

AMENDMENTS TO THE POLISH INDUSTRIAL PROPERTY LAW

There have been a number of recent amendments to the Industrial Property Law harmonizing the Polish system with solutions which, to a great extent, have already been implemented in many other Member States of the European Union.

SHIFT IN THE PROCEDURE FOR GRANTING TRADEMARK PROTECTION

A change that will become effective April 15th shifts the current trademark "examination" system to an "objection" system. Prior to this change, the Patent Office was required to examine each application and determine whether the trademark applied for was identical or similar to any other trademarks already registered. Under the new system, the Patent Office will no longer refuse to grant protective rights to a trademark on its own initiative if it conflicts with the prior rights of other trademarks. It will prepare non-binding information for the applicant listing identical or similar trademarks that have been previously registered to warn the applicant that a his/her application may infringe upon the rights of a third party.

Trademarks for which registration is sought will be announced in the online Bulletin of the Patent Office. Within 3 months of the publication date, holders of previously registered trademarks may oppose the registration of a trademark application. Such opposition is subject to a fee and the opposition proceedings will be conducted in writing only. The Patent Office will promptly notify the applicant that an objection has been lodged and will set a deadline for the applicant to present his/her response. If no objections are raised, protective rights will be granted to the trademark under registration. The right, stipulated under prior law, to file an objection within 6 months after protective rights are granted will no longer apply in relation to trademarks.

Inactive or less important trademarks will no longer affect the process unless their owners raise an objection. Faster processing should also lead to an increase in the number of national trademark applications as they are much more affordable than EU applications. However, the new system means that new trademarks should be filed with constant and continuing attention to ensure that the rights of existing trademark holders are not infringed upon. After expiry of the three-month deadline to file an objection, potentially infringing trademarks can only be contested by applying for its invalidation, a process that is always more burdensome.

Since November 2015, applicants no longer have their representation limited to patent attorneys in trademark proceedings before the Patent Office. The cases in which non-patent attorneys may represent clients are limited to ones concerning trademark applications and the maintenance of trademark protection.

LETTERS OF CONSENT FROM THE OWNER OF A PREVIOUSLY REGISTERED TRADEMARK

Another amendment, which entered into force in December 2015, provides for the protection of a similar trademark with the written consent of the owner of an earlier trademark. In practical terms, this mechanism should be useful for companies belonging to the same parent company which often use trademarks with a similar symbol, shape or colour theme. Prior to the amendment, if a parent company had already registered its trademark, its subsidiary was unable to subsequently register a similar trademark. The Patent Office rejection could not be influenced even by the parent company's consent. The December 2015 amendment's introduction of "letters of consent" will make it possible for an applicant to be granted protection for a trademark in such cases involving the same parent company or group.

NOVELTY GRACE PERIOD FOR PATENTS

The implemented changes also cover patents and include introduction of the so-called "novelty grace period". Prior to the amendment, an invention could be deemed to lack novelty because of a pre-application disclosure from third parties in, for example, an academic journal. The amendment makes it possible to file an application and to obtain a patent within 6 months of such disclosure, provided that the applicant is able to prove that the disclosure was an obvious act of abuse towards the applicant or his/her legal predecessor.

DOUBLE PROTECTION FOR INDUSTRIAL DESIGNS

A number of other changes came into effect in December 2015. Items covered by registered industrial designs may now obtain double protection. In addition to the protection provided for in the Industrial Property Law, it is permissible to exercise copyright protection as well. Prior law prohibited the assertion of copyright claims for an industrial design after the protection period of the design expired. Why does this matter? Industrial designs are only protected for 5 years (with the opportunity to extend it for a maximum of 25 years). Copyrights have 70 years of protection. The amendments allow double, cumulative protection throughout the entire period of registration. This could be of crucial importance to manufacturers attaching long-term significance to the aesthetic value of their products, e.g., furniture and toys. This also suggests that an entity using a third-party industrial design after expiry of its formal protection should take care not to infringe on any embedded copyrights.

OTHER CHANGES IN PROCEDURE AND LEVEL OF FEES

New procedural rules concerning the handling of international industrial designs were introduced. They were added as a result of Poland being a party to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Geneva, July 2, 1999).

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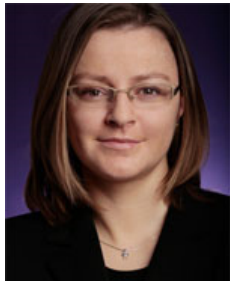
Starting in December 2015, when an applicant establishes an inability to pay the full registration fee for a patent, utility model, industry design or trademark application, the Patent Office will permit a reduction of up to 80% of the otherwise required fee. Prior law was limited to a 70% reduction and only covered inventions and utility models.

Legal basis: amendments to the Act – Industrial Property Law.

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For more information about our services, please contact:



Anna Dobosz
Senior Associate
anna.dobosz@wolftheiss.com
T: +48 22 3788 900



Monika Gaczowska
Associate
monika.gaczowska@wolftheiss.com
T: +48 22 3788 900

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Wolf Theiss
Schubertring 6
AT – 1010 Vienna

www.wolftheiss.com