

Question Q230

National Group: Polish

Title: Infringement of trademarks by goods in transit

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Date: May 17, 2012

Questions

I. Analysis of current legislation and case law

The Groups are invited to answer the following questions under their national laws and if applicable their regional/community legislation:

In-transit term

- 1) Does your country's law provide for an "in transit" concept (regardless of the exact terminology)?

Yes, Polish Law provides for an "in transit" concept.

- 2) If yes to question 1, what term is used in your country to describe this concept?

Polish Industrial Property Law does not provide any definition of transit concept with regard to trademarks. On the other hand, Polish Industrial Property Law uses the term of transit with regard to patents. According to Article 69 of Polish Industrial Property Law: "The following shall not be considered acts of infringement of a patent: (i) the exploitation of an invention concerning means of transport or their parts or accessories, temporarily located on the territory of the Republic of Poland, or concerning articles which are in transit through its territory". Moreover, Polish Industrial Property Law uses the term of transit with regard to rights in topography registration. According to Article 213: "The right in registration shall not be considered infringed by applying the topography of an integrated circuit in means of transport or their parts or accessories, temporarily located on the territory of the Republic of Poland, or in articles which are in transit through its territory".

The term "transit" is used in the Council Regulation (EEC) No. 2913/92 of 12 October 1992 establishing the Community Customs Code, which is the part of Polish Law. The most important legal act with regard to trademarks which strictly refers to provision of this Regulation is the Council Regulation (EC) No. 1383/2003 of 22 July 2003 concerning customs actions against goods suspected of infringing

certain intellectual property rights and the measures to be taken against goods found to have infringed such rights. Poland, as an EU member, is bound by these Regulations. Council Regulation (EC) No. 1383/2003 states in its Article 1 that *“This Regulation sets out the conditions for action by the customs authorities when goods are suspected of infringing an intellectual property right in the following situations:*

(a) when they are entered for release for free circulation, export or re-export in accordance with Article 61 of Council Regulation (EEC) No 2913/92 of 12 October 1992 establishing the Community Customs Code;

b) when they are found during checks on goods entering or leaving the Community customs territory in accordance with Articles 37 and 183 of Regulation (EEC) No 2913/92, placed under a suspensive procedure within the meaning of Article 84(1)(a) of that Regulation, in the process of being re-exported subject to notification under Article 182(2) of that Regulation or placed in a free zone or free warehouse within the meaning of Article 166 of that Regulation.”

- 3) If yes to question 1, does your country make any distinction between “customs transit”, “transshipment” and “in-transit”?

Polish Law does not make distinction between “customs transit”, “transshipment” and “in-transit”.

- 4) Does your country's “in transit” concept include for example customs warehouses, free warehouses, free zones and other customs procedures under which the goods are not released for free circulation and are kept under customs control?

In Polish Law “in transit” concept includes customs warehouses, free warehouses, free zones and other customs procedures under which the goods are not released for free circulation and are kept under customs control in accordance with provisions of Polish Customs Law and the Community Customs Code.

Goods in transit – infringement

In the following questions 5-12, “in-transit” refers to the term used in your country.

- 5) Are goods in transit considered to fall within the trademark owner's exclusive right to prevent others from importing goods bearing the trademark?

Yes, the goods in transit might – under certain circumstances – be considered to fall within the trademark owner's exclusive right to prevent others from importing goods bearing the trademark. However, the prevention against such import should mostly concern counterfeit goods or illegal parallel import of genuine goods.

- 6) Taking into account the following scenarios, are goods in transit considered to be infringing in the country of transit if:

- i. goods bearing a trademark are sent from country A (where it is not registered) to country C (where it is not registered) via transit country B (where it is registered).

In such scenario the goods in transit may – under certain circumstances – be considered as infringing in the country of transit.

- ii. the trademark owner has a valid trademark registration only in the country of destination (country C).

In such scenario the goods in transit should not be considered as infringing in the country of transit.

- iii. the trademark owner has a valid trademark registration only in the country of origin (country A).

In such scenario the goods in transit should not be considered as infringing in the country of transit.

- iv. the final destination of the goods is not known at the time of entrance of the goods in the transit country (consider both scenarios – where it is registered in country B and where it is not registered in country B).

The infringed trademark should be registered and valid in the country of transit. Therefore, in the first scenario in case of registration of trademark in country B (the country of transit) the goods in transit may – under certain circumstances – be considered as infringing in the country of transit. In the second scenario (the trademark is not registered in country B – the country of transit) the goods in transit should not be considered as infringing in the country of transit.

- 7) In those scenarios where in-transit goods are considered to infringe a registered trademark right in the transit country:

- i. Would that be the case if it is shown that goods will be or that there is a risk for the goods being illicitly diverted into the market in the transit country?

Yes, it would be the case if it is shown that goods will be or that there is a risk for the goods being illicitly diverted into the market in the transit country (*vide* very recent judgment of the Court of Justice of the European Union (CJEU) *Nokia/Philips* C-446/09 and C-495/09).

- ii. Who has the burden of proof to show that goods will be or that there is a risk for the goods being illicitly diverted into the market of the transit country?

In civil proceeding the main burden of proof rests always with the plaintiff (trademark owner). As a rule, the Court does not consider any evidence *ex officio*.

In criminal proceeding the Prosecutor Office, Customs or Police, in case of filing the motion for prosecution due to counterfeiting of the trademark, are authorized to conduct the investigation and collect the proofs *ex officio*.

The very recent case law (*Nokia/Philips* C-446/09 and C-495/09) should be also taken into consideration in that regard as a crucial for the practice of Polish Civil Courts and Customs Authorities regarding seizures of goods in transit. According to the position of CJEU taken in that judgment:

- trademark owner should prove that the introduction of goods being a subject of external transit or customs warehousing procedures leads to the goods being put on the community market;
- such evidence exists where it turns out that the goods have been sold to a customer within the EU;
- goods are offered for sale or advertised for consumers in the EU;
- the fact that diversion of the goods into the EU is envisaged may derive from documents or correspondence regarding the goods;

- nevertheless of the above the customs authorities may act and either suspend the release of or detain the goods without such evidence if there are indications that an infringement exists;
- such indications could be that the destination of goods is not declared where the customs procedure requires such a declaration;
- the lack of precise or reliable information as to the identity or address of the manufacturer or consignor of goods;
- a lack of cooperation with the customs authorities or the discovery of documents or correspondence concerning the goods suggesting that there is a risk of diversion of these goods to the EU.

iii. What is the nature of evidence that may have to be submitted in this regard?

The main kinds of evidence in civil and criminal proceeding are: witnesses, documents, affidavits, opinions of court appointed experts, opinions of private experts.

In accordance with the very recent judgment of CJEU (*Nokia/Philips C-446/09* and *C-495/09*):

- trademark owner should prove that the introduction of goods being a subject of external transit or customs warehousing procedures leads to the goods being put on the community market;
- such evidence exists where it turns out that the goods have been sold to a customer within the EU;
- goods are offered for sale or advertised for consumers in the EU;
- the fact that diversion of the goods into the EU is envisaged may derive from documents or correspondence regarding the goods;
- nevertheless of the above the customs authorities may act and either suspend the release of or detain the goods without such evidence if there are indications that an infringement exists;
- such indications could be that the destination of goods is not declared where the customs procedure requires such a declaration;
- the lack of precise or reliable information as to the identity or address of the manufacturer or consignor of goods;
- a lack of cooperation with the customs authorities or the discovery of documents or correspondence concerning the goods suggesting that there is a risk of diversion of these goods to the EU.

iv. What is the standard of proof in such cases?

The standard of proof in such cases (witnesses, documents, affidavits, opinions of court appointed experts, opinions of private experts, etc.) is not different in comparison with other trademark infringement cases. This means that it is required from the plaintiff/claimant/trademark owner to prove, without any doubts, the existence of infringement.

Moreover, in accordance with the above-mentioned judgment of CJEU (*Nokia/Philips C-446/09* and *C-495/09*):

- trademark owner should prove that the introduction of goods being a subject of external transit or customs warehousing procedures leads to the goods being put on the community market;
- such evidence exists where it turns out that the goods have been sold to a customer within the EU;
- goods are offered for sale or advertised for consumers in the EU;

- the fact that diversion of the goods into the EU is envisaged may derive from documents or correspondence regarding the goods;
- nevertheless of the above the customs authorities may act and either suspend the release of or detain the goods without such evidence if there are indications that an infringement exists;
- such indications could be that the destination of goods is not declared where the customs procedure requires such a declaration;
- the lack of precise or reliable information as to the identity or address of the manufacturer or consignor of goods;
- a lack of cooperation with the customs authorities or the discovery of documents or correspondence concerning the goods suggesting that there is a risk of diversion of these goods to the EU.

Categories of goods and trademarks

- 8) Are there any differences as to whether goods in transit are considered to be infringing in the country of transit if the goods are (i) counterfeit, (ii) parallel traded or (iii) bear confusingly similar trademarks?

A difference can be seen from the perspective of the border measures under Council Regulation (EC) No. 1383/2003, which are not available for parallel imported goods, as well as for goods contained in a travellers' private luggage. In respect of counterfeit goods in transit Polish Customs Authorities are actively acting against them, however, in fact there is no stable case law in that regard. In practice, the goods in transit through Poland are considered by Customs Authorities to be infringing the trademark (and, in consequence, seized) if the goods are counterfeit.

- 9) Is there any extended or special protection for well-known and famous trademarks in respect of goods in transit?

There is no special protection for well-known and famous trademarks in respect of goods in transit. However, it should be stressed that with regard to goods in transit in general also the provisions of Polish Industrial Property Law regarding protection of well-known and famous trademarks may apply. According to Article 296 point 2 of Polish Industrial Property Law: *„Infringement of the right of protection for a trademark consists of unlawful use in the course of trade of:*

- (i) a trademark identical to a trademark registered in respect of identical goods;*
- (ii) a trademark identical or similar to a trademark registered in respect of identical or similar goods, if a likelihood of misleading the public, including in particular a risk of associating the trademark with a registered trademark, exists;*
- (iii) a trademark identical or similar to a famous trademark registered for any kind of goods, if such use without due cause would bring unfair advantage to the user or be detrimental to the distinctive character or the repute/fame of the earlier trademark.”*

- 10) Does the extended or special protection under question 9 above, exist even where no registration has been obtained in the country of transit?

As to the principle, special protection under question 9 above does not exist if there is no registration of a trademark in Poland. The border measures do not apply with regard to unregistered well-known trademarks, which means that registration of IP rights (i.e. trademark) is required. Nevertheless, it should be noted that according to Article 301 of Polish Industrial Property Law an owner of a well-known trademark on the territory of the Republic of Poland may demand the

cessation of the use of the identical or similar trademark in respect of identical or similar goods, if such use is likely to mislead the public as to the origin of the product. However, there is no specific case law in that regard.

Border measures and Remedies

11) Are border measures available for goods in transit under your statutory law? If yes, please quote the corresponding article(s) or paragraph(s).

The most important legal act with regard to trademarks and border measures, directly effective in the whole European Union, is the Council Regulation (EC) No. 1383/2003 concerning customs actions against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights. Council Regulation (EC) No. 1383/2003, in its Article 1, states that: *“This Regulation sets out the conditions for action by the customs authorities when goods are suspected of infringing an intellectual property right in the following situations:*

(a) when they are entered for release for free circulation, export or re-export in accordance with Article 61 of Council Regulation (EC) No 2913/92 of 12 October 1992 establishing the Community Customs Code;

(b) when they are found during checks on goods entering or leaving the Community customs territory in accordance with Articles 37 and 183 of Regulation (EEC) No 2913/92, placed under a suspensive procedure within the meaning of Article 84(1)(a) of that Regulation, in the process of being re-exported subject to notification under Article 182(2) of that Regulation or placed in a free zone or free warehouse within the meaning of Article 166 of that Regulation.”

There is no doubt for Polish Customs Authorities that the above provisions refer also to goods in transit (one of the “suspensive procedures”), despite the fact that a lot of controversies have aroused in connection with this issue throughout the European Union, in particular after the judgment of European Court of Justice (ECJ – now CJEU) in *Montex v Diesel* case (C-281/05). Now, some clarification was achieved, thanks to the guidelines stemming from the above-referred judgment of CJEU in *Nokia/Philips* case (C-446/09 and C-495/09).

It should be also noted that intensive legislative work was started in 2011, on the European level, in connection with a draft of the new EU regulation on Customs measures. During the legislative process, *inter alia* in the European Parliament, there were made various attempts to deal also with in-transit goods. It is still uncertain how this difficult and complicated aspect will be eventually solved in the regulation, when adopted (which can be expected in September/October 2012). As a minimum, the guidelines stemming from the *Nokia/Philips* case (C-446/09 and C-495/09) will need to be followed and reflected. The prevailing view is, however, that whether goods being in transit is sufficient for the goods to be able to be infringing is a matter for substantive law (and not for “procedural” regulations governing Customs measures).

Under Council Regulation (EC) No. 1383/2003 a trademark owner may officially contact the Customs Office, by which the goods have been seized, and ask for detailed information about the importer of the goods. In case of seizure, a trademark owner is obliged to provide Customs Authorities with evidence that the infringement was followed by filing a motion for prosecution, a request for interim injunction or a statement of claims.

In practice, this means that a trademark owner should file the motion for prosecution (with the Police, Public Prosecutor Office or the appointed Customs Offices), or the request for interim injunction, or the statement of claims with a civil court, within 20 working days counting from the date of the customs seizure (10 working days which can be extended to 20 if justified properly). The 10-day period is counted from the date on which the trademark owner is notified in writing about the seizure.

Another option is to provide the Customs Authorities, within the aforementioned 20 working days, with a written consent of the importer of the seized goods for their destruction under Customs supervision (it is a “simplified procedure” provided under Article 11 of Council Regulation (EC) No. 1383/2003 and under the Regulation of Polish Minister of Finance on the Destruction of Goods).

- 12) Does your case law / jurisprudence deal with border measures regarding goods in transit? If yes, please comment if possible trends can be observed from court precedents, and in which direction.

Polish authorities (mostly Customs and Public Prosecutor Offices) deal with border measures regarding goods in transit. This results from the fact that Poland is bound by Council Regulation (EC) No. 1383/2003 concerning customs actions against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights. Under this Regulation Polish Customs Authorities seize the goods in transit. There is, however, no reliable case law / jurisprudence in this regard, in particular civil court precedents to be quoted.

However, taking into consideration the content of several judgments of the Court of Justice of the European Union (CJEU – previously ECJ), it should be noted that:

- trademark infringement requires that the trademark be used in the territory of Poland after customs clearance, i.e. once the goods are released for free circulation within Poland;
- if the final destination of the goods is another Member State, the trademark owner can only prohibit the goods in transit if the goods are subject to the act of a third party while they are placed under the external transit procedure, which necessarily entails them to be put on the market in that Member State of transit (the *Montex v Diesel* case C-281/05).

On the other hand, the practice of Police, Customs Offices and Public Prosecutor Offices, as the authorities responsible for conducting investigations against criminal infringements of trademarks, proved from time to time to be different. Irrespective of the fact that the counterfeit goods had been in transit, they were seized and, in case of filing of the motion for criminal prosecution against the involved entities, kept in detention until final destruction. It means that after filing of the motion for criminal prosecution the criminal investigation was started in spite of the fact that the goods were in transit. Even if the proceedings were subsequently discontinued due to lack of identification of any entities which could be held liable in Poland, there were still legal grounds to order forfeiture and, in further course, destruction of the seized goods as coming from a criminal offence of counterfeiting. Moreover, as a result of such criminal proceedings the owner of infringed trademark could obtain information regarding importer and exporter of counterfeit goods (foreign entities). However, the owner of infringed trademark should have valid trademark on the territory of Poland in order to file successfully the motion for prosecution.

Another option with regard to counterfeit goods in transit is providing the Customs Office responsible for the seizure, within the aforementioned 20 working days, with a written consent of the importer of the seized goods being in transit to their destruction under Customs supervision (a “simplified procedure” provided under Article 11 of Council Regulation (EC) No. 1383/2003 and under the Regulation of Polish Minister of Finance on the Destruction of Goods). It is usually difficult, however, to obtain such a consent if there is no responsible entity operating in Poland.

From the Polish perspective, in general, the counterfeit goods in transit are nevertheless a “hard nut to crack”. And this refers probably to all jurisdictions within the European Union.

Anyway, the very recent case law of CJEU (*Nokia/Philips* C-446/09 and C-495/09) should have the crucial impact for the practice of Polish Civil Courts and Customs Authorities regarding seizures of goods in transit. According to the position of CJEU taken in that judgment:

- trademark owner should prove that the introduction of goods being a subject of external transit or customs warehousing procedures leads to the goods being put on the community market;
- such evidence exists where it turns out that the goods have been sold to a customer within the EU;
- goods are offered for sale or advertised for consumers in the EU;
- the fact that diversion of the goods into the EU is envisaged may derive from documents or correspondence regarding the goods;
- nevertheless of the above the customs authorities may act and either suspend the release of or detain the goods without such evidence if there are indications that an infringement exists;
- such indications could be that the destination of goods is not declared where the customs procedure requires such a declaration;
- the lack of precise or reliable information as to the identity or address of the manufacturer or consignor of goods;
- a lack of cooperation with the customs authorities or the discovery of documents or correspondence concerning the goods suggesting that there is a risk of diversion of these goods to the EU.

13) What kinds of remedies are available if goods in transit are considered to be infringing in the transit country? Are, for example, injunctions, monetary damages, or destruction of such goods possible?

Civil claims

In accordance with the provisions of Polish Industrial Property Law the following civil claims are available to trademark owners:

- cessation of infringement;
- surrender of unlawfully obtained profits;
- compensatory damages in accordance with the relevant principles of the Civil Code or payment of a lump sum equivalent to a license fee, or any other remuneration, which would have been due if the infringer had been authorized by the trademark owner to use the trademark;
- announcement to the public of the Court verdict as a whole or in part, or publishing information regarding the verdict;

- the Court may, at the trademark owner's request, decide on the disposal of the unlawfully manufactured or marked products, and the means used for the manufacture or marking thereof (i.e. removal from the market, destruction);
- the Court may order the infringer (in case of unintentional infringement) to pay the relevant sum to the benefit of the trademark owner if the cessation of infringement or forfeiture of the goods held by the infringer would be extensively punishing, and the above mentioned sum to be paid would fulfill the trademark owner's interest.

These are claims available in case of any trademark infringement (in general). It should be noted, however, that – due to various difficulties – civil law remedies are very rarely used in relation to infringing goods in transit. There is no specific case law in this respect.

Interim injunction

Before filing a lawsuit with the Court, it is also possible to request a preliminary injunction in order to restrain the alleged infringer from infringing the trademark further. A preliminary injunction is usually granted for the duration of the Court proceedings. The request for an interim injunction may be filed before initiating the Court proceedings or simultaneously with filing a lawsuit with the Court. If a preliminary injunction is requested before initiating the Court proceedings, together with a decision on the preliminary injunction the Court will appoint a maximum two-week deadline for filing a lawsuit. If the lawsuit is not filed with the Court in due time, the preliminary injunction will lapse. In order to obtain a preliminary injunction it is necessary to:

- indicate legal interest in requesting a preliminary injunction (e.g. exclusive rights of the holder; unlawful practices of the infringer);
- justify the grounds for filing the request for injunction; and
- indicate how the injunction should be effected (e.g. seizure of goods in the infringer's warehouse, ban on further sale, etc.).

When requesting a preliminary injunction, the right holder is obliged to prove his rights with the official documents, as well as to define precisely the infringer and his infringing practices. At this stage of the proceedings it is not required to prove one's claims. The trademark holder must certify his trademark rights through an official document and announce that those exclusive rights have been infringed.

Criminal procedure

Criminal law measures can be used to tackle counterfeit goods in transit (if seized by Customs) and they are applied much more often than civil law remedies. Even if the criminal proceedings are discontinued due to lack of identification of any entities which could be held liable in Poland, there are still legal grounds to order forfeiture and, in further course, destruction of the seized goods as coming from a criminal offence of counterfeiting.

The Industrial Property Law provides a legal definition of a counterfeit trademark and sets forth criminal provisions referring to trademark counterfeiting. According to that Law a 'counterfeit trademark' is any mark identical to, or indistinguishable in the course of trade from a registered trademark, and unlawfully used in respect of goods covered by the registration.

A party, either affixing a counterfeit trademark to goods with the intention of introducing them onto the market, or committing acts resulting in the turnover of such goods, may be subject to:

- a fine,
- restriction of liberty, or
- imprisonment, up to 2 years.

Trademark owners must be aware of the fact that, in most cases, they must file a motion for prosecution if they wish to enforce their rights through the criminal justice system. Only after such motion is filed the proceedings can be started and continued *ex officio*. The exception is when permanent profits are obtained from criminal activity against a registered trademark, or criminal acts result in the turnover of counterfeit goods with a significant value. In such cases, the perpetrator is subject to more serious penalty (namely, imprisonment from 6 months up to 5 years) and the proceedings may be initiated *ex officio* (it is not necessary to file the motion for prosecution). However, a party committing the said criminal acts will only be punished if it is proved that the action was intentional.

The evidence obtained in criminal proceedings may be admitted for use in civil proceedings and vice versa.

14) If the answer to question 13 includes monetary damages, how are the damages computed?

In accordance with the provisions of Polish Industrial Property Law with regard to compensation the trademark owner, whose trademark has been infringed, may demand from the infringer:

- surrender of the unlawfully obtained profits;
- and, if the infringement was deliberate:
 - compensation for damages in accordance with the general principles of the Civil Code or
 - payment of a lump sum equivalent to a license fee, or any other remuneration, which would have been due to the trademark owner at the date of the demand if the infringer had been authorized by the trademark owner to use the trademark.

The conditions for obtaining compensation for damages based on principles of the Civil Code are as follows:

- providing evidence confirming that infringement has taken place,
- evidencing damages sustained by the rights owner,
- evidencing direct impact of the infringer's actions upon the harmed person,
- proving guilt of the infringer.

According to Polish Law, apart from real lost profits (*damnum emergens*) damage also means profits which could be made by the party if it did not suffer damage (*lucrum cessans*). Usually it is difficult to evidence damages sustained by the rights owner and the Courts have problems related to estimation of compensation. However, in accordance with the rules of Polish Code of Civil Proceeding the Court, in case of problems with exact estimation of damages (or impossibility in that regard), may adjudge a relevant amount of compensation in accordance with own opinion based on consideration of all circumstances of the case.

15) If the answer to question 13 includes destruction of the infringing goods, who is responsible for ensuring the destruction of the infringing goods?

In civil execution proceeding the Court and Court Bailiff are mainly responsible for ensuring destruction of the infringing goods (however, the plaintiff and defendant are also involved in this proceeding).

In criminal proceedings the Criminal Court and the Public Prosecutor Office are mainly responsible for ensuring the destruction of the infringing goods.

Another option with regard to counterfeit goods is providing the relevant Customs Office with a consent of the importer of the seized goods being in transit to their destruction under Customs supervision (a “simplified procedure”) – which is very difficult in transit cases. In such situation the goods are destroyed under Customs supervision upon the special request of the importer or the special request of the trademark owner (depending on the content of the settlement agreement between the trademark owner and infringer/importer). As a general rule, however, the financial burden in connection with destruction is on the trademark owner, who must arrange all destruction details not only with Customs but also with a certified destruction/recycling company.

II. Proposals for harmonisation

The Groups are invited to put forward proposals for the adoption of harmonised rules as to the infringement of trademarks by goods in transit. More specifically, the Groups are invited to answer the following questions.

Please note that in-transit in the following refers to the term in a broader sense and is not limited to a specific customs procedure.

Goods in transit – infringement

16) Should goods in transit be considered to infringe a registered trademark in the transit country? If yes, why? If no, why not?

The goods in transit, and in particular counterfeit goods, should be considered to infringe a registered trademark in the transit country. The reason is that the owner of trademark should have the right to eliminate the counterfeit and infringing products even if they are in transit. This is important issue particularly due to the process of globalization and creation in the world of the zones of free movement of persons and goods. It should be also stressed that many trademark owners distribute their products in a global scale and they should have effective instrument for fighting with infringing goods in transit. There is no reasonable reason for waiting by the owner of rights for the delivery of the counterfeit goods to the country of final destination.

However, it should be stressed that the infringed trademark should be registered and valid in the country of transit.

17) Should it matter whether the goods have been lawfully manufactured in and/or exported from the country of origin?

This issue may be indicated by the defendant/importer, however, as to the principle it should not matter. For example, it is possible that in some countries the goods would be treated as lawfully manufactured and/or exported but in other country, i.e. Poland, they will be treated as infringing the trademark. The reason is that the owner of trademark should have the right to eliminate the counterfeit and

infringing products even if they are in transit. However, it should be stressed that the infringed trademark should be registered and valid in the country of transit.

- 18) Should it matter whether the goods could be lawfully put on the market in the country of destination?

This issue may be indicated by the defendant/importer, however, as to the principle it should not matter. The reason is that the owner of trademark should have the right to eliminate the counterfeit and infringing products even if they are in transit. However, it should be stressed that the infringed trademark should be registered and valid in the country of transit.

- 19) If in-transit goods are not considered to infringe a registered trade mark in the transit country, should there be an exception if it is shown that the goods will be or that there is a risk for the goods being illicitly diverted onto the market in the transit country?

As already stated, in-transit goods should be considered to infringe a registered trademark in the transit country. However, if it is impossible to achieve such a high standard of protection, at least there should be an exception allowing to establish a trademark infringement if it is shown that the goods will be or that there is a risk for the goods being illicitly diverted onto the market in the transit country.

- 20) What kind of evidence should be presented for this exception to take effect?

The above-mentioned judgment of Court of Justice of the European Union (CJEU) (*Nokia/Philips* C-446/09 and C-495/09) could be applied in this regard, i.e. to secure a minimum standard of protection for trademark owners (as mentioned above, however, it would be desirable to establish a general rule that in-transit goods can be considered to infringe a registered trademark in the transit country).

According to the said judgment:

- trademark owner should prove that the introduction of goods being a subject of external transit or customs warehousing procedures leads to the goods being put on the community market;
- such evidence exists where it turns out that the goods have been sold to a customer within the EU;
- goods are offered for sale or advertised for consumers in the EU;
- the fact that diversion of the goods into the EU is envisaged may derive from documents or correspondence regarding the goods.

Categories of goods and trademarks

- 21) Should infringement by goods in transit be limited to counterfeit goods or should also parallel traded goods and goods bearing confusingly similar goods be considered to infringe when in-transit?

The infringement by the goods in transit should not be limited only to counterfeit goods, which means that parallel traded goods and goods with confusingly similar marks may be also considered as infringement. In case such a high standard of protection cannot be achieved, the respective remedies should be applicable to at least clearly counterfeit goods.

- 22) Should famous and well-known trademarks enjoy extended protection in respect of goods in transit? If so, should this be the case even when no registration has been obtained in the country of transit?

The famous and well-known trademarks should enjoy extended protection also in respect of goods in transit. However, the infringed trademark should be registered and valid in the country of transit.

Border measures and Remedies

- 23) Should border measures be available for goods in transit?

Yes, border measures should be available for goods in transit, and in particular to counterfeit goods.

- 24) Should the same remedies (such as injunctions, monetary damages and destruction) be available for infringement by goods in transit as for other trademark infringements?

Yes, the same remedies should be available for infringement by goods in transit as for other trademark infringements.

- 25) Should the same defenses be available for the importers of goods in transit as for goods under direct importation from the country of origin or other?

Yes, the same defenses should be available for the importers of goods in transit as for goods under direct importation from the country of origin or other.

Summary

The main regulation in Poland with regard to trademarks and goods in transit is the Council Regulation (EC) No. 1383/2003 of 22 July 2003.

The goods in transit might – under certain circumstances – be considered to fall within the trademark owner’s exclusive right to prevent others from importing goods bearing the trademark.

In Poland such goods are mainly considered to be infringing the trademark (and, in consequence, seized) if the goods are counterfeit. Polish Customs Authorities are acting against such goods in spite of controversies aroused in connection with this issue (*vide* the judgment of ECJ in *Montex v Diesel* case (C-281/05)).

The very recent case law of CJEU (*Nokia/Philips* C-446/09 and C-495/09) should be crucial for the practice of Customs and other Authorities regarding seizures of goods in transit, i.e. to secure a minimum standard of protection for trademark owners.

From the Polish perspective, in general, the goods in transit are a “hard nut to crack”.

The goods in transit (particularly counterfeit goods) should be considered to infringe a trademark which is registered in the country of transit.

Résumé

Régulation de Conseil (EC) No 1383/2003 du 23 juillet 2003 et autres actes législatifs prévoient des mesures à la frontière et interventions des douanes contre les contrefacteurs.

Les produits en transit peuvent – dans certaines circonstances – être considérés comme infraction de droits exclusives de titulaire d'une marque ce qui donne le fondement pour la prévention d'importation par de tiers des produits désignés par une telle marque.

En Pologne les produits en transit sont en général considérés comme la contrefaçon une marque, et s'il sont contrefaits, il sont en conséquence saisis. Les Services Douaniers Polonais agissent contre de tels produits en transit malgré les controverses dans cette question (*vide* le jugement de TEJ *Montex v Diesel* (C-281/05)).

La jurisprudence récente (*Nokia/Philips* C-446/09 et C-495/09) devrait avoir une importance principale pour les pratiques des Services Douaniers et les autres Autorités à l'égard de saisies des produits en transit pour assurer le minimum de standard de protection des droits de titulaires des marques.

De la perspective polonaise les produits en transit sont « un os dur à ranger ».

Les produits en transit (en particulier les produits contrefaits) peuvent être considérés comme infraction des marques enregistrées dans le pays de transit.

Zusammenfassung

Die wichtigste Regulierung in Polen in Bezug auf Markenzeichen und Waren in Transit ist die Verordnung (EC) Nr. 1383/2003 vom 22. Juli 2003.

Die Waren in Transit können – unter gewissen Umständen – als geschützt, durch das absolute Recht des Markenzeichenbesitzers zur Verhinderung von Import der Waren mit dem Markenzeichen, betrachtet werden.

In Polen werden solche Waren als das Markenzeichen verletzend betrachtet (und folglich beschlagnahmt), wenn sie gefälscht sind. Das polnische Zollamt handelt gegen Waren dieser Art, trotz erregter Kontroversen, die mit dieser Angelegenheit zusammenhängen (siehe Urteil ECJ im Fall *Montex vs. Diesel* (C-281/05)).

Der neueste Fall (*Nokia/Philips* C-446/09 und C-495/09) sollte entscheidend für die Praxis des Zollamtes und die anderen Institutionen bezüglich der Beschlagnahme von Waren in Transit sein, unter anderem, um den Grundschutz für Markenzeichenbesitzer zu sichern.

Im Allgemeinen sind die Waren in Transit von polnischer Perspektive „eine harte Nuss zu knacken“.

Die Waren in Transit (vor allem gefälschte Waren) sollten als das Markenzeichen verletzend, das in dem Land - wo der Transit stattfindet – registriert ist, betrachtet werden.