

Changes to Industrial Property Law

Dear Sirs,

On 24 July 2015 and on 11 September 2015, the most significant amendments in recent years to the Act of 30 June 2000 - the Industrial Property Law, were adopted. The said changes substantially modified the hitherto regulations concerning, *inter alia*, patents, trademarks and industrial designs. Please find below a summary of the most important changes, the majority of which shall enter into force on 1 December 2015.

What deserves particular attention, in our opinion, is the change of the procedure for granting trademark protection rights. Effective from 15 April 2016 it will considerably accelerate the process of trademark registration with the Polish Patent Office.

We invite you to read our paper – we will be also pleased to help you should you require any assistance in this matter.

Faithfully yours,

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This information was prepared to advise the Firm's Clients of selected important changes in Polish law and does not represent a legal advice on a specific situation of any Client and should not be treated by Clients as such. Should you have any questions concerning the legal matters outlined above as they may apply to your business in Poland, please contact dr. hab. Ewa Skrzydło-Tefelska (ewa.tefelska@skslegal.pl) or Mr. Szymon Gogulski (szymon.gogulski@skslegal.pl) or the partner in charge of your account.



Amendment to the Industrial Property Law – the most important changes:

1. New procedure for granting trademark protection rights

To date, the so-called examination system existed in Poland. This means that the Patent Office would check each time if the trademark being applied for was not identical or similar to any prior designations and refuse to grant protection in the case where such trademark was found to be misleadingly similar to prior trademarks.

As soon as on 16 April 2015 the so-called opposition system which exists already in many European countries and OHIM will be introduced in Poland. The Patent Office will examine trademark applications only in terms of formal issues and absolute grounds for refusal, without checking potential collisions with prior trademarks. Once the trademark application is published, the owners of any prior identical or similar trademarks will have the right to file an objection to the registration. In the absence of any objections, the protection for trademark will be granted.

This change is intended to significantly shorten the duration of trademark registration procedure, which presumably will now last only 6 months (currently, the examination of a trademark application in Poland often takes more than a year). Another favorable consequence of the changed registration procedure will be that unused prior trademarks, not important to their owners, will not constitute an obstacle to registration if the owners do not file an objection. What should be deemed somewhat inconvenient, however, is the need for trademark owners to monitor new trademark applications more carefully and to incur costs should it be necessary to file an objection against applications for similar or identical trademark.



2. Introduction of letters of consent from earlier trademarks holders

With effect from 1 December 2015 it will be possible to obtain a protection for a similar trademark should the owner of an earlier trademark owner consent to this.

The introduction of letters of consent will, *inter alia*, enable entities from one corporate group, using the same or similar designations on a day-to-day basis, to register similar trademarks. It will also make it possible to register trademarks in a situation where independent business entities accept the presence of similar trademarks in business transactions due to the fact that the owners operate on different markets.

3. Accumulation of industrial design rights and copyrights protection.

As a result of the amendment, Art. 116 of the IPL will be rescinded. The article excluded the possibility of asserting copyright claims for industrial design after the expiry of registration rights to a design. Therefore, the Polish legislator expressly acknowledged the possibility of accumulation of protection for industrial design rights and copyrights.

In practical terms, this change may have significant impact on entities using in the course of businesses the industrial designs for which protection has expired. With effect from 1 December 2015 such actions may infringe the copyrights to industrial designs.

4. Grace period for patents and utility designs.

To date, a public disclosure of the subject of an invention has destroyed its novelty, which resulted in a refusal to grant, or in invalidation of a patent. The change introduces grace period which is favorable for inventors. With effect from



1 December 2015 it will be possible to file an invention application within 6 months of its disclosure if such disclosure resulted from an evident abuse towards the applicant or its legal predecessor.

5. Preliminary assessment of patentability

Under the new legislation, for each patent application's publication the Patent Office, in addition to prior art report, may prepare a preliminary assessment concerning the patentability of a given invention, including its novelty, inventive step or unity. The change will enable the applicant to learn more quickly the Patent Office's preliminary position regarding the invention and to present additional arguments should such preliminary assessment of patentability is unfavorable.

6. Register of supplementary protection rights

The Supplementary Protection Certificate (SPC) makes it possible to extend patent protection for a medical product or plant protection product up to 5 years. To date, an annotation on granting such certificate has been entered in the patent register. The creation of a separate register is intended to ensure better clarity and avoid situations in which it was possible to misinterpret the duration of a patent or nature of a right.

7. Admission of a trademark division in proceedings at Patent Office

In case of an opposition to a decision granting a trademark or an application for a trademark invalidation the owner will be able to divide the trademark with regard to some goods or services. Previously, a trademark division was only possible at the stage of application proceedings.

As a result of the change, the owner will be able to plan its strategy in a more flexible manner should any third person make an attempt at invalidating a trademark.



8. International industrial design

The legislator introduced into the Polish law provisions regulating the procedure of recognition in the territory of Poland of international industrial design registration in accordance with the Geneva Act of the Hague Agreement Concerning the International Deposit of Industrial Designs.

A similar procedure has been in force for several years regarding international trademarks and is popular among entities wishing to simultaneously obtain protection of industrial property rights in selected countries around the world.

