

Polish industrial property law

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In recent years, entrepreneurs have become increasingly aware of the legal means to protect intangible goods, but to ensure proper protection it is necessary to possess certain knowledge of the ways how to do it efficiently. The article is intended to explain the basic issues of Polish industrial property law. The systematics of Polish law including the issues concerning inventions, utility models, industrial designs, trademarks and geographical indication have been presented. However, currently it is not enough to be familiar with the national laws of each member states of the EU. It is also necessary to know EU law which affects strongly the law of individual member states. Therefore Polish industrial property law cannot be interpreted without taking into account EU law. At the same time, it is difficult to accurately delineate the boundaries of EU law. For example, there is the concept of a “European patent”, which will be granted by the European Patent Office in Munich. The “European Patent” is based on the European Patent Convention of 5 October 1973. It must be noted that the European patent is not an EU instrument and the Convention itself is not part of the EU *acquis communautaire*. Nevertheless, it is an important instrument signed by 38 countries, including all EU Member States. The European patent is often referred to as a “bundle of national patents”, and patent protection may differ from country to country. On the other hand, the law of EU Member States has only been harmonised to some extent. Thus, there is a need for further harmonisation as well as uniform interpretation of the existing provisions by the national courts and by the Court of Justice of the European Union. Thus, in the coming years, also Polish industrial property law may be expected to have been amended accordingly.

Keywords: industrial property, industrial property law, patent, utility models, design, industrial design, trademarks, geographical indications.

Introduction

Article 2 (VIII) of the *Convention on the Establishment of the World Intellectual Property Organisation* of 1967 defines intellectual property as rights relating to: literary, artistic and scientific works, artists' interpretations and performances, phonograms and radio and television programmes, inventions in all fields of human activity, scientific discoveries, industrial designs, trademarks and service marks, as well as brand names and commercial signs, protection against unfair competition and all other rights concerning intellectual activity in the industrial, scientific, literary and artistic fields.

Intellectual property law is basically divided into two main branches: industrial property law and copyright law. Such a division is expressed in two international conventions — the Paris Convention for the Protection of Industrial Property of 1883 and the Bern Convention for the Protection of Literary and Artistic Works of 1886.

1. Industrial property

The most important international legislative act in the field of industrial property is the *Paris Convention for the Protection of Industrial Property* of 20 March 1883. The Paris

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Convention has been revised several times since its entry into force on 7 July 1884. The version that is currently in force and binding is the text of the Paris Convention contained in the Stockholm Act of 14 July 1967. The Convention is administered by the World Intellectual Property Organisation (WIPO) and today (2020) there are 177 States that are signatories to the Paris Convention. Poland has been a party to the Convention since 1919.

The Paris Convention also provides a definition of the concept *industrial property*. Pursuant to its Art. 1 (3): “industrial property is to be understood in the broadest sense and apply not only to industry and trade in the strict sense, but also to agricultural and mining industries and to all manufactured or natural products such as, for example: wines, seeds, tobacco leaves, fruit, animals, minerals, mineral waters, beer, flowers, or flour”.

What is noteworthy is that the Paris Convention contains a directive of a broad understanding of the concept of industrial property. According to the conventional definition, industrial property is not limited to industry and trade, but extends to agricultural and mining industries, as well as to all manufactured and natural products.

It is therefore recommended to adopt the *definition of industrial property* as a collective concept covering this group of intangible goods whose role and significance become apparent in the broadly understood industry, regardless of whether these goods are the result of the creative effort of the human mind (solutions) or if they, when transferring only specific information, become instruments for capturing clientele (designations)¹. According to Art. 1 (2) of the Paris Convention, the subject matters of industrial property protection are: 1) patents for inventions; 2) utility models; 3) industrial designs; 4) trademarks; 5) service marks; 6) trade names; 7) designation of origin or names of origin; 8) combating unfair competition.

The above catalogue of industrial property goods is an open catalogue. Thus, even though the Paris Convention does not mention the objects of industrial property protection, such as integrated circuit topography, the protection of business secrets or the protection of plant varieties, they are all considered to be objects of industrial property law.

In Polish law, the basic legislative act regulating industrial property is the *Law on Industrial Property* of 30 June 2000 (hereinafter referred to as LIP). The catalogue of industrial property goods adopted in the Act is slightly different from the one adopted in the Paris Convention. LIP includes, for example, integrated circuit topographies which are not listed in the Paris Convention. On the other hand it makes no mention of trade names, and leaves out the protection against unfair competition to the provisions of a separate Act of 16 April 1993 on Combating Unfair Competition.

2. Inventions

The legal situation related to patent protection in Poland is complicated. This is due to the fact that the patent protection may be granted both, at the national and the European (non-EU related) level². An entity wishing to protect its invention in Poland may opt for the national patent protection. In this case, under the Polish legislation, the national patent will be granted by the Polish Patent Office and be applicable in Poland only. However, the European path may also be chosen, and in such a case a European patent, based on the Convention on the Grant of European Patents (European Patent Convention of 5 October 1973, hereinafter referred to as EPC), will be granted by the European Patent Office (www.epo.org) in Munich. The European patent is granted on the basis of a single application in which

¹ *Promińska U. Wprowadzenie do prawa własności przemysłowej // Prawo własności przemysłowej / eds A. Nowicka, M. Poźniak-Niedzielska, U. Promińska, H. Żakowska-Henzler. Warszawa: DIFIN, 2005. P. 18.*

² See: <https://www.epo.org>.

38 European countries (including Poland) may be indicated as territories in which protection may be granted. Poland has been a signatory of this Convention since 1 March 2004.

It must be noted that the *European patent* is not an EU instrument and the Convention itself is not part of the EU *acquis communautaire*. Nevertheless, it is an important instrument signed by 38 countries, including all European Union Member States. Although a patent granted under the Convention is referred to as a European patent (Art. 2 (1) of the EPC), pursuant to Art. 2 (2) of the Convention “The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless this Convention provides otherwise”. The European patent is often referred to as a “bundle of national patents”, and patent protection may differ from country to country³.

Despite numerous attempts, the European Union has failed to create a *unified patent protection system*⁴. In response to the failure by the EU to create an EU patent, a decision of the Council authorising enhanced cooperation in the area of the creation of a unitary patent protection was made. In December 2012, Regulations No. 1257/2012 and No. 1260/2012 providing for a European patent system with unitary effect were adopted. In February and March 2013 twenty five EU Member States (excluding Poland and Spain) signed the Agreement on a Unified Patent Court According to the Agreement (Art. 89) the European patent with unitary effect will be granted within the EU if at least thirteen countries, including France, Germany and the United Kingdom, ratify this Agreement. Till date this condition has not been met as Germany has not yet ratified it due to a constitutional complaint. The situation got further complicated by the United Kingdom’s withdrawal from the European Union. There are various scenarios possible following Brexit⁵. It is also noteworthy that Poland and Spain have not signed the Agreement and in these countries the European patent with unitary effect will not be granted.

An invention is an intangible good in the form of a technical solution resulting from the intellectual work of man. The formal definition of an invention is missing in national legislations of most countries. However, the views expressed in the literature are supportive of the opinion that there is no need for a legal definition of an invention and that it will suffice to define clearly only the prerequisites for its patentability⁶.

Article 24 of LIP determines that “patents shall be granted, irrespective of the field of technology, for inventions which are new, involving an inventive step, and capable of industrial application”. Some main categories of inventions are distinguished in the literature: a) process, b) machine, c) manufacture, d) composition of matter, and e) new improvement, i. e. new uses of inventions already existing⁷.

On the other hand, there are also some objects which pursuant to Art. 28 of LIP are not considered inventions. There are: a) discoveries, scientific theories and mathematical methods; b) products of purely aesthetic character; c) plans, principles and methods involving mental or economic activity and games; d) products whose inability to be used may be demonstrated in the light of generally accepted and recognised scientific principles; e) programs for digital machines (computer programmes); f) presentation of information.

Furthermore, Art. 29 of LIP lists inventions, but their patentability has been excluded by the law. This is because no patent may be granted for an invention the use of which

³ More: *Nowicka A.* Kontrowersje dotyczące utworzenia jednolitej ochrony patentowej oraz jednolitego sądu patentowego — Analiza prawna // *Rzecznik patentowy*. 2011. Vol. 2–4. P. 33–53.

⁴ *Ibid.* P. 34–61.

⁵ The Unified Patent Court after Brexit // European Parliament, Think Thank. 2020. Available at: https://www.europarl.europa.eu/thinktank/en/document.html?reference=IPOL_ATA%282020%29649575 (accessed: 31.10.2020).

⁶ *Vall M. du.* Prawo patentowe. Warszawa: Wolters Kluwer Polska, 2008. P. 158.

⁷ *Ibid.* P. 156.

would be contrary to public order or good morals. The concept of morality gained particular importance in connection with the incorporation to the Polish system (in Art. 931–937 of LIP) of Directive 98/44/EC on biotechnological inventions. And so, Art. 933 (2) of LIP lists the following inventions as contrary to public order or morality: a) processes for cloning humans; b) processes for modifying the genetic identity of a human embryonic line; c) use of human embryos for industrial or commercial purposes; d) processes for modifying the genetic identity of animals that are likely to cause their suffering without any substantial medical benefit to humans or animals, and also animals resulting from the application of such processes.

Article 24 of LIP stipulates that regardless of the field of technology, *patents are granted for new inventions with an inventive step and industrial application*. Although LIP does not explicitly refer to the premise of the “technical nature”, it should be assumed that for a certain solution to be considered an invention, it must be have a technical character.

In order to explain the concept of *technical nature*, one should start from explaining the concept of “technology” first. The term “technology” should be understood as “all known methods and ways of influencing the matter, calculated to satisfy individual or collective human needs”. Consequently, the technical nature of an invention consists in finding a new way of using inanimate and animated matter to satisfy various human needs⁸.

The premise of *novelty* has been defined in Art. 25 of LIP. According to it, an invention is considered new if it is not part of the state of the art of technology. The state of the art of technology should be understood as everything that prior to the date on which novelty was determined had been made available to the public in the form of a written or oral description, through use, exhibition or any other way of disclosure. Information contained in applications for inventions enjoying an earlier priority that had not been made available to the public, provided it was announced in the manner specified in the Act, is also considered to form part of the state of the art of technology.

The above concerns novelty on a global scale. The Polish legislator has not provided for any geographical, linguistic, or time limitations nor any restrictions as to how the information is to be made available to the public. If a certain technical solution has been made available to the public worldwide, it will not be possible, as a rule, to patent such a solution in Poland because it will be regarded as being devoid of novelty. Article 25 (4) of LIP provides for an exception, according to which the provisions on novelty do not exclude the possibility of granting a patent for an invention concerning a new use of a substance which is part of the state of the art of technology, or the use of such a substance to obtain a product following a new application. The exception will therefore apply, for example, to inventions concerning the new use of an existing active substance contained in painkillers to treat cancer.

Taking into account the above regulation, a solution may be considered as new if it has not been made available to the public in any way. As a rule, the priority to obtain a patent is determined based on the date on which the invention has been notified at the Patent Office (ordinary priority.) If two or more persons file an application for an invention with different priority dates (parallel applications), the right to obtain a patent will be granted to the person who was the first to file the application. If an application for the invention is filed independently by at least two persons enjoying priority resulting from the same date of application (parallel applications), the right to obtain a patent is vested in either of the two, or each of the applicants. In addition to the priority arising from the date of the application, there are two other types of priority: one called a “conventional priority” and one called a “display” priority. In the first case, the applicant may apply for a patent at the Polish Patent Office based on the fact that an application has been duly filed in another country

⁸ Sołtyński S. Projekty wynalazcze // System prawa własności intelektualnej (System prawa własności intelektualnej) / eds J. Szwaja, A. Szajkowski. Wrocław; Warszawa; Kraków; Gdańsk; Łódź: Zakład Narodowy im. Ossolińskich, 1990. P. 39.

pursuant to international agreements. However, such an application must be filed within twelve months of the date of the first application made in another country. Regarding the “display” priority, the applicant may point to the date on which the invention was displayed at an official or officially recognised international exhibition in Poland or abroad, provided however, that the application to the Polish Patent Office for that invention, utility model or industrial design is filed within six months from that date.

It is not enough for an invention to be new, it must also involve an *inventive step*. Article 26 of LIP states that an invention is considered to have an inventive step if for an expert (a person skilled in the art) the invention does not result, in an obvious way, from the state of the art of technology. The assessment of the premise of the inventive step must be made through the prism of an expert. This is because what may seem momentous and non-routine to the average person, does not have to mean that it is non-obvious. While an expert is “a professional with average knowledge of a given field of technology, who is able to compare certain solutions in an objective manner, without excessive mental effort, and to draw appropriate conclusions from this comparison”⁹.

Pursuant to Art. 27 of LIP, an invention is considered suitable for industrial application if, according to the invention, a product may be obtained or a certain process may be applied, in technical terms, in any industrial activity, including agriculture. As pointed out in the literature, when this above premise is satisfied, a technical solution is complete.

An invention does not have to be useful or bring economic benefits. Thus, it may even be a solution that is of little or no practical use or has no economic justification, or one that does not guarantee that it is a good invention. Nevertheless, an invention ought to pursue some practical goal.

If the invention meets the patentability premises, an application for a patent may be filed with the *Polish Patent Office*.

By obtaining a patent, one acquires the right to use the invention for profit or professional purposes in the entire territory of the Republic of Poland. The term of a patent is 20 years from the date of filing the patent application with the Patent Office.

According to the Annual Report of the Polish Patent Office¹⁰ (hereinafter referred to as the Annual Report) in 2019 a total of 3999 applications for inventions were filed, of which 3946 applications were filed under the national procedure and 53 applications under the international procedure (PCT)¹¹. In 2019 there were no applications from Russia¹².

The following table (Table 1) summarizes key information about inventions.

Table 1. Summary: Inventions

What is protected?	Inventions: a) process, b) machine, c) manufacture, d) composition of matter, e) new improvement
Premises for protection	Novelty Inventive step Capable of industrial application
How to get protection?	Registration
Rights granted	Patent — the exclusive right to use an invention for profit or for professional purposes throughout the Republic of Poland
Duration of right	20 years from the date of filing an application with the Patent Office

⁹ *Vall M. du. Prawo patentowe*. P. 199.

¹⁰ Annual Report 2019. Available at: Published on: https://uprp.gov.pl/sites/default/files/inline-files/Raport%20roczny%202019_1.pdf (accessed: 31.10.2020).

¹¹ PCT (Patent Cooperation Treaty) — International Patent System. More information: <https://www.wipo.int/pct/en> (accessed: 31.10.2020).

¹² But last patents for the Russian entities were granted in 2015 (2) and in 2018 (2).

3. Utility models

A utility model is an intangible good which is a result of intellectual work of man. They are treated as “small inventions” and the protection rights granted for them are frequently referred to as “small patents”. This is because in many aspects the solutions adopted for utility models are similar to those for inventions. It is also important to remember that while a patent application is being examined or within two months of the date on which a decision refusing a patent becomes final and non-revisable, the applicant may file an application for protection for a utility model. This application for a utility model will be considered to have been filed on the patent application date (Art. 38 of LIP).

The provisions relating to utility models are set out in Art. 94 to 101 of LIP. The statutory definition of a utility model is contained in Art. 94 of LIP and provides that a utility model is: a new, industrially applicable solution of a technical nature concerning the shape or construction of an object of permanent form or an object consisting of functionally related parts in a permanent form.

The *novelty* of a utility model is understood in the same way as the novelty of an invention. Pursuant to Art. 25 in connection with Art. 100 (1) of LIP, a utility model is new if it is not a part of the state of the art of technology. It must be new worldwide. The novelty of the utility model may be challenged by proving that there exists already in the state of art a particular technical solution identical to the utility model in question.

Utility models, unlike inventions, do not have to meet the premise of the *inventive step*. As a result of the 2019 amendment, a utility model needs no longer (as it was in the past) be a useful solution¹³. It is enough that it is a *technical solution* suitable for industrial applicability. It means that a utility model, like an invention, must be complete, repeatable and a sufficiently disclosed solution.

Moreover, a utility model must be a specific object with a permanent, spatial (three-dimensional) form, separated from its surroundings. It may be either specific one-element (single, one-piece) or multi-element (complex) objects.

To obtain protection, an application for the registration of a utility model must be submitted to the *Polish Patent Office*. Pursuant to Art. 95 of LIP a utility model may be granted an exclusive right. By obtaining the protection right, the owner acquires a right to use the utility model for commercial or professional purposes across the entire territory of the Republic of Poland. The duration of the right of protection is *10 years* from the date of submitting the patent application to the Polish Patent Office¹⁴.

Pursuant to the Annual Report of the Polish Patent Office there were 911 utility models applications filed with the Office in 2019 of which only one from a Russian entity¹⁵.

Key information about utility models is presented below (Table 2).

Table 2. Summary: Utility models

What is protected?	Small inventions (primarily products)
Premises for protection	Novelty Solution of a technical nature Industrial applicability
How to get protection?	Registration

¹³ Before the amendment of 2019 a utility model had to be a useful solution, i. e. to achieve a goal of practical importance in the manufacture or in the use of products.

¹⁴ About utility models in Poland see: *Vall M. du. Wzory użytkowe i ich ochrona // Studia prawa prywatnego*. 2009. Vol. 3. P. 49–71.

¹⁵ Annual Report 2019. P. 63, 67.

Rights granted	Protective right (Pl. <i>prawo ochronne</i>) — an exclusive right to use a utility model for profit or for professional purposes throughout the Republic of Poland
Duration of right	10 years from the date of filing an application with the Patent Office

4. Industrial designs

The attractiveness of any good is largely determined by its appearance and is one of the elements that influence the buyer's decision to purchase a product. The growing number of Polish industrial design registrations at the Polish Patent Office and Community designs registered with the European Union Intellectual Property Office (hereinafter referred to as EUIPO)¹⁶ in Alicante (Spain) show that entrepreneurs operating on the Polish and EU market are increasingly aware of the need to protect their industrial designs.

A distinction should be made between the term "Polish industrial design" and "Community design". Each type of design is regulated in a different legislative act.

The concept of a "Community design" appears in Regulation No. 6/2002 on Community designs. The Regulation introduces, at the level of the EU, a system of protection of Community designs that coexists with national protection systems, but is autonomous. It provides for the possibility to register a design with EUIPO and this single registration allows protection to be acquired in all EU Member States. The Regulation does not exclude the possibility of registration and protection of industrial designs under national laws, including the domestic law in Poland. However, in such a case, the protection of a given design covers only the country where the registration took place.

It should be added that the Polish regulation concerning industrial designs is an implementation of Directive 98/71/EC on the legal protection of designs, the purpose of which was to approximate the legal regulations of Member States concerning industrial designs. Pursuant to recital 9 of the Preamble to Directive 98/71/EC, achieving the objectives of the internal market requires that the conditions for obtaining the right of protection of a registered design be the same in all Member States. To that end, it is necessary to provide a uniform definition of the concept of an industrial design and the requirements as to its novelty and individual character. Therefore, any uncertainties related to the interpretation of the LIP should be considered from the perspective of EU regulations. The Member States are left free to decide on the procedure for registration, as well as the renewal and invalidity of industrial design rights and the consequences of their invalidity. In this respect, the legislation of individual EU countries may differ.

Polish industrial designs are regulated in Art. 102 to 119 of LIP. The term "industrial design" has been defined in Art. 102 of LIP which provides that it is a new form of an appearance of the product or a part of a product having individual character, given to it by the following features in particular: a) lines, i. e. geometric creations having only one dimension; b) contours and shapes, i. e. features of the design related to the three-dimensional aspect of the design; c) the colouring, which may constitute an essential feature of the design, although colour alone cannot be regarded as a design; d) the structure (texture), i. e. the characteristic features of the surface, which are most often identifiable by the sense of touch, but can also be presented visually; or e) the material of a product which is not directly perceived by the sense of sight and cannot in itself be protected as a design. Specific properties of the material, such as weight, flexibility or texture, may also, if needed, be indicated; f) ornamentation, i. e. external decoration, an ornamental element;

¹⁶ Available at: <https://euiipo.europa.eu/ohimportal/en> (accessed: 31.10.2020).



Fig. 1. Industrial design No. 20966 — Lining board (Pl. płyta okładzinowa).
Source: <https://uprp.pl>

There is an industrial design (Fig. 1) registered in Polish Patent Office by a Russians entity.

The concept of a “product” has been defined as an object produced in an industrial or artisanal way, including in particular: a) packaging; b) graphic symbols and c) typographic typefaces, but with the exclusion of computer programs. A product is also considered to be: a) an object consisting of multiple replaceable components enabling it to be disassembled and re-assembled (a complex creation); b) a component if, when incorporated into a complex creation, remains visible during normal use, which means any use, excluding maintenance, service or repair; c) a component, provided it can be traded on its own.

The term “appearance of the product” (Pl. *postać wytworu*) contained in the definition of an industrial design indicates that only those elements of the industrial design which are visually perceived are protected.

The essence of design protection is to protect its appearance. This is indicated, for example, in recital 11 of the Preamble to Directive 98/71/EC, which emphasises that the protection conferred by registration covers all or part of the features of a design which are clearly presented in the application for registration and which are made available to the public through publication or consultation of relevant documents.

It should be added that in the case of components of a complex creation, the visibility requirement is more strict. Pursuant to Art. 102 (3) (2) of LIP, a component part may also be deemed to be an industrial design if it is visible during normal use when incorporated into a complex creation. It follows that only visible parts may be protected in a complex creation. In the motor car industry, these are external parts of the bodywork, *inter alia*, the bonnet, wheel arches, mudguards, bumpers, mirrors, rims, hubcaps, lamps and others. The parts under the bonnet cannot be protected as an industrial design. The term “normal use” does not include maintenance, repair or servicing¹⁷.

For a design to be eligible for protection, it must pass a two-stage test comprising a novelty test and an individual character test.

Article 103 of LIP defines an industrial design as new if, prior to the date by which the priority to obtain the registered right is indicated, an identical design has not been made available to the public by use, display or disclosure in any other manner, with the reservation however that an industrial design cannot be deemed to have been made available to the public if it could not have been made available to persons professionally engaged in the field to which it relates. The definition of the premise of *novelty* of an industrial design indicates that the novelty of the design applied for will be invalidated if this design is identical to an earlier design. An industrial design that differs from an earlier design in insignificant details will also be considered identical. Hence minor differences in the design will not render it a new design.

The premise of *individual character* has been defined in Art. 104 of LIP and it indicates that an industrial design has an individual character if the overall impression it produces on an informed user differs from the overall impression made on him by a design that was available to the public before the date on which priority is claimed. In assessing the individual character of an industrial design, the degree of freedom of the designer in developing

¹⁷ Kępiński J. Wzór przemysłowy i jego ochrona w prawie polskim i wspólnotowym. Warszawa: Wolters Kluwer Polska, 2010. P. 42.

the design must be taken into consideration. The test of individual character focuses on the overall impression an industrial design produces, without referring to the details. This means that slight differences between the designs will not be sufficient to consider that the design in question meets the requirement of individual character. The term “overall impression” should be understood as a recommendation that the design ought to be seen as a whole and no attempt should be made to examine its individual fragments thoroughly in search of differences. It does not matter in how many details the examined design differs from the existing design if the overall impression it produces on an informed user is similar.

An informed user through whom the individual character of the design is assessed is not an expert¹⁸. He is not an average user, either. An informed user should be aware of the information provided to the public concerning the improvements of designs, and know how far the scope of creative freedom extends when a design is being developed on a given market.

Not all designs may be registered (see Art. 106 of LIP). Design rights are not granted to industrial designs if their use would be contrary to public order or morality. They are neither granted to designs which contain certain signs, e. g. symbols, names or abbreviations of the name of the Republic of Poland or foreign countries or elements which are symbols of religious, patriotic, cultural or other nature.

Pursuant to recital 14 of Preamble to Directive 98/71/EC, a technological innovation should not be hampered by granting design protection to features dedicated by a technical function only, nor should it extend to the design of the mechanical fitting (must-fit) in order to ensure the unhindered interchangeability of products from different manufacturers. Consequently, the Polish regulation (Art. 107 (1) of LIP) provides that registration does not protect features of a product which result exclusively from its technical function, nor the features which must be reproduced in a precise form and dimensions in order to enable mechanical fitting or interoperability cooperation of products of different makes. An exception to this regulation was introduced for combinations of modular products.

In order to obtain protection, a Polish industrial design, must be registered in Poland with the Patent Office. However, as a rule, an industrial design will be registered following only a formal investigation. What will only need to be verified is whether the submitted design is not contrary to public policy and principles of morality.

The registered design right grants the holder the exclusive right to use the industrial design for commercial or professional purposes in the entire territory of the Republic of Poland, and to prohibit third parties from manufacturing, offering, placing on the market, importing, exporting or using the product in which the design is incorporated or used, or storing such a product for such purposes (Art. 105 (2) and (3) of LIP). The right in registration is valid for a period of 5 years, which may be renewed (upon payment of a fee) for up to 25 years.

In 2019 the Polish Patent Office received a total of 1054 applications and notifications in the domestic procedure and under the Hague Agreement¹⁹, of which 95 % (1004 applications) were applications for registration made by Polish entities. None of the applications was filed by the Russian entities.

The table below (Table 3) summarizes the most important information about industrial designs.

¹⁸ More: *Wernicka K.* Poinformowany użytkownik w prawie wzorów przemysłowych. Studium prawnoporównawcze. Warszawa: Urząd Patentowy Rzeczypospolitej Polskiej, 2018. P. 131–153.

¹⁹ Hague Agreement Concerning the International Registration of Industrial Designs governs the international registration of industrial designs, available at: <https://www.wipo.int/treaties/en/registration/hague/index.html> (accessed: 31.10.2020).

Table 3. Summary: Industrial designs

What is protected?	Appearance of the product
Premises for protection	Novelty Individual character Must not be considered functional
How to get protection?	Primarily registration
Rights granted	Right in registration — an exclusive right to use the industrial design for profit or for professional purposes throughout the Republic of Poland
Duration of right	Maximum of 25 years (divided into 5 year terms) from the date of filing an application with the Patent Office

5. Trademarks

Currently, trademarks play a special role in the market. A trademark individualises a good or service. They are carriers of various information about the trademarked product itself and the entrepreneur that offers it. The basis for granting protection to trademarks is their ability to communicate information that allows consumers to make an informed choice²⁰.

The Polish system of trademark protection has been harmonised in accordance with the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trademarks (89/104/EEC) which was replaced by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks.

Moreover, the national systems of the EU Member States coexist with the EU protection system. The EU system was established by Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trademark. Currently, the European Parliament and Council Regulation (EU) 2017/1001 of 14 December 2017 on the European Union trademark (OJ L. No. 154. P. 1–99) is in force.

The basic way to obtain protection for a trademark in Poland is its registration with the Patent Office of the Republic of Poland or in the case of European Union trademarks, with the EUIPO. When registering a trademark at the Polish Patent Office, its protection will extend only to the territory of Poland, whereas in the case of registration of the European Union trademark, the protection will extend to all Member States of the European Union including Poland.

Thus, a person or a legal entity may choose either the national or an EU trademark system of protection. Both systems of protection coexist, which may lead to different consequences. For example, an earlier registration of a trademark in one of the Member State may be opposed when an attempt to register a trademark in the EUIPO is made at a later date. In this case, the applicant for a European Union trademark may be refused registration extending to the whole EU. On the other hand, if the trademark has been registered in the European Union and the same (or similar) trademark was previously registered for the same (or similar) goods in a Member State, the Community trademark will be capable of being revoked.

Pursuant to Art. 120 (1) of LIP: “A trademark may be any sign which makes it possible to distinguish the goods of one entrepreneur from those of another and which can be

²⁰ Kur A., Dreier T. *European Intellectual Property Law. Text, Cases and Materials*. Northampton: Edward Elgar Publ., 2013. P. 157.



Fig. 2. Trademark
No. R. 248234, registered for
Interstolitsa Ltd., Moscow.
Source: <https://uprp.pl>



Fig. 3. Trademark No. R. 308737,
registered for the Siberian Vodka
Company Ltd., Mariinsk.
Source: <https://uprp.pl>

presented in the trademark register in a manner which makes it possible to determine the unequivocal and accurate subject matter of the protection granted”.

The basic function of a trademark is that of the *designation of origin*. This means that the trademark must be capable of distinguishing the goods and services of one entrepreneur from those of another. This basic function of a trademark is to determine the requirements for designations that may fall into a category of trademarks.

It should be added that Art. 120 (2) of LIP specifies that a trademark may be a word, including a surname, a drawing, a letter, a digit, a colour, a spatial form, including the shape of goods or packaging, as well as a sound. There are also many other trademarks for example: position marks, pattern marks, colour marks, motion marks, multimedia marks and hologram marks²¹.

In the register of the Polish Patent Office there are some trademarks (Fig. 2 and Fig. 3) registered by Russian entities.

Apart from its main function, which is designation of origin, the trademark has also other functions²².

The *guarantee (or quality) function* of a trademark is to be understood as the ability to communicate the quality characteristics, and the quality of the trademarked good or service. A client identifies a certain quality, value of goods or services with a given trademark. It is emphasised in the literature that the guarantee function is secondary to the function of the designation of origin, as it can only be performed when a given product is in circulation. The customer must first identify the quality of a given trademarked product with a given entrepreneur. Based on the origin of that product from a given entrepreneur, the customer acquires a belief in its quality.

In turn, the trademark's *advertising function* manifests itself in the possibility of using the trademark as a means of advertising. This function is based on the trademark's ability to encourage customers to buy a given good or service in order to maintain the existing customer base. As with the trademark's guarantee function, the advertising function

²¹ Available at: <https://euipo.europa.eu/ohimportal/en/trade-mark-definition> (accessed: 31.10.2020).

²² Skubisz R. Funkcja znaku towarowego // Księga pamiątkowa z okazji 80-lecia rzecznictwa patentowego w Polsce. Warszawa: PIRzP, 2001. P. 167–170.

is secondary to that of the indication of origin. The trademark will only begin to fulfil its advertising function if the customer distinguishes the goods bearing a given trademark from those of another entrepreneur, and starts to identify them with certain positive perceptions of the goods. As a result, the trademark will encourage potential customers to purchase goods or services under this specific trademark.

It should be added that there are other functions of the trademark that may be distinguished, such as the information (communication) function, which consists in conveying certain information (images, associations, etc.) about the trademarked good or service, the aesthetic function, or the functional function.

Industrial property law provides for the possibility of granting protection to a trademark if the latter is expressed in abstract and concrete terms (Art. 1291 (1) (1–2) of LIP) and if there are no absolute obstacles to its registration.

The distinctive character in abstract terms requires an assessment of whether the designation under examination may be a trademark at all. Pursuant to Art. 1291 (1) (1) of LIP no protection rights are granted to marks which cannot be counted as trademarks. A mark may be a trademark if it is capable of being perceived with senses and is uniform, independent of goods and suitable for presentation in the register of trademarks. If a given designation (mark) does not have these features cumulatively, it cannot be a trademark as it does not have the abstract distinctive character.

A more frequent reason for non-registration will be the lack of specific distinctive character. The specific distinctive character of a mark is assessed in relation to a particular mark or designation and for a particular product/service. Article 1291 (1) (2) of LIP provides that no protection is granted for marks which lack sufficient distinctive character. There is no statutory definition of the concept of distinctive marks but certain designations are identified as having insufficient distinctive features. These are:

- designations which are not capable of being distinguished in the course of trading in the goods for which they have been registered. In this is the case, they do not have sufficient distinctive features and therefore cannot fulfil the essential function of a trademark, which is the indication of origin;
- descriptive (informative) designations, that is to say, designations which consist exclusively of elements which may serve, in particular, to indicate the nature of the goods, their origin, quality, quantity, value, intended use, method of manufacture, composition, function or suitability. First of all, they are descriptive (informative) marks, which should be generally available and each entrepreneur should be able to use them. Moreover, the grounds for excluding the possibility of their registration is that no one can know the origin of the goods on their basis. As an example, the following marks may be indicated: natural, artificial, coloured, Asian, milky, universal, automotive, etc.;
- free designations that is to say signs which have entered the common language or are customary in fair and established commercial practices. In the first case, these are indications that were originally fancy (e. g. thermos, aspirin, gramophone) and distinctive, but have 'entered' the common language as a result of use and have become the names of certain types of products. In the second case, those are signs which, in turn, are used in commercial practices, by which is to be understood to mean repetitive commercial behaviour consisting in the use of a certain sign in connection with commercial activities for the purposes of selling goods and services. Such signs should not be registered in favour of one of the entrepreneurs because of their customary use in fair and established commercial practices.

In assessing the distinguishable character of marks, account must be taken of all the circumstances surrounding the marking of goods in circulation.

Under the existing regulations, a designation which originally lacked a distinguishable character may acquire it in the course of its use, by gaining a secondary distinguishing ability. It is of consequential nature, as it results from the actual and consistent use. In such a case the protection may not be denied. However, not every use of a designation will lead to its acquiring a distinctive character. This will only be possible as a result this mark or designation being used as a trademark, or, in other words, allowing the average consumer to distinguish the goods of one entrepreneur from those of another.

The registration obstacles are listed in Art. 1291 (1) (5–13) and in Art. 1321 of LIP. It is assumed that Art. 1291 (1) (5–13) of LIP lists absolute obstacles to registration and Art. 1321 of LIP lists relative obstacles to registration.

Absolute obstacles are those which, as a rule, exclude the possibility to register a mark for all goods and services and which are examined *ex officio*. Their purpose is to protect the general interest. Pursuant to Art. 1291 (1) (5–13) of LIP the right of protection will not be granted for a marks which:

- is the shape of the product which is determined exclusively by its nature, is necessary to achieve a technical effect or significantly increases the value of the product;
- has been submitted for registration in bad faith;
- is contrary to public order or morality;
- contains an element which is a symbol, in particular of a religious, patriotic or cultural nature, the use of which would offend religious feelings, or patriotic, or national tradition;
- contains a symbol of the Republic of Poland (emblem, colours or anthem), a sign of the armed forces, a paramilitary organisation or security forces, a reproduction of a Polish order, decoration or badge of honour, a military badge or sign or other official or commonly used decoration and badge, in particular of governmental or local government administration or a social organisation acting in an important public interest, where the area of activity of that organisation covers the whole country or a substantial part of it, if the applicant does not demonstrate the entitlement, in particular the authorisation of the competent State or local government authority or the consent of the organisation, to use the sign in circulation;
- contains the symbol (coat of arms, flag, emblem) of a foreign State, the name, abbreviation or symbol (coat of arms, flag, emblem) of an international organisation or an official designation, control or guarantee stamp adopted in a foreign State, if such prohibition is provided for under international agreements, unless the applicant shows authorisation by the competent authority which entitles him to use such designation in trade;
- bears an officially recognised sign accepted for use in the course of trade, and in particular a safety, quality or legalisation mark, in so far as it is liable to mislead the public as to the nature of that sign, unless the applicant proves that he is entitled to use it;
- may mislead the public as to the nature, quality or geographical origin of the goods;
- constitutes a protected plant variety denomination and refers to a plant variety of the same or related species.

If the Office identifies such obstacles, it will refuse the protection. Obstacles of a relative nature are obstacles which do not allow registration of a trade mark of a specific type of goods and services due to the existence of prior rights of third parties. Article 132¹ of LIP lists these relative obstacles to registration. Firstly, it is not possible to register a trademark

if the scope of the right of protection granted for it might coincide with the scope of the earlier rights (moral and/or economic) of third parties. Secondly, it is crucial that two same or similar marks for the same (or similar) types of goods are not entered in the register. Otherwise, the public might be confused as to the origin of the goods. Thus, the Patent Office refuses to register such marks. Whenever there is a problem of assessing the similarity of two trademarks, the two factors have to be taken into account: the similarity of trademarks and the similarity of goods.

It must be stressed that before the amendments to industrial property law of 11 November 2015, the Patent Office examined *ex officio* the absolute obstacles and the relative obstacles for registration. Now, in line with the change in the system resulting from the amendments, the Office only examines absolute obstacles. However, relative obstacles to registration may be grounds for opposing the registration. These obstacles are only taken into account in the event when an opposition procedure has been applied. Thus the proprietor of an earlier trademark will have to act himself or herself rather than wait for the decision of the Patent Office. In the absence of opposition to the registration, the Office will grant the registration of a mark which infringes the rights of holders of earlier marks.

The Polish trademark system is based on the principle of the trademark registration as a basis for exclusive rights. The same is true also for European Union Trademarks, where the registration of a mark also constitutes the basic way of obtaining protection for a trademark. The duration of the exclusive rights to a trademark is 10 years from the date of filing the trademark application with the Patent Office. The right to a trademark may be extended for a further 10 years of protection, provided that a fee for the further period of protection have been paid.

In 2019, 14 228 domestic and 2781 international (The Madrid System)²³ trademark applications were filed with the Patent Office. Of these, 6 were filed by Russian entities and 1 right in registration was granted²⁴.

The most important information about trademarks is shown in the table below (Table 4).

Table 4. **Summary: Trademarks**

What is protected?	Any sign which makes it possible to distinguish the goods or services
Premises for protection	Distinctive character
How to get protection?	Registration
Rights granted	Right in registration — an exclusive right to use a trade mark for profit or for professional purposes throughout the Republic of Poland
Duration of right	10 years (but may be extended) from the date of filing an application with the Patent Office

6. Geographical indications

A geographical indications fall in a category of intangible goods which, like trademarks, are designations. Geographical indications indicate the origin of goods from a given geographical area. On the other hand it must be emphasised that geographical indications have similar functions to trademarks, with the difference that trademarks refer to a particular entrepreneur, while geographical indications indicate a certain geographical

²³ The Madrid System is a solution for registering and managing trademarks worldwide. Available at: <https://www.wipo.int/madrid/en> (accessed: 31.10.2020).

²⁴ Annual Report 2019. P. 79, 83.

area. There are several functions of geographical indications. First of all, there is a function of a *designation of origin*. The function of the designation of origin consists of two functions — an *information function* and a *differentiation function*. On the one hand, geographical indications indicate the origin of goods from a certain geographical area and, on the other hand, they make it possible to distinguish goods originating in a certain geographical area from goods of the same kind originating elsewhere. Another function of geographical indications is the *guarantee function*. A geographical indication indicates that a given product has specific characteristics and features which it owes to a specific place of origin. Geographical indications encourage consumers to purchase products from a given geographical area. Thus they also have an *advertising (promotional) function*.

Granting protection to geographical indications is aimed at supporting diversity and promoting products with specific characteristics. On the other hand, it also aims to ensure that the consumer making the choice is not misled and is guided by clear and concise information on the origin of the products.

There is no doubt that geographical indications influence consumers' choices of goods. Indeed, the consumer ascribes specific features of the product to its place of origin. This place, or in other words, a certain geographical area, distinguishes the product from products of the same type but originating elsewhere. For example, when buying Nuremberg gingerbread, the consumer expects that it will be gingerbread with certain characteristics (typical of Nuremberg) that are other than in gingerbreads available elsewhere.

The most well-known examples of geographical indications include the indication "Champagne", which designates a sparkling wine originating in the Champagne region of France, or the indication "Feta", which designates a brine cheese originating in Greece. Among Polish geographical indications, it will certainly be the indication "oscypek" (see: Fig. 4) used to refer to cheese made of sheep and cow milk from Podhale (the southern part of Poland).



Fig. 4. Registered Protected Designation of Origin "Oscypek".

Source: http://potrawyregionalne.pl//media/Image/specjalny/sery/oscypek_3.jpg

The definition of geographical indications in Art. 174 (1) of LIP provides that the following belong to them: a) word marks; b) indications relating directly or indirectly to the name of a place, village, town, region or country (territory); c) indications which identify a good as originating in that territory if a given quality, reputation or other characteristic of the good is attributed primarily to its geographical origin.

Article 175 (1) introduces a division of geographical indications defined in Art. 174 and divides them into regional names and designations of origin.

Regional names should be understood as indications used to distinguish goods:

- originating in a certain, specified territory, and
- possessing particular characteristics which derive exclusively, or predominantly, from the impact of the geographical environment comprising a combination of natural and human factors in which their production or processing takes place.

The designation of origin serves to distinguish goods:

- originating from a specified territory, and
- possessing particular characteristics or other specific features ascribed to their geographical origin being the territory in which they are manufactured or processed.

Both regional names and indications of origin are used to distinguish goods originating in a particular area. The difference between them is that regional names indicate goods whose specific characteristics result from a geographical environment comprising natural and human factors, while designations of origin indicate goods whose specific characteristics result from their geographical origin.

Protection of geographical indications under industrial property law is connected with the obligation to register them with the Patent Office. Following a correct application, the Patent Office issues a decision to grant the registration right to a geographical indication (Art. 182). The registration right is unlimited in time and lasts from the date of entry in the register of geographical indications. Unlike a trademark, which may in principle be used by the holder of the registration, a geographical indication may be used in the course of trading by anyone whose goods meet the premises allowing to bear a given indication (Art. 187 of LIP).

Currently, LIP is of *limited relevance* for the protection of geographical indications²⁵ because, under Art. 174 (3) the protection of geographical indications of agricultural products and foodstuffs covered by Regulation No. 1151/2012 as well as spirit drinks covered by Regulation No. 110/2008 has been excluded from the scope of this Act.

It does not mean, however, that LIP remains completely irrelevant. Geographical indications for products other than agricultural products and foodstuffs, and therefore in particular industrial products, may acquire protection but only through national registration.

In reality, however, in 2019 only one application of geographical indication was filled, and subsequently dismissed²⁶.

A summary of information about geographical indications is presented in the table below.

Table 5. Summary: Geographical indications

What is protected?	Regional names and designations of origin
Premises for protection	Originating from a specified territory Possessing particular characteristics
How to get protection?	Registration (limited relevance of the Polish registration)
Rights granted	Right in registration — A person whose goods meet the requirements for using a geographical indication is entitled to use it in the course of trade
Duration of right	Unlimited in time (perpetual) and lasts from the day an entry is made in the register of geographical indications kept by the Polish Patent Office

²⁵ *Całka E.* Geograficzne oznaczenie pochodzenia. Studium z prawa wspólnotowego i prawa polskiego. Warszawa: Wolters Kluwer Polska, 2008. P. 83.

²⁶ Annual Report (2019). P. 21.

Conclusions

The Polish system of industrial property protection provides an opportunity for an effective protection of intangible goods. The choice of an appropriate method of protection depends on many factors, and in particular on the nature of intangible goods.

However, since entrepreneurs have the possibility of protecting intangible goods in certain European territories under the European system (for patents) or the EU system (for industrial designs and trademarks) they tend to choose them more frequently rather than the national systems. With regard to geographical indications for agricultural products and foodstuffs, the EU system replaced the national systems in their entirety.

Thus, the current situation poses new challenges to the national patent offices. The entrepreneurs are also becoming more and more aware of the need to protect their intangible goods which are often the core value of a company. However, the analysis of the annual report shows that the Russian entities rarely decide to seek protection of their intangible goods under the Polish system of protection of industrial property.

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Польское право о промышленной собственности

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В последние годы повысилась правовая осведомленность предпринимателей, стремящихся защитить свои нематериальные активы. Для получения надлежащей защиты необходимо знать существующие возможные меры защиты. В статье разъясняются основные положения польского законодательства о промышленной собственности. С учетом систематики польского права в статье представлены вопросы, касающиеся изобретений, полезных моделей, промышленных образцов, товарных знаков и географических указаний. Однако в настоящее время нужно знать не только национальные законы отдельных

государств — членов Европейского союза, но и право ЕС, которое сильно влияет на законодательство государств-членов. По этой причине польское законодательство о промышленной собственности нельзя интерпретировать без учета права ЕС. При этом сложно точно очертить границы собственно права ЕС. Например, существует понятие «европейский патент», который предоставляется Европейским патентным ведомством в Мюнхене. Европейский патент базируется на Европейской патентной конвенции от 05.10.1973. Он выдается на основании одной заявки, где 38 европейских стран (включая Польшу) указываются в качестве территорий, на которых может быть предоставлена охрана. Польша подписала эту Конвенцию 01.03.2004. Европейский патент не является инструментом ЕС, а сама Конвенция не является частью законодательства сообщества ЕС. Тем не менее это важный документ, подписанный 38 странами, включая все государства — члены ЕС. Европейский патент часто называют «пакетом национальных патентов», и патентная защита может отличаться в разных странах. Вместе с тем законодательство государств — членов ЕС гармонизировано лишь до определенной степени. Следовательно, существует необходимость в дальнейшей гармонизации, а также в единообразном толковании действующих норм национальными судами и Судом ЕС, поэтому в ближайшие годы можно ожидать дальнейших изменений в польском законодательстве о промышленной собственности.

Ключевые слова: промышленная собственность, право промышленной собственности, патенты, полезные модели, дизайн, промышленные образцы, товарные знаки, географическое указание.

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