

# Kluwer Trademark Blog

## Polish Constitutional Tribunal says a claim for information in trademark disputes is not constitutional

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The Polish Constitutional Tribunal issued a long-awaited judgment in December 2018 regarding a claim for information under the Polish Industrial Property Act (case no. [SK 19/16](#)). It ruled that a trademark owner cannot claim for information against an auction portal to disclose information about entities selling goods and about the quantity and prices paid for these goods, as this claim is inconsistent with the Constitution.

### Legal issue at stake

A claim for information is only partially codified in the Polish Industrial Property Act. It grants the party whose trademark rights have been infringed the right to certain information regarding a) the origin and b) the distribution channels of the goods infringing the trademark. This includes purchase and sale prices and sales outlets. This was supposed to transpose the EU Enforcement Directive 2004/48 and has been applied into Poland since 2007. Since then there has been a fierce discussion among Polish scholars on this matter.

### Facts

In practice we observe many trademark infringement cases concerning auction portals. A complaint was brought by a company which runs an auction portal, where the District Court in Warsaw - acting as the EUTM court - forced the claimant (a German company) to provide information about the origin of the elements marked with trademarks, offered through the portal by two users operating under pseudonyms. The court ordered that the infringer provides: companies or names and addresses of sellers, amounts put up for sale and sold by the sellers under the indicated trademarks, and amounts obtained from the sale of these goods. The German company also lost on appeal. Its complaint to the Constitutional Tribunal was successful.

The Tribunal upheld the company's position and recognized art. 286 (1) par. 1 point 3 non-constitutional. The claim for information is not proportionate and thereby infringes the freedom of commercial activity. The Tribunal applied the proportionality criterium regarding information obligations incumbent on third parties. The alleged

infringer must provide the trademark owner with the requested information, whereas the trademark owner does not need to launch or further pursue the infringement claim. The civil courts cannot verify how requested information is used – whether only for a compensation claim or also as a means of gaining insight information from a competitor against a trade secret protection? Also, the Tribunal pointed out that any means of trademark protection in the market should match its prevention or compensation aims and thereby the information claim is linked to the court's ruling on trademark infringement. Taking the claimant's side, the Tribunal finally underlined that the national legislator, when implementing the Directive, did not correctly balance the interests of the right holder and its market competitors.

### **Further controversy?**

Even prior to the judgment the Polish rule on claim for information in industrial property matters was heavily criticised for alleged inaccurate implementation. The strict approach of the Polish Constitutional Tribunal however, might have opened a can of worms. We now observe in the Polish market that infringers already use this judgment in pending trademark litigations, stating that the claim for information is completely inadmissible in Poland. Also, this judgment follows earlier judgments of the Tribunal regarding trademark owners' claims in IP disputes (see case no. [SK 32/14](#)). Clearly the Polish Constitutional Tribunal took IP matters on the radar. Yet, this is a result of growing importance of the IP market in the CEE.

### **Upcoming changes?**

There is light at the end of this tunnel. The Polish Government has decided to reform the Industrial Property Act. The debate launched in early 2018 and the proposed reform comprises of significant changes in patent, trademark and design issues. The aim is to remodel industrial property laws to comply with recent judgments of the EU Court and legislation, as well as more effectively balance the interests of stakeholders in the Polish market. The draft legislation expressively provides for the claim for information against a third party, provided the plaintiff makes an IP infringement sufficiently credible. It also provides for protection of trade secrets in connection with the information claim.

The new Industrial Property Act is expected to be effective as of autumn this year. Watch this space!

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