

Claims available in the scenarios of patent infringement

In this article, we have gathered for you essential information regarding claims that are available in Polish legal system in cases of patent infringement: we are presenting their catalogue with brief descriptions, emphasizing particular possibilities and limitations in terms of their enforcement. At the beginning, it should be mentioned that the relevant provisions of the Act of 30 June 2000 - Industrial Property Law (IPL) constitute an implementation of the [EU directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights](#).

The preventive action

Before we discuss actions that an entitled person can bring once the patent is infringed, it is worth mentioning that **the IPL allows for bringing an action in a situation where an infringement has not occurred yet**. According to Art. 285, a holder of a patent, an SPC (also a right of

protection or rights in registration) or another person authorized by the statute **can request cessation of acts that threaten with a violation of the right.**

In literature, it is pointed out that this provision is related to Art. 439 of the Act of 23 April 1964 - Civil Code, pursuant to which anyone who, as a result of another person's conduct, in particular due to a lack of proper supervision of the operations of an enterprise or establishment run by that person or of the condition of a building or other facility in their possession, is directly threatened with damage may demand that that person undertakes the measures necessary to avert the imminent danger and, if needed, that they give appropriate security. **The provision of Art. 285 of the IPL should be viewed as a more specific law (*lex specialis*) vis-à-vis the regulation that we can find in the Civil Code:** comparing those two provisions, we can notice that **the scope of the application of the preventive claim on the grounds of the IPL is going to be broader** (it is not only going to be available when there is a direct threat of damage — the hypothesis of the provision refers to a more capacious category of “acts that threaten with a violation of the right”), while it does not allow for requesting an appropriate security, unlike Art. 439 of the Civil Code.

Claims available in the scenarios of patent infringement: the catalogue of claims

Moving on to the analysis of the scenarios where an infringement indeed occurs, we have to begin with **Art. 287 of the IPL containing a catalogue of claims that an entitled person can bring.** Those are:

- Cessation of the infringement;
- Return of the profits that were obtained illegitimately;
- Compensation for the prejudice suffered:
 - a) determined in accordance with general principles;
 - b) through payment of a specified monetary amount corresponding with a licensing fee or another appropriate remuneration which — at the moment of their enforcement — would be due for the consent of an entitled person for the use of an invention — the so-called lump sum damages.

Moreover, the court may order, at the request of an entitled person, to publish a part or all of its ruling or information about the ruling in a manner and to the extent specified by the court (Section 2).

Let us add that the pursuit of one of the claims from the catalogue does not preclude an entitled person to advance the others — **the cumulation of claims is possible**, since — as it is

remarked in the Commentary to the IPL edited by Professor Sieńczyło-Chlabicz, “depending on the choice of claims by an entitled person it may turn out that in particular circumstances all of the claims pursued may perform different functions”.

The characteristic of claims as claims ensuing from property rights

The claims that are available in the scenarios of patent infringement can be characterized as property claims, which finds an express support in the case-law of the Polish Supreme Court. For instance, in the decision of the Civil Law Division of the Supreme Court of 16 February 2012 (case no. II CSK 469/11), the Supreme Court stated very strongly that “the claims listed in the [IPL], serving the protection of property rights effective towards everyone (patent, protection of a trademark) **are directly determined by economical interests of the entitled person**” — that justifies considering them property claims. Such a classification entails consequences in terms of the statute of limitations: under Art. 117 of the Civil Code, only property claims are barred by the statute of limitations.

As a side note, also the preventive claim based on Art. 285 is a property claim.

Restitution claims

A. The claim for cessation of an infringement

The claim for cessation of an infringement is described by Profesor Du Vall in “Patent Law” as “the most important claim;” likewise, in the Commentary by Professor Sieńczyło-Chlabicz, it is underscored that it is the claim most often pursued in reality as others are fraught with difficulties in terms of discharging the burden of proof.

- The main goal of the claim is to obtain **an injunction prohibiting the use of the objects of the right in a specific manner.**
- The basis of the claim is the **illegality** of a given conduct. It does not matter whether the conduct can be characterized as culpable.
- An entitled person may formulate the claim in such a way as to demand the prohibition of unlawful actions also in future — as long as there exists a real danger of repeating the infringement.
- The claim for cessation is not the same as the claim for removal of the effects of the infringement.

B. The claim for removal of the effects of the infringement?

The afore-mentioned claim for elimination of the effects of the infringement existed in the Polish legal system before the 2007 amendment, however, in order to adapt Polish regulation to the EU directive, it was eliminated. **Certainly, it should not be equated with the claim for cessation of infringement under Art. 287 of the IPL; it can be, to a certain extent, replaced, however, through the application of Art. 286 of the IPL.**

Pursuant to Art. 286, **the court, deciding on the violation of the law, may rule, at the entitled person's request, on the illegally manufactured or marked products as well as means and materials that were used for their manufacturing or marking owned by the infringer;** in particular, it may order to withdraw them from the market, grant them to the entitled person on account of a monetary amount they were awarded, or destroy them. The provision obliges the court to take into consideration the significance of the infringement and interests of third parties. As remarked by Professor Du Vall, such a ruling may be made only with respect to objects owned by the infringer — thus, “in case they are sold to a third party, the pursuit of the claim will not be available”.

At the same time, it should be noted, following P. Podrecki (the Commentary to the IPL by Professor Sieńczyło-Chlabicz), that **the substitution of the eliminated claim for the removal of effects of the infringement through application of Art. 286 of the IPL would be possible only to a limited extent as this provision “does not provide full compensation”** (on its ground, only claims regarding products, means, and materials can be pursued, but “it is not possible to demand on the basis of Art. 286 [of the IPL], e.g., making an appropriate statement, sending explanatory letters to clients, conducting so-called remedial advertising, etc.).

C. Limitation of the scope of the claim for cessation

It has been indicated that a sufficient basis for the claim for cessation of the infringement is illegality of the conduct, however the mental element of fault is not entirely irrelevant. Art. 287(3) provides that **an alternative is available in the form of an appropriate monetary compensation.** According to that provision, the court may order a person who has infringed the patent, on their request, if they were not at fault, to pay an appropriate monetary amount to an entitled person, if cessation of the infringement or a ruling based on Art. 286 would be disproportionately burdensome for the infringer and the payment of the appropriate monetary amount duly takes into account the interests of the right holder. **The condition that must be fulfilled is the submission of the motion by the infringer; moreover, their subjective attitude is critical: they must not be at fault.** An example of a scenario where that provision might be applied is provided by Professor Du Vall who writes that a lack of fault might be determined if an infringer, before committing an infringement, commissions in good faith independent expertises and relies on a reasonably justified

conclusion derived from them that a particular manufacturing process would not involve the patent infringement.

Compensatory claims

The category of compensatory claims comprehends the claim for the return of illegitimately obtained profits as well as the claim for the compensation of the prejudice suffered.

A. The claim for the return of the illegitimately obtained profits

- The legal qualification of that claim in the doctrine, especially with respect to its relation to Art. 405 of the Civil Code concerning the unjust enrichment, has turned out to be a source of major controversies: **there is no consensus on whether it is a claim based on the unjust enrichment, or an unrelated *sui generis* claim specific for the intellectual property law** (it is worth remarking that the Supreme Court in the judgment of 24 October 2007, case no. IV CSK 203/07, unambiguously affirmed the autonomy of that claim).
- **Determining the size of the profits to be returned might be challenging:** it has been suggested, for instance, to determine them on the basis of a licensing fee that would be due or permit an entitled person to demand the return of all the profits from the trade in products manufactured on the basis of the patent.
- The profits are obtained illegitimately whenever an authorized person uses the object of an exclusive right (unless one of the statutory exceptions occurs).

B. The claim for the compensation of the prejudice suffered

- The general principles of liability for damage established by the Civil Code are applicable here: they include, i.a., the requirement of fault of the infringer, an adequate causal link between a particular conduct and damage, as well as the principle of basing the amount of compensation on both actual damage (*damnum emergens*) as well as lost profits (*lucrum cessans*). Also, in the paragraph 26 of the preamble of the directive 2004/48/EC, it is indicated that “the amount of damages awarded to the rightholder should take account of all appropriate aspects, such as loss of earnings incurred by the rightholder, or unfair profits made by the infringer and, where appropriate, any moral prejudice caused to the rightholder”.
- An entitled person is offered a choice: **either they demand compensation in an amount determined in accordance with general principles, or demand payment of a sum corresponding to the amount of a licensing fee** (or another adequate remuneration).

- Such an alternative is also mentioned in the directive's preamble as an option particularly useful in situations where determining the amount of actual prejudice suffered would be difficult (it can be especially appealing to an entitled person interested in avoiding the costs of evidentiary proceedings).

Who can bring a claim

The provision of Art. 287, indicating who can bring a claim in a case of a patent infringement, **mentions holders of exclusive rights** (such as a patent) **but also “another person authorized by the statute”**. As Professor Du Vall explains, this quite enigmatic term should be construed as encompassing, **e.g., a usufructuary, a pledgee, and especially an exclusive licensee** who, based on Art. 76(6), may, on the same terms as the patent holders, pursue claims regarding patent infringement, as long as the license has been entered in the patent register and its relevant provisions do not provide otherwise.

The statute of limitations

The IPL introduces also a notable temporal limitation **by indicating a timeframe when bringing a claim regarding patent infringement is possible**. On the grounds of Art. 289(1), the limitation period for those claims is 3 years. The same provision specifies that a limitations period starts running on the day when a rights-holder finds out about the infringement as well as about the identity of the infringer, separately with respect to each infringement; however, in any case, it expires 5 years after the day when the infringement occurs. Moreover, it is provided that the limitations period is suspended for a period between the filing of a patent application to the Patent Office and the awarding of the patent (Section 2).