



Maria Lozinska

Changes to patent regulation in Poland

Maria Lozinska from PolSERVICE explains the selected changes of Polish patent regulations in amended Industrial Property Law.

December 1st 2015 is the date of entry into force of the Act of July 24th 2015¹, amending the Act on Industrial Property Law (IPL) in Poland. The new act, together with the Act of September 11th 2015², constitutes the first major amendment of IPL in many years.

The legislator's intention was to close loopholes found in the Act applied so far and take into account current state of jurisprudence and international agreements to which Poland is a party. Another intention was to make Polish IPL more attractive to applicants so that they are encouraged to use it.

National exhibition priority

The amended IPL restores the institution of priority claimed from a national exhibition. This option, however, will apply only to utility model and industrial design applications. The legislator has excluded the possibility of claiming such priority in the case of national patent applications.

According to the added Article 15¹, priority to obtain in Poland the right of protection for a utility model or a right in registration for an industrial design is determined according to the date on which the utility model or the industrial design was displayed at an exhibition designated by the President of the Polish Patent Office (PPO) by an official announcement in "Monitor Polski", the Official Gazette of the Republic of Poland, provided that the utility model or industrial design application has subsequently been filed with the PPO within six months of that date. Such exhibition must guarantee its credibility, in particular it must have well-established reputation and long tradition (Art. 15¹ (3) IPL). The initiative to designate an exhibition set forth in section 2 shall be taken by a competent minister, voivode or an entity specialized in the organization of exhibitions. (Art. 15¹ (4) IPL).

Disclosure resulting from abuse of rights that does not challenge patentability of an invention

Previously, an applicant that falls victim to an abuse of his rights had two options: be deprived of the possibility to be granted a patent in Poland or file his invention with the EPO and then validate the granted European patent in Poland, which involved high costs on the part of the Applicant.

The present version of the provision defining the state of art (Art. 25 IPL) includes an additional section according to which a patent for an invention may also be granted if its disclosure took place not earlier than six months before its filing date and was due to an evident abuse of rights in respect of the applicant or his legal predecessor.

Thus, the Polish legal system has adopted a concept known from the European Patent Convention (Art. 55(1)(a) EPC).

State of the Art – preliminary assessment of inventions

Starting from the effective date of the amended Act on Industrial Property Law, the PPO will not draw up a state of the art report within a scope in which the application does not make it possible to carry out the prior art search. In such case the Office informs the applicant of the reasons for failure to provide the report within this scope (Art. 47 (1¹) IPL).

The PPO may prepare a preliminary assessment concerning the invention's novelty, inventive step or the requirement of unity. Such preliminary assessment is sent to the applicant without delay, but it cannot be made available to any third parties. When the patent application has been published in accordance with Article 43 IPL, third parties can only have access to the state of the art report.

Translation of foreign language documents in examination proceedings

Previously, the obligation to translate prior art documents provided by the PPO during the examination proceedings was on the applicants. Now, Article 242¹ provides that the applicant who filed a request for translation of foreign language materials and documents that may indicate obstacles to the grant of a patent, a supplementary protection certificate, a right of protection or a right in registration, shall bear the costs of translation thereof into the Polish language. The PPO may also require the Applicant to make an advance payment for the translation.

The above provision applies also to translations of materials and documents for the purposes of proceedings before an administrative court.

Experts adjudicating in teams

Cases related to the granting of patents and supplementary protection certificates for inventions, rights of protection for utility models and trademarks, and rights in registration for industrial designs, geographical indications and topographies of integrated circuits may also be decided by experts in adjudicating teams. The composition of an expert team is determined by the President of the PPO, or by an authorised expert in a management or supervisory position, taking into account the necessity to ensure efficient and proper adjudication of cases.

The legislator does not set forth any detailed rules concerning the nature of adjudicating teams, the number of experts and criteria of their selection, which clearly indicates that the PPO and the expert teams are independent as regards adjudication (Art. 269, 270 IPL).

Secret inventions

Apart from the above changes, the new Act includes many other equally important provisions, such as amendments concerning secret inventions which provide for a more detailed supervision of the disclosures outside Poland of national inventions that might be deemed secret.

According to amended Article 40 IPL, the obligation to file first with the PPO applies not only to "a Polish legal person or a Polish national residing in the Republic of Poland", but also to "a person having a registered office or residing in the Republic of Poland". Thus, the question of citizenship has been made irrelevant and the provision has been extended to include organizational units without legal personality. The Article explicitly states that the requirement to first file with the PPO applies to inventions for which the applicant "wishes to obtain protection abroad", and not, as previously set forth, for which the applicant "wishes to obtain a patent abroad". This amendment results from international regulations which provide that in the case of international patent applications entering a national or regional phase the applicant may apply for the grant of a patent as well as, for example, a utility model, a patent of addition or a certificate of addition, an inventor's certificate of addition, etc. (Art.2 (ii) and Art.43 PCT).

To sum up, the following amendments to the Polish IPL seem to be particularly advantageous for the applicant: preliminary assessment of inventions by the PPO, judgments made by experts in adjudicating teams and disclosure resulting from abuse of rights that does not challenge patentability of an invention.

Résumé

Maria Lozinska, PolSERVICE

Maria is a patent and trademark attorney and a professional attorney before the Office for Harmonization in the Internal Market (OHIM).

She graduated from the Faculty of Biocybernetic and Biomedical Engineering at the Warsaw University of Technology and completed postgraduate studies at the Industrial Property Law Department of the University of Warsaw. She joined PolSERVICE in 2007.