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Pharmaceutical products in the US & the EU: The challenges of protecting your trademark globally

by Benjamin Goldenberg
from Galderma



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Brexit Update: Stephen Hodsdon from Mewburn Ellis comments on the recent European Commission's position paper on IP rights



- Non-conventional trademarks • Indian trademark applications • The ARIPO challenges
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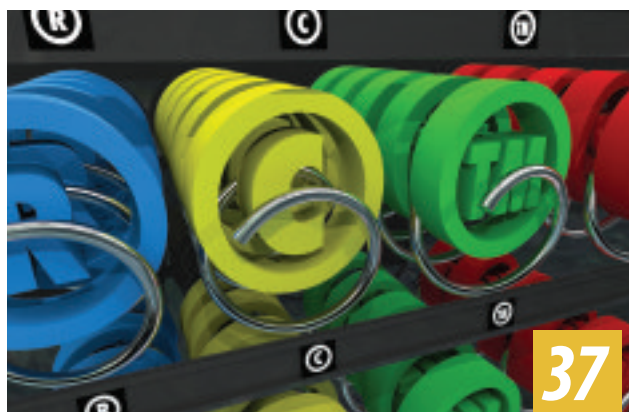
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Design rights in Poland

Klaudia Błach-Morysińska from Zaborski, Morysiński Law Office gives an in-depth explanation of the fundamental aspects of design right law in Poland and how this has adapted over the years.

The Act of 30th June 2000 – Industrial Property Law (OJ 2013.1410 dated 29 November 2013, as amended) (further ‘IPL’) was amended lately to make the Polish design law more attractive for the applicants. Poland is a member of the European Union and, in general, Polish design law is harmonized with EU law. This article refers only to Polish regulations and tries to bring it closer to the potential right holders.

1. Design and design rights

1.1 The right to registration (hereinafter the ‘**design right**’) is granted for an industrial design (hereinafter a ‘**design**’). A design is a new and individual form of a product, or a part of a product, representing the features of the outline, shape, colors, structure, or ornaments of the product (the list is open). The form of the product shall be understood as its appearance.

2. Unregistered design

2.1 Unlike in the EU regulation, the IPL does not provide protection for unregistered designs. The unregistered design may be protected under copyright law or unfair competition law, provided that the conditions specified in these laws are met.

3. Product as a subject of the protection

3.1 A product is any article made by means of a craft or industrial process including, in particular, a piece of packaging, graphic symbols, or typographic typefaces, except for computer programs. Products also include:

- (i) ‘Complex products’ - i.e. article consisting of

many replaceable components, which allows it to be disassembled and re-assembled) and their

- (ii) Replaceable component parts – if they are incorporated into a complex product and remain visible during regular use.

3.2 The designs that are not visible in normal use are not eligible for design protection. Visibility means visible during regular use, which is understood as every use excluding maintenance, servicing, or repairs.

4. Design application

4.1 The design application shall contain at least the identity of the applicant, the description of the subject of the application, and a request for the granting of a design right. Additionally, a design illustration, i.e. drawings, photographs or any other graphical representations shall be filed.

4.2 The illustration shall show the product with a clear indication of the essential features of the design. As a rule, one design per application is allowed. However, the application may include varieties of the design, i.e. separate appearance of the product that share the same material features. A single application may not exceed ten variants, unless the varieties form a set of products. If there are more than ten, the application shall be divided; if not divided, the application is regarded as applying to the first ten variants.

4.3 Until the decision to grant the design right is given, the applicant may make supplements or amendments to the application. The amendments may not concern the design itself or the varieties presented in the specification, drawings or photographs.

4.4 Filing a description providing an explanation of the design illustration may be attached to the application, but this was made optional as of 1 December 2015. Previously, it was an obligatory part of the design application.

4.5 Protection may be sought for partial design. If the novelty and individual character refers to partial design, the illustration must present the entire product. The claimed and disclaimed features must be clearly differentiated. As a general rule, broken lines are recommended. When broken lines cannot be used due to technical reasons other disclaimers can be used: color shading, boundaries, and blurring.

Résumé

Klaudia Błach-Morysińska, Attorney-at-Law, Patent Attorney, Zaborski, Morysiński Law Office, Poland

Klaudia specializes in intellectual and industrial property law, copyright, advertisement and unfair competition law. She provides expert-level legal assistance in courtroom litigations and in administrative disputes involving IP. She has a vast expertise before the Polish courts and authorities and international authorities. She is an advocate, patent attorney and European Trade Mark and Design Attorney. She authored numerous publications in the field of industrial and intellectual property law. She gives lectures in intellectual and industrial property rights and is a member of the Legislative Committee and Application Committee at the Polish Patent Attorney Chamber, AIPPI (Design Committee), PTMG, INTA, ECTA (Law Committee).



5. Novelty and individual character

5.1 The main statutory requirements for granting a design right are novelty and individual character. The form of the product to be protected as a design must include both of the above characteristics at the same time.

5.2 A design is new if, before its priority date, an 'identical' design has not been made available to the public through use, exhibition, or any other form of disclosure. An 'identical' means that the features of the designs differ solely in terms of insignificant details. The assessment of novelty shall take into consideration the prior public disclosure and area of the examined designs. Novelty has an objective character and applies the standard of novelty on a global scale.

A design is made available to the public if it can reach the attention of active professionals of any nationality, in the field of art to which the design relates. Polish disclosure is broader than EU disclosure, which refers only to professionals from the Community. There is a 12-month grace period preceding the priority date, for which disclosure shall not prevent the granting of the design right (i) for designs disclosed by the designer or with the his consent; and (ii) if the design has been disclosed because of an abuse. Moreover, disclosing the design to a third party, who was explicitly or implicitly obliged to keep it confidential, shall have no impact on the question of novelty.

5.3 A design has individual character if it leaves an informed user with the overall impression that it is different from the overall impression left on this user by a design made available before the priority date. The overall impression is the visual effect that a design has on the user. This refers to the design as a whole, not to its parts or details.

5.4 The extent of creative freedom shall be taken into consideration to assess the individual character of a design. Where the designer has little creative freedom, small differences shall be enough to create a different overall impression.

6. Informed user

6.1 An informed user is a person between an ordinary consumer and specialist. He is well informed, is familiar with and has good

knowledge in the examined field, and uses its products. He has awareness of previous designs and product trends in the relevant market. His knowledge is equal to the common experience that results from use of the product and average knowledge of the market.

7. Registration procedure

7.1 The Patent Office of the Republic of Poland (hereinafter the 'PPO') grants design rights in an administrative proceeding that started with a design application. The proceeding focuses on a formal examination. Nevertheless, novelty or individual character, as well as the registration requirements for a complex product or component part, or a design's contravention of public policy or accepted principles of morality, may constitute grounds for refusal of protection.

7.2 PPO issues a decision to grant a design right on the condition that the fee for the first protection period is paid. A design right is granted for 25 years following the filing date, divided into five-year periods if the protection fee is paid. Renewal is subject to timely renewal payments. Lack of payment results in the lapse of the design right on the day the previous protection period expires.

7.3 The issuance of a registration certificate proves the granting of a design right. The certificate consists of an industrial design specification containing the description (if provided), drawings, photographs, and textile samples included in the application. The industrial design specification is made available to third parties. Unlike in EU law, it is impossible to defer the design's publication.

8. Scope of registration

8.1 The design right is territorial and confers the exclusive right to exploit a design for profit or professional purposes in Poland. The proprietor may forbid any third party to make, offer, market, import, export or use a product in which the design is contained or applied, or to store said product for the purposes mentioned above.

8.2 Unlike in the EU system, the design right is limited to products indicated in the application (the 'specialisation rule'). The applicant is obliged to classify the goods in accordance with the Locarno classification. The IPL does not allow for registration of a general solution that may be used on different goods, for example a pattern that will be used on fabric, furniture or notebook covers.

8.3 One of the amendments of IPL was the repeal of regulation, which prevented registered designs benefiting from copyright after their registered rights expired. Following the repeal, design owners no longer have to choose between copyright or registered design rights to protect their designs. Now the design has stronger protection by way of design right and copyright.

9. Opposition

9.1 Within six months after publishing of granting of design right in the PPO's official bulletin "*Wiadomości Urzędu Patentowego*" (further: 'WUP'), any person may file an opposition to a decision on granting a design right. The opposing party shall prove that the statutory requirements for design registration have not been met.

9.2 If the design owner disputes the opposition, the case is transferred to PPO's dispute division. The opposition procedure includes the hearings and the writs exchange. Parties shall present the evidences to support their arguments. After the opposition proceeding, the PPO shall issue a decision dismissing the opposition or recognizing it in whole or in part. If the PPO accepts the opposition as justified, the design will be dismissed. The party that does not accept the PPO's decision may file an appeal to the administrative court.

10. Enforcement

- 10.1 The design may be enforced in a civil proceeding. A cease and desist letter shall be sent before filing a claim. Considering that the court case may be long lasting, it is important to obtain an interim injunction. The preliminary injunction is decided in ex parte proceeding. If it is filed before the claim, the right holder will have 14 days to file a suit. If the deadline is not met, the injunction will lapse.
- 10.2 As all evidence must be presented with first writ, it is important to collect all evidence at the beginning of the case. The right holder may request:
- (i) Discontinuance of the infringement,
 - (ii) Removal of the effects of the infringements,
 - (iii) Surrender of unlawfully obtained profits,
 - (iv) Compensation for damages (if the infringement was willful).
- 10.3 A civil lawsuit may take even several years to complete. In fact, the settlements are quite common and the enforcement of an injunction usually makes perpetrators willing to negotiate.
- 10.4 The design claims may be enforced after the design registration. They are subject to three years limitation period from the date on the day when the right holder learns about the infringement but not later than five years after the infringement date.
- 10.5 The design may be the subject of customs protection, which may be granted for one year (extendable for further one year periods on written request). The customs shall notify the right holder of seizure of goods suspected for design infringement. If rights holders undertake all steps foreseen in customs regulation, the goods may be destroyed. If no action is taken, the goods will be released.

11. Fees

- 11.1 As of October 14, 2016, the Polish Patent Office significantly decreased the protection fee for the designs. The application fee for registration of a single design, in the amount of 300 pln (approx. Euro 75), shall be paid on filing day. The fee for the first five-year protection period, in the amount of 150 pln (approx. Euro 37,5) shall be paid after registration. The opposition fee equals to 1,000 pln (approx. Euro 250). The fees decreased to make the Polish fee competitive to the EU one. While filing a statement of claim, the court fee equals to 5% of the value of the matter shall be paid. The customs seizure motion is free of official charges.

The amendment simplifies the procedure before the PPO and makes it cheaper. They may shorten the time for examining design applications. These changes shall make the Polish design more attractive for potential applicants. The time will tell, if the introduced amendments will serve to support innovation and creativity in Poland.





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