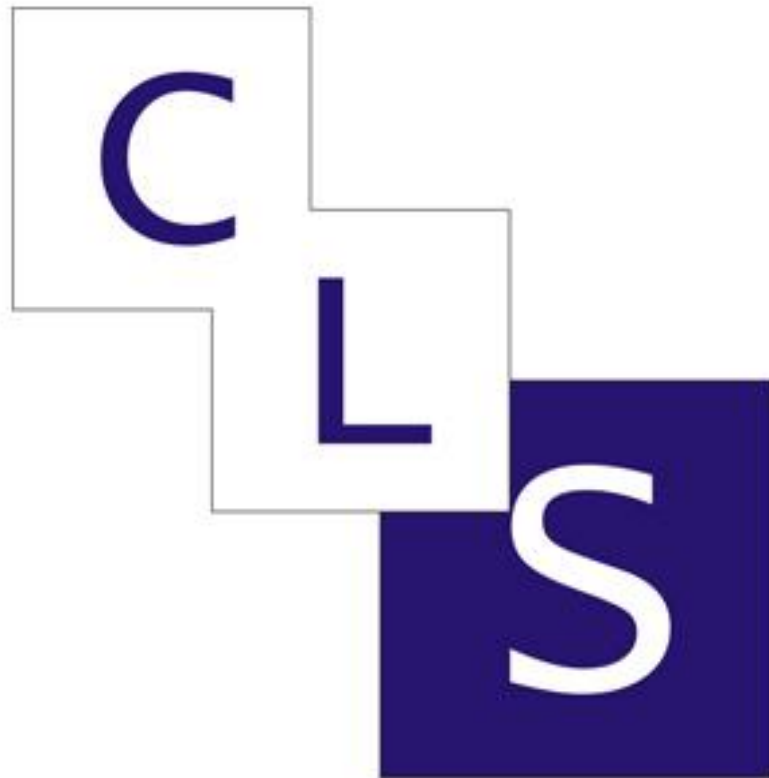
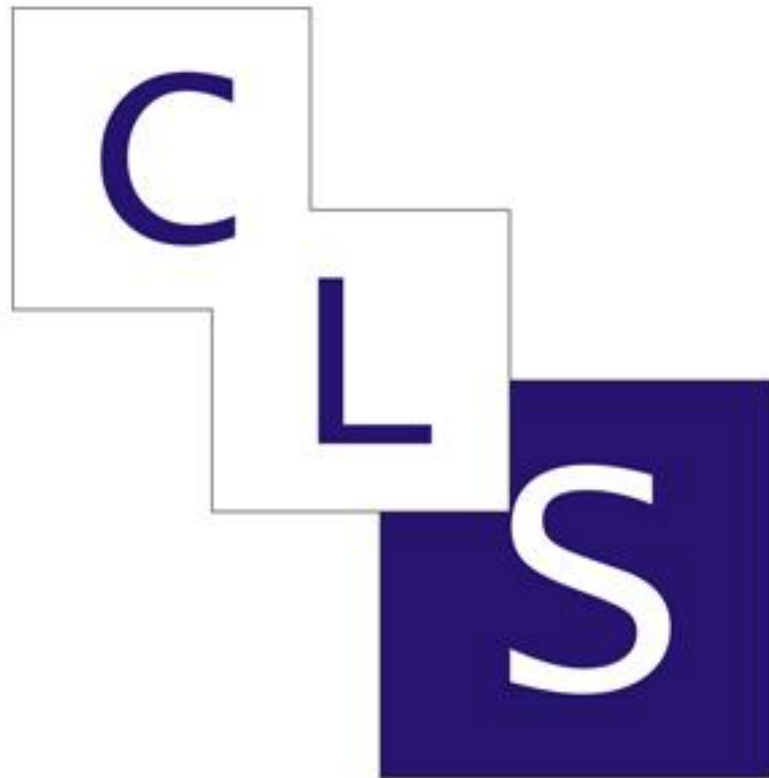


COMMON LAW SOCIETY



JOURNAL

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Foreword

The academic year of 2008/2009 was one of the most successful in history of the University of Warsaw Common Law Society. The Society has initiated the Law in Action project – a series of interactive workshops delivered by prominent academics and legal practitioners from different common law jurisdictions. We also organised The First International Law in Action Conference: Commercial Speech, which included a professional moot court competition.

Now I have a great pleasure to introduce you to the very first issue of the Common Law Society Journal. The Journal is the result of the Society's study visit in the United Kingdom where we met with renowned British scholars, discussed legal issues with our peers from Oxford and Cambridge Universities, took part in hearings in London's most famous courts (the Appellate Committee of the House of Lords, the Central Criminal Court, the Royal Courts of Justice) and gave lectures on Polish law. We also collected the materials and discussed essays providing the opportunity for students to write on diverse aspects of common law which interest them and to have those works published. I hope now that the Journal will be of benefit to the students of the University of Warsaw.

I therefore hope that you will enjoy reading this very first issue, with a variety of topics discussed by the students.

Mateusz Gawalkiewicz

Vice president of the Common Law Society - University of Warsaw

Editor-in-chief of Common Law Society Journal

Warsaw, June 2009

Contents

The role of Queen's Counsel in English Legal System. Controversies, ideas, reforms	
<i>Mateusz Gawalkiewicz</i>	9
Constitutional Reform Act 2005 – the future of the House of Lords	
<i>Katarzyna Kozak</i>	18
Moot court – the idea, use and role in legal education in the UK	
<i>Karolina Łasowska</i>	26
Trade Marks Registration under Polish Intellectual Property Law	
<i>Bartosz Mendyk</i>	33
Time for deliberation in English and 'European' divorce law	
<i>Jakub Pawliczak</i>	42
The doctrine of public policy in English private international law	
<i>Nikodem Rycko</i>	50
Class actions from the Polish perspective – harmonizing the EC antitrust rules	
<i>Karolina Sereja</i>	56

The role of Queen's Counsel in English Legal System

Controversies, ideas, reforms

I. Introduction – who is Queen's Counsel?

The legal profession in England and Wales is divided traditionally into two separate branches: barristers and solicitors. Barristers are professional legal advisers and courtroom advocates who argue a case before a judge or tribunal in the courtroom. The role of solicitors is much wider, as they provide legal services in variety of areas of law, but traditionally they have not appeared in the higher courts.¹ In contrast with barristers, solicitors are often compared to general practitioners.² Queen's Counsel is in fact a special status which is awarded for distinguished branch of advocates in England and Wales. Traditionally, this was restricted to barristers but in 1996 the system was changed and solicitors became entitled to be appointed Queen's Counsels.

In recognition of excellence and experience the Queen annually appoints the lawyers to be one of "Her [or His] Majesty's Counsel learned in the law"³. It is worth remarking that when the Sovereign is the King then an order of the Privy Council translates all Queen's Counsel into King's Counsel. QC status is connected with formal privileges and fees charged, which would be discussed later.

II. History and position of Queen's Counsel within the English Legal System.

The history of Queen's Counsel started in 1597 when Sir Francis Bacon was given a patent giving him precedence at the Bar.⁴ He was appointed first Queen's Counsel "Extraordinary" in contrary to King's Counsels in Ordinary such as Attorney-General, Solicitor-General and King's Serjeants. The status of QC was at that time connected with certain disadvantages such as the prohibition to appear in the court against the Crown without

¹ Which was changed by the Courts and Legal Services Act 1990, which enable solicitors to gain higher rights of audience by applying to become a 'solicitor advocate'.

² A Gillespie, *The English Legal System* (OUP, Oxford 2007) 234

³ The status of QC is also awarded on an honorary basis to people who are not practicing advocates, but who have made a significant contribution to the law, for example as distinguished academics.

⁴ W Holdsworth, *History of English Law* (Sweet and Maxwell, London 1938) vi 473-4

special licence.⁵ Moreover, they were prohibited from drafting pleadings alone without the assistance of a junior counsel. They were also not permitted to appear in Court without a junior barrister and they had to have chambers in London.⁶ On the other hand, the appointment meant that the lawyer could instantly and greatly increase his fees.

As J. H. Baker points out:

...the holders benefited financially from the valuable right to be heard in the courts before junior barristers and it is known that Francis Winnington enjoyed a tenfold increase in his professional income after becoming king's counsel in 1672.⁷

However, by the end of the twentieth century, the majority of the rules which constrained but also favored QCs, had been abolished so that the appointment is now a matter of status and prestige only.

As was mentioned before, QC status is connected with formal privileges and fees charged. Three formal privileges could be distinguished. Firstly, QC wears a distinctive uniform. Court working dress differs among QCs, junior barristers and solicitor-advocates. QCs wear a short wig, wing collar and bands and silk gown over a special court coat; junior barristers wear a short wig and stuff gown with bands; solicitors and other advocates authorised under the Courts and Legal Services Act 1990 wear a black stuff gown, wing collar and bands, but no wig.⁸ It is worth to add that Queen's Counsel gown gives rise to the colloquial reference to them as "silks" and to the phrase "taking silk" referring to their appointment. Secondly, the judiciary have traditionally given QCs a formal right to address the court with preference to any other advocates. However, it is really doubtful whether this right has practical significance any longer.⁹ The third privilege is connected with sitting in a particular part of the court. Silks are entitled to sit in the front row. This is also the a matter of professional etiquette rather than a serious advantage.¹⁰

The appointment results in fees charged by QC. Due to the fact that Silks have to focus on fewer, more complex cases, it usually leads to an increased fee rate per case. It

⁵ It shows the political characteristic of the appointment. Most of QCs were members of the Parliament where royals were anxious to get support.

⁶ D Duman, *The English and Colonial Bars in the Nineteenth Century* (Croom Helm, London 1983)

⁷ J Baker *The Common Law Tradition: Lawyers, Books and the Law* (Hambledon Press, London 2000)

⁸ *Constitutional Reform: The future of Queen's Counsel*, Department for Constitutional Affairs (Consultation Paper) (July 2003) CP 08/03 para 5

⁹ *Ibid* para 7

¹⁰ *Ibid* para 8

derives from the fact that QCs tend to specialize in different types of work. Cases which are legally or factually complex may need the special expertise. Sometimes Silks are chosen to lead a team of advocates, which could be caused by the large amount of material to be managed. The last but not least consequence of appointment is the exemption of the Silks in the Code of Conduct for the Bar of England and Wales from the so called "cab-rank rule". This rule is described as:

A self-employed barrister must comply with the 'Cab-rank rule' and accordingly except only as otherwise provided in paragraphs 603 604 605 and 606 he must in any field in which he professes to practise in relation to work appropriate to his experience and seniority and irrespective of whether his client is paying privately or is publicly funded:

- (a) accept any brief to appear before a Court in which he professes to practise;
- (b) accept any instructions;
- (c) act for any person on whose behalf he is instructed;

and do so irrespective of (i) the party on whose behalf he is instructed (ii) the nature of the case and (iii) any belief or opinion which he may have formed as to the character reputation cause conduct guilt or innocence of that person.¹¹

This rule stipulates that barristers (contrary to solicitors) cannot pick and choose their clients. In other words, personal preference cannot decide which case a barrister takes. A barrister could not, as well, decide that he will refuse to take briefs from companies that trade with a particular country because his personal ethics infringes the rule.¹² As the Lord Irvine QC pointed out:

[the cab-rank rule is] the duty to appear for the Yorkshire Ripper or any other defendant against whom there may be a hostile climate of public opinion. In civil cases, it is also his duty to appear not only for a particular interest group with which he might prefer to identify but for every interest group...¹³

¹¹ *The Code of Conduct of the Bar of England & Wales* (8th Edition, London 2004) rule 602

¹² A Gillespie, *The English Legal System* (OUP, Oxford 2007) 234

¹³ D Pannick, *Advocates* (OUP, Oxford 1992) p 136

Although “the cab-rank rule” raises many doubts among non-professionals¹⁴ and professionals¹⁵, in general it is supported by the members of the Bar, as David Pannick QC states:

Any lawyer who does not understand [the purpose of the rule] really has no business being an advocate.¹⁶

The Code of Conduct of the Bar of England & Wales specifies for QCs that they are not obliged to accept instructions to settle documents of the kind normally settled by (a) junior counsel. It comes from the expectation that they will deal with particularly complex cases, or lead a team.¹⁷

The number of self-employed Queen’s Counsels in December 2008 was 1273¹⁸. Taking into account that there were 12136 self-employed barristers, it shows that around 10% of members of the Bar have been distinguished as QCs.¹⁹ It should not be forgotten that since 1996 solicitors are also entitled to apply for a QC but the amount of former solicitors among Silks is low. The number of women in the Bar in December 2008 was 3772, which constituted around 30 per cent²⁰. However, when comparing with the number of female QCs it could be seen that it is much lower – 127, which is around 10 per cent²¹. In case of ethnic minorities, the number of barristers from an ethnic minority group was 2573, which is around 20 per cent.²² Again when comparing this information to the number of QCs from an ethnic minority group, the difference is significant – only 107 Silks have ethnic minority background, that is around 10 per cent.²³ These statistics shows that the profession of barrister is still a domain of white British males, which was widely criticized not only by the society

¹⁴ See F Gibb, ‘Is the cab-rank rule worth saving?’ *The Times* (London 1 May 2008) <<http://business.timesonline.co.uk/tol/business/law/columnists/article3855965.ece>> accessed 6 June 2009

¹⁵ See G Webber, ‘A barrister’s right to choose’ *The Times* (London 18 July 2000) Business 6

¹⁶ D Pannick, *Advocates* (OUP, Oxford 1992) p 145

¹⁷ Department for Constitutional Affairs, *Constitutional Reform: The future of Queen’s Counsel* (Consultation Paper) (July 2003) CP 08/03 para 15

¹⁸ Self-Employed Bar QC’s by Ethnicity and Gender, The Bar Council Annual Statistics (December 2008) <<http://www.barcouncil.org.uk/assets/documents/Self%20Employed%20Bar%20QC%27s%20by%20Ethnicity%20and%20Gender%20Apr%202009.pdf>> accessed 12 April 2009

¹⁹ *Ibid*

²⁰ Self Employed Bar excl Pupils by Ethnicity and Gender, The Bar Council Records Office (December 2008) <<http://www.barcouncil.org.uk/assets/documents/Self%20Employed%20Bar%20excl%20Pupils%20by%20Ethnicity%20and%20Gender%20Dec%202008.pdf>> accessed 12 April 2009

²¹ Self-Employed Bar QC’s by Ethnicity and Gender, The Bar Council Annual Statistics (December 2008)

²² Self Employed Bar excl Pupils by Ethnicity and Gender, The Bar Council Records Office (December 2008)

²³ *Ibid*

but also by other lawyers.²⁴ On the other hand, it should not be forgotten that in recent years the legal professions have succeeded in opening their doors to a wider range of people, so that they are more representative of the society in which they work.²⁵

III. Does Britain really need aristocrats among lawyers?

The Silk system was criticized on many occasions for, *inter alia*, being too secretive, prone to the allegation that it was simply a means of perpetuating an Old Boys' Network of very well-paid barristers.²⁶ In fact, it was Lord Chancellor whose role was the most significant in the process of appointment. He had the power to recommend candidates for appointments to the monarch, reinforced by custom and practice. It should not be forgotten that the Lord Chancellor is appointed by the Sovereign on the advice of the Prime Minister, which makes this office undoubtedly political. Therefore the QC appointment process was questioned. As Diana Woodhouse points out:

[The Lord Chancellor's] operation as a executive arm of government means that such appointments are in danger of being tainted by accusations of political influence.²⁷

The landmark in the debate was the publishing of a Report on competition in legal professions issued by the Director General of Fair Trading in 2001.²⁸ The report raised a number of issues, especially restrictions of competition, as well as their justifications and suggested the ways of liberalizing it in professional services. The review, which was carried out under section 2 of the Fair Trading Act 1973, is based on the lengthy report of a firm of consultants known as LECG. The Office of Fair Trading (OFT) addressed what the OFT believes may be unjustified and anti-competitive restrictions on the practice of law. With

²⁴ See C Dyer, 'Solicitors boycott old boys' network' *The Guardian* (London 28 September 1999) <<http://www.guardian.co.uk/uk/1999/sep/28/claredyer>> accessed 6 June 2009

²⁵ C Elliott, F Quinn, *English Legal System* (Longman, London 2008) p 182

²⁶ See R Verkaik, 'The Big Question: Should we abolish Queen's Counsel?' *The Independent* (London, 27 July 2006) <<http://www.independent.co.uk/news/uk/crime/the-big-question-should-we-abolish-queens-counsel-409395.html>> accessed 20 April 2009

²⁷ D Woodhouse, *The Office of Lord Chancellor* (Hart Publishing, London 2001) p 65

²⁸ *Competition in Professions, A report by the Director General of Fair Trading*, Office of Fair Trading, (March 2001) OFT 328

regard to barristers, there were four main targets of criticism.²⁹ The fourth concerned the QC system both as an institution, and with reference to the present system of selection.³⁰ The report questioned the Silk system's value to consumers, the way it operates as a quality mark and the extent to which the rank acts to distort competition. The emphasis was put on the following issues: whether clients need a quality mark when direct access to barristers is restricted³¹, is it appropriate for the Crown to give a title to selected practitioners, which enhanced their earning power and competitive position relative to others. The other concerns were raised as to the selection process. The Director General of Fair Trading argued that there is inadequate peer review on selection and that there are no professional examinations that must be taken in order to become a QC.³² Moreover, the transparency, objectiveness and non-discrimination of the process were questioned. And last but not least, the Director General of Fair Trading asked the client's need for a quality mark where restrictions upon direct access by clients to barristers remain in place and barristers' services are consequently purchased by solicitors who are specialists.³³

IV. Reform or abolition?

After the publication of the Report by the Office of Fair Trading the government issued a consultation paper entitled *In the Public Interest?*, which asked for comments on the perceived benefits and potential drawbacks of the current system.³⁴ The responses, mostly obtained from the lawyers, were published on 14 May 2003. Although there was no clear majority in favour of any particular way forward, there was a strong body of opinion which supported some form of significant change. In particular, many respondents doubted whether state involvement was appropriate.³⁵

²⁹ See The Bar's Consultation Paper in response to the OFT Report – 'Competition in Professions', The Bar Council Consultation Papers (2001) < <http://www.barcouncil.org.uk/consultations/consultationpapers/>> accessed 20 April 2009 para 2.1

³⁰ Ibid para 2.1(d)

³¹ Until recently, it was not possible for members of the public to go to a barrister directly. They needed to use a solicitor, or some other recognised form of access. After the change in the rules set down by the General Council of the Bar in July 2004, in certain circumstances, it is possible for the members of the public to instruct a barrister directly.

³² *Competition in Professions, A report by the Director General of Fair Trading*, Office of Fair Trading, (March 2001) OFT 328 para 46

³³ Ibid

³⁴ *In the Public Interest? A Consultation following the Office of Fair Trading's report on Competition in Professions*, Department of Constitutional Affairs (July 2002) <<http://www.dca.gov.uk/consult/general/oftrept.htm>> accessed 5 April 2009

³⁵ *Constitutional Reform: The future of Queen's Counsel*, Department for Constitutional Affairs (Consultation Paper) (July 2003) CP 08/03 para 19

Many respondents, for example firms of solicitors or The Law Society, did not find the QC mark to be of use. They saw the market in legal advocacy as highly developed and were not convinced that solicitors needed a broad and undifferentiated quality mark to help them decide whom to instruct.³⁶ Moreover, they argued that the rank of QC is not a reliable guarantee of quality or expertise (particularly as the current system does not include a stage for review and possible removal, or indicate the area of any specialism). In addition, in their opinion, the rank restricts competition and does not allow market forces to determine freely the allocation of resources.³⁷ The Law Society put in question the whole idea of designation of QCs, which they considered as a public honour accorded to a private group. They repeated the view expressed in The Law Society's submission from 1999:

There is no logical reason why such an honour or its equivalent might not be given to outstanding doctors, dentists or accountants. The designation is a mark of patronage that is inappropriate in the modern age³⁸

The respondents to the consultation paper in favour of QC system (mainly barristers, QCs and judges) made several points. Firstly, they stated that the system provides a body of advocates who are identified as leaders of their profession and so gives a clear mark of distinction as an advocate.³⁹ Secondly, that mark is internationally recognised, and as such is both an example to other systems, and a very substantial source of foreign earnings, particularly by attracting commercial litigation to the UK.⁴⁰ Thirdly, it enhances competition in the interests of the consumer, by enabling solicitors to shop around among a number of barristers who have been recognised by the award of Silk.⁴¹ Fourthly, it assists solicitors in selecting the quality of legal assistance their client needs, particularly in areas with which the solicitors may be less familiar.⁴² As it could be easily seen, most of the arguments from both sides were stating exactly the opposite in the same matters.

³⁶ Ibid para 40

³⁷ Ibid para 41

³⁸ *Appointment to the Judiciary and to Silk - The Law Society's submission in 1999 to the enquiry by Sir Leonard Peach*, The Law Society (December 1999)

³⁹ *Constitutional Reform: The future of Queen's Counsel*, Department for Constitutional Affairs (Consultation Paper) (July 2003) CP 08/03 para 38

⁴⁰ Ibid para 39

⁴¹ Ibid para 40

⁴² Ibid para 41

Due to the controversial appointment procedure and to results of the open consultation, the Lord Chancellor, Lord Falconer of Thoroton decided to suspend the appointment of Queen's Counsel in 2003. He made the following statement:

While the consultation did not produce a consensus as to whether the title of Queen's Counsel should continue to exist, it is clear to me that as Lord Chancellor and Secretary of State I should no longer play a part in assessing and selecting candidates to be appointed as QCs. None of the consultees could demonstrate that such involvement in the selection process is fundamental to the Silk mark's value; nor does it add value for consumers of legal services. I will, therefore, not continue that role.⁴³

It was widely expected that the system would be abolished, although existing QCs were not affected by the suspension. Then the campaign was set up to retain the Silk system. Apart from the Bar Council and Judiciary, those who supported the retention (for example foreign commercial litigants) were trying to convince the government that the QC system adds value and diversity to the English Legal System, and that it performs a significant role in the international provision of UK legal services.⁴⁴ The others contended in a letter to *The Times* in London that QC system was a means whereby the most able barristers from ethnic minorities could overcome prejudice.⁴⁵ David Pannick QC, who firstly was in favour of abolition, pointed out:

An independent profession cannot justify a system by which conferral of a distinction is dependent on the advice of civil servants and the judgment of a politician, however conscientious. By analogy with some Commonwealth jurisdictions, appointment should be made by the Queen on the recommendation of the Lord Chief Justice, on the basis of advice from eminent lawyers and distinguished non-lawyers, applying a fair and open selection process.⁴⁶

⁴³ Hansard HC vol 421 col 77WS (26 May 2004)

⁴⁴ See *Building on Strength: The response of the Commercial Bar Association*, The Commercial Bar Association (London, 2003) p 15

⁴⁵ See C Griffiths; L Dobbs, O Nsugbe, 'Barristers from ethnic minorities' Letters to the Editor *The Times* (London 3 November 2003) <<http://www.timesonline.co.uk/tol/comment/letters/article1007444.ece>> accessed 10 April 2009

⁴⁶ D Pannick, 'The 400-year-old Queen's Counsel system is on trial. Both sides present their case' *The Times* (London 7 October 2003) <<http://business.timesonline.co.uk/tol/business/law/article1166645.ece>> accessed on 10 April 2009

He also argued that silk route is encouraging advocates to be awarded, which helps to promote high standards of advocacy and assist to maintain the rule of law. Moreover, the rank of QC is internationally recognized, which produces very substantial earnings by attracting foreign capital. The campaign resulted in switching the government's focus from the abolition to reform of the system.

The Government announced in November 2004 that the QC system would be resumed, however, future appointees would not be chosen by the Lord Chancellor but by a special panel, chaired by a lay person and consisting of at least 9 members, which would include three barristers, two solicitors, one retired judge and three non-lawyers. Formally, however, the appointment remains a royal one made on the recommendation of the Secretary of State for Justice, but he no longer comments on the individual applications put forward by the independent panel, and merely supervises the process and reviews the recommendations in general terms.

V. Conclusions

The role of Queen's Counsel in English legal system is really significant. It is not only the quality mark recognized internationally but also a way to encourage the advocates to maintain high standards of their work. Although certain drawbacks could be noticed such as the lack of review and possible removal among existing QCs, the most controversial elements including the selection procedure have been reformed. The future of Silks seems to be assured after the public debate of 2001-2003 years.

Katarzyna Kozak

Constitutional Reform Act 2005 – the future of the House of Lords

I. The House of Lords as the highest court in Britain – from evolution to revolution

The House of Lords constitutes the upper chamber of the bicameral legislature in Great Britain. It emerged as the separate House of Parliament in the course of the fourteenth century. Within centuries, its competences regarding legislative power, as well as a number of hereditary Members sitting in the House, have been considerably limited. Provisions of the Parliament Act of 1911, for instance, stated that Money Bills passed by the Commons became law if not approved without amendment by the Lords within one month after it was sent up to that House.¹ Similarly, the Act, amended by the Parliament Act 1949, restricted further the powers of the Lords with reference to other Public Bills (with exception of the ones extending the life of Parliament) which became law without the consent of the upper chamber if passed by the House of Commons in two successive sessions with the reservation that the period of one year elapsed between second reading in the first of the sessions and final passing in the Commons.²

The House of Lords Act 1999 put a completely new face to the upper chamber of Parliament by removing the right of most hereditary peers to sit and vote in the House, exempting only 92 peers from this provision. The House of Lords currently comprises: 92 hereditary peers; life peers, appointed for the lifetime by the Queen on advice of the Prime Minister; Lords Spiritual, including the archbishops of Canterbury and York, the bishops of Durham, London and Winchester and 21 other bishops holding sees in England; as well as 12 Law Lords who are full-time professional judges of the Supreme Court of Judicature (the Court of Appeal and the High Court of Justice), appointed to hear appeals from the lower courts until the age of 70. After the Law Lords³ retire, they continue sitting in the House. In general, appeal hearings take place in Appellate Committee Rooms rather than in the

¹ The Parliament Act of 1911, amended by the Parliament Act 1949, s 1(1).

² Ibid s 2(1).

³ Also known as Lords of Appeal in Ordinary.

Chamber but still in the Parliament's building. The overlapping of two powers, legislative and judicative, is here quite visible but on the other hand the House of Lords ceased to impose checks and balances on the government's actions in the way which could guarantee effectiveness of such control. It seems that powers of the upper chamber will be further diminished due to The Constitutional Reform Act 2005.

II. The main provisions introduced in the Constitutional Reform Act 2005

Ideological motives behind the Constitutional Reform Act 2005 concern the notion of separation of powers. It is said that this principle is substantially infringed by the fact that the House of Lords acts both as the upper chamber of Parliament in Britain and as a court of last resort. However, its main function is to revise the proposed new laws introduced by the Commons, so the Lords should preserve their independence and have more solid expertise than the lower chamber. According to Sir John Baker, Downing Professor of the Laws of England at the University of Cambridge, separation of powers is not a concept on which constitutional principles in Britain are fundamentally based. On the contrary, the functioning of the English system actually consists in an interlocking of powers.⁴

The fundamental change introduced by the Act concerns the establishment of a new supreme court in place of Law Lords in order to separate them from the legislature.⁵ When these provisions come into force in October 2009, the Supreme Court will take over the appellate jurisdiction of the House of Lords. Under the new regulations, the Justices of the Supreme Court ("the judges other than the President and Deputy President"⁶) will not be permitted to sit and vote in the House while holding office.⁷ A decision of the Supreme Court "on appeal from a court of any part of the United Kingdom, other than a decision on a devolution matter, is to be regarded as a decision of a court of that part of the United Kingdom"⁸.

Apart from that, sweeping changes were made with reference to the office of Lord Chancellor so that its holder no longer sits as a judge or acts as head of judiciary system and speaker of the House of Lords.⁹ Lord Chancellor's judicial functions in turn were transferred to the Lord Chief Justice (this post was first assumed by Lord Phillips Of Worth Matravers).

⁴J Baker, 'The Constitutional Revolution', Talk given in St Catharine's College, Cambridge, on 20 April 2004.

⁵ Constitutional Reform Act 2005 s 23(1).

⁶ Ibid s 23(6).

⁷ Ibid s 137.

⁸ Ibid s 41(2).

⁹ Baroness Hayman became Lords' first ever Speaker.

Furthermore, the Act provides the establishment of a Judicial Appointments Commission which takes over previous functions of Lord Chancellor in the sphere of recommending judicial appointments. According to the provisions of the Act, the persons who immediately before the commencement are Lords of Appeal in Ordinary become *ipso iure* judges of the Supreme Court and the person who holds office of the senior Lord of Appeal in Ordinary and the second senior Lord of Appeal in Ordinary becomes the President of the Court and the Deputy President of the Court respectively.¹⁰ When vacancies arise a selection commission will be convened by Lord Chancellor.¹¹ This will comprise “the President of the Supreme Court; the Deputy President of the Supreme Court; one member of each of the following bodies: the Judicial Appointments Commission, the Judicial Appointments Board for Scotland, the Northern Ireland Judicial Appointments Commission.”¹² There is a regulation that “the commission must have regard to guidance given by the Lord Chancellor as to matters to be taken into account in making a selection”¹³. Admittedly, Lord Chancellor may reject the selected person in case when they are not suitable for the office concerned or request reconsideration of a selection¹⁴ but this power may be exercised only if reasons for rejecting or requiring reconsideration of a selection are presented to the commission in writing¹⁵.

III. Separation of powers or the end of judicial independence

The idea of separation of powers, which the Constitutional Reform Act 2005 was to represent, was not warmly received during a spirited debate on 20 June 2006. Lord Waddington, for instance, expressed his concern due to the prospective disqualification of the Law Lords from the membership of the House, as well as the possibility that retired Justices of the Supreme Court would not be allowed to sit in Parliament. “Is it not rather absurd that, when the Supreme Court is set up the Law Lords will be kicked out for no better reason than to emphasise the independence of the judiciary, which was never in doubt until the noble and learned Lord introduced his legislation, and to reinforce the doctrine of separation of powers, which was never part of our constitution? Surely we should try to save something from the wreck that the Government have created and at least make sure that, in any reformed House,

¹⁰ Constitutional Reform Act 2005 s 24.

¹¹ *Ibid* s 26(5).

¹² *Ibid* schedule 8, part 1, s 1(1).

¹³ *Ibid* s 27(9).

¹⁴ *Ibid* s 29.

¹⁵ *Ibid* s 30(3).

there is room for at least some retired Supreme Court judges.”¹⁶ Lord Falconer of Thoroton came out with a conclusion that “if you are to be appointed to the final court of appeal you should be appointed to a court and not to a parliament.”¹⁷ Lord Goodhart in turn assumed that there are already enough lawyers in the House irrespective of whether or not they would sit in Parliament after retirement.¹⁸

However, the issue whether the judiciary should be separated from the legislative power once and for all is not the only bone of contention. Judicial independence constitutes the crux of the matter in this respect. There is cause for concern that current government’s actions aiming at attenuating the powers of Lord Chancellor and politicizing his office will leave the U.K. judicial system in disarray and render it totally ineffective. The question arises as to whether Lord Chancellor, who traditionally upheld the independence of a judicial system, will be able despite his diminished authority to enforce main principles concerning judges’ accountability, namely adherence to rule of law, preservation of judges’ impartiality and enhancement of public confidence in judiciary. Constitutional Reform Act provides that “the Lord Chancellor and other Ministers of the Crown must not seek to influence particular judicial decisions through any special access to the judiciary”¹⁹ and states as follows: “The Lord Chancellor must have regard to the need to defend that independence; the need for the judiciary to have the support necessary to enable them to exercise their functions; the need for the public interest in regard to matters relating to the judiciary or otherwise to the administration of justice to be properly represented in decisions affecting those matters.”²⁰ Laws pertaining to upholding judicial independence after the establishment of the Supreme Court blur clear boundaries of the Lord Chancellor’s powers. Actually, the vague regulations of the Act give no clue how these powers should be exercised.²¹

The central idea of the independent, apolitical judiciary consists in the fact that the judges are able to pass sentences impartially regardless of any political affiliations. They should also be appointed in the procedure which provides necessary vetting of the candidates with regard to their merit, qualifications and objectivity. It is highly probable that the new regulations which required that Lord Chancellor relinquished the judicial powers were introduced to the detriment of courts’ independence. Professor John Baker points out that the

¹⁶ Hansard HL vol 683 col 628 (20 June 2006).

¹⁷ Ibid.

¹⁸ Ibid col 629.

¹⁹ Constitutional Reform Act s 3(5).

²⁰ Ibid s 3(6).

²¹ D Woodhouse, ‘The Constitutional Reform Act 2005 – defending judicial independence the English way’ [2007] (5) *International Journal of Constitutional Law* < <http://icon.oxfordjournals.org/cgi/content/full/5/1/153> > accessed 8 April 2009.

previous system of appointing judges was functioning beyond reproach to much greater extent than the new one because now there is no person such as Lord Chancellor who would be answerable for his judicial appointments, whereas the committees tend more to reach compromises and may act on political premises.²²

Moreover, the Lord Chancellor was previously “an eminent lawyer, sworn as a judge, and holding the highest lay office of state in the kingdom.”²³ Therefore, he didn’t need to seek promotion and had an inculcated idea of the necessity of preserving judicial independence. The holder of this office doesn’t need to be a lawyer any more and “is likely to be a career politician with an eye on higher office.”²⁴ Again a question arises whether the reforms which were conducted under pretence of fulfilling the idea of separation of powers and rendering the judiciary more democratic will not enhance the government’s position to the extent of actually disturbing the balance of powers.

IV. Balance of powers or powers off balance?

It is perfectly possible that the acclaimed reform which was meant to provide separation of powers is, in fact, something of a red herring. Why, one may ask, is it necessary to alter the system of Law Lords which functioned since the Appellate Jurisdiction Act of 1876 that called it into being? One of the possible reasons why to preserve the existing model is that it was sanctioned by social custom. This fear of change was criticized by Karl Popper in his work “The Open Society and Its Enemies” in reference to the idealistic philosophy of Plato, especially his views on the state, described by Popper as totalitarian justice. “The idealist formula is: Arrest all political change! Change is evil, rest divine. All change can be arrested if the state is made an exact copy of its original, i.e. of the Form or Idea of the city. Should it be asked how this is practicable, we can reply with the naturalistic formula: Back to nature! Back to the original state of our forefathers, the primitive state founded in accordance with human nature, and therefore stable; back to the tribal patriarchy of the time before the Fall, to the natural class rule of the wise few over the ignorant many.”²⁵ According to Karl Popper, social customs become ossified because people tend to share a magical attitude towards them. An intense dislike to any changes, enforced by a supernatural element standing

²² J Baker, ‘The Constitutional Revolution’, Paper delivered at Magdalen College, Oxford, 23 Oct. 2008.

²³ Ibid.

²⁴ Ibid.

²⁵ K Popper, ‘The Open Society and Its Enemies’ (Routledge, London and New York 2002), p. 95.

behind socially sanctioned customs, is a kind of rationalization of this fear – a fear most commonly found in very young children or rigid tribal societies.²⁶

Of course, keeping up with the times, as well as introducing a more effective system of checks and balances, seems highly recommendable. But what if democratic values and noble motives are a smokescreen for achieving political goals? A system which was supposed to prevent the legislature, the executive, as well as the judiciary, to overlap and have an excessive impact on each other, can lead to the situation in which one of the branches will gain unfettered power. Karl Popper, defined democracy as “not based upon the principle that the majority should rule; rather, the various equalitarian methods of democratic control, such as general elections and representative government, are to be considered as no more than well-tried and, in the presence of a widespread traditional distrust of tyranny, reasonably effective institutional safeguards against tyranny, always open to improvement, and even providing methods for their own improvement.”²⁷ The key word here is control. The open society requires effective functioning of the Parliament. If the executive branch gains far-reaching competences, not only the balance of powers will be shaken, but it will also mean an infringement of social contract.

According to Professor John Baker, an increasing role of the executive leads to the abuse of the law by the Government under the colour of executing emergency powers. This will be the beginning of the end of Parliament’s supremacy.²⁸ A disturbing example, for instance, constitute the regulations of the Legislative and Regulatory Reform Bill of 2006. “The Government had the effrontery to ask Parliament to give Ministers the power to amend, repeal or replace any Act of Parliament simply by making an Order.”²⁹ The Government also tries to expand their power under the pretence of fighting with terrorism. Is it possible that the battle against an unidentified enemy will make British system less democratic? Mainly by the Government’s interference in civil liberties. This situation evokes the same fears as those expressed in George Orwell’s novel “1984”.

A relatively strong position of the House of Lords is especially useful in cases such as a proposal to amend the Terrorism Act 2000, by passing the Counter-Terrorism Act 2008, and to extend pre-charge detention period for the suspected terrorism-related offences from 28 to maximum 42 days. This followed the former Government’s plan from 2005 to extend this period even to 90 days of detention without trial for this group of suspects. The House of

²⁶ Ibid 188.

²⁷ Ibid 137.

²⁸ J Baker (n 22).

²⁹ Ibid.

Lords blocked this controversial proposal. Without the House of Lords, being able to exercise checks on the Government's actions, the old values of Magna Carta could be neglected.

V. New Supreme Court – a matter-of-fact approach to the matter

Apart from philosophical deliberations on issues of separation of powers and its meaning for democracy, also slightly more pragmatic matters shall be considered. The new Supreme Court will be housed in the Middlesex Guildhall on London's Parliament Square – actually, opposite the Houses of Parliament. Supporters of the reform apparently came to a conclusion that establishing the Supreme Court in the Palace of Westminster would be inappropriate, as opposed to establishing it nearby, as if it was evident that at least now the influence of the legislature upon the judiciary would not reach that far.

The next problem are high costs of establishing the institution which, as a matter of fact, existed before. Is it indeed deemed necessary to make the highest court in Britain resemble the one in the United States? The running costs of the Supreme Court are estimated for £8.4m, whereas Appellate Committee Costs in years 2002-03 were £3.2m.³⁰ It is already known that the costs will be much higher than that. *The Times* called even the idea to establish the Supreme Court in the Middlesex Guildhall, which now houses Middlesex Crown Court, with seven courtrooms, 'Lord Falconer's supreme blunder'³¹. First of all, this building needs a thorough refurbishment. Second of all, many think that it is not suitable for the seat of the Supreme Court. "Whether in Washington, Tokyo, Jerusalem or Canberra, supreme courts are purpose-designed buildings of immense presence, gravitas and nobility. Compared with the overpowering presence of the Abbey, the Palace of Westminster and the Treasury on the other sides of Parliament Square, the Guildhall, fine though it is, will look a mere bagatelle, subservient to the others."³²

VI. Conclusions

The Constitutional Reform Act 2005 introduced a far-reaching irreversible change to the British constitutional law. The establishment of the Supreme Court and depriving the Law Lords of the right to sit and vote in Parliament, on the one hand, and on the other hand, divesting the Lord Chancellor of his judicial powers, may seem an epoch-making occurrence.

³⁰ G Dymond, 'The Appellate Jurisdiction of the House of Lords' [15 November 2007] House of Lords Library, Library Note, LLN 2007/008, p 26
<<http://www.parliament.uk/documents/upload/HLLAppellate.pdf>> accessed 14 April 2009.

³¹ M Binney, 'Lord Falconer's supreme blunder' *The Times* (London 22 June 2006).

³² *Ibid.*

But, in fact, it is only a tempest in a teacup. The controversies that arose over this reform, as well as its costs, are bigger than the potential benefits. The reform is, in fact, nothing but a cosmetic change. Time will show whether the proposed changes contribute to the defence of democracy, or quite the opposite. The limitations imposed on the Parliament, and in consequence lack of checks on the Government's actions, as well as ambiguous method of selecting judges, may render the British judicial system more susceptible to political manipulations. It is evident that current politics determines the plans concerning judiciary branch and, at the same time, tries to rationalize them with lofty ideas. Such ill-considered solutions, based on political matters and throwing public money away, do not bode well.

Moot court – the idea, use and role in legal education in the UK

1. Introduction

When I ask Polish students about mooting and its role in legal education, in most cases they are entirely surprised, and it seems they are not familiar with the topic. However, asking the same question to British students, the answer is completely different. Hardly anyone knows about mooting, since almost in each college and at each Faculty of Law mooting is an integral part of education. This paper is aimed at presenting the idea of 'Moot court' and explaining its role in legal education.

A 'moot' may be defined as an ancient English meeting, especially a representative meeting of the freemen of a shire.¹ Nowadays, it means a hypothetical case discussed by law students as an exercise.² 'Moot court' is often substituted by 'mock court', but It should be indicated that the terms do not mean the same thing. The former refers to a mock appellate court, while the latter describes a simulated jury trial or bench trial.³ The term 'moot court' stems directly from the word 'moot' and can be defined as a mock court a where hypothetical cause is discussed by law students as an exercise.⁴ The British have shortened the phrase from 'moot court' to simply 'a moot' and the activity is often referred to as 'mooting'.⁵ The idea of mooting is to help students to become lawyers and provide them with practical knowledge which they cannot obtain from law books or notes. The basis of this simulated trial is the 'moot point' or as others call it the 'moot question', meaning an issue or an argument for further discussion.⁶

2. The history of moot court

The first recorded reference of a moot court is found in the law of Ethelred the Unready published in 997.⁷ Prominent jurists, such as Pollock and Maitland researched the origin of the jury trial and discovered that Danish law required the moot to be held every weekend, and discussed how the twelve eldest things are to go out with the reeve and to swear

¹ *Webster's II New Riverside University Dictionary* (3rd edn Houghton Mifflin Harcourt, 2004)

² *The American Heritage Dictionary of the English Language* (4th edn Houghton Mifflin Company, Boston 2000)

³ R Rahman 'History of the moot court' <http://www.thedailystar.net/campus/2007/01/02/feature_court.htm> accessed 9 June 2009

⁴ *Webster's II New Riverside University Dictionary* (n 1)

⁵ RRahman (n 3)

⁶ Christine Ammer, *The American Heritage® Dictionary of Idioms* (Houghton Mifflin Harcourt, 1997)

⁷ M Arachid and CR Knerr, 'Brief History of Moot Court: Britain and U. S. 2000' [2000]

<http://www.eric.ed.gov/ERICDocs/data/ericdocs2sql/content_storage_01/0000019b/80/16/43/6e.pdf> accessed 9 June 2009

upon the relic that he puts into their hands that they will accuse no innocent and conceal any unguilty man.⁸ It is an example of the first recorded use of this word in a legal context.

However, the first written reference to mooting was located in the guide to the Inns of Court and Chancery of Robert Pearce. The British author asserted that ‘mooting’ became a common practice in England in the late 14th century in a chapter of his book entitled ‘A guide to the Inns of court and Chancery with notices of their ancient discipline, rules, orders and customs, reading, moots, masques, revels and entertainments...’.⁹

A further reference of mooting in English Law is found in a description of another British writer, George Crabb. He claimed that the a sort of exercise in the Inns of Court was called a moot, which derives from the Latin word for ‘to move’ or debate cases. These moots were usually performed by students of a certain standing, before they commenced practice. Mootmen in Lord Coke’s time were those who argued readers’ cases in the court of chancery. From the mootmen, after eight years’ study, were chosen utter Barristers.¹⁰ Another example of a written reference to the term ‘moot’ was the report for Henry VIII prepared by Nicholas Bacon in 1540.

The term ‘moot court’, together with changes in legal education which took place in the 19th century, has increased in its usage. When formal legal education began in the United States in the late 18th and early 19th centuries, it was very similar to that of the Inns of Court.¹¹ Many professors began to give lectures, which became to resemble and reflect a kind of moot court exercise. At the beginning of each class, a lecturer, acting as a judge, posed a legal problem, thus provoking and encouraging students to face, examine, and finally resolve it. In this way, the students were given the opportunity to play the role of a lawyer during a hearing and to obtain practical experience which, according to their professors, was better than reading lengthy books. The idea of mooting was welcomed with enthusiasm and satisfaction. This modified English system prevailed in the United States law schools until the onset of the case method, first introduced at Harvard Law School in 1870.¹²

3. Moot court nowadays

Nowadays ‘moot court’ is an extracurricular activity at many law schools in which participants take part in simulated court proceedings.¹³ It is like a kind of debate except that each member is marked on the basis of different criteria which include: the way the arguments are presented, how well they are constructed and developed, how a student responds to the

⁸ F Pollock and FW Maitland, *The History of English Law* (2nd edn Cambridge University Press, London 1968) 140–142.

⁹ RR Pearce, *A Guide to the Inns of Court and Chancery* (Butterworth’s, London 1855)

¹⁰ G Crabb, *A History of English Law* (1st American edn C. Goodrich, Burlington 1831)

¹¹ RJ Martineau, ‘Appellate Litigation: Its Place in the Law School Curriculum’ (1979) 39 *Journal of Legal Education* 71-88

¹² *Ibid*

¹³ R Rahman (n 3)

questions asked by judges, and how well a student knows the law. In a ‘moot court’ two or more student teams take part and prepare and argue a legal case. A case, which is the basis of the proceedings, can be real or hypothetical and often involves current issues, actual cases or difficult legal problems which students try to solve.

Taking part in mooting does not mean following strict rules involving the number of members or the number of teams. It depends on the Moot court programme of different Schools of Law. Some of them accept a small group of people for membership, who later take part in national or regional moot court competition. However, other law schools accept a larger number of members, and each member is matched with one competitor.¹⁴

4. Mooting as a part of legal education in England and Wales

We can’t describe ‘mooting’ in the United Kingdom as such, because the legal system is different in every British country, and mooting also varies depending on the jurisdiction in which it is to be heard.¹⁵ Analysing ‘moot’, we shall distinguish between mooting in England and Wales, and mooting in Scotland.

For years, mooting has been an important part of legal education in England and Wales. It is used in different ways and to different extent in various law schools. Mooting is a teaching tool in tutorials as well as a co-curricular activity offered through moots organised by Colleges and by Law Faculties. In many universities, it is almost impossible to avoid mooting while at law school. Moots within and between Colleges have a long history, particularly at the University of Oxford and at the University of Cambridge. For years, these two universities have been struggling against each other in moot competitions.

In England and Wales ‘moots’ typically simulate proceedings in the Court of Appeal and the House of Lords. At the beginning of the event, participants in a ‘moot court’ receive questions of law that are under dispute. These questions usually come from a set of agreed facts which was the subject of the decision of the trial at first instance. The moot point usually involves a decision on an unsettled issue of law. Two teams take part in mooting, and each team consists of senior or lead counsel and junior counsel. It is normal practice for the senior counsel to take the first point and the junior the second. A few weeks in advance, before the hearing of the moot takes place, the teams are divided into appellants and respondents. The teams have to prepare their cases as if they were barristers.

Mooting consists of two parts: written and oral. A few days before the moot takes place, each team will prepare and exchange their skeleton arguments or brief written submissions. Copies will also be provided to the judge along with the moot problem. Depending on the competition, the person chosen to judge a moot may be a current or a

¹⁴ DF Prenatt, ‘Frequently Asked Questions at and about King Hall, King Hall Law School USENET FAQ Part 6 of 9’ (1995) <<http://www.faqs.org/faqs/ucdavis/king-hall-faq/part6/>> accessed 9 June 2009

¹⁵ R Rahman (n 3)

retired judge, a practising barrister or a solicitor, an academic lawyer or even another student with demonstrated experience in mooting. After the written submissions, there is the oral part of mooting. Each member of a team has to present arguments. One of the differences between English and Scottish moot courts is the order of participants' speeches. In England and Wales, senior counsel addresses the court before junior counsel. Each participant has a set time to speak. Moreover, they have to refute the opposing arguments and respond to any questions asked by the judge during the moot. At the end of the moot court, the judge delivers a decision announcing the winner.

In England and Wales there are many inter-university competitions in mooting, including the English Speaking Union - Essex Court Chambers National University Mooting Competition and the Oxford University Press Mooting Competition.

5. Mooting as a part of legal education in Scotland

In Scotland 'moots' can be set in a variety of forums¹⁶ depending on the area of law. In a civil case a forum for a Scottish moot might be the Court of Session, the Sheriff's Court or the House of Lords and, occasionally, an Employment Appeal Tribunal. If the case involves criminal law, the moot might take place in the Appellate division of the High Court of Justiciary. The procedure involved and the kind of problems students face are similar to mooting in England and Wales, although we can highlight some significant differences.

First of all, in Scotland the order of participants' speeches is different. At the beginning of the event, a junior counsel for the appellant makes a speech, followed by junior counsel for the respondent and then the senior counsel for each side. The terms 'appellant' and 'respondent' are used loosely; depending on the forum, the appeal might be known as a 'reclaiming motion' and the appellant as the 'reclaimer'. The form of the moot is far more adversarial than that of English and Welsh moots because of the fact that appellants and respondents aren't facing the judge but instead they are facing each other during a moot.

Every year in Scotland there are many moot court competitions, as in England and Wales. The Scottish 'home' of mooting is Glasgow, where each year Scottish students participate in the Dean's Cup Competition, an internal mooting competition. Moreover, Glasgow is the host of the annual Alexander Stone Mooting Competition. However, Scottish law students don't limit themselves to competitions on the local stage. Hundreds of students take part in moot court competitions which involve the whole United Kingdom on an annual basis.

¹⁶ M Spillane, *International moot court; an introduction* (International Debate Education Association, Amsterdam – New York - Salem 2008)

6. The international idea of mooting and Moot Court Competitions

The idea of Moot Court Competitions comes from the United States and, like Law Advice Centres, which consist of law students who give legal advice, they are an integral part of legal education there. Apart from mooting competitions that exist at almost every university in the United States and in Commonwealth countries, every year there are many national or international moot court competitions, in which teams of students can take part, representing individual Schools of Law.

Although there are not as many moot programmes in Europe as in the UK or in the U.S., mooting arouses students' interest and they eagerly take part in international competitions, like such as the European Law Moot Court Competition, the ELSA Moot Court Competition on WTO Law and the Philip C. Jessup International Law Moot Court Competition. All of these competitions have been initiated by different Moot Court Societies or Moot Court Associations from all over the world (like the International Law Students Association – ILSA), which prepare students for participating in mooting. Competitions, which are organized every year, are typically sponsored by organizations with interest in one particular area of law, and the moot court problems address an issue in that field.¹⁷

International mooting usually takes a team format, focusing on a specific area of law and simulating proceedings before an international institution like the Court of Justice of the European Communities or the International Court of Justice. The rules of the competitions approximate real procedural rules, because one of the aims of competitions is to expand the students' knowledge about particular institutions and tribunals and methods of resolving legal cases. In moot competitions, there are usually four participants who are divided into two opposing teams which take different stands. Moreover, the teams are supported by a coach who takes care of them and, perhaps, also by researchers who do not present an oral argument. Participants receive a problem in advance, which includes the facts of the underlying case, and often an opinion from a lower court that is being challenged in the problem.¹⁸ They must then act, think and argue like real lawyers to convince the judges. Criteria for selecting the winner include Law, Presentation, Etiquette and Response to Judicial Intervention. Competitions are often judged by legal practitioners with expertise in the particular area of law concerned, or sometimes by sitting judges.¹⁹

Students who take part in moot court gain new experience and valuable skills which lawyers need to possess. Most of the time the prize is an internship in an international organization or legal institutions. Winners are often targeted by head-hunters from chambers and companies from different countries.

¹⁷ J Snape and G Watt, *How to Moot: A Student Guide to Mooting* (OUP, Oxford 2004)

¹⁸ J Snape and G Watt, *How to Moot: A Student Guide to Mooting* (OUP, Oxford 2004)

¹⁹ A Gillespie, 'Mooting for learning' (2007) 5 *Journal of Commonwealth Law and Legal Education* 19-37

7. The moot court in Poland

For many years the Polish have not been acquainted with the idea of mooting. Most universities put emphasis on theory instead of practice. Students have to memorize long formulas and rules which they are required to repeat in their exams. However, studying doesn't only mean reading books and obtaining knowledge, but also applying the theory in practice. This notion has led to appearance of 'mooting' in Poland.

Nowadays, at a few Polish universities there are organizations that prepare their members for participating in moot competitions, both national and international. Students take part in the ELSA Moot Court Competition which is organized by The European Law Students' Association (ELSA) or The Philip C. Jessup International Law Moot Court Competition. Apart from the 'international mooting struggle', each year the Polish stage of such moot court competitions is organized, as is the case with the Moot Court Competition conducted by The European Law Students' Association in Poland, which took place for the first time in 1999. The aim is to broaden students' knowledge about proceedings before the Court of Justice of the European Communities. Students from all over of Poland form 3-person teams to have the chance to take part in the competition which consists of two stages: written and oral. After the written part, three winning teams take part in the oral stage, a hypothetical trial. Although 'mooting' is a 'new creation' in Poland, it attracts more and more students.

Recently the idea of mooting was presented by The Common Law Society, one of the robustly existing student organization of the Faculty of Law of University of Warsaw. Every year, the Society organizes a series of workshops on practical legal skills held by renowned practitioners and scholars from both common law jurisdictions of Poland. The workshops were completed by the professional moot court competition on US 'commercial speech' which took place during the First International Law in Action Conference: Commercial Speech. Moreover, members of the CLS take part in prestigious international law mooting competitions such as Philip C. Jessup International Law Moot Court Competition in Washington.

There is no denying that 'mooting' in Poland doesn't play the same role in legal education as in the UK or in the US. Universities do not have obligatory 'moot court programmes', though this may change in a few years' time.

8. How to moot?

Though the novice, perhaps understandably influenced by TV programmes, tends to think that what is required is a resounding voice, a pompous manner, and the ability to stroll up and down with thumbs hooked into a waistcoat, glaring at some wretch at the bar of the courtroom, the reality is different.²⁰ Everyone who wants to participate in mooting should

²⁰ J Horrocks, 'Outline Guide to Student's Moot' <<http://bls.uwe.ac.uk/pdf/mooting.pdf>> accessed 7 June 2009

have some core skills. It is desirable that participant has an analytical mind. It is necessary to read the problem carefully in order to identify issues that are to be argued.²¹ Moreover, the participant should have wide knowledge in the area of law that forms the basis of the moot. Cursory reading of a book is not enough to take part in a competition. It's necessary to familiarize yourself with an issue, and prepare properly before arguing.

In addition, participants should find the main authorities that support their arguments, but it is worth remembering that one good authority is better than six mediocre ones. The structure of a speech is also very important. It can't be chaotic and incoherent, it's necessary to plan an order for each speech. Diction and behaviour can also be very helpful. Participants should put all their hearts into mooting and then it will be their 'key to success'.

9. Conclusions

It's worth asking oneself whether moot courts are a necessity, an aid for law students or simply another manifestation of commercialism. We now have hundreds of competitions, which consist of hypothetical trials. After all, for years, when moot courts didn't exist, people studied and graduated from universities, colleges and became successful lawyers.

In result, the question arises of whether or not mooting is really useful and necessary? The answer is straightforward. We definitely need a practice like 'moot courts'. Although students are presented with skilled lecturers and we learn a lot of theory, which is very important in our legal education, each student of law should know how to use it in practice. 'Mooting' provides such an opportunity, which widens experience and gives valuable skills. Moreover, mooting offers an insight into interesting and topical legal issues, and enhances our skills of persuasive advocacy and legal research and analysis in the formal context of an appellate court. Last but not least, mooting gives an opportunity to develop an understanding of substantive legal principles, to construct and defend legal arguments, to collaborate closely with teammates, and to interact with academic staff, practitioners and judges in an environment that is both rewarding and enjoyable.²²

²¹ Ibid

²² See J Snape and G Watt (n 17)

Trade Marks Registration under Polish Intellectual Property Law

1. Introduction

The Polish law has a long tradition in the field of intellectual property (IP). However, before the transformation of the year 1989 the role of that area of law was strictly limited. This had its origin inter alia in the lack of free market of goods. Therefore, the value of goods was not so important and manufacturers were not particularly interested in building the brand and then protecting it. The situation has changed radically after the transformation which occurred in Poland in 1989. In the situation of free competition between manufacturers, finding a customer became the main issue of functioning on the market. Polish entrepreneurs started to build their brands and, in consequence, it led to the necessity of protection of their intellectual property.

What is crucial, after 1989 Polish Government decided to integrate with the European Communities. In the article 66 of the 'Europe Agreements' from 16 December 1991,¹ the Republic of Poland proclaimed that it shall continue to improve the protection of intellectual, industrial and commercial property rights in order to provide a level of protection similar to that existing in the Community, including comparable means of enforcing such rights. Furthermore, Polish Government obliged to accede to the Munich Convention on the Grant of European Patents of 5 October 1973 and to other multilateral conventions on intellectual, industrial and commercial property rights.²

As a result, the Republic of Poland consequently improved the law to the standards of the European Community. The grounds for modern intellectual property were particularly laid down by replacing the Trade Mark Act of 1985³ by the Intellectual Property Act of 2000 (the IP Act)⁴. The new law adopted the European standards.⁵

1 Europe Agreement establishing an association between the European Communities and their Member States, of the one part, and the Republic of Poland, of the other part

2 See Annex XIII paragraph 1 to which Member States are Parties, or which are de facto applied by Member States

3 Trade Mark Act from 31 January 1985 (Journal of Laws No 5, item 17) (Ustawa z dnia 31 stycznia 1985 r. o znakach towarowych. (Dz. U. Nr 5, poz. 17 z dnia 15 lutego 1985 r.)

4 The Intellectual Property Act from 30 June 2000 (Journal of Laws No 49, Uniform text available in Journal of Law 2003, No 119, item 1117 with amendments), Ustawa z dnia 30 czerwca 2000 r. Prawo własności przemysłowej (Dz. U. z 2001 r. Nr 49, poz. 508) (tekst jednolity - Dz. U. z 2003 r. Nr 119, poz. 1117 z późn. zm.)

5 Inter alia First Directives of Council of 21 December 1988.

The main aim of this article is to point out the contemporary principles of Polish IP law concerning the trade marks, the obstacles to the registration of trade marks by the Polish Patent Office and their protection.

2. The application to the Patent Office

The very important answer for the question - what is the trade mark - was in Europe given by the European Court of Justice (ECJ) rather than by national jurisprudence. The more interesting and diverse issue within the EU Members States is application and proceedings before the national Patent Offices.

The application to the Polish Patent Office is regulated by articles 138-142 of the IP Act, where the general principle is set forth. Article 138 stipulates that one motion may regard only one trade mark. This motion should describe the trade mark and indicate what kind of products would be bearing these trade marks. If the applicants want to register a common trade mark, they must abide by the specific statute concerning the use of these trade marks. If the applicant has a prior right to the trade mark, he must note it in that motion together with the documents which can prove this fact.

The IP Act lays down that until the final approval the applicant may change the trade mark in such a way that he completes an amendment if such an amendment does not change the substance of the mark.⁶ Also until the final decision the applicant may withdraw the element which causes the obstacles to registration. Such an application sheet must be written in Polish technical terminology, and that the list should also be consistent with classification (in parentheses it is obviously a Nice classification). A photo or a picture of the trade mark should be attached to the registration sheet. In case of sound marks the soundtrack must be attached.

The Patent Office cannot change the application unless it notices obvious mistakes and simple language mistakes. In any case, such changes should not cover the classification if they were to alter the scope of protection.

3. Proceedings of registration

The Patent Office, within three months from receiving an application, must make the application public in order to be known for all interested, together with detailed information about what kind of goods will be bearing the trade mark. Originally, it should give the

⁶ Article 140

competition a chance to express the objection. When the IP Act became a law, the term for the application to be made public was six months, but after many demands from the patent agents the legislator changed it into three months. If the applicant makes the amendments which are contrary to the statute, on the ground of article 141¹, the Patent office gives the resolution in which it rejects the amendments.

The decision of giving the protection to the trade marks is made, after the office checks whether all the statutory requirements are met. In practice, after putting forward such an application, one has to wait for its examination from two to even four years. It seems too long, but the Patent Office is underfinanced and has a heavy workload.

If the Office states that application does not meet the legal requirements, it must give the negative decision. However, before doing so it has an obligation to inform the applicant about this fact and fix the term in which he may answer to the objection and explain his standpoint. In case when only one category of goods does not meet the requirements, the patent office before the refusal of giving the protection right for that part of goods inform about it, and afterwards it gives protection to the other part in which case all conditions are met.

If Patent Office states that there are no obstacles, it gives the decision but beforehand the applicant has to pay for ten years' period of protection. If he does not pay in due term, the office revokes its decision concerning the protection. Immediately after the approval decision the trade mark is entered in a special register, and the applicant receives the certificate which proves the fact of protection. The general rule of protection is that the possessor of protected trade mark can mark it by putting the symbol ® next to it.

In one of its ruling⁷ the Voivodeship Administrative Court in Warsaw stated that such a certificate which is, in fact, a kind of attestation in the sense of general administrative rule (article 217 § 2 pkt 1 of the Code of Administrative Procedure⁸) should be equal to the decision of protection. Because such a certificate, given to the plaintiff, does not cover all the elements of the trade mark distinguished in the decision, the appropriate office should take notice of all aspects of the decision, not only those figuring on the certificate.

4. Obstacles to receive the right of protection

The main obstacles to receive the protection are formulated in article 129 of the IP

⁷ Judgment of voivodeship VI SA/Wa 1597/05 known as ("Caffe Mokate Mocna") LEX nr. 193398

⁸ Code of Administrative Procedure from 14 June of 1960, Journal of Law 2000 No 98, Item 1071

Act, which provides that the law does not give the protection right to the marks which have not enough distinguished features. They are construed only by the elements which point out the kind of goods, their origin, the quality, amount, value, destination, the way of production and their function. They are adopted by colloquial language, and then used in honest business practice. In theory, it seems to be comprehensible, but in practice it is not as clear as it appears on the first glance.

The Voivodeship Administrative Court in Warsaw⁹ allowed trade marks to combine the letters and numbers. This was in a case where a company wanted to register for their product the trade mark “700” in Nice classification 16 i.e. the brochure and newspapers containing the crosswords. The Patent Office responded that under IP Act and according to the definition of trade mark such registration is impossible. The Court found that the Office breached the general rule of administrative proceedings by explaining the point of view not sufficiently. Moreover, Patent Office does not answer to the arguments which try to prove that such “trade mark” gets both the primary and secondary distinguishing ability. The Court explained the meaning of “trade mark” as defined in the Directive and ECJ. In this perspective, the “trade marks” containing only numbers are correct. On the other hand, the Court noted that the ‘naked’ numbers have not a primary distinguishability but, on the other hand, a trade mark can acquire it by being ‘used’ ie as a result of being put on the market.

Another problem arises with using the names. The Supreme Administrative Court stated¹⁰ that the situation in which one element could be used to different referents, for example for the chemical substance and some other product, as well, could not automatically cause the lack of described character. It is especially visible if such chemical substance constitutes the feature and destination of the goods. In this ruling the court stated also that the trade mark which contains information in a foreign language (an issue which should be important for a foreigner), could be registered only if the customers on the national market, who do not know the foreign language sufficiently, find that such goods possess the distinguishing function to the origin of the good.

4.1 Generic name problems.

But on the other hand, in other ruling the Voivodeship Administrative Court in

9 The Voivodeship Administrative Court judgment VI SA/Wa 294/04

10 Supreme Administrative Court judgment II GSK 56/07

Warsaw¹¹ emphasized that trade marks which constitute only signs consisting of information of general character, which used to mark this kind of goods or services, have not distinguishability, even if these signs are formulated in other language than Polish. In order to throw light on this issue, a case of M. CE shall be considered. This Belgian corporation with registered office in Esaimpus lodged a protest in 2004 in Polish Patent Office, claiming that the trade mark JAVEL is used unlawfully. The aforesaid trade mark belongs to the Nice class 3 (bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices) and 5 (pharmaceutical and veterinary preparations; sanitary preparations for medical purposes). The claimant, in a lawsuit said that the trade mark did not meet the Act's requirements and its registration was unlawful under articles 129 section 2 and 131 section 2 of IP Act. because it did not possess distinguishability, since its generic name was registered in bad faith. The plaintiff attached the definition of the word „javel” from the Great Polish-French Dictionary (1980) which said that the word means „water from Javel” or „chlorine water” so „eau javel” and „javel” mean the same thing.

As a result, in the above mentioned case the Patent Office agreed with the argumentation that the requirements of article 129 were not met. The claimant appealed against this decision to Voivodeship Administrative Court claiming that it was unlawful because the office misinterpreted the requirements, since an average end consumer in Poland understands by term “Javel” these chemicals. In the applicant's opinion, the term „eau de javel” is a generic name for hydrochloride potassium, however, only in France, which does not mean that in Poland it should be treated the same way. The applicant highlighted that the trade mark „Javel” does not contain any elements which make the end consumer think that it is a French word, inter alia because there is no indication that it has a typically French spelling. The court found that this argumentation was correct and the Patent Office did not breach both the substantial and procedural administrative law. In its opinion, it remains beyond any doubt that “javel” is a French word and appears quite frequently in the common use of language as an abbreviation from “eau de javel” which, in fact, means the chlorine water.

In the other precedent ruling the Voivodeship Administrative Court in case of signature VI SA/Wa 1705-06¹² pointed that goods possess proper distinguishing ability only if they

11 Voivodeship Administrative Court judgment VI SA/Wa 153/06

12 Voivodeship Administrative Court judgment VI SA/Wa 1705/06

possess the feature which helps to individualize them on the market among the same products. Furthermore, it should be noted that using such a good by a licensee cannot lead to the loss of distinguishing features, as the license-agreement concerning using the trade mark must be treated the same way as using by the licensor. The fact of giving the license to the other party must be regarded as a proof of the attractiveness of such a trade mark. It supports and enhances its position on the market. Even using the trade mark by many different licensees for many years cannot cause the loss of distinguishing feature which differentiates it from other producers who are not bound by such an agreement.

What is more, the Warsaw's Voievodship Administrative Court case law points out in another case of signature VI Sa/Wa 1420/06¹³ said that the Patent Office first must check the general ability of a mark to become a trade mark. Only after such an examination the Office checks whether the mark existing on the market of the particular product possesses the distinguishing feature in a sufficient extent. The lack of such distinguishing feature is an absolute obstacle to registration. However, using such a mark on the market for a long time may lead to acquiring of a distinguishing feature.

4.2. The problem with foreign words.

In the Polish jurisprudence it is said that under both the old and new IP law, the graphical signs, as well as the combinations of words and graphical elements and signs consisting of words can be regarded as those which are only the generic description¹⁴. The English word "Miss" does not have a distinguishing character. The same applies to the symbol which constitutes only the shape of a crown, but in this case it is not absolute because it is not constructed only by such elements. The mark can be distinguished by the following elements: design, lettering, characteristic coloring and layout of the elements.

The above-mentioned opinion was issued as a result of the Polish Supreme Court decision in the case of signature I CKN 1128/98¹⁵ The plaintiff sued the defendant on the basis of using the word "miss" in the trade mark with regard to certain events such as „Miss of Warsaw” or „Miss of Warsaw teenagers”. The protected trade mark consists of an inscription “miss” and the stylish crown. The defendant used only the inscription so in his

13 Voievodship Administrative Court judgment VI SA/Wa 1420/06

14 OSP 2002/2/20 Stefanicki R – R Stefanicki, Gloss to the – tytuł poda czy co

15 The Supreme Court decision I CKN 1128/98 < <http://prawo.money.pl/orzecznictwo/sad-najwyzszy/postanowienie;sn;izba;cywilna,ic,i,ckn,1128,98,3992,orzeczenie.html>>

opinion the character of his trade mark was different. What is more, in Polish the word “miss” is in common use. The Supreme Court pondered upon the issue whether the word “miss” is just a generic name. In order to establish its proper meaning the Court looked it up in a dictionary and noted that besides the common use of this word, especially in Anglo-Saxon countries, which is closely connected with choosing the most beautiful woman, sometimes, however, it refers to the other things. Organizing a beauty contest is a very popular event, regardless whether its character is institutional or rather temporary, and it always leads to one final effect. In such a contest, people who are to win are the centre of attention, which creates no connection with the subject, included in the name of the registered trade mark. Thus, in opinion of the court using the word „miss” have not distinguishing features as defined by the former act. An organizer of the contest who simultaneously is the user of this word which, by its nature, is only the generic name, does not mislead the audience.

The group of the trade marks which have not distinguishing features includes also such marks which indicate amount, quality, or destination of a good. The marks which are the part of everyday language (such as trade marks ‘artificial leather’) have not such features, as well.

4.3 Similarity of trade marks

With regard to determining the similarity of particular trade marks, three dimensions should be taken into consideration: the visual, the phonetic and the meaning– the most important element for it makes the general impression on an average receiver, for whom such a mark should distinguish from other signs sufficiently in order to indicate the origin of the product.¹⁶

In the case of 6 SA 416/03, the Voivodeship Administrative Court decided that the general information included in the trade marks consisting of words and graphic elements do not *ipso per se* lose the distinguishability just as the word “common” within the phrase “common margarine” does not.¹⁷ There is no instruction which shape trade marks may not take but they should create in consumer’s mind a connotation with the origin of only one producer. In this case an entrepreneur wanted to register the trade mark which constituted the combination of two colors: white and orange. It was already entered in the international register of trade marks on the ground of Madrid agreement. The Court found that the

¹⁶ The Voievodship Administrative Court judgement Wsa VI sA/Wa 1660/04

¹⁷ The Voievodship Administrative Court judgement in the case of signature WSA 6 SA 416/03

composition of colors can be registered as a trade mark, but such a composition should be new and original. The court noted that with regard to ‘international standards’, the applicant did not describe the exact proportion of colors and, thus, in Court’s opinion the trade mark cannot be distinguished from the ones possessed by other companies in good faith. Moreover, the defendant did not use exactly the same composition which was registered. The attached material illustrated that the colors were overlapping, which was regarded by the Court as characteristic. However, the registered trade mark consisted of smooth colors.¹⁸

The trade mark indicating directly only to the intended use of the product is deprived of its distinguishability. In the Voievodship Administrative Court in Warsaw case of VI SA/Wa VI 2241/04¹⁹, one company sued the other for using the trade mark “Alergin” because in its opinion such pharmaceutical is only a generic name for a common illness: allergy so, as a matter of fact, it cannot possess the first and second distinguishability. In this case the Court noted that such a name has an imaginative character and it is not the generic name. Indeed such a name is very close to a generic name but in Polish jurisprudence giving it is not forbidden.²⁰

A trade mark can receive the secondary distinguishability, if there exists a connotation with the origin of the the trade mark. In the Voievodship Administrative Court in Warsaw case of signature WSA 6 II SA 3170/02²¹ the applicant wanted to register the trade mark ‘super’ which consisted of the words: ‘super’ and the ‘caffe bean’. In opinion of the court such a trade mark cannot indicate to the producer of a product and in consequence cannot get the second distinguishability. Many producers of various goods may use the word “super” with regard to their products. In result, the consumer cannot distinguish whether such a product has one common origin.

4.4 Problem with well-known part of trade marks

The very famous ruling of The Judgment of Voievodship Administrative Court in Warsaw signature VI SA/Wa 1100/07²² concerned the registration of trade mark ‘MacCoffe’. The claimant, Company “M” with registered office in the United States, argued that the registration of this trade mark by other company from Singapore was unlawful. The registered

¹⁸The Judgment of Supreme Administrative Court judgment NSA GSK 864/0

¹⁹ The Voievodship Administrative Court judgement VI SA/Wa VI 2241/04

²⁰ The Voievodship Administrative Court judgement WSA VI SA/Wa VI 2241/04

²¹ The Voievodship Administrative Court judgement WSA 6 II SA 3170/02 unpublished

²² The Voievodship Administrative Court judgement VI SA/Wa 1100/07

<<http://orzeczenia.nsa.gov.pl/doc/5080D49DB1>>

trade mark was a combination of words and pictures and was entered in the register in Nice classification 30 i.e. the coffee and its components, moreover the tea, tea blend, and chocolate to drink. The claimant noted that he is the owner of ten other trade marks: BIG MAC, MCCHICKEN, FISH MAC, M MCDONALD'S, EGG MCMUFFIN, MC PIZZA, MC BURGER, McDONALDLAND, McBACON, registered earlier in Nice class 30. In his opinion a trade mark may confuse the end consumer as to the origin of such goods. Moreover, he claimed that the Polish Patent Office infringed the appropriate Directive 89/104/EEC²³ and did not respect the European Court of Justice rulings.

The Court found that claimant did not explain why in his opinion those provisions of the Directive were breached. Just noting a violation of the rules is not enough. The court stated that the similarity was not proved as well. Probably the most similar element is the syllable 'Mac', which in opinion of company M is the dominant part of the trade mark in question. In this case the trade mark consists of two words: Mac and Coffee. The first generally means nothing, the second one is clear. The combination of those two words give a new, invented word. The visual dimension is different from the characteristic trade marks of the claimant. Under such circumstances, even if the word 'Mac' is the most characteristic, the registration of the word 'Mac' is with detriment to the rest of the market. In opinion of the court the syllable 'Mac' or 'Mc' are very common both in Poland and around the world. However, the similarity of two trade marks cannot be compared only by one syllable. In opinion of the court the probability that the products bearing such trade marks, sold in various places to different consumers, would be confused, does not exist. Hence, the Court found that claim of company M was unfounded.

5. Conclusions.

The free market competition caused the increase the number of cases. The task of that Article was to outline the general line of case law of Polish tribunals, on the ground of the most typical and famous litigations, which occurred in practice. The cases show the wide range of problems which arise on the intellectual property law. Some problems are typical and occurred in other states, the ruling of other state tribunals are generally similarly to that which gave the Polish courts.

26 First Directive 89/104/EEC of the Council, of 21 December 1988, to Approximate the Laws of the Member States Relating to Trade Marks <<http://www.oami.europa.eu/en/mark/aspects/direc/direc.htm>>

The doctrine of public policy in English private international law

1. Introduction.

One of the main principles of the private international law is when a court renders a decision in a case where the factual circumstances are connected with a foreign country, it can use the law of this country instead of *lex fori*. This principle was clearly expressed in *Kuwait Airways Corp v Iraqi Airways Co*¹ in which the House of Lords stated that:

The jurisprudence is founded on the recognition that in proceedings having connections with more than one country an issue brought before a court in one country may be more appropriately decided by reference to the laws of another country even though those laws are different from the law of the forum court. The laws of the other country may have adopted solutions, or even basic principles, rejected by the law of the forum country. These differences do not in themselves furnish reason why the forum court should decline to apply the foreign law.²

However, many legal systems contain rules, the application of which would be completely unacceptable in other countries. In other words, the application of such rules would lead to results that would be manifestly unjust in the country, where the question is being decided. To prevent such unacceptable judgments most states introduced to their private international law provisions which restrict the application of foreign law. In English law this function is realised mainly by the doctrine of public policy. The task of this paper is to present the basics of this doctrine.

2. The effects of the application of the doctrine.

It should be noted that in English jurisprudence private international law covers the issue of both substantive and procedural law. Thus, the doctrine of public policy can be invoked in order to exclude the application of foreign rules or the recognition and enforcement of foreign judgments.³

¹ *Kuwait Airways Corp v Iraqi Airways Co* (Nos 4 and 5) [2002] 2 AC 883

² *Ibid* 1078

³ See W Ludwiczak, *Mi dzynarodowe Prawo Prywatne* (3rd edn PWN, Warszawa 1979) 23

If the application, recognition or enforcement of a foreign rule or a foreign court decision would be against English public policy, an English court will not give effect to this rule or judgment. 'It is as though it did not exist'.⁴ Such a law or judgment will be disregarded and the English court will make a decision with no respect to it.

With regard to the application of foreign rules in English jurisprudence, it is stressed that the doctrine of public policy can be used only to refuse the application of a foreign law, ie not to invoke the application of an otherwise inapplicable law.⁵ This rule was expressed in the case of *Bank voor Handel en Scheepvaart NV v Slatford*.⁶ In this case, a Dutch bank deposited some amount of gold in London before the beginning of the Second World War lepiej mi brzmi stylistycznie. With the approval of the UK Government, the Royal Netherlands Government, which established itself in London after the Netherlands were invaded by the Germans, exercised their powers from London and issued a decree which had the effect of transferring property, such as the gold bars, to the Netherlands Government. On the question of whether the Netherlands' decree was effective in transferring the gold bars to the Dutch state, it was held that it was only effective regarding property that was situated within the given state (the Netherlands) and did not apply to the property that was situated in England. The court rejected any public policy arguments and stated that it should not be used in a positive sense or 'as a sword' to allow the recognition of a foreign decree.

3. The extent of the doctrine.

The doctrine of public policy and the way in which it is applied has been entirely created by common law.⁷ It also appears in some recent statutes regulating conflict of laws but these statutes do not contain the definition of public policy or its role. Thus, the meaning of public policy and the way in which this doctrine is applied should be inferred completely from common law. In theory, public policy can be taken into account in any case. However, it is used mainly with regard to the recognition of foreign legal statutes, capacities and incapacities, the law of contract, and questions of title to property.⁸

English jurisprudence distinguishes two groups of cases in which the court may use the doctrine of public policy. From another point of view it can be said that public policy may have two different meanings. According to one of them, public policy means fundamental

⁴ *Kuwait Airways* (n 1) 991

⁵ C Clarkson, *Conflict of Laws* (3rd edn Oxford University Press, New York 2006) 484

⁶ *Bank voor Handel en Scheepvaart NV v Slatford* [1953] 1 QB 248

⁷ C Clarkson (n 5) 485

⁸ J Collier, *Conflict of Laws* (3rd edn Cambridge University Press, Cambridge 2004) 361

English ideas of morality, decency, human liberty or justice.⁹ A foreign law that is contrary to these values shall not be applied and the foreign judgment shall not be recognised or enforced, if it violates them. In such a case, the doctrine of public policy would be invoked even if the case has connections only with other countries and, therefore, no English interest is infringed.

English courts have provided a wide variety of judicial decisions that exemplify in which situations laws or judgments are repugnant to public policy. For example, in *Oppenheimer v Cattermole*¹⁰ the court considered whether to give effect to Nazi laws providing for the confiscation of property belonging to Jews. On the question of whether the seizure by the German government of this property situated within its territory should be recognized in England, the court held that a foreign law which ordered to take away property on the grounds of race was a gross violation of human rights and such a seizure was not to be recognized. Similarly, in *Kuwait Airways Corp v Iraqi Airways Co*¹¹ the court considered the case in which at the time of the invasion of Kuwait by Iraqi military forces in 1990 aircrafts were seized by the Iraqi forces on the grounds of two resolutions proclaiming ‘the sovereignty of Iraq over Kuwait and its annexation to Iraq.’ The court decided that confiscation orders are in gross breach of clearly established principles of international law and refused to give effect to them.

There are many other judgments that can be classified in this group including: a rule prohibiting the guilty party of a divorce from remarrying before the innocent party does so,¹² a rule upholding a contractual promise by a wife to repay money stolen by her husband as the price for a criminal prosecution not being brought against the latter,¹³ the refusal to recognise or enforce judgments obtained by fraud,¹⁴ the refusal to recognise or enforce judgments obtained by duress,¹⁵ the refusal to recognise a foreign maintenance agreement entitling a child to receive maintenance after minority,¹⁶ the refusal to recognise an extra-judicial divorce when the marriage had substantial connections with England and recognition would mean that the wife would have been deprived of the financial relief to which she would be entitled under English law,¹⁷ the refusal to give effect to foreign confiscatory laws which, as the court stated,

⁹ C Clarkson (n 5) 485

¹⁰ *Oppenheimer v Cattermole* [1976] AC 249 278-282

¹¹ *Kuwait Airways* (n 1) 883

¹² *Scott v A-G* (1886) 11 PD 128

¹³ *Kaufman v Gerson* [1904] 1 KB 591

¹⁴ *Kendall v Kendall* [1977] Fam 208

¹⁵ *Kaufman* (n 13) 591

¹⁶ *Re Macartney* [1921] 1 Ch 522

¹⁷ *Chaudhary v Chaudhary* [1985] Fam 1

by reason of their being discriminatory on grounds of race, religion or the like, constitute so grave infringement of human rights that they ought not to be recognised as laws at all.¹⁸

In the second group of cases the doctrine of public policy is understood as a rule, which protects English public interest. If the law or the judgment threatens the English public interest, it will not be applied, enforced or recognised even if it does not violate values like morality, decency, human liberty or justice.¹⁹ Similarly as in the first group of cases, the detailed meaning of public interest can be inferred from judicial decisions. Those include judgments where court: refused to give effect to a clause in restraint of trade,²⁰ refused to enforce a contract to import liquor contrary to a friendly country's prohibition laws,²¹ refused to enforce a contract to export goods prohibited in a friendly country.²² Consequently, such meaning of public policy is found in *Saxby v Fulton*,²³ in which the court enforced a contract for the loan of money to be used for gambling in Monte Carlo. If the gambling had to take place in England, the contract would have been unenforceable.²⁴ In this example the difference between two meanings of public policy can be seen. If the court had found that loaning money for gambling is contrary to values presented above (public policy in the first meaning), the contract for the loan of money would have not been given effect, no difference in which country the money had to be used.

4. Similar institutions

In English private international law there are many principles which have the same function as the doctrine of public policy. For example in *Adams v Cape Industries plc*²⁵ the court introduced a rule that a foreign judgment will not be recognised, if insufficient notice of the foreign proceedings was given or, if no reasonable opportunity to take part in the proceedings was provided. A similar rule may be found in *Owens Bank Ltd v Bracco*²⁶ where a foreign commercial judgment obtained by fraud was not recognised or enforced. If these rules were not in force, the court would have to use the doctrine of public policy.

Another institution similar to the doctrine of public policy can be found in a series of court decisions refusing to apply a foreign law or recognise a foreign judgment on the

¹⁸ *Williams & Humbert Ltd. v W & H Trade Marks (Jersey) Ltd.* [1986] AC 379

¹⁹ C Clarkson (n 5) 489

²⁰ *Rousillon v Rousillon* (1880) 14 Ch D 351

²¹ *Foster v Driscoll* [1929] 1 KB 470

²² *Regazzoni v KC Sethia* (1944) Ltd [1958] AC 301

²³ *Saxby v Fulton* [1909] 2 KB 208

²⁴ C Clarkson (n 5) 489

²⁵ *Adams v Cape Industries plc* [1990] Ch 433

²⁶ *Owens Bank Ltd v Bracco* [1992] 2 AC 443

grounds that it offends English notions of substantial justice.²⁷ For example, in *Gray v Formosa*²⁸ a Maltese nullity decree granted on the ground that the parties had not married in a Roman Catholic church was refused to be recognised as offending English notion of substantial justice. Also in *Adams v Cape Industries plc*²⁹ it was decided that a process, whereby the amount of the plaintiff's damages was averaged – with the plaintiffs being placed by their lawyers in four bands according to the seriousness of their injuries – rather than assessed following a judicial investigation into the injuries sustained by each plaintiff, offended English notions of substantial justice. The court did not give any explanation of the relationship between public policy and substantial justice. In English jurisprudence this issue remains unclear.³⁰

5. The limits of the doctrine

The doctrine of public policy is used relatively rarely in the English conflict of laws, especially in comparison with the law of some foreign countries such as France or Germany.³¹ One reason for this is the existence of other institutions with the same function. The other is the construction of the whole system of English private international law, which orders to apply English law incredibly often.³² For example, any matter of procedure automatically falls under English law. If the applicable law is *lex fori*, there is no chance of considering public policy. English courts also broaden the ambit of these rules to make a decision on the basis of English law that is well known to the judges.³³

The other reason of the narrow space left for the doctrine of public policy is the common opinion among English judiciary that public policy should only be invoked 'exceptionally and with the greatest circumspection'.³⁴ 'The golden rule is that care must be taken not to expand its application beyond the true limits of the principle. These limits demand that, where there is any room for doubt, judicial restraint must be exercised'.³⁵ In jurisprudence it is often stressed that it is 'necessary that the doctrine should be kept within proper limits, otherwise the whole basis of the system is liable to be frustrated'.³⁶

²⁷ *Pemberton v Hughes* [1899] 1 Ch 790

²⁸ *Gray v Formosa* [1963] P 259

²⁹ *Adams* (n 27)

³⁰ C Clarkson (n 5) 487

³¹ L Collins (ed), *Dicey & Morris on The Conflict of Laws* (13th edn Sweet & Maxwell, London 2000) 82

³² PB Carter, 'The Role of Public Policy in English Conflict of Laws' (1993) 42 ICLQ 3

³³ C Clarkson (n 5) 485

³⁴ *Kuwait Airways* (n 1) 1078

³⁵ *Ibid* 1109

³⁶ L Collins (n 33) 81

It is also argued that using public policy is ‘discourteous to the foreign state whose law is excluded. It is like throwing stones at your neighbour’s house.’³⁷ This comparison seems to be quite popular. For example in *R v Brentwood Superintendent of Marriages*³⁸ the court stated that ‘many foreign laws are different and even strange to English eyes but those who live in legal glass houses, however well constructed, should perhaps not be over-astute to throw stones at the laws of other countries’. In *Loucks v Standard Oil Co*³⁹ it was also stated that ‘We are not so provincial as to say that every solution of a problem is wrong because we deal with it otherwise at home. ... The courts are not free to refuse to enforce a foreign right at the pleasure of the judges, to suit the individual notion of expediency or fairness. They do not close their door unless it would violate some fundamental principle of justice, some prevalent conception of good morals, some deep-rooted tradition of the common wealth.’ From these reasons the role of public policy in English conflict of laws is still declining.

6. Conclusions

Abundant international exchange throughout the history of England resulted in the impressive amount of judgments in which the institution of public policy has been shaped. However the meaning of the doctrine is quite capacious, the ensemble of the system of English private international law causes that the area to invoke public policy is rather narrow. Moreover, English judiciary has been recently changing in the direction to restrain the role of public policy even more.

English experience with the doctrine of public policy and similar institutions can and should be exploited in Polish law. Rapidly growing international exchange with Poland will certainly result in similar growth in number of legal cases containing international element. However Polish and English legal systems differ immensely, some parts of the extremely rich outcome of the English judiciary and jurisprudence will certainly be useful.

³⁷ N. Enonchong, ‘Public Policy in the Conflict of Laws: A Chinese Wall Around Little England?’ (1996) 45 ICLQ 653.

³⁸ *R v Brentwood Superintendent of Marriages, ex p Arias* [1968] 3 WLR 537

³⁹ *Loucks v Standard Oil Co* (1918) 120 NE 201–202

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² *Ibid* 1078

³ See W Ludwiczak, *Mi dzynarodowe Prawo Prywatne* (3rd edn PWN, Warszawa 1979) 23

If the application, recognition or enforcement of a foreign rule or a foreign court decision would be against English public policy, an English court will not give effect to this rule or judgment. 'It is as though it did not exist'.⁴ Such a law or judgment will be disregarded and the English court will make a decision with no respect to it.

With regard to the application of foreign rules in English jurisprudence, it is stressed that the doctrine of public policy can be used only to refuse the application of a foreign law, ie not to invoke the application of an otherwise inapplicable law.⁵ This rule was expressed in the case of *Bank voor Handel en Scheepvaart NV v Slatford*.⁶ In this case, a Dutch bank deposited some amount of gold in London before the beginning of the Second World War lepiej mi brzmi stylistycznie. With the approval of the UK Government, the Royal Netherlands Government, which established itself in London after the Netherlands were invaded by the Germans, exercised their powers from London and issued a decree which had the effect of transferring property, such as the gold bars, to the Netherlands Government. On the question of whether the Netherlands' decree was effective in transferring the gold bars to the Dutch state, it was held that it was only effective regarding property that was situated within the given state (the Netherlands) and did not apply to the property that was situated in England. The court rejected any public policy arguments and stated that it should not be used in a positive sense or 'as a sword' to allow the recognition of a foreign decree.

3. The extent of the doctrine.

The doctrine of public policy and the way in which it is applied has been entirely created by common law.⁷ It also appears in some recent statutes regulating conflict of laws but these statutes do not contain the definition of public policy or its role. Thus, the meaning of public policy and the way in which this doctrine is applied should be inferred completely from common law. In theory, public policy can be taken into account in any case. However, it is used mainly with regard to the recognition of foreign legal statutes, capacities and incapacities, the law of contract, and questions of title to property.⁸

English jurisprudence distinguishes two groups of cases in which the court may use the doctrine of public policy. From another point of view it can be said that public policy may have two different meanings. According to one of them, public policy means fundamental

⁴ *Kuwait Airways* (n 1) 991

⁵ C Clarkson, *Conflict of Laws* (3rd edn Oxford University Press, New York 2006) 484

⁶ *Bank voor Handel en Scheepvaart NV v Slatford* [1953] 1 QB 248

⁷ C Clarkson (n 5) 485

⁸ J Collier, *Conflict of Laws* (3rd edn Cambridge University Press, Cambridge 2004) 361

English ideas of morality, decency, human liberty or justice.⁹ A foreign law that is contrary to these values shall not be applied and the foreign judgment shall not be recognised or enforced, if it violates them. In such a case, the doctrine of public policy would be invoked even if the case has connections only with other countries and, therefore, no English interest is infringed.

English courts have provided a wide variety of judicial decisions that exemplify in which situations laws or judgments are repugnant to public policy. For example, in *Oppenheimer v Cattermole*¹⁰ the court considered whether to give effect to Nazi laws providing for the confiscation of property belonging to Jews. On the question of whether the seizure by the German government of this property situated within its territory should be recognized in England, the court held that a foreign law which ordered to take away property on the grounds of race was a gross violation of human rights and such a seizure was not to be recognized. Similarly, in *Kuwait Airways Corp v Iraqi Airways Co*¹¹ the court considered the case in which at the time of the invasion of Kuwait by Iraqi military forces in 1990 aircrafts were seized by the Iraqi forces on the grounds of two resolutions proclaiming ‘the sovereignty of Iraq over Kuwait and its annexation to Iraq.’ The court decided that confiscation orders are in gross breach of clearly established principles of international law and refused to give effect to them.

There are many other judgments that can be classified in this group including: a rule prohibiting the guilty party of a divorce from remarrying before the innocent party does so,¹² a rule upholding a contractual promise by a wife to repay money stolen by her husband as the price for a criminal prosecution not being brought against the latter,¹³ the refusal to recognise or enforce judgments obtained by fraud,¹⁴ the refusal to recognise or enforce judgments obtained by duress,¹⁵ the refusal to recognise a foreign maintenance agreement entitling a child to receive maintenance after minority,¹⁶ the refusal to recognise an extra-judicial divorce when the marriage had substantial connections with England and recognition would mean that the wife would have been deprived of the financial relief to which she would be entitled under English law,¹⁷ the refusal to give effect to foreign confiscatory laws which, as the court stated,

⁹ C Clarkson (n 5) 485

¹⁰ *Oppenheimer v Cattermole* [1976] AC 249 278-282

¹¹ *Kuwait Airways* (n 1) 883

¹² *Scott v A-G* (1886) 11 PD 128

¹³ *Kaufman v Gerson* [1904] 1 KB 591

¹⁴ *Kendall v Kendall* [1977] Fam 208

¹⁵ *Kaufman* (n 13) 591

¹⁶ *Re Macartney* [1921] 1 Ch 522

¹⁷ *Chaudhary v Chaudhary* [1985] Fam 1

by reason of their being discriminatory on grounds of race, religion or the like, constitute so grave infringement of human rights that they ought not to be recognised as laws at all.¹⁸

In the second group of cases the doctrine of public policy is understood as a rule, which protects English public interest. If the law or the judgment threatens the English public interest, it will not be applied, enforced or recognised even if it does not violate values like morality, decency, human liberty or justice.¹⁹ Similarly as in the first group of cases, the detailed meaning of public interest can be inferred from judicial decisions. Those include judgments where court: refused to give effect to a clause in restraint of trade,²⁰ refused to enforce a contract to import liquor contrary to a friendly country's prohibition laws,²¹ refused to enforce a contract to export goods prohibited in a friendly country.²² Consequently, such meaning of public policy is found in *Saxby v Fulton*,²³ in which the court enforced a contract for the loan of money to be used for gambling in Monte Carlo. If the gambling had to take place in England, the contract would have been unenforceable.²⁴ In this example the difference between two meanings of public policy can be seen. If the court had found that loaning money for gambling is contrary to values presented above (public policy in the first meaning), the contract for the loan of money would have not been given effect, no difference in which country the money had to be used.

4. Similar institutions

In English private international law there are many principles which have the same function as the doctrine of public policy. For example in *Adams v Cape Industries plc*²⁵ the court introduced a rule that a foreign judgment will not be recognised, if insufficient notice of the foreign proceedings was given or, if no reasonable opportunity to take part in the proceedings was provided. A similar rule may be found in *Owens Bank Ltd v Bracco*²⁶ where a foreign commercial judgment obtained by fraud was not recognised or enforced. If these rules were not in force, the court would have to use the doctrine of public policy.

Another institution similar to the doctrine of public policy can be found in a series of court decisions refusing to apply a foreign law or recognise a foreign judgment on the

¹⁸ *Williams & Humbert Ltd. v W & H Trade Marks (Jersey) Ltd.* [1986] AC 379

¹⁹ C Clarkson (n 5) 489

²⁰ *Rousillon v Rousillon* (1880) 14 Ch D 351

²¹ *Foster v Driscoll* [1929] 1 KB 470

²² *Regazzoni v KC Sethia* (1944) Ltd [1958] AC 301

²³ *Saxby v Fulton* [1909] 2 KB 208

²⁴ C Clarkson (n 5) 489

²⁵ *Adams v Cape Industries plc* [1990] Ch 433

²⁶ *Owens Bank Ltd v Bracco* [1992] 2 AC 443

grounds that it offends English notions of substantial justice.²⁷ For example, in *Gray v Formosa*²⁸ a Maltese nullity decree granted on the ground that the parties had not married in a Roman Catholic church was refused to be recognised as offending English notion of substantial justice. Also in *Adams v Cape Industries plc*²⁹ it was decided that a process, whereby the amount of the plaintiff's damages was averaged – with the plaintiffs being placed by their lawyers in four bands according to the seriousness of their injuries – rather than assessed following a judicial investigation into the injuries sustained by each plaintiff, offended English notions of substantial justice. The court did not give any explanation of the relationship between public policy and substantial justice. In English jurisprudence this issue remains unclear.³⁰

5. The limits of the doctrine

The doctrine of public policy is used relatively rarely in the English conflict of laws, especially in comparison with the law of some foreign countries such as France or Germany.³¹ One reason for this is the existence of other institutions with the same function. The other is the construction of the whole system of English private international law, which orders to apply English law incredibly often.³² For example, any matter of procedure automatically falls under English law. If the applicable law is *lex fori*, there is no chance of considering public policy. English courts also broaden the ambit of these rules to make a decision on the basis of English law that is well known to the judges.³³

The other reason of the narrow space left for the doctrine of public policy is the common opinion among English judiciary that public policy should only be invoked 'exceptionally and with the greatest circumspection'.³⁴ 'The golden rule is that care must be taken not to expand its application beyond the true limits of the principle. These limits demand that, where there is any room for doubt, judicial restraint must be exercised'.³⁵ In jurisprudence it is often stressed that it is 'necessary that the doctrine should be kept within proper limits, otherwise the whole basis of the system is liable to be frustrated'.³⁶

²⁷ *Pemberton v Hughes* [1899] 1 Ch 790

²⁸ *Gray v Formosa* [1963] P 259

²⁹ *Adams* (n 27)

³⁰ C Clarkson (n 5) 487

³¹ L Collins (ed), *Dicey & Morris on The Conflict of Laws* (13th edn Sweet & Maxwell, London 2000) 82

³² PB Carter, 'The Role of Public Policy in English Conflict of Laws' (1993) 42 ICLQ 3

³³ C Clarkson (n 5) 485

³⁴ *Kuwait Airways* (n 1) 1078

³⁵ *Ibid* 1109

³⁶ L Collins (n 33) 81

It is also argued that using public policy is ‘discourteous to the foreign state whose law is excluded. It is like throwing stones at your neighbour’s house.’³⁷ This comparison seems to be quite popular. For example in *R v Brentwood Superintendent of Marriages*³⁸ the court stated that ‘many foreign laws are different and even strange to English eyes but those who live in legal glass houses, however well constructed, should perhaps not be over-astute to throw stones at the laws of other countries’. In *Loucks v Standard Oil Co*³⁹ it was also stated that ‘We are not so provincial as to say that every solution of a problem is wrong because we deal with it otherwise at home. ... The courts are not free to refuse to enforce a foreign right at the pleasure of the judges, to suit the individual notion of expediency or fairness. They do not close their door unless it would violate some fundamental principle of justice, some prevalent conception of good morals, some deep-rooted tradition of the common wealth.’ From these reasons the role of public policy in English conflict of laws is still declining.

6. Conclusions

Abundant international exchange throughout the history of England resulted in the impressive amount of judgments in which the institution of public policy has been shaped. However the meaning of the doctrine is quite capacious, the ensemble of the system of English private international law causes that the area to invoke public policy is rather narrow. Moreover, English judiciary has been recently changing in the direction to restrain the role of public policy even more.

English experience with the doctrine of public policy and similar institutions can and should be exploited in Polish law. Rapidly growing international exchange with Poland will certainly result in similar growth in number of legal cases containing international element. However Polish and English legal systems differ immensely, some parts of the extremely rich outcome of the English judiciary and jurisprudence will certainly be useful.

³⁷ N. Enonchong, ‘Public Policy in the Conflict of Laws: A Chinese Wall Around Little England?’ (1996) 45 ICLQ 653.

³⁸ *R v Brentwood Superintendent of Marriages, ex p Arias* [1968] 3 WLR 537

³⁹ *Loucks v Standard Oil Co* (1918) 120 NE 201–202

Trade Marks Registration under Polish Intellectual Property Law

1. Introduction

The Polish law has a long tradition in the field of intellectual property (IP). However, before the transformation of the year 1989 the role of that area of law was strictly limited. This had its origin inter alia in the lack of free market of goods. Therefore, the value of goods was not so important and manufacturers were not particularly interested in building the brand and then protecting it. The situation has changed radically after the transformation which occurred in Poland in 1989. In the situation of free competition between manufacturers, finding a customer became the main issue of functioning on the market. Polish entrepreneurs started to build their brands and, in consequence, it led to the necessity of protection of their intellectual property.

What is crucial, after 1989 Polish Government decided to integrate with the European Communities. In the article 66 of the 'Europe Agreements' from 16 December 1991,¹ the Republic of Poland proclaimed that it shall continue to improve the protection of intellectual, industrial and commercial property rights in order to provide a level of protection similar to that existing in the Community, including comparable means of enforcing such rights. Furthermore, Polish Government obliged to accede to the Munich Convention on the Grant of European Patents of 5 October 1973 and to other multilateral conventions on intellectual, industrial and commercial property rights.²

As a result, the Republic of Poland consequently improved the law to the standards of the European Community. The grounds for modern intellectual property were particularly laid down by replacing the Trade Mark Act of 1985³ by the Intellectual Property Act of 2000 (the IP Act)⁴. The new law adopted the European standards.⁵

1 Europe Agreement establishing an association between the European Communities and their Member States, of the one part, and the Republic of Poland, of the other part

2 See Annex XIII paragraph 1 to which Member States are Parties, or which are de facto applied by Member States

3 Trade Mark Act from 31 January 1985 (Journal of Laws No 5, item 17) (Ustawa z dnia 31 stycznia 1985 r. o znakach towarowych. (Dz. U. Nr 5, poz. 17 z dnia 15 lutego 1985 r.)

4 The Intellectual Property Act from 30 June 2000 (Journal of Laws No 49, Uniform text available in Journal of Law 2003, No 119, item 1117 with amendments), Ustawa z dnia 30 czerwca 2000 r. Prawo własności przemysłowej (Dz. U. z 2001 r. Nr 49, poz. 508) (tekst jednolity - Dz. U. z 2003 r. Nr 119, poz. 1117 z późn. zm.)

5 Inter alia First Directives of Council of 21 December 1988.

The main aim of this article is to point out the contemporary principles of Polish IP law concerning the trade marks, the obstacles to the registration of trade marks by the Polish Patent Office and their protection.

2. The application to the Patent Office

The very important answer for the question - what is the trade mark - was in Europe given by the European Court of Justice (ECJ) rather than by national jurisprudence. The more interesting and diverse issue within the EU Members States is application and proceedings before the national Patent Offices.

The application to the Polish Patent Office is regulated by articles 138-142 of the IP Act, where the general principle is set forth. Article 138 stipulates that one motion may regard only one trade mark. This motion should describe the trade mark and indicate what kind of products would be bearing these trade marks. If the applicants want to register a common trade mark, they must abide by the specific statute concerning the use of these trade marks. If the applicant has a prior right to the trade mark, he must note it in that motion together with the documents which can prove this fact.

The IP Act lays down that until the final approval the applicant may change the trade mark in such a way that he completes an amendment if such an amendment does not change the substance of the mark.⁶ Also until the final decision the applicant may withdraw the element which causes the obstacles to registration. Such an application sheet must be written in Polish technical terminology, and that the list should also be consistent with classification (in parentheses it is obviously a Nice classification). A photo or a picture of the trade mark should be attached to the registration sheet. In case of sound marks the soundtrack must be attached.

The Patent Office cannot change the application unless it notices obvious mistakes and simple language mistakes. In any case, such changes should not cover the classification if they were to alter the scope of protection.

3. Proceedings of registration

The Patent Office, within three months from receiving an application, must make the application public in order to be known for all interested, together with detailed information about what kind of goods will be bearing the trade mark. Originally, it should give the

⁶ Article 140

competition a chance to express the objection. When the IP Act became a law, the term for the application to be made public was six months, but after many demands from the patent agents the legislator changed it into three months. If the applicant makes the amendments which are contrary to the statute, on the ground of article 141¹, the Patent office gives the resolution in which it rejects the amendments.

The decision of giving the protection to the trade marks is made, after the office checks whether all the statutory requirements are met. In practice, after putting forward such an application, one has to wait for its examination from two to even four years. It seems too long, but the Patent Office is underfinanced and has a heavy workload.

If the Office states that application does not meet the legal requirements, it must give the negative decision. However, before doing so it has an obligation to inform the applicant about this fact and fix the term in which he may answer to the objection and explain his standpoint. In case when only one category of goods does not meet the requirements, the patent office before the refusal of giving the protection right for that part of goods inform about it, and afterwards it gives protection to the other part in which case all conditions are met.

If Patent Office states that there are no obstacles, it gives the decision but beforehand the applicant has to pay for ten years' period of protection. If he does not pay in due term, the office revokes its decision concerning the protection. Immediately after the approval decision the trade mark is entered in a special register, and the applicant receives the certificate which proves the fact of protection. The general rule of protection is that the possessor of protected trade mark can mark it by putting the symbol ® next to it.

In one of its ruling⁷ the Voivodeship Administrative Court in Warsaw stated that such a certificate which is, in fact, a kind of attestation in the sense of general administrative rule (article 217 § 2 pkt 1 of the Code of Administrative Procedure⁸) should be equal to the decision of protection. Because such a certificate, given to the plaintiff, does not cover all the elements of the trade mark distinguished in the decision, the appropriate office should take notice of all aspects of the decision, not only those figuring on the certificate.

4. Obstacles to receive the right of protection

The main obstacles to receive the protection are formulated in article 129 of the IP

⁷ Judgment of voivodeship VI SA/Wa 1597/05 known as ("Caffe Mokate Mocna") LEX nr. 193398

⁸ Code of Administrative Procedure from 14 June of 1960, Journal of Law 2000 No 98, Item 1071

Act, which provides that the law does not give the protection right to the marks which have not enough distinguished features. They are construed only by the elements which point out the kind of goods, their origin, the quality, amount, value, destination, the way of production and their function. They are adopted by colloquial language, and then used in honest business practice. In theory, it seems to be comprehensible, but in practice it is not as clear as it appears on the first glance.

The Voivodeship Administrative Court in Warsaw⁹ allowed trade marks to combine the letters and numbers. This was in a case where a company wanted to register for their product the trade mark “700” in Nice classification 16 i.e. the brochure and newspapers containing the crosswords. The Patent Office responded that under IP Act and according to the definition of trade mark such registration is impossible. The Court found that the Office breached the general rule of administrative proceedings by explaining the point of view not sufficiently. Moreover, Patent Office does not answer to the arguments which try to prove that such “trade mark” gets both the primary and secondary distinguishing ability. The Court explained the meaning of “trade mark” as defined in the Directive and ECJ. In this perspective, the “trade marks” containing only numbers are correct. On the other hand, the Court noted that the ‘naked’ numbers have not a primary distinguishability but, on the other hand, a trade mark can acquire it by being ‘used’ ie as a result of being put on the market.

Another problem arises with using the names. The Supreme Administrative Court stated¹⁰ that the situation in which one element could be used to different referents, for example for the chemical substance and some other product, as well, could not automatically cause the lack of described character. It is especially visible if such chemical substance constitutes the feature and destination of the goods. In this ruling the court stated also that the trade mark which contains information in a foreign language (an issue which should be important for a foreigner), could be registered only if the customers on the national market, who do not know the foreign language sufficiently, find that such goods possess the distinguishing function to the origin of the good.

4.1 Generic name problems.

But on the other hand, in other ruling the Voivodeship Administrative Court in

⁹ The Voivodeship Administrative Court judgment VI SA/Wa 294/04

¹⁰ Supreme Administrative Court judgment II GSK 56/07

Warsaw¹¹ emphasized that trade marks which constitute only signs consisting of information of general character, which used to mark this kind of goods or services, have not distinguishability, even if these signs are formulated in other language than Polish. In order to throw light on this issue, a case of M. CE shall be considered. This Belgian corporation with registered office in Esaimpus lodged a protest in 2004 in Polish Patent Office, claiming that the trade mark JAVEL is used unlawfully. The aforesaid trade mark belongs to the Nice class 3 (bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices) and 5 (pharmaceutical and veterinary preparations; sanitary preparations for medical purposes). The claimant, in a lawsuit said that the trade mark did not meet the Act's requirements and its registration was unlawful under articles 129 section 2 and 131 section 2 of IP Act. because it did not possess distinguishability, since its generic name was registered in bad faith. The plaintiff attached the definition of the word „javel” from the Great Polish-French Dictionary (1980) which said that the word means „water from Javel” or „chlorine water” so „eau javel” and „javel” mean the same thing.

As a result, in the above mentioned case the Patent Office agreed with the argumentation that the requirements of article 129 were not met. The claimant appealed against this decision to Voivodeship Administrative Court claiming that it was unlawful because the office misinterpreted the requirements, since an average end consumer in Poland understands by term “Javel” these chemicals. In the applicant's opinion, the term „eau de javel” is a generic name for hydrochloride potassium, however, only in France, which does not mean that in Poland it should be treated the same way. The applicant highlighted that the trade mark „Javel” does not contain any elements which make the end consumer think that it is a French word, inter alia because there is no indication that it has a typically French spelling. The court found that this argumentation was correct and the Patent Office did not breach both the substantial and procedural administrative law. In its opinion, it remains beyond any doubt that “javel” is a French word and appears quite frequently in the common use of language as an abbreviation from “eau de javel” which, in fact, means the chlorine water.

In the other precedent ruling the Voivodeship Administrative Court in case of signature VI SA/Wa 1705-06¹² pointed that goods possess proper distinguishing ability only if they

11 Voivodeship Administrative Court judgment VI SA/Wa 153/06

12 Voivodeship Administrative Court judgment VI SA/Wa 1705/06

possess the feature which helps to individualize them on the market among the same products. Furthermore, it should be noted that using such a good by a licensee cannot lead to the loss of distinguishing features, as the license-agreement concerning using the trade mark must be treated the same way as using by the licensor. The fact of giving the license to the other party must be regarded as a proof of the attractiveness of such a trade mark. It supports and enhances its position on the market. Even using the trade mark by many different licensees for many years cannot cause the loss of distinguishing feature which differentiates it from other producers who are not bound by such an agreement.

What is more, the Warsaw's Voivodeship Administrative Court case law points out in another case of signature VI Sa/Wa 1420/06¹³ said that the Patent Office first must check the general ability of a mark to become a trade mark. Only after such an examination the Office checks whether the mark existing on the market of the particular product possesses the distinguishing feature in a sufficient extent. The lack of such distinguishing feature is an absolute obstacle to registration. However, using such a mark on the market for a long time may lead to acquiring of a distinguishing feature.

4.2. The problem with foreign words.

In the Polish jurisprudence it is said that under both the old and new IP law, the graphical signs, as well as the combinations of words and graphical elements and signs consisting of words can be regarded as those which are only the generic description¹⁴. The English word "Miss" does not have a distinguishing character. The same applies to the symbol which constitutes only the shape of a crown, but in this case it is not absolute because it is not constructed only by such elements. The mark can be distinguished by the following elements: design, lettering, characteristic coloring and layout of the elements.

The above-mentioned opinion was issued as a result of the Polish Supreme Court decision in the case of signature I CKN 1128/98¹⁵ The plaintiff sued the defendant on the basis of using the word "miss" in the trade mark with regard to certain events such as „Miss of Warsaw” or „Miss of Warsaw teenagers”. The protected trade mark consists of an inscription “miss” and the stylish crown. The defendant used only the inscription so in his

13 Voivodeship Administrative Court judgment VI SA/Wa 1420/06

14 OSP 2002/2/20 Stefanicki R – R Stefanicki, Gloss to the – tytuł poda czy co

15 The Supreme Court decision I CKN 1128/98 < <http://prawo.money.pl/orzecznictwo/sad-najwyzszy/postanowienie;sn;izba;cywilna,ic,i,ckn,1128,98,3992,orzeczenie.html>>

opinion the character of his trade mark was different. What is more, in Polish the word “miss” is in common use. The Supreme Court pondered upon the issue whether the word “miss” is just a generic name. In order to establish its proper meaning the Court looked it up in a dictionary and noted that besides the common use of this word, especially in Anglo-Saxon countries, which is closely connected with choosing the most beautiful woman, sometimes, however, it refers to the other things. Organizing a beauty contest is a very popular event, regardless whether its character is institutional or rather temporary, and it always leads to one final effect. In such a contest, people who are to win are the centre of attention, which creates no connection with the subject, included in the name of the registered trade mark. Thus, in opinion of the court using the word „miss” have not distinguishing features as defined by the former act. An organizer of the contest who simultaneously is the user of this word which, by its nature, is only the generic name, does not mislead the audience.

The group of the trade marks which have not distinguishing features includes also such marks which indicate amount, quality, or destination of a good. The marks which are the part of everyday language (such as trade marks ‘artificial leather’) have not such features, as well.

4.3 Similarity of trade marks

With regard to determining the similarity of particular trade marks, three dimensions should be taken into consideration: the visual, the phonetic and the meaning– the most important element for it makes the general impression on an average receiver, for whom such a mark should distinguish from other signs sufficiently in order to indicate the origin of the product.¹⁶

In the case of 6 SA 416/03, the Voivodeship Administrative Court decided that the general information included in the trade marks consisting of words and graphic elements do not *ipso per se* lose the distinguishability just as the word “common” within the phrase “common margarine” does not.¹⁷ There is no instruction which shape trade marks may not take but they should create in consumer’s mind a connotation with the origin of only one producer. In this case an entrepreneur wanted to register the trade mark which constituted the combination of two colors: white and orange. It was already entered in the international register of trade marks on the ground of Madrid agreement. The Court found that the

¹⁶ The Voievodship Administrative Court judgement Wsa VI sA/Wa 1660/04

¹⁷ The Voievodship Administrative Court judgement in the case of signature WSA 6 SA 416/03

composition of colors can be registered as a trade mark, but such a composition should be new and original. The court noted that with regard to ‘international standards’, the applicant did not describe the exact proportion of colors and, thus, in Court’s opinion the trade mark cannot be distinguished from the ones possessed by other companies in good faith. Moreover, the defendant did not use exactly the same composition which was registered. The attached material illustrated that the colors were overlapping, which was regarded by the Court as characteristic. However, the registered trade mark consisted of smooth colors.¹⁸

The trade mark indicating directly only to the intended use of the product is deprived of its distinguishability. In the Voievodship Administrative Court in Warsaw case of VI SA/Wa VI 2241/04¹⁹, one company sued the other for using the trade mark “Alergin” because in its opinion such pharmaceutical is only a generic name for a common illness: allergy so, as a matter of fact, it cannot possess the first and second distinguishability. In this case the Court noted that such a name has an imaginative character and it is not the generic name. Indeed such a name is very close to a generic name but in Polish jurisprudence giving it is not forbidden.²⁰

A trade mark can receive the secondary distinguishability, if there exists a connotation with the origin of the the trade mark. In the Voievodship Administrative Court in Warsaw case of signature WSA 6 II SA 3170/02²¹ the applicant wanted to register the trade mark ‘super’ which consisted of the words: ‘super’ and the ‘caffe bean’. In opinion of the court such a trade mark cannot indicate to the producer of a product and in consequence cannot get the second distinguishability. Many producers of various goods may use the word “super” with regard to their products. In result, the consumer cannot distinguish whether such a product has one common origin.

4.4 Problem with well-known part of trade marks

The very famous ruling of The Judgment of Voievodship Administrative Court in Warsaw signature VI SA/Wa 1100/07²² concerned the registration of trade mark ‘MacCoffe’. The claimant, Company “M” with registered office in the United States, argued that the registration of this trade mark by other company from Singapore was unlawful. The registered

¹⁸The Judgment of Supreme Administrative Court judgment NSA GSK 864/0

¹⁹ The Voievodship Administrative Court judgement VI SA/Wa VI 2241/04

²⁰ The Voievodship Administrative Court judgement WSA VI SA/Wa VI 2241/04

²¹ The Voievodship Administrative Court judgement WSA 6 II SA 3170/02 unpublished

²² The Voievodship Administrative Court judgement VI SA/Wa 1100/07
<<http://orzeczenia.nsa.gov.pl/doc/5080D49DB1>>

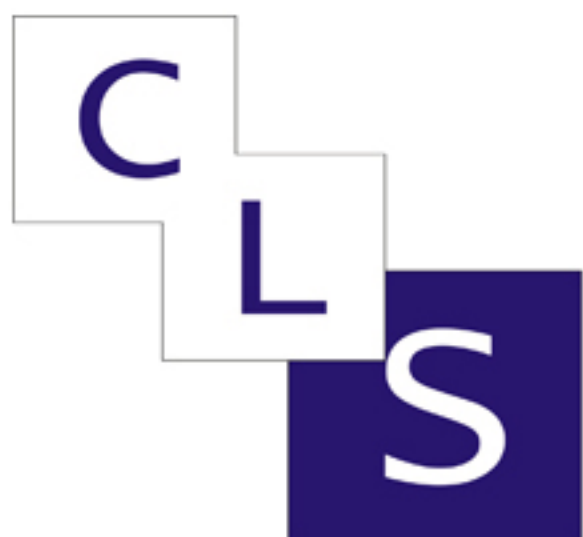
trade mark was a combination of words and pictures and was entered in the register in Nice classification 30 i.e. the coffee and its components, moreover the tea, tea blend, and chocolate to drink. The claimant noted that he is the owner of ten other trade marks: BIG MAC, MCCHICKEN, FISH MAC, M MCDONALD'S, EGG MCMUFFIN, MC PIZZA, MC BURGER, McDONALDLAND, McBACON, registered earlier in Nice class 30. In his opinion a trade mark may confuse the end consumer as to the origin of such goods. Moreover, he claimed that the Polish Patent Office infringed the appropriate Directive 89/104/EEC²³ and did not respect the European Court of Justice rulings.

The Court found that claimant did not explain why in his opinion those provisions of the Directive were breached. Just noting a violation of the rules is not enough. The court stated that the similarity was not proved as well. Probably the most similar element is the syllable 'Mac', which in opinion of company M is the dominant part of the trade mark in question. In this case the trade mark consists of two words: Mac and Coffee. The first generally means nothing, the second one is clear. The combination of those two words give a new, invented word. The visual dimension is different from the characteristic trade marks of the claimant. Under such circumstances, even if the word 'Mac' is the most characteristic, the registration of the word 'Mac' is with detriment to the rest of the market. In opinion of the court the syllable 'Mac' or 'Mc' are very common both in Poland and around the world. However, the similarity of two trade marks cannot be compared only by one syllable. In opinion of the court the probability that the products bearing such trade marks, sold in various places to different consumers, would be confused, does not exist. Hence, the Court found that claim of company M was unfounded.

5. Conclusions.

The free market competition caused the increase the number of cases. The task of that Article was to outline the general line of case law of Polish tribunals, on the ground of the most typical and famous litigations, which occurred in practice. The cases show the wide range of problems which arise on the intellectual property law. Some problems are typical and occurred in other states, the ruling of other state tribunals are generally similarly to that which gave the Polish courts.

26 First Directive 89/104/EEC of the Council, of 21 December 1988, to Approximate the Laws of the Member States Relating to Trade Marks <<http://www.oami.europa.eu/en/mark/aspects/direc/direc.htm>>



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