

Regulation of the Prime Minister
of 8 July 2002
on filing and processing of trademark applications
(as amended on 14 June 2005)

By virtue of Article 152 of the Act of 30 June 2000 – Industrial Property Law (Journal of Laws of 2001, No 49 text 508 and of 2002, No 47 text 676, No 108 text 945, and No 113 text 983) the following is decreed:

Chapter 1
General provisions

1. This Regulation regulates:

- (i) the detailed requirements for filing trademark applications;
- (ii) the detailed extent and procedure of processing trademark applications.

2. References in this Regulation to:

- (i) “the Law” mean the act of 30 June 2000 – Industrial Property Law,
- (ii) “Patent Office” mean the Patent Office of the Republic of Poland,
- (iii) “applicant” mean the person who is, on his own behalf, filing the trademark application with the Patent Office,
- (iv) “Nice Agreement” mean the Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised in Stockholm on July 14, 1967 and in Geneva on May 13, 1977, and amended on September 28, 1979 (*Wiadomości Urzędu Patentowego of 1997 No 5 text 110*),
- (v) “Vienna Agreement” mean the Agreement Establishing an International Classification of the Figurative Elements of Marks, done in Vienna on June 12, 1973 and amended on October 1, 1985 (*Wiadomości Urzędu Patentowego of 1997 No 4 text 84*),
- (vi) “Madrid Agreement” mean the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised in Brussels on December 14, 1900, in Washington on June 2, 1911, in The Hague on November 6, 1925, in London on June 2, 1934, in Nice on June 15, 1957 and in Stockholm on July 14, 1967, and as amended on October 2, 1979 (*Journal of Laws of 1993 No 116 text 514*),
- (vii) “Protocol Relating to the Madrid Agreement” mean the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid on June 27, 1989 (*Wiadomości Urzędu Patentowego of 1997 No 3 text 52*),
- (viii) “international application” mean an application for the international registration, filed with the International Bureau through the intermediary of the Patent Office under the Madrid Agreement or the Protocol Relating to the Madrid Agreement,

- (ix) “international registration” mean the registration by the International Bureau under the Madrid Agreement or the Protocol Relating to the Madrid Agreement of the trademark having effect on the territory of the Republic of Poland,
- (x) “International Bureau” mean the International Bureau of the World Intellectual Property Organization;

3. The provisions of this Regulation governing trademarks shall apply accordingly to collective trademarks and collective guarantee trademarks.

Chapter 2 Trademark application

4.-(1) The trademark application referred to in Article 138 of the Law, shall in particular contain:

- (i) a request,
- (ii) where the applicant wishes to take advantage of the priority of an earlier application, the priority document,
- (iii) where the priority document states a person other than the applicant – an applicant’s statement of the grounds on which his right for claiming the priority is based,
- (iv) five reproductions (photographs or photo-copies) of the trademark presented or expressed, at least in part, in a form of a drawing or drawings or a combination of colours,
- (v) in case of colour trademarks, additional two reproductions (photographs or photo-copies) in black and white,
- (vi) in case of a sound trademark, two record-copies or two copies of other electronic carrier with the sound recorded,
- (vii) the document in evidence of the authorisation or permission to use certain signs in the trademark in the cases specified in Article 131(2)(ii)-(iv) of the Law,
- (viii) where the applicant applies for the grant of a right of protection for a collective trademark, a collective guarantee trademark or for the grant of a joint right of protection, the regulations governing use of the trademark,
- (ix) where the applicant has a representative, the power of attorney.

(2) The statement referred to in paragraph (1) (iii) shall be submitted together with the priority document within the time limit prescribed in Article 139 of the Law.

(3) Letters, numerals and inscriptions presented in a particular graphical form or in colours, as well as signs containing the letters of other alphabets than Latin or numerals and numbers other than Arabic or Roman, shall be considered the drawings referred to in paragraph (1)(iv).

(4) The power of attorney furnished in the cases referred to in Article 239 of the Law, in a form of a statement shall be accompanied by a copy of the authorisation, referred to in that Article.

5.-(1) The request referred to in section 4(1)(i) shall in particular contain:

- (i) the surname and first name or the name of the applicant together with his address, and the tax identification number (NIP), as well as the PESEL number and the REGON number, if any;

- (ii) where the applicant acts through the intermediary of a representative – the surname and first name of the representative together with his address;
- (iii) a petition for the grant of a right of protection for a trademark, or for a collective trademark, or a collective guarantee trademark, or for the grant of a joint right of protection,
- (iv) the determination of the trademark,
- (v) the names of the goods, for which the trademark is intended,
- (vi) the signature of the applicant or, where the applicant acts through the intermediary of a representative, the signature of the representative.

(2) Where the application is filed in the name of the State Treasury by a government agency or a state organisational unit that does not enjoy the status of legal person, the name of that agency or that unit shall be indicated as the applicant, referred to in paragraph (1)(i); where a person signing the request on behalf of the applicant is not an appointed representative, he shall indicate his post held.

- (3) The request referred to in paragraph (1) shall also contain:
- (i) where the applicant wishes to take advantage of the priority of an earlier application, a declaration claiming the priority of that earlier application, together with the indication of at least the date and the country of filing of the first application or the name, place and country of an exhibition and the date of the display in the exhibition of the product bearing the trademark,
 - (ii) where there are two or more applicants and they do not act through the intermediary of a common representative, the indication of a person authorised to be served upon communications,
 - (iii) the list of the documents annexed.

6.-(1) The determination of a trademark, referred to in section 5(1)(iv), shall be made by way of its presentation or expression in the request in a graphical form, and by the definition of its kind and its description, if necessary.

(2) The trademark, depending on its kind, shall be presented or expressed in the following manner:

- (i) where the trademark is a letter, a numeral, an inscription, a drawing or a combination of colours, it shall be included in that form in the request,
- (ii) where the trademark consists of a number of separate parts intended for use in their combination (label, counter-label, tag), these parts shall be placed side by side, in a manner corresponding to their actual arrangement on the product,
- (iii) where the trademark is a three-dimensional mark, it shall be presented in a form of a drawing representing its overall appearance or, where its distinguishing features appear on different planes, in a form of drawings placed side by side,
- (iv) where the trademark, in particular a melody, is not eligible for immediate graphical illustration, it shall be expressed indirectly in the request by means of a graphical notation enabling it to be reproduced (music notes, letters illustrating articulated sounds).

(3) Colour trademarks shall be presented in colours, the used colours being specified and, if necessary, their detailed parameters (shades) determined, as well as, in respect of each colour, the parts of the trademark indicated which are in that colour.

(4) In the case, referred to in paragraph (2)(i), where the mere presentation of the trademark is not sufficient for its complete illustration, a description of the trademark shall be included.

(5) In the cases, referred to in paragraph (2)(ii) and (iii), the description of the trademark shall be included in the request with an explanation as to what it represents and, if necessary, in what way it is intended to be used.

(6) In case of any trademark containing letters, numerals, numbers or inscriptions, the description of the trademark shall contain:

- (i) a translation of the inscriptions in foreign languages, if the corresponding expressions thereof in the Polish language exist,
- (ii) where the letters of an alphabet other than Latin, or numerals other than Arabic or Roman have been used, a transliteration in the letters of the Latin alphabet and in the Arabic or Roman numerals.

(7) Where the inclusion of the description of the trademark has been found not to be necessary, a space intended for its inclusion shall be filled in with an annotation: "As presented".

(8) In the case referred to in paragraph (2)(iv), a kind of the trademark shall be specified and, if required for the identification of the trademark, the necessary information provided on how the trademark is perceived by the public.

(9) If it is infeasible for the trademark to be included in the request due to its details that have to necessarily be illustrated, the trademark may be presented on a separate sheet of A4-format.

7.-(1) The goods for which the trademark is intended shall be indicated in a form of a list of the goods.

(2) When establishing the list of the goods, referred to in paragraph (1), the corresponding classes for specific goods, hereinafter referred to as "classes of goods", shall at the same time be indicated according to the up-dated classification applicable under the Nice Agreement.

(3) Where the product for which the applicant wishes to register the mark is not mentioned in the classification, referred to in paragraph (2), the product shall be classified by reference to the criteria adopted in the general comments to that Classification.

(4) The list of the goods, referred to in paragraph (1) may not include expressions irrelevant for the scope of the protection sought.

(5) The list of the goods shall be presented in the order of the classes.

(6) Separate sheets of the list of the goods, established in accordance with the provisions of Article 141(1) of the Law, shall be of A4-format and filled in with typewritten letters with 60 characters in a line and spaces between the lines of 6 mm.

8.-(1) The document of the priority of an earlier application shall consist of:

- (i) a copy or a duplicate of that application, certified as a true copy by a competent authority with which the application was filed,

- (ii) a certificate issued by the authority mentioned in sub-paragraph (i), with the indication of the date and number of the application and, when applicable, the date of the display of the product bearing the trademark in the exhibition referred to in Article 126 of the Law.

(2) The document of the priority of the prior display of the product bearing the trademark applied for protection shall consist of:

- (i) a certificate issued by the organiser of the exhibition in confirmation of the display of the product bearing that mark,
- (ii) where the exhibition was organised in another country, a document stating that the exhibition was an official or officially recognised international exhibition.

(3) The certificate referred to in paragraph (2)(i), shall contain:

- (i) the surname and first name or the name of the exhibitor,
- (ii) the name and the place of the exhibition and its duration,
- (iii) the date of the display of the product,
- (iv) a statement of the identity of the trademark and the displayed products, with a photograph or a photo-copy of the mark and the list of the goods enclosed.

(4) The applicant's statement of the grounds on which his right for claiming the priority is based, referred to in section 4(1)(iii), shall contain:

- (i) the surname and first name or the name of the person, in whose favour the priority document has been issued,
- (ii) the surname and first name or the name of the applicant,
- (iii) the indication of the grounds on which the right of claiming the priority is based,
- (iv) the signature of the applicant or of his representative and the date.

9.-(1) Photographs or photo-copies of the trademark may not, subject to paragraph (3), be of a size smaller than 30 mm x 30 mm and larger than 50 mm x 50 mm.

(2) A photograph or a photo-copy of the trademark may be made by means of any method available enabling them to be reproduced.

(3) Where the size of 50 mm x 50 mm is not large enough to illustrate the details of the trademark, the photographs or photo-copies of the trademark may be of a size not larger than 100 mm x 100 mm.

10. *repealed*

11.-(1) The request referred to in section 4(1)(i) shall be drawn up in the Polish language.

(2) Where the priority document, referred to in section 4(1)(ii), has been drawn up in a language other than the Polish, English, French, German or Russian language, it shall be accompanied by a translation into one of the above languages.

(3) Where the documents, referred to in section 4(1)(iii) and (vii) – (ix), have been drawn up in a language other than the Polish language, they shall be accompanied by a translation into that language.

(4) Subject to paragraph (2), the Patent Office may require furnishing a translation of any document drawn up in a language other than Polish.

(5) Documents drawn up in another country shall comply with the applicable law in that country or with the provisions of respective international agreements.

(6) *repealed*

Chapter 3 Processing of trademark applications

12.-(1) After having received a trademark application the Patent Office shall immediately proceed with the action, referred to in Article 41(1) of the Law.

(2) Where the application has been filed by means of telefacsimile, the Patent Office shall, after having received the original copy of the application, ascertain the date of its receipt and check its identity with the telefacsimile.

(3) Where the Patent Office finds that the original copy of the application has been received 30 days after the date on which the transmission of the telefacsimile effected or that it is not identical with the application transmitted by means of telefacsimile, or, because of the telefacsimile copy being illegible, the trademark applied for protection or the list of the goods indicated in the original copy can not be identified, the date of receipt of the original copy shall be deemed to be the filing date of the trademark application, which fact shall be confirmed by way of order.

(4) Where the Patent Office finds that the trademark has not been determined in the application or the list of the goods for which the trademark is intended has not been indicated, it shall request the application to be completed in accordance with the provision of Article 31(4) of the Law.

13.-(1) Where the application has been filed by a person pretending to be a representative and the Patent Office finds that the document of the power of attorney has not been furnished together with the application, it shall invite that person and the applicant to remedy this omission within the fixed time limit, failing which shall result in the discontinuance of the proceeding.

(2) In the case referred to in paragraph (1), the applicant may, together with the confirmation, at the same time, of the validity of the act done, continue to act by himself or appoint another representative.

14.-(1) Where the Patent Office finds that the filing fee has not been paid, it shall invite the applicant to pay the fee within one month from the date on which the applicant has been served upon the invitation, failing which shall result in the discontinuance of the proceeding.

(2) The provision of paragraph (1) shall apply to a national fee for filing of an international application.

15.-(1) Where the applicant has failed to file divisional trademark applications within the fixed time limit or has failed to pay the relevant filing fees, the application shall be deemed to

cover the trademark first mentioned in the application. In that case, the application in respect of the remaining trademarks shall be deemed withdrawn and the proceedings shall be discontinued.

(2) Where the applicant fails to file the divisional trademark applications in the fixed time limit, the application shall be deemed to relate to the trademark first determined in the request. In that case, the application shall be deemed to be withdrawn in respect of remaining trademarks, and the proceeding shall be discontinued.

16.-(1) At an applicant' request, the Patent Office shall issue the priority document referred to in Article 128 of the Law.

(2) The priority document referred to in paragraph (1), shall consist of a certificate issued by the Patent Office and of a copy of the request furnished in the application which constitutes a ground for the filing date to be established.

(3) The certificate, referred to in paragraph (2), shall state:

- (i) the surname and first name or the name of the applicant and the place of his residence or of place of his business,
- (ii) the filing date and number.

(4) The Patent Office shall confirm in the certificate, referred to in paragraph (2), that the attached copy is a true copy, and, before the priority document is issued a change in the person of the applicant has been effected, a relevant annotation to that effect shall be mentioned in that certificate.

(5) In the certificate, referred to in paragraph (2), the Patent Office shall make an annotation on the date of the earlier priority sought by the applicant in the case of the product bearing the trademark having been earlier displayed in the exhibition referred to in Article 126 of the Law.

(6) The certificate referred to in paragraph (2) shall be sealed and signed by a person authorised in writing to do that by the President of the Patent Office.

17.-(1) The Patent Office shall publish the particulars of the trademark application in the official gazette "*Biuletyn Urzędu Patentowego*" in accordance with Article 143 of the Law, containing the following indications:

- (i) the filing number of the trademark application,
- (ii) the filing date of the trademark application,
- (iii) the date and the country of the earlier application and the number of the application or the determination of the exhibition,
- (iv) the surname and first name or the name of the applicant, his place of residence or of seat and the access code of the country,
- (v) a category of the trademark or of the right of protection, where the application concerns the collective trademark, the collective guarantee trademark or the joint right of protection,
- (vi) the definition of the trademark,
- (vii) indication by the applicant of the classes of goods, referred to by in section 7 (2).

(2) The classes of goods, referred to in section 7(2), indicated by the applicant in the list of goods, shall not be liable to correction for the purpose of publication, unless the applicant himself makes relevant changes before the publication.

(3) As from the date of publication of the mention of the filing of the trademark application, the indications contained in the request, referred to in section 4(1)(i), to the extent corresponding to the contents of the publication, the mark presented in the request and the goods for which the mark is intended, shall be made available to the public in the library of the Patent Office or a printing copy containing the above data may be made on request.

18. *repealed*

19.-(1) With regard to the condition laid down in Article 142 of the Law, the Patent Office itself may also make corrections in the list of the goods, in relation to:

- (i) *repealed*
- (ii) the indication of the names of the goods corresponding to those used in the Classification, referred to in section 2(iv), where the applicant has used popular or slang expressions or expressions commonly used only in a given line of business, and the equivalent expressions exist in the Classification,
- (iii) the order in which the goods are grouped in the list, in a manner corresponding to the order of the classes of goods.

(2) The corrections referred to in paragraph (1) shall be made by the Patent Office to the extent, as it is not required for the list of the goods to be rewritten in order to maintain its legibility.

(3) *repealed*

(4) *repealed*

20. Where the applicant indicates correctly and clearly the name of the good for which the trademark is intended, the Patent Office may not make any corrections or demand a change to be made merely because such good is not mentioned in the Classification referred to in section 2(iv).

21. When justified, the Patent Office may invite the applicant to furnish, within a time limit as may be fixed by it, evidence and explanations in particular in support of his entitlement to seek protection or to claim the right of priority.

22. Before the order referred to in Article 48 of the Law is issued, the Patent Office shall notify the applicant of the facts that bar the grant of the right of priority and fix a time limit for furnishing explanations or for removing defects.

23.-(1) Where the Patent Office reveals the obstacles for the grant of a right of protection in respect of at least a part of the goods, it shall notify the applicant accordingly and fix a time limit for furnishing his comments or making corrections whereby the obstacles are removed. Where some of the goods bearing a different trademark are deemed to constitute an obstacle for the grant of a right of protection, they shall be indicated in the notification.

(2) Failing by the applicant to react within the fixed time limit shall not release the Patent Office from an obligation to re-examine the matter before a decision on refusal to grant a right of protection is taken.

24.-(1) A decision on the grant of a right of protection for a trademark may be taken by the Patent Office after the expiry of the time limit referred to in Article 44 (1) of the Law.

(2) In the decision, referred to in paragraph (1), the following shall, in particular, be indicated:

- (i) the number and the date of the filing of the trademark application,
- (ii) the definition of a category of the mark or of the right of protection,
- (iii) the trademark to be the subject matter of the right of protection,
- (iv) the list of the goods grouped according to the relevant classes of goods, including the corrections made in accordance with section 19.

(3) The provisions of paragraphs (1) and (2) shall apply accordingly to the decision on the grant of a right of protection for a part of the goods and to the decision on refusal to grant such a right in respect of the remaining part of the goods.

25.-(1) Upon the entry in the Trademark Register of the granted right of protection, the Patent Office shall issue a certificate of protection for the holder of the right, containing:

- (i) confirmation of the grant of the right of protection or of the joint right of protection for the trademark, the collective trademark or the collective guarantee trademark,
- (ii) indication of the holder of the right and the number of the right, referred to in subparagraph (i),
- (iii) determination of the trademark,
- (iv) indication of the date of filing and of the number of the application,
- (v) indication of the right of priority,
- (vi) the date of the decision on the grant of the right of protection,
- (vii) the list of the goods grouped according to the relevant classes of goods,
- (viii) the number and year of the publication of the gazette "*Wiadomości Urzędu Patentowego*", in which the mention of the grant of the right of protection was published.

(2) The certificate of protection shall be sealed and signed by a person authorised in writing by the President of the Patent Office.

26. In the announcement on the grant of the right of protection in the gazette "*Wiadomości Urzędu Patentowego*", the following indications shall be published:

- (i) the number of the right of protection, the filing date and the number of the application and the date of the publication of the application,
- (ii) the date of the decision on the grant of the right of protection,
- (iii) the category of the trademark or, where the joint right of protection or the collective trademark, or the collective guaranteed trademark is involved, the category of the right granted,
- (iv) the surname and first name or the name of the holder, his place of residence or of seat and the code of the country,
- (v) determination of the trademark with the indication of colours and the symbols of the Classification of the figurative elements of marks, adopted under the Vienna Agreement, and a kind of the trademark, if necessary,

- (vi) the goods grouped according to the relevant classes of goods.

Chapter 4 Processing of international registrations

27.-(1) Immediately after the Patent Office is notified by the International Bureau of an international registration, the Patent Office shall publish the information on that registration. The provision of section 17(3) shall apply accordingly.

- (2) The information, referred to in paragraph (1), shall contain:
- (i) the registration number in the international register of trademarks,
 - (ii) determination of the trademark presented in a form of letters or numerals and, if applicable, indication of the symbols of the classes of figurative elements of the mark, and, if necessary, a kind of the mark,
 - (iii) indication of the classes of goods in respect of the goods for which the trademark is intended.

(3) In the course of processing of an international registration, the Patent Office shall examine whether the trademark being the subject matter of that registration may be granted protection in the Republic of Poland.

(4) *repealed*

(5) Where in respect of the trademark being the subject matter of the international registration the facts have been found which bar its registration on the territory of the Republic of Poland in whole or in part, the Patent Office shall take a temporary decision on refusal to grant a right of protection and notify the International Bureau accordingly.

(6) In the case referred to in paragraph (5) the Patent Office shall fix a time limit, within which the applicant is invited to furnish his comments in accordance with Article 242(2) of the Law.

(7) Subject to paragraphs (5) and (6), the Patent Office, after having revealed the facts which bar the grant of a right of protection in the territory of the Republic of Poland for the whole or of a part of the trademark being the subject matter of the international registration, shall take a final decision on refusal to grant that right and notify the International Bureau accordingly.

(8) The provisions on legal measures of appeal against decisions on refusal to grant a right of protection for a trademark available to the applicant and the provisions on publication of information on such decisions shall apply accordingly to the final refusal referred to in paragraph (7).

28.-(1) An international registration recognised in the Republic of Poland shall be recorded in the auxiliary register and an announcement of it shall be published in the gazette “*Wiadomości Urzędu Patentowego*”.

(2) The announcement referred to in paragraph (1) above shall, in addition to the indications referred to in section 27(2), contain the following:

- (i) the surname and first name or the name of the holder of the right, his place of residence or seat and the country code,
- (ii) the date of the international registration,
- (iii) the date of publication of the mention of the registration,
- (iv) the date of the designation of the Republic of Poland for the international registration of the trademark.

Chapter 5
The final provision

29. The Regulation shall become effective after 14 days from the date of promulgation.