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Legal framework

In Poland, designs are governed by the Industrial Property Law (as amended) and the EU Community Designs Regulation (6/2002). Both are harmonised with the EU Designs Directive (98/71/EC).

Poland is a party to the following international conventions and treaties:

- the Geneva Act of the Hague Agreement;
- the Paris Convention;
- the Agreement on Trade-Related Aspects of IP Rights; and
- the Locarno Agreement.

The Polish design regime is based on registration. The Patent Office examines applications for compliance with the formal requirements.

Unregistered designs

The Industrial Property Law does not protect unregistered designs, but they can be protected

under the EU Community Designs Regulation for a period of three years from the date on which the design is first made available to the public within the European Union. An unregistered design enables the rights holder to prohibit a third party from making unauthorised use of the design only if the contested use results from copying.

An unregistered design may also be protected under the Copyright Law or Unfair Competition Law, provided that the specific conditions therein are met.

An unregistered Community design is defined in the same way as a registered Community design and must meet the same requirements (ie, novelty and individual character). For protection of an unregistered Community design, the duration of use is not as important as the novelty and individual character requirements and first disclosure to the public.

Registered designs Ownership

Any natural or legal person can register a design. The right to register a design generally belongs to the creator. Where a design has

been created jointly by several persons, the right of registration belongs to them jointly. Where a design has been created in the course of employment or in the execution of a contract, the right belongs to the employer or commissioner, unless otherwise agreed.

A design application can be filed by the applicant or its representative. Foreign applicants must be represented by a Polish patent attorney. A power of attorney is required, plus documents proving that the person who signed the power of attorney is duly authorised to represent the applicant.

Protectable subject matter

The Industrial Property Law defines an 'industrial design' as any appearance of the whole or part of a product which is new and has individual character resulting from the lines, colours, shapes, textures or materials of the product and its ornamentation.

The following also constitute designs:

- a complex product composed of multiple components which can be replaced, permitting disassembly and reassembly;
- a component part of a complex product which remains visible during normal use of such complex product (excluding maintenance, servicing or repair work); and
- a component part which may by itself be subject to commercialisation.

The scope of protection for component parts is severely limited by the 'repair clause', which provides that design protection does not cover a component part of a complex product that is used for the purpose of repair of that complex product, so as to restore its original appearance.

A design shall not be protected if:

- it is not a 'design' by legal definition, as described above;
- its exploitation would be contrary to public order or morality;
- it consists of or includes protected national or international flags and emblems;
- it is dictated solely by the technical function of the product; or
- it violates third-party rights.

The Industrial Property Law provides no protection to 'must-fit' features of designs

(ie, features which must be reproduced in their exact form to allow the product to be connected to, or interact with, another product). However, registration of a design intended for multiple assembly or connection of mutually interchangeable products within a modular system is permitted.

Novelty and individual character

An industrial design shall be considered new if no identical design has been made available to the public (ie, used, exhibited or otherwise disclosed) before the priority date. A design shall be deemed to be identical to a prior design if it differs from the prior design only in immaterial details. The Industrial Property Law provides for a 12-month grace period preceding the priority date, during which disclosure of a design by its proprietor does not destroy the novelty of the design.

A design shall be considered to have individual character if the overall impression that it produces on the informed user differs from that produced by any design made available before the priority date. In assessing individual character, the degree of freedom afforded to the designer in developing the design is taken into consideration. According to well-established case law, an 'informed user' is someone in between the average consumer and an expert, who is acquainted with design development in the relevant field, familiar with products to which the design is applied, observant and circumspect.

Fees

On filing, the applicant need pay only the application fee. Publication and renewal fees are paid after registration. In contrast, the fee for registration of a Community design is due in full on filing. The official fees for registration of a single design, including the first five-year protection period, is approximately €180 for a national design and €350 for a Community design.

Procedures

Application process

Designs can be registered directly with the Patent Office or, in the case of a Community design, with the Office for Harmonisation in the Internal Market (OHIM). Poland can also be designated within the Hague system.

A national design application must contain a representation and description of the design. The representation can comprise drawings, photographs or fabric samples. The description should present the design in a manner that is clear and detailed enough to enable it to be reproduced on the basis of the representation in any form indicated in the application. In particular, the description must:

- contain a definition of the design and indicate what it is intended for;
- itemise the illustrations or indicate the number of samples;
- include a numbered list of the forms of the design, where the application contains such forms; and
- designate those features which distinguish the design from other known designs and enable its identification.

A description of the design is not required for a Community design registration.

As a rule, one design per application is allowed. However, one design application may relate to separate appearances of a product which have essential features in common (ie, variations). The maximum number of variations in one application is 10, unless they form a set of products.

Under the EU Community Designs Regulation, multiple designs may be combined in one application, provided that the products in which the designs are incorporated all belong to the same Locarno class (except in cases of ornamentation).

A design application may be filed electronically or directly with the Patent Office. Once registered, the design is published in the *Patent Office Journal*.

Deferred publication is not available under Polish law. Under the EU Community Designs Regulation, at the time of filing, the applicant can request that publication of a registered Community design be deferred for a period of 30 months from the filing date.

Examination and appeals procedure

A decision on registration will be taken after verification that the design has been duly filed with the Patent Office. Only formal requirements are subject to verification (eg, design representation, fees, power of

attorney). No substantive examination is conducted.

If the Patent Office refuses registration, a request for re-examination can be filed within two months of the decision. A re-examination decision can be appealed to a provincial administrative court within 30 days. The court's judgment may further be subject to a cassation complaint before the Supreme Administrative Court, whose decision is final.

Opposition

Registration can be opposed within six months of publication. An opposition can be filed by anyone who can prove that the statutory requirements for registration have not been met. If the rights holder finds the opposition to be unjustified, the case is transferred to the Patent Office's Litigation Division. If the opposition is upheld, registration is revoked.

Registration

Registration gives the owner the exclusive right to exploit the design commercially in Poland. A registered Community design applies throughout the European Union, including Poland. The owner can prohibit any third party from manufacturing, offering, placing on the market, importing, exporting or using a product in which the design is incorporated, or stocking such a product for these purposes.

The term of a design registration is 25 years from the filing date, divided into five-year periods.

Removal from register

A design registration lapses on expiry of the protection period or after a five-year period if no renewal fee is paid. A design registration can be surrendered by the rights holder for all or part of the goods for which it was granted.

The Patent Office can invalidate a design registration in whole or in part at the request of any party with a legal interest. The requesting party must prove that the statutory requirements for the grant of protection were not met. An invalidation decision can be appealed directly to the administrative courts.

Invalidation of a Community design is decided directly by OHIM or by a Community court on the basis of a counterclaim in infringement proceedings.

Enforcement

The rights holder may initiate a civil action against alleged infringers. A Polish design registration can be enforced before the common civil courts. The court of first instance is the district court where the alleged infringer resides or is domiciled, or where the infringement was committed. Community design infringements are handled by one Community court established in Warsaw. In order to initiate court proceedings, a statement of claim, supported by relevant evidence, must be lodged. Polish patent attorneys can represent rights holders before the courts in enforcement proceedings concerning both Polish and Community designs.

Remedies

The rights holder may request:

- cessation of infringement;
- surrender of unlawfully obtained profits;
- compensation for damages (in case of wilful infringement); and
- publication of the judgment or information about the judgment.

Further, the court may decide on the disposal of unlawfully manufactured or marked products and equipment used in their manufacture or marking. The court may order:

- their removal from the market;
- their assignment to the rights holder on the account of the sum of money to be adjudged to it; or
- their destruction.

Where the infringement was unintentional, the court may order the infringer to pay a reasonable amount of money to the rights holder instead of cessation or destruction.

Preliminary injunction

A preliminary injunction may be requested before or when initiating court proceedings, or during the proceedings. If the request is filed before infringement proceedings commence, the court will appoint a deadline (usually 14 days) to file suit. If the deadline is missed, the injunction will lapse. The preliminary injunction is decided in *ex parte* proceedings.

To obtain a preliminary injunction, it is necessary to prove legal interest, the rights

which have been infringed and the factual and legal circumstances of the infringement. The standard of evidence required is lower than in the main proceedings. The rights holder must define claims secured by the preliminary injunction and the injunction measures sought (eg, seizure of infringing products, a ban on the sale of infringing products or a ban on the use of an infringing method).

A preliminary injunction is granted for the duration of the main proceedings; it lapses one month after the close of the main proceedings at the latest. If the plaintiff loses the lawsuit or decides to withdraw the suit before a verdict is issued, the alleged infringer is entitled to compensation for damages suffered as a result of the interim injunction.

Border measures

Customs protection – available for valid national and Community designs – can be an effective legal tool against design infringement. Border measures are based on the EU Customs Regulation (1383/2003), which will be replaced by a new regulation (608/2013) from January 1 2014.

Customs protection is granted for one year, extendable for a further year on written request. It enables the rights holder and its representatives to obtain customs notification relating to the seizure of products suspected of infringement.

Documents confirming that infringement proceedings have commenced must be submitted to Customs in order to detain goods for the duration of the proceedings. If the owner of the seized goods agrees to their destruction, a simplified procedure can be initiated. Consent for destruction must be explicit and given in writing. If consent for destruction is not given, the rights holder must then initiate a civil action against the alleged infringer within 10 working days of the seizure (extendable for a further 10 working days). No criminal measures are available for design infringement. If no action is undertaken in due time, the goods are released. Due to the complexity of design infringement cases and the limited timeframes involved, a border detention programme should be prepared thoroughly before requesting Customs to take action.

Timeframes

Design infringement claims can be enforced after registration. Where the infringer has acted in good faith, infringement claims can be enforced in respect of the period commencing on the day following publication or, where the infringer was notified earlier of filing of the design application, from the date of notice. The limitation period for infringement claims is three years from the date on which the rights holder learns of the infringement; this period runs separately for each individual infringement. Claims are time barred five years after the date of the infringement.

Ownership changes and rights transfers

Assignment and licensing

A design registration or pending application may be assigned or subject to succession. The assignment agreement must be in writing on pain of invalidity. All changes must be entered in the Design Register in order to be effective against third parties.

Licences

A licensing agreement must be in writing on pain of invalidity. The licensee shall have the right to exploit the design to the same extent as the licensor (full licence), unless restricted in the contract (limited licence).

A licence can be exclusive or non-exclusive. The grant of a licence to one party shall not prevent the rights holder from granting a licence to other parties (non-exclusive licence), unless otherwise agreed.

A licence terminates at the latest on lapse of the design right.

A licensee may grant a sub-licence only with the rights holder's consent. Registration of a licence agreement is not mandatory; however, an exclusive licensee recorded in the Design Register may, to the same extent as the rights holder, enforce its claims in the event of infringement, unless the licence stipulates otherwise.

Related rights

The appearance of a product can be protected by both design rights and copyright. So-called 'industrial design works' are explicitly listed in the Copyright Law as protectable subject matter. An industrial product must meet the

same requirements as other copyrighted works in order to enjoy copyright protection. The protection granted to industrial products on the basis of the Copyright Law is independent of the protection granted on the basis of the Industrial Property Law and vice versa. The duration of copyright protection for a design that is simultaneously protected as a registered design is limited by the Industrial Property Law to a maximum of 25 years. Pursuant to Article 116 of the Industrial Property Law, products that are manufactured by means of a design and put on the market after registration lapses shall not benefit from copyright protection (economic rights of the author). Article 116 will likely be abolished in the planned amendment to the Industrial Property Law.

In some areas (eg, packaging), design products are commonly registered as three-dimensional trademarks. The shape of a product can also enjoy protection under the Unfair Competition Law, provided that separate criteria are met. [WTR](#)

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