of the request is an infringer who had been proven the infringement. When developing provisions applicable to proceedings whose function is auxiliary in relation to provisions applicable to the main proceedings, one needs to describe the relationship between the persons participating in such proceedings while preserving the special function of the construct, the intended purpose of which is to facilitate preparations for the actual suit. The above assumptions must support the ambiguous phrases and terms used in the Directive itself, which are understood differently in different language versions, and the possibility of implementation adjusted to the inconsistent terminology used throughout national laws.

If we assume such an approach, then we can use the term 'infringer' without any concern in relation to a person with respect to whom there is a probability that they have committed a tort, or credible circumstances exist which indicate an infringement. The term 'infringer' should, in the case of information disclosure requests, be interpreted in the procedural context, while remembering that whether that person is responsible for the infringement will only be decided in the final ruling. An argument in that respect may be the observation that whether the person indicated in the statement of claim as the defendant is the infringer is only confirmed by the ruling of the court, which, in many cases, is not favourable to the claimant. As a result, where the claimant loses its case, the defendant is not deemed to be an 'infringer'. Therefore, any terms applied for the purpose of developing information disclosure requests should be given a meaning which defines the relationships between the parties to such proceedings, and they should be interpreted accordingly.

To sum up this portion of considerations about information disclosure requests, we could say that the proposed provisions adequately define the procedural roles of the requester and the addressee of the information disclosure request. It seems more difficult, however, to define the premises which necessitate the application of that construct. Going back to the wording of the Directive, particular attention should be paid to the requirements which precondition acceptance of the request, that is a "justified and proportionate" demand of the claimant. In that respect, the proposed wording introduces new premises compared to the current wording. In place of "high probability" of the obligee's claims, the bill introduces a requirement that credible circumstances of the infringement must be demonstrated. The semantic proximity of those two premises is evident; however, their legal understanding may still provoke criticism. Nevertheless, given the opinions voiced in the doctrine, unstable case law

and, last but not least, the ruling of the Constitutional Tribunal, the attempt to introduce a new criterion for accepting an information disclosure request may be considered a sort of compromise. The essence of the problem with information disclosure requests boils down to finding such a level of demonstrating the probability of an infringement which is not equivalent to certainty – which is formally guaranteed once the hearing of evidence is fully completed – but the credibility of facts presented by the obligee should be high enough to accept the obligee's request. Assuming that information disclosure requests may be – which is supported by the Directive – examined before commencement of the actual infringement suit, the fact that the order regarding the information disclosure request may state that there was an infringement of a right should not prevail over the findings during the suit, and certainly not be binding on the court. It should, therefore, be accepted that when looking for adequate premises for the requests in question, using the phrase “demonstration of reliable circumstances of the infringement” gives procedural guarantees to both parties to the proceedings – the obligee and the infringer. It should be uncontroversial to say that the undoubtedly special construct of information disclosure requests creates its own evidentiary standards and requirements. When it comes to auxiliary proceedings, the purposes are not identical, and therefore the premises are not identical; this has already been stated above, but also criticised, for example, in the case of a defective connection that has been made between information disclosure requests and injunction requests under the current provisions of Article 286<sup>1</sup> of the Industrial Property Law.

It should also be noted that the proposed provisions contain an additional requirement that the disclosure of information serves the purpose of defining the claim. Although such a premise is not found in the Directive, one could defend the argument that it expresses, in a complementary manner, the need for the request to be justified. Such an approach would be consistent with the Directive, which mentions the requirement of the request being “justified”. The judge's evaluation of whether the information disclosure request lies within the boundaries of the future claim could serve as verification of its legitimacy. That way, in addition to evaluating whether the requester has credibly presented the circumstances of an infringement of its right, there would also be a possibility of controlling whether the information is serving the purpose of formulating a claim, or, in other words, whether the request for it is justified.

What remains to be investigated is whether the proposed construct provides the possibility of testing whether the principle of proportionality is observed. Such detailed requirements cannot be directly derived from the wording of the new provision itself. However, Article 479<sup>95</sup> proposed in the amendment to the Code of Civil Procedure may come to our aid here. According to that provision: “When applying the measures laid down in Article 479<sup>97</sup>, Article 479<sup>106</sup>

or Article 479<sup>112</sup> § 1, the court shall take into account the interests of the parties to such a degree as to ensure adequate protection for the right holder [obligee] and not to burden the obligor, or the defendant, more than is necessary, while bearing in mind the burden on the defendant and the obligor that would result from the measures applied and the protection of trade secrets”. That provision aims at expressing detailed premises for a kind of ‘proportionality’ test. Without going into doctrine-related deliberations about the essence of the principle of proportionality, the proposed legislative solution could be considered a practical attempt to apply that principle as an actual element in the structure of the new provision.

Another remark on information disclosure requests is that the possibility of adjudicating a disclosure claim is not permissible before a suit is filed. Although issues related to the timing of the request were already controversial at the initial stages of assessing the outcomes of implementation of Directive 2004/48/EC, arguments in support of the possibility of filing such requests before the suit is initiated seem entirely convincing. T. Targosz points out that in some countries, such as France or Spain, it was believed that the construct in question should also be available during the pre-litigation stage<sup>36</sup>. French legislation supports such interpretation. In this respect, of special significance should be, in particular, the Guidance on how to apply Directive 2004/48/EC published by the Commission in November 2017<sup>37</sup>. The document says that – if a Member State provides for such a possibility – a disclosure claim may also be available before the commencement of the suit<sup>38</sup>. An example of a law which permits a disclosure claim only against entities which have already been found to have infringed on a particular industrial property right is German law<sup>39</sup>.

The last of the main objections against the current regulation of the right of information is the issue of preventing abuses related to the use of information

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<sup>36</sup> Synthesis of The Comments on the Commission Report on the Application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the Enforcement of Intellectual Property Rights (COM/2010/779 final), p. 14.

<sup>37</sup> Communication from the Commission to the European Parliament, the Council and the European Economic and Social Committee. Guidance on certain aspects of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights, COM(2017) 708, <http://eur-lex.europa.eu/legal-content/PL/TXT/HTML/?uri=CELEX:52017DC0708&from=EN> [access: 3.12.2019].

<sup>38</sup> The statement in Article 8 of the Directive on the enforcement of intellectual property rights that the order to provide information shall be available “in the context of proceedings concerning an infringement of an intellectual property right” means that the ordering of information disclosure does not have to take place within the same court proceedings. Such an order may be issued in separate proceedings initiated with the objective to seek damages. Depending on the applicable national laws, it may also be issued at an earlier stage as a preliminary order.

<sup>39</sup> See § 19(7) MarkenG; § 140b(7) PatG.

in the context of trade secret protection. The current standards of trade secret protection during court proceedings, which are limited to a general statement that the court is to ensure protection of trade secrets, without listing any specific solutions, have to be deemed insufficient<sup>40</sup>. The issue of trade secret protection in court proceedings has undoubtedly been insufficiently regulated for a long time, and the implementation of Directive (EU) 2016/943 of the European Parliament and of the Council of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure (OJEU L 157/1) has, unfortunately, not made any satisfactory changes in that matter when it comes to provisions on civil procedure<sup>41</sup>.

When it comes to that issue, the bill proposes that where the obligor or the defendant invokes trade secrecy, the court may, in addition, hear the parties. It will be at the court's discretion whether such a hearing would concern one or both parties (assuming that the hearing would not always be obligatory, but would take place in situations actually justified by protection of trade secrets). In this case, however, the president of the court, at the request of the obligee, would set a date for an open session to obtain explanations about the information provided. Thus, this solution shifts the burden of determining the protected trade secrets onto the court, which must, having first analysed the request and the position of persons obliged to disclose information, decide what scope of knowledge is to be provided in order to enable preparation for a suit. The role of the court in examining information disclosure requests is, therefore, decisive and has many far-reaching consequences. If the court decides that the scope of the information requested is to a large extent a trade secret, the requester will be unable to formulate its claims. Giving the obligee access to only a narrow range of information should not, therefore, dictate the necessity to initiate a suit. Such a deficit of information resulting from the need to protect trade secrets should, for that reason, be reflected in the possibility of optional imposition of the obligation to file a pleading to initiate a suit. Difficulties with defining the boundaries of trade secret protection confirm the need to derogate from the unconditional obligation to file a statement of claim.

In the context of the proposed changes to the Code of Civil Procedure, it is also worth noting that the proposed provision of Article 479<sup>113</sup> indicates

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<sup>40</sup> M. Kubiak [in:] A. Michalak (ed.), *Prawo własności przemysłowej. Komentarz*, Warszawa 2016.

<sup>41</sup> Implementation of Directive (EU) 2016/943 of the European Parliament and of the Council of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure (OJEU L 157/1) took place in the Act of 5 July 2018 Amending the Act on Combating Unfair Competition (Dz.U. [Journal of Laws], item 1637).



a requirement when the construct of information disclosure request may be applied to an obligor other than the infringer. In doing so, it uses a new phrase to describe the facts the existence of which warrants an information disclosure request – it makes the validity of such a request conditional upon whether the volume of services provided or the quantities of goods held in one's possession "show that [the obligor] does in fact engage in economic activity". The bill's Reasons say that the bill's drafters used that phrase on purpose to distinguish it from the phrase "in connection with any economic activity conducted". The assumption underlying the bill is that the proposed provisions apply to actual situations, where the "volume" of one's activity, rather than the sole fulfilment of certain formal requirements (such as registration of the business or obtaining of a licence), provides grounds to accept the request<sup>42</sup>. A reference in the bill to being "in fact engaged in economic activity" may, therefore, serve the purpose of emphasising its autonomy, while still being able to refer to such features of economic activity as being profit-oriented, of an organised nature, and continuity. This direction of changes seems to be consistent with Article 8 paragraph 1 point (a) and (b) of the Directive, which uses the phrase "commercial scale" when referring to the activity of a third party. As regards the current Article 286<sup>1</sup>(1) of the Industrial Property Law, it should, on the other hand, be noted, that the activity of a third party must have "the purpose of obtaining, directly or indirectly, profit or other economic gain" and may not be the activity of "consumers acting in good faith". The differences between those regulations are not significant and, although there are arguments in favour of approximating the wording of the Polish provisions to the Directive, a change in that respect does not seem necessary.

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<sup>42</sup> The latest publications of the European Commission – in particular the document of 29 November 2017 – Communication from the Commission to the European Parliament, the Council and the European Economic and Social Committee: Guidance on certain aspects of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights, contain some remarks which enable making that concept more precise. The Communication notes that the concept of 'commercial scale', as provided for in Article 6(2), 8(1) and 9(2) of Directive 2004/48/EC, should be interpreted and applied taking into account qualitative elements, such as the economic or commercial advantage which may be pursued by the infringements in question, as well as quantitative elements, such as the number and extent of the infringements, which are relevant in the case at hand. In relation to Article 61 of the TRIPS Agreement, it has also been argued in the relevant literature that an infringement of a copyright on a commercial scale means actions performed "in a continuous manner in order to obtain financial gain" (M. Barczewski, *Traktatowa ochrona praw autorskich i praw pokrewnych*, Kraków 2007, p. 149). In connection with the Directive, it has also been argued that "activity on a commercial scale means any activity directed at obtaining, directly or indirectly, economic profit or other commercial gain" (P. Podrecki, *Środki ochrony praw własności intelektualnej*, Warszawa 2010, LEX/el).

In the context of amendments concerning information disclosure requests, it can also be said that a provision which defines the scope of the request that may be filed by the obligee is necessary. It needs to be strictly defined by a closed catalogue and concern only the information listed at length. The scope of information requested in information disclosure requests is exhaustively and adequately indicated in, for example, the current Article 286<sup>1</sup> paragraph 2 and 3 of the Industrial Property Law. Given the fact that it strictly corresponds to the provisions of Directive 2004/48/EC, that provision should remain unchanged<sup>43</sup>. Due to the specific nature of information disclosure requests, it is also justified that this scope applies to persons other than the infringer.

To sum up the legislative work that is currently taking place on information disclosure requests, it can be concluded that the proposed changes to the Code of Civil Procedure may ensure consistency of provisions on information disclosure in all legal acts in intellectual property law. It should also be assumed that Article 296<sup>1</sup> of the Industrial Property Law, which is being amended within a separate legislative path, may be successfully used in order to make the changes introduced by the amendment of the Code of Civil Procedure in other acts. The wording of Article 296<sup>1</sup> of the Industrial Property Law mentioned above fulfils the requirements arising from the ruling of the Constitutional Tribunal of 6 December 2018 in case SK 19/16 and preserves the necessary level of regulation arising from the provisions of Directive 2004/48/EC. For the purpose of determining the legal nature of the right of information in intellectual property law, it is particularly important to preserve the general statement that information disclosure requests are independent procedural measures. Furthermore, it needs to be emphasised that exercising the right of information should continue to be dependent on the court's verification of the justifiability and proportionality of the demand to provide information<sup>44</sup>. An information disclosure request may also precede further stages of seeking civil law claims. This means that a request to order the disclosure of information may be filed with a court also before filing a suit. The right of information should, therefore, be exercised in such a way as to also permit the possibility of seeking the disclosure of information independently of any injunction proceedings. This does not preclude any situations in which information disclosure requests and injunction requests are filed jointly. Requests to order the disclosure of information may be filed against both the

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<sup>43</sup> This is the direction in which the Court of Appeal in Warsaw leaned in its ruling, stating that "the subject-matter range of the disclosure obligation is specified in Article 286<sup>1</sup>(2) of the Industrial Property Law, and, due to the specific nature of that provision, and because of the construct of disclosure request as such, shall not be subject to broad interpretation" (Ruling of the Court of Appeal in Warsaw of 20 September 2012 in case I ACA 251/12, Legalis).

<sup>44</sup> Cf. A. Nowak-Gruca, *Roszczenie informacyjne w ustawie Prawo własności przemysłowej w świetle ekonomicznej analizy prawa*, "Monitor Prawniczy" 2008, no. 15, p. 798.

alleged infringer and a third party. The premise for accepting such a request is showing that the requested information is necessary for the purpose of seeking the identified claim arising out of an infringement. It should also be added that the request may be accepted only after a hearing, and the court's decision shall have the form of an order and may be appealed against through a complaint. The information which the alleged infringer or a third party is obliged to disclose may only concern the items explicitly stated in the wording of the provision. Finally, it has to be said that the form of the 'information disclosure request' construct proposed in the amendment to the Industrial Property Law seems to be more synthetic and more closely corresponds to the provisions of Directive 2008/48/EC than the new provisions proposed in the draft amendment of the Code of Civil Procedure.

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## SUMMARY

This article discusses the proposed legislative changes which aim to introduce a special court into the Polish court system that would handle intellectual property matters. The need to introduce a separate adjudication track for cases regarding intangible property rights, and in particular intellectual property rights, seems to be validated by the numerous demands from businesses and representatives of collective management organisations and of jurisprudence. The bill is part of a vast exercise to amend civil procedure law, but, to a large extent, has an impact on the substantive provisions of Industrial Property Law and the Act on Copyright and Related Rights. A substantial portion of the doctrine-related considerations addressed in this article is, however, about selected issues related to the new laws on remedies available in intellectual property law proceedings. In particular, they include provisions which enable the disclosure of information on intellectual property right violations. An analysis of the provisions on information disclosure requests is also important for another reason: it touches upon the essential issue of the extent and balance of protection between the intellectual property right holder and the alleged infringer. In this context, we should also look into the legal situation of persons who are not directly identified as intellectual property right infringers, but may have knowledge of infringements. In the light of Polish legislation, delineating the boundaries of protection for intellectual property right holders has not only become an issue requiring interpretation of the relevant provisions within both the judicature and the doctrine, but has also given rise to the need to verify the constitutionality of those provisions. In this respect, the Constitutional Court ruling of 6 December 2018 (SK 19/16) is of particular importance. For the purpose of determining the legal nature of the right of information in intellectual property law, it is particularly important to preserve information disclosure requests as independent procedural measures. Furthermore, it needs to be emphasised that exercising the right of information should continue to be dependent on the court's verification of the justifiability and proportionality of the demand to provide information. An information disclosure request may also precede further stages of seeking civil law claims. Requests to order the disclosure of information may be filed against both the alleged infringer and a third party. The premise for accepting such a request is showing that the requested information is necessary for the purpose of seeking the identified claim arising out of an infringement.

**Key words:** Polish court system, Intellectual property law, Industrial Property Law, Copyright and Related Rights, Information disclosure request