

Amendments to Polish Industrial Property Law

By Monika Witkowska, Kulikowska & Kulikowski, Poland

Over the last few months two amendments to the Act of June 30, 2000 – Industrial property Law (unified text, Journal of laws of 2003, No. 119 item 1117) – hereinafter referred to as “IPL” were adopted and published in Poland.

The first of the two amendments in question of June 24, 2015 becomes effective on December 1, 2015. Since some amendments are of the “cosmetic” nature, this study focuses solely on the most essential changes.

The following amendments have been approved with respect to the industrial design:

1. Art. 166 of IPL has been repealed, in line with which *“Products manufactured by means of an industrial design and put on the market after the lapse of the right in registration granted for such a design shall not benefit from the protection of author’s economic rights in a work under the provisions of the copyright law.”* This law provision was repealed since it stipulated that the protection of author’s economic rights in a work is not applicable to the products/works manufactured by means of an industrial design and put on the market after the lapse of the right in registration granted for such a design. As said law provision might be construed in a manner contrary to the stand supported in the judgments of the Court of Justice of the European Union in the cases C-198/10 (*Cassina*) and C-168/09 (*Flos*), removal thereof from the legal system has been a consequence of the above-referred judgments.
2. Rules of procedure regarding international industrial designs have been introduced to Art. 117(1) – 117 (5). This amendment was a result of the Polish Republic being bound by the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs adopted on 2 July, 1999.

The following amendments have been approved with respect to the trademarks:

1. An amendment has been made to Art. 122 of IPL which regulates, so called, joint right of protection to a trademark. Joint right of protection is granted for a designation intended for concurrent use by several undertakings, provided that such use is not contrary to public interests and is not intended to mislead the public, in particular as to the nature, intended purpose, quality, properties or origin of the goods. Regulations governing use of trademark adopted by the undertakings need to be submitted in order to be granted a joint right of protection. The amendment to this provision is that so far the joint protection right could be granted solely in the name of undertakings (business entities) while after the amendment, said right will be able to be granted in the name of each entity.

2. Collision of a trademark with geographical indication (agricultural products, foodstuffs, spirit drinks) – Art. 132 section 1 point 1(1) and 1(2) of IPL. According to the amended provisions, a right of protection shall not be granted for a trademark in respect of identical or similar goods, if the trademark is identical or similar to:
 - 1(1) a registered geographical indication and designation of origin of a product pursuant to the provisions of Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs (Official Journal UE L 343 of 14 December 2012, page 1);
 - 1(2) a registered geographical indication of spirit drinks as well as geographical indication entered in the list of protected geographical indications of spirit drinks pursuant to the provisions of Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89 (Official Journal UE L 39 of 13 February 2008, page 16, as amended);

The currently binding version of the law provision at issue provides for an absolute prohibition on registration of trademarks which are identical or similar to the designations specified in the above-mentioned EC regulations without having examined the circumstances related to them. Such practice was contrary to the principle of prevailing the EU legislation over the national law and the necessity to apply it directly.
3. Trademarks incorporating symbols – the amendment relates to Art. 131 section 2 point 2 of IPL which enlists the symbols incorporation of which results in refusal to grant the protection right for such a trademark; the symbols are as follows: the symbols of the Republic of Poland (emblem, national colours or national anthem), the insignia of the armed forces, paramilitary organisations, governmental organizations, social organizations, etc., unless the applicant is able to produce evidence of his right, in particular in a form of an authorisation issued by a competent State agency or a local government, or a permission given by an organisation, to use the sign in the course of trade. The prohibition on granting the protection right for the trademark incorporating the name or abbreviated name of the Republic of Poland, the names or armorial bearings of Polish voivodships, towns or communities was removed from said provision. It was caused by the fact that, from the practical point of view, obtaining a permission to use such signs generated a great number of problems since it was not clear (in particular with regard to the designation Polska/Poland) which authority is responsible for issuing such permission.
4. Another ground for refusal to grant the protection right for a trademark was added in Art. 132 section 2 point 7 of IPL, in line with which, a right of protection shall not be granted for the designations if they have been applied for names of plants or varieties of animals.
5. In my opinion, the most significant change regarding the trademarks is introducing the **institution of “letters of consent”**, which so far, the Polish Patent Office have found, in general, insufficient to eliminate the collision faced between a trademark and prior rights held by third parties. The discussed amendment has been introduced to Art. 133 of IPL. Once it is in force, the Patent Office will be able to apply a legislative provision in a statutory manner and accept letters of consent in all the cases involving collision of a trademark with prior rights held by third parties.
6. The extension of trademark protection for subsequent ten-year period (Art. 153 sections 3 and 4) shall be made by way of administrative decision. So far, the Patent Office has informed on the extension of the protection right without issuing any decision in this regard, which was criticised in judicial decisions.

7. Additional exemptions from prohibitive powers of a trademark owner have been introduced. Pursuant to Art. 156 section 1 of IPL, the right of protection shall not entitle the right holder to prohibit third parties from using, in the course of trade their names or addresses. The following expression has been added: or names or other designations individualising a given entrepreneur or his/her enterprise. Section 2 of the discussed provision remained unchanged and it stipulates that the use of the signs referred to in paragraph (1) shall only be permitted, where it satisfies reasonable needs of the user and of purchasers of the goods and is, at the same time, in accordance with fair practices in industrial or commercial business, or in services.
8. The trademark registered by an agent or representative – application of this law provision has been extended to other entities under Art. 161 section 3 of IPL. Art. 161 regulates the situation in which an agent or a representative of the person enjoying the exclusive right to use that trademark in another country has applied such trademark for protection on their own behalf. In such circumstances, that person may demand that the protection granting proceeding be discontinued or the right of protection revoked. S/he may also demand that the right of protection be granted on his /her behalf, or the right already granted transferred to him/her. The right may not be demanded to be revoked or transferred, where the entitled person referred above has acquiesced, for a period of five successive years, in the use of the registered trademark while being aware of such use. The amendment to this provision has extended the application thereof to the persons who, being unauthorized to do so, have applied a trademark for registration or have been granted a right to such a trademark.
9. Restoration of a time limit – adjustment of the relevant provision on the trademarks to the Singapore Treaty (Art. 243 section 2 point 1 of IPL). The following provision has been introduced: where in the course of proceedings a time limit to perform an act requisite for continuance of the proceeding has not been observed, the Patent Office may, at the party's request, restore the time limit, provided that the party provides a plausible explanation that non-observance was without fault on its part and, at the same time, performs the act. Such a request must be submitted within six months counted from the day on which the time limit to perform the specified act expired - applicable to the trademarks.
10. Art. 253(1) has been added, pursuant to which, when making an assessment of fulfillment of the conditions requisite to be granted a patent, a right of protection, a supplementary protection right and a right in registration, evidence from an expert opinion shall not be applied unless the Patent Office deems such evidence indispensable.

Please note that another amendment dated September 11, 2015 becomes effective on April 15, 2016 and includes the regime change with respect to the procedures governing the trademark examination. This amendment will be described in one of the next newsletters.

For more information, please contact:



Monika Witkowska
Advocate, Trademark & Patent Attorney
Kulikowska & Kulikowski, Poland
mwitkowska@kulikowski.pl
www.kulikowski.pl