Prof. Michał du Vall
Jagiellonian University, Cracow

"IPR Legislation in Poland in the context of Polish accession to the UE"

The Polish Industrial Property Law of 2000 (Polish IPR) has been harmonized with the Laws of the UE. In fact, such harmonization was one of the conditions to join the Union. Nevertheless, some differences exist. They result from not-full harmonization of Polish regulations with the European ones (cf. Item 1 below) or from adopted transitional solutions providing European entrepreneurs in Poland with more favourable protection principles than those applicable in "old" EU member states (cf. Item 2 below).

Consequences of Poland's jointing the European Patent Convention (EPC)

Beginning from 1 April 2004, European patents will be granted also for the territory of Poland. Due to the fact that inventions in Poland will be protected based on both domestic and EU patents, it is beyond doubt that the conditions for patent protection and the scope of such protection should be identical. However, it is not the case (as presented below).

Novelty of invention

(a) In accordance with Article 54 Section 5 of EPC, *the provisions of paragraphs 1 to 4 do not exclude patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 52, paragraph 4, provided that its use for any method referred to in that paragraph is not comprised in the state of the art*.

According to the Amendment to EPC of 2000, it is also possible to protect the second and the next use of the substance or the composition.

Under Polish law, the protectable–subject–matter is broader; it is possible to protect any new use of known substance, that is to mean, not only the medical use.

(b) According to Article 55 Section 1 (a) of EPC, the non–prejudicial disclosure takes place in two situations:

- *an evident abuse in relation to the applicant or his legal predecessor, and*
- *no earlier than six months preceding the filing of the European patent supplication.*

In the said situations, it would not be possible to obtain the patent protection in Poland because of lack of novelty. So, the conditions of novelty in that respect are less strict in our country.

Interpretation of patent claims

In accordance with Article 69 Section 1, the extent of protection conferred by a European patent (…) is determined by the terms of claims. Nevertheless, the description and drawings are used to interpret the claims.

Practically, the same provisions exist in Article 63 Section 2 of the Polish Law on Industrial Property of 2000 (Polish IPR).

Nevertheless, the Protocol to EPC, covering the applicable interpretation of Article 69 of the EPC, stipulates that it *should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only*

for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes witch combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

In my opinion, the above Article 63 Section 2 of Polish law lacks basis for the application of interpretation assumed in the Protocol in circumstances where the wording of patent claims is unambiguous. In such a case, the interpretation is simply not carried out.

In fact, I have serious doubts as to the point of the principles contained in the Protocol. In practice, they increase legal instability and uncertainty. This is reflected in divergent decisions issued in cases connected with violation of the same European patent in various member states (cf. EPILADY case).

Consequences of Poland's accession to the EU

Supplementary Protection Certificate (SPC) protecting pharmaceutical products and plant protection products.

Beginning from 1 May 2004, i.e., from Poland's accession to the EU, Supplementary Protection Certificates will be issued in Poland on the terms and conditions set forth in the Council Regulation (EEC) No. 1768/92 of 18 June 1992 and Regulation (EC) No. 1610/96 of 23 July 1996.

In exceptional cases, SPC will be granted despite non-fulfilment of the terms and conditions.

Pursuant to Article 2 of the Law of 2002 adjusting Polish IPR, SPC *may be granted for an active substance or a combination of such substances which, on the date of Poland's accession to the European Union, are protected by a basic patent and for which the first permit for introduction to the Polish market or the European Union market was obtained prior to Poland's accession to the European Union, but not earlier than on 1 January 2000* (Section 1).

Application for an additional protection right in cases referred to in Section 1 may be filed within six months of the date on which Poland became a member state of the European Union (Section 2).

The scope of application of this exceptional regulation may be disputable. Pharmaceutical products and chemical compounds as such have been protected in Poland since 1993, while the methods of their production were protected even earlier (an indirect protection of products applied then, provided that they were produced with the use of patented methods).

Thus, a question arises whether the "basic patent" referred to in the above regulation is just a patent protecting products as such or a patent protecting method.

In my opinion, the standpoint that SPC may be granted exclusively when the protection concerns products as such is justified and grounded.

Exhaustion of rights

Pursuant to Article 70 Section 1 of the Law, *the rights conferred by a patent shall not extend to acts concerning a product embodying the invention or manufactured by means of the*

invention, consisting in particular of its offering for sale or further putting on the market, if that product has been put on the market on the territory of the Republic of Poland by the patent holder or with his consent.

On 1 May 2004, Section 2 of this Article entered into force, according to which a *patent shall neither be considered infringed by an act of importation into the territory of the Republic of Poland or other acts referred to in section (1) in respect of a product that has earlier been put on the market on the territory of the European Economic Area by the patent holder or with his consent.*

One can observe that the principles of exhaustion of rights applicable in Poland have been taken from those set in the European case law.

However, special principles concern, temporarily, pharmaceutical products.

The Poland's Accession Treaty, Appendix No. II Item 4, provides for the so-called *Specific Mechanism*, according to which:

With regard to the Czech Republic, Estonia, Latvia, Lithuania, Hungary, Poland, Slovenia or Slovakia, the holder, or his beneficiary, of a patent or supplementary protection certificate for a pharmaceutical product filed in a Member State at a time when such protection could not be obtained in one of the abovementioned new Member States for that product, may rely on the rights granted by that patent or SPC in order to prevent the import and marketing of that product in the Member State or States where the product in question enjoys patent protection or SPC protection, even if the product was put on the market in that new Member State for the first time by him or with his consent.'

Any person intending to import or market a pharmaceutical product covered by the specific mechanism in a member state where the product enjoys patent or supplementary protection shall demonstrate to the competent authorities in the application regarding that import that one month's prior notification has been given to the holder or beneficiary of such protection.

It should be noted that the restriction set forth in the above regulation is unilateral since it provides for no obstacles for import of products from Member States to Poland (as regards such circumstances, the principles contained in Article 70 Section 2 of Polish IPR apply). In my opinion, the above presented regulation should be evaluated positively since, in practice, it allows for the sale of pharmaceutical products in Poland at lower prices.

Michał du Vall is a professor of the Jagiellonian University, dean of the Management and Communication Faculty of Jagiellonian University and head of the Competition Law Department of the Institute of the Intellectual Property in Cracow. Professor du Vall was also a visiting professor on many distinguished universities such as: Stanford University, University of London and Max-Planck-Institute in Munich.

Professor du Vall is a attorney at law and a Parnter in Szwaja, du Vall, Nowińska office and represents his clientes in a range of competition law and intellectual property cases. In the years 1990-1992 Professor du Vall as a representative of Poland, took part in the work of an international workgroup, created by the European Community Studies Association (ESCA), sponsored by the EU, whose assignment was to determine the what extend the ownership

transformations in Middle-European countries correspond to European standards. The work resulted in a report, which was published in a book: Privatisation and Regulatory Change in Europe, ed. M.Moran and T.Proser, Open University Press 1994. Professor du Vall is also a co-author of the Commentary to the Treaty signed between EU and Poland, preparing part on the intellectual property law problems. Professor du Vall has published over 150 books and articles in Poland and abroad.