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## POLAND: From letters of consent to abandonment of the *ex officio* examination of relative grounds

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 In two significant legislative steps, Poland has changed its overprotective approach to earlier rights in trademark application proceedings.

Traditionally, the Polish Patent Office (PPO) examined relative grounds for refusal *ex officio*. It refused to register trademarks identical or confusingly similar to those covered by earlier registrations or applications, even if the owner of an earlier mark had given his consent to such registration. Following several (not so user friendly) decisions by the administrative courts, letters of consent **ceased to be accepted** by the PPO at all, even in cases involving closely related entities. Such policy was justified by the public interest reasons (the need to protect consumers, etc.) but at the same time it led to many artificial conflicts between peacefully co-existing market operators and adversely affected the competitiveness with the CTM (now EUTM) registration system.

After the recent amendments to the Polish IP Law, the PPO will no longer be a “do-gooder”. The first amendment, effective as from **December 1, 2015**, has introduced explicitly “**classic**” **letters of consent** as a measure to overcome earlier rights’ citations by the PPO (still made on an *ex officio* basis). It is now possible to obtain registration of a similar, or even identical, trademark if the owner of the earlier mark agrees thereto in writing. The new rule is expected to be applied only to marks filed on or after December 1, 2015 but there are also voices that it should have a retroactive effect, i.e. also in respect of applications pending on that day (the latter view being in the spirit of the changing laws and in line with Art. 4(5) of the “old” EU TM Directive – Art. 5(5) of the new one).

But the real revolution is yet to come. Starting from **April 15, 2016**, there will be no *ex officio* examination of relative grounds for refusal by the PPO. A brand **new opposition procedure**, inspired (at least in part) by the procedure applied at OHIM (now EUIPO), has been introduced by another act amending the IP Law. It diametrically changes the trademark application proceedings, switching from the full examination system (with post-grant oppositions only) to **the “classic” opposition system**. In a nutshell, the new procedure will be as follows.

Every trademark application filed on or after April 15, 2016 will be first disclosed by the PPO in its on-line database (within 2 months of the filing date) and then officially published in the PPO’s Bulletin, provided that no absolute grounds for refusal have been found in the course of *ex officio* examination. In the meantime, third parties can submit their **observations** as to the existence of such absolute grounds (what is interesting, including also bad faith). Actually, such observations

can also be submitted after the official publication and still may result in refusal based on absolute grounds. Within **3 months** following the publication, **an opposition** may be filed by the proprietor of an earlier mark or, interestingly, other earlier right. This will open the opposition procedure, which is separate from the main application proceedings and requires a separate decision. A **cooling-off period**, lasting from 2 up to 6 months, is envisaged as part of the opposition procedure, preceding the actual *inter partes* phase. During the latter phase, all arguments and evidence will need to be provided by the parties within the deadlines appointed by the PPO, otherwise – as a principle – they will be disregarded. In his defense, the applicant will be entitled to raise **a non-use objection** against the earlier trademark on which the opposition has been based (without a need of instituting separate revocation proceedings). The whole procedure will be conducted in writing, with a hearing option (left to the PPO's discretion) at second (“appeal”) instance.

So, everything looks quite clear and easy, at least in theory. All these changes – aimed to simplify and expedite trademark application proceedings before the PPO (currently taking more than 1 year) – are very much welcome by Polish practitioners. There are obviously some loopholes and pitfalls which have already been identified by this author and he will always be happy to discuss them offline.

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