

First filing requirement in Poland

Many states adopt in their legislation certain limitations when it comes to permissibility of filing patent applications before foreign offices: usually they are imposed on citizens of those countries or their residents; they can apply as well to inventions developed within their territories. **Such regulations of given states provide that the first filing for an invention must take place with their proper intellectual property offices, and only then would it be possible to seek protection in other jurisdictions.**

In this issue of WTS Legal Report we would like to examine the matter of first filing requirement in the Polish legal system. We know very well that the question of being obliged to submit first filing in Poland raises quite often some serious doubts in practice. In the era of global economy, complex organizational ties between corporations that operate all around the globe, scientific research conducted by teams dispersed throughout different continents, application of regulations of this kind is prone to generating some difficulties. This issue gains particular importance in a context of foreign concerns that delegate their employees to Poland, or partnerships established by persons of different nationalities. We would therefore closely analyze the specific rules and then attempt to answer the questions: when would they apply and what consequences can a potential non-compliance engender.

Basis in the Polish law

The fundamental rule that delineate the scope of freedom of filing abroad is expressed in **Article 40 of the Act of 30 June 2000 – the Intellectual Property Law (IPL)**. According to this provision, the applicant established or domiciled in the Republic of Poland, may file a patent application for an invention, seeking protection in other countries, with the Patent Office of Republic of Poland (PPO), in a manner prescribed by:

- A) an international agreement or provisions of the European Union law as referred to by Article 40 (international agreements or provisions of the European Law directly effective in Member states that provide a particular mode for granting protection for inventions, utility models, industrial designs, trademark, geographical indications or mask works),
or;
- B) The IPL
– **after having filed an application for this invention with the PPO.**

In other terms, the phrasing of this rule means that **if persons indicated in its disposition are interested in obtaining a patent protection abroad, they have to file application first with the Patent Office of Republic of Poland.**

As a side note, it is worth mentioning that Article 40 does not require for an application to be filed correctly and effectively. The obligation will be discharged even if the proceedings are discontinued at some point.

The subjective scope of the regulation

Who is the addressee of this provision? Its subjective scope is defined rather clearly: it encompasses **persons established or domiciled in the Republic of Poland**, therefore it will apply both to natural and legal persons, as well as to organizational entities without legal personality to whom a statute attributes legal capacity, pursuant to Article 3 Section 1(1) of the IPL.

We have to notice that this provision has undergone some significant changes due to the amendment of 2015 (the Act amending the Industrial Property Law and several others acts of 24 July 2015). Previously, Article 40 applied to the Polish legal persons and

Polish citizens domiciled in the Republic of Poland. Thus the subjective scope of the regulation has been extended: **the natural person upon which the IPL imposes a duty to file the first application with the PPO does not need to have the Polish citizenship; what is relevant is being domiciled in Poland.** The place of residence is defined under Article 25 of the Act of 23 April 1964 — the Civil Code as a place where a person is staying with an intention of a permanent stay. **In consequence a citizen of another state who is staying in Poland, is also obliged to file the first application with the PPO.**

Ratio legis of Article 40

The presence of regulation regarding the requirement of first filing with the PPO in the IPL shall undoubtedly be seen in the light of protection of vital interests of the state, which increasing availability of a given invention and technical knowledge supporting it is expected to contribute to. In particular it shall guard the interests of the state in the field of defense and security. Under Article 56, an invention developed by a Polish citizen can be deemed classified, if it concerns defense (the premise referring mainly to types of weapons or military equipment and methods of combat) or security of the state (in particular technical means employed by state services authorized to carry out preliminary investigative activities, as well as new types of equipment and appliances and methods of their employment by those services). Such a regulation poses a certain risk for an inventor — an institution of a classified invention threatens that he or she might be dispossessed of their right, at it is strongly expressed by doctor Michalak in his commentary to the IPL.

It shall be also noted that Article 40 of the IPL does not indicate its material scope. No matter what invention the application is actually filed for, it is going to be reviewed in terms of identifying those inventions which have certain significance for defense and security of the state.

No sanctions?

What is absolutely crucial, the provision of Article 40 does not mention any sanctions; it is therefore a so-called *lex imperfecta* — imperfect law. The rule concerning the requirement of first filing in Poland is silent when it comes to the consequences of non-compliance.

Let us imagine a situation wherein an inventor files an application in other state and subsequently the application “returns to” Poland — for example as an application claiming the conventional priority or as an European patent that the inventor seeks to validate. We

need to remember that, according to Article 14 of the IPL, the priority to obtain a patent, protective rights or registration rights can be claimed in the Republic of Poland under the rules prescribed by international agreements with respect to the date of the first **duly** filed application for an invention, utility model or and industrial design in a given country, if the application is filed with the PPO within a period of:

- 1) **12 months — for patents** and utility models;
- 2) 6 months — for industrial designs.

It must be strongly emphasized: **the Paris Convention for the Protection of Industrial Property of 20 March 1883, referring to the matter of priority, clearly indicates that correctness of the application is evaluated with regard to a domestic law of a state in which it is filed**; domestic regulations of any other states-parties to the convention are irrelevant (Article 4(a)). The industrial property office in Canada or in Japan does not have to demonstrate its knowledge of the Polish statutory provisions when they review an application submitted to them, regardless of possible ties the given case might have with Poland; they do not have to determine what are the applicable provisions for first filing requirement in the Polish legal system.

Nevertheless, if such an application reaches subsequently the PPO, would it be entitled to reject its priority claim, concluding that the foreign application has not been duly filed? As the authors of the commentary to the IPL edited by professor Sieńczyło-Chłabcz rightly point out, “according to the Paris Convention the correctness of the first application can be evaluated solely under to the law of the country where it has been filed, and Article 40 of the IPL does not apply there, so it would be hard to argue that an application violates the law”. However, it must be noted that such a position does not enjoy a complete consensus in the doctrine; for instance, professor De Vall expressed his different opinion: he claimed that in fact the PPO would be entitled to reject a priority claim of an application failing to comply with Article 40 of the IPL. Of course, such a scenario would entail negative consequences for an applicant: in that situation Article 4(b) which provides that within the period of 12 months the application with the PPO cannot be invalidated by reason of any acts accomplished in the interval such us, for example, another filing, the publication or exploitation of the invention. In such a case the state of art that is relevant for determination whether patentability criteria has been met would be different, and as a result their fulfillment will get much more difficult.

Finally, we cannot forget that **the catalogue of grounds to refuse a priority contained in Article of 48 is exhaustive** — the refusal is permissible only in cases enumeratively listed in that provision. If the PPO reached such a decision and tried to justify it by referring to the premisses beyond the catalogue, it would risk being accused of overstepping its competences.

The European patent application

The provisions of the Act of 14 March 2003 on the filing of European patent applications and the effects of European patents in the Republic of Poland implied that it is possible to file an European patent application without filing first national application, as long as it is filed with the PPO. Until 1 December 2015 Article 3 Section 2 of the act in question provided that if a European patent application for an invention for which a national application has not been yet filed in Poland, a Polish citizen or a foreign legal person or natural person respectively established or domiciled in the Republic Poland were obliged to file it with the PPO; the application of Article 40 of the IPL was excluded.

Due to the aforementioned amendment of 24 July 2015 the provision has been reduced to a prescription that a European patent application filed via the PPO by persons listed in Article 40 of the IPL shall be in Polish, or a translation to Polish shall be attached to it. **Despite this editorial change it is accepted that the exception to the first filing requirement, which was in force previously, still applies: currently the first application filed with the PPO does not necessarily have to be a national application. The obligation under Article 40 of the IPL will be discharged also if we file an European patent application via the PPO (likewise in case of an application in the PCT procedure).** Certainly, it is a reasonable solution: an applicant does not have to file two separate applications for two patents that would have exactly the same effect within the territory of Poland.

We might wonder to what extent the situation of a European application resembles the one we have described in the context of a foreign application. Admittedly, validation is dependent upon submitting of a Polish translation of a European patent within 3 months from the date when EPO publishes a notice of its grant; the PPO does not carry out substantive examination. Yet if a patent, after having gone through the process of validation, “enters” the Polish legal system, it could be invalidated under Article 89 of the IPL, therefore it might be necessary to reflect on whether the problem of violating Article 40 could not raise at this stage.

The provision of Article 89 states that a patent can be invalidated in a whole or partially upon a request of anyone who demonstrates that:

- 1) the conditions for the grant of a patent have not been fulfilled;
- 2) The invention is not disclosed in the manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- 3) The patent has been granted for the invention that is beyond the scope of the application or the original application;

4) The patent claims do not describe the subject-matter of the protection in the manner clear and succinct or are not fully corroborated by the description of the invention.

It is however highly dubious whether any of these grounds could be interpreted broadly enough to include non-compliance with Article 40 of the IPL. The most general premise of Article 89 Section 1 concerns cases when an invention does not fulfill patentability criteria, or is not considered an invention at all, or finally is an invention but excluded from patentability, as it is discussed in the commentary edited by professor Sierń-czyło-Chlabicz — therefore it would not be possible to fit into this category the incorrectness of an application raising from the fact of it being filed first in another country. Similarly, it would not be possible to invoke Article 74 which is a *lex specialis* to Article 89 and allows for invalidation of a patent obtained by an ineligible applicant; clearly, it will not be the flaw we are dealing with in that case.

Applications filed by persons other than inventors; multiple applicants

Another question of practical importance can be raised when it comes to the first filing requirement: what happens with applications filed by and for persons other than inventors, established or domiciled in different countries? As we argued in the introduction to this report, in the time of progressing globalization and cooperation of entities originating from various states, various legal systems, such situations are expected to occur more and more often. **When dealing with those cases, we shall not be interested in who has made a given invention, but who is entitled to obtain a patent.**

Let us assume that an inventor who resides in Poland develops an invention. According to Article 8 of the IPL, upon development of an invention he or she gains specific rights: to obtain a patent, to remuneration (material rights) and to be mentioned as the inventor in descriptions, registries and other documents and publications (personal rights). Article 12 expressly indicates that the right to obtain a patent is transferrable and can be inherited. Hence, the contractual transfer is possible — such a contract under pain of being void has to be concluded in writing. According to the principle of freedom of contract, the parties are free to form the contract as long its content and purpose do not contradict the nature of a legal relation, statutory provisions and principles of community life (Article 353¹ of the Civil Code); the transfer of right can take place with or without payment. A particular case of the transfer of the right to obtain a patent is provided by Article 20 ILP: an inventor can transfer this right gratuitously or for an agreed charge to an entrepreneur or hand an invention over to an entrepreneur for their use (an entrepreneur is defined under Article 3 Section 1(3) as a person who carries out manufacturing, constructional, mercantile and service activities for commercial purposes, further referred to as “business activity”,

while according to Article 3 Section 2 the provisions of the act that concern entrepreneurs shall apply respectively to persons carrying out activities other than business activity). It might also happen that **a development of invention results from the inventor's performance of obligations related to an employment relationship or another contract – in those cases the right to obtain a patent would belong to an employer or the contractor, unless the parties agree otherwise.**

An entrepreneur/employer/contractor can be established or domiciled outside the territory of Poland: then, if they seek to file an application, they would not fall within the scope of application of Article 40 of the IPL. In such a situation an obligation to file first in Poland would not exist; and other circumstances of development of the invention would have no significance whatsoever.

Eventually, considering a different scenario, we should remember that there might be instances with more than a single applicant involved. It could occur that an application is filed by persons who have developed an invention in cooperation (Article 11 Section 2 of the IPL), and one of them is not covered by the disposition of Article 40 of the IPL; or a transfer of a share in the right for a person not domiciled in Poland has taken place. How would such circumstances affect the first filing requirement? It must be underscored that in such situations, if only one of applicants does not meet the criteria of the application of Article 40, there would be no obligation and the path to file the first application abroad would be open.

Summary

Below you can find a recap of the most important information discussed in this Legal Report:

- According to Article 40 of the IPL, a person domiciled or established within the territory of Poland, can seek a patent abroad only after having filing the first application with the PPO.
- This provision shall be applied regardless of: where the invention has been made; what is the applicant's citizenship; the domicile of an inventor if it is not him or her who files the application. In case of the application being filed by several applicants, if only one of them is not covered by the disposition of Article 40, the statutory duty would be excluded.
- There is not any specific sanction for non-compliance with the first filing requirement in the Polish legal system. Industrial property offices in other countries are not bound by Polish domestic regulations and they would not take them into consideration when making a decision concerning the grant of a patent.

- A person indicated in the disposition of Article 40 of the IPL who files their first application outside Poland, should be aware of existence of a certain risk if they plan to file later in Poland an application claiming the conventional priority or seek validation of an European patent.
- It seems that the PPO could not deny priority in such a situation — under the Paris Convention the correctness of the application shall be evaluated under the law of the state where it is filed; moreover, the decision to reject a priority claim can only be made on the grounds specifically provided by Article 48. Due to a limited practice of the PPO in this field and diverging views of the representatives of the doctrine, it cannot be expected with complete certainty that such a line of reasoning would be chosen by the Office.
- The aforementioned risk, rather insignificant in the case discussed above, would be even less grave in the context of European patents. Validation does not involve any substantive examination; if someone attempts to invalidate a patent, it seems that a violation of Article 40 cannot be considered a basis to allow such a request.
- The first application with the PPO does not have to be a national application — the obligation imposed by Article 40 would be discharged also if a European patent application or a foreign patent application in the PCT process is filed via the PPO.