

# The patent invalidation in Poland

The very nature of patents implies their temporal limitation, but the expiry of the protection period may not be the only reason for the termination of exclusive rights arising from the patent. In this article, we present **the regulations in Polish law regarding the invalidation of a patent, which can basically take place in two procedures:**

- **as a result of an objection;**
- **in patent invalidation proceedings.**

One more procedure can be added to this short list, however, with some reservations — provided that one of qualified defects of the decision to grant a patent is present, it is also possible to apply the general rules of the Act of June 14, 1960 - Code of Administrative Procedure.

## Effects of the patent invalidation – the difference between the invalidation and the expiration of a patent

A decision to invalidate a patent is effective *erga omnes* (towards everyone). The invalidation of a patent, thus, has an ***ex tunc* effect** – **the exclusive right granted by the patent will be treated as if it never existed**; the defective decision to grant a patent will be eliminated from the legal system.

It should be noted that **the *ex tunc* effect of the patent invalidation clearly distinguishes this case from patent expiration**, another institution related to the termination of exclusive rights to a patent. In the provision of Art. 90 of the Act of 30 June - Industrial Property Law (IPL), we find a catalogue of situations in which the expiration occurs: the expiration of the period for which the patent was granted; renunciation of the patent by the holder; failure to pay the periodic fee within the prescribed period; and in the case of biotechnological inventions, the permanent loss of the ability to use the invention, due to the unavailability of the necessary biological material needed for it, which has become unavailable. In all these cases, except for the expiration of the patent due to the expiration of the period of protection, the PPO issues a decision confirming the expiration of the patent. Importantly, the expiry is effective only for the future (*ex nunc*) - as we read in "Patent Law" by prof. Du Vall, "after the date of expiry of the right, the technical solution previously protected by it passes to the sphere of industrial freedom, which means that its use no longer requires the consent of the patentee, who, even after the expiration of protection, cannot prohibit third parties from using invention". Expiration, therefore, unlike invalidation, will not affect the effectiveness of any action taken with respect to the patent prior to the date on which protection expired.

## Limitation of the effect of invalidating a patent with respect to third parties

To some extent, however, the effect of invalidating a patent is mitigated in relation to third parties. The provision of art. 291 of the IPL stipulates that **in the event of invalidation of a patent, the purchaser, licensee or other person for whom the entitled person has made a monetary disposition, may demand reimbursement of the payment made and compensation for damage on general terms**. It is stipulated that the seller may deduct the benefits that the purchaser obtained by using the invention before the patent was invalidated; if these benefits are higher than the payment made and the claimed compensation, the seller is not liable. It is worth emphasizing that this is a dispositive provision – therefore, the parties may adopt different contractual provisions and regulate this issue differently among themselves.

## The premise of the legal interest and the 2019 amendment

The Act of 16 October 2019 amending the Act - Industrial Property Law and the Act on Court Costs in Civil Matters, which entered into force on 27 February 2020, led to **the removal of the previously applicable requirement to demonstrate a legal interest by the person applying for the invalidation of the patent**. So far, due to the lack of a definition of a legal interest under the IPL, it has been postulated in the literature to use Art. 28 of the Code of Administrative Procedure, according to which a party is anyone whose legal interest or obligation relates to the proceedings or who requests the action of the authority due to their legal interest or obligation. Under the previous legal regime, it was, therefore, necessary to demonstrate the connection between the existence of an allegedly defective patent and the person filing such a motion: a legal interest could be held, for example, by someone against whom the patent holder filed a patent infringement claim; or a competitor of the right-holder who was interested in starting the production of protected products or using the protected technology. **Since the amendment's entry into force, the applicant no longer has to demonstrate their legal interest in invalidating the patent**, and the PPO is released from the obligation to make findings in this regard and can proceed directly to the substantive assessment of the application.

It should be added that the Prosecutor General of the Republic of Poland and the President of the PPO are vested with special competence in this respect — they may apply for the invalidation of a patent or join pending proceedings in a case on the grounds of the public interest. In the commentary on the IPL edited by prof. Sieńczyło-Chlabicz, it is explained that the public interest will find expression in "protection of the state of industrial freedom, unjustifiably limited by a patent, which was granted despite the failure to meet the conditions for obtaining patent protection." The use of this prerogative by the Prosecutor General or the President of the PPO will be justified, for instance, in a situation where a defective patent causes undesirable economic effects, especially in terms of limiting competition.

## Grounds for the invalidation

The IPL lists situations in which invalidation of a patent is possible: as pointed out by prof. Du Vall in "Patent Law" this enumeration reflects the conviction that "although patents are granted in the procedure of full examination, the expectation of an absolute assessment by the Patent Office of the Republic of Poland is unrealistic for practical reasons." Thus, the procedure enables a correction of a decision to grant a patent in case certain circumstances are discovered afterwards that, if known prior, would have precluded such a decision.

In Art. 89, we find grounds for the invalidation relating in particular to cases in which the invention does not meet the conditions of patentability, is excluded from patentability, or a given solution is not an invention at all — these will all be objective grounds (the provision mentions also insufficient disclosure). They are as follows:

- A) The conditions required to obtain a patent have not been met;
- B) The invention has not been disclosed clearly and sufficiently for a person skilled in the art to be able to recreate the invention;
- C) The patent was granted for an invention not covered by the content of the application or the original application;
- D) Patent claims do not define the subject of the protection sought in a clear and concise manner or are not fully supported by the description of the invention.

This catalogue is supplemented by Art. 74, which — constituting *lex specialis* in relation to Art. 89 of the IPL — formulates the subjective grounds: in the event of an invention being filed or a patent for an invention being obtained by an unauthorized person, the entitled person may request discontinuance of the proceedings or invalidation of the patent (the provision subsequently adds that the entitled person may also request that a patent be granted to them or a patent already granted be transferred to them, with the reimbursement of the costs of filing an invention or obtaining a patent). It should be noted that the legal standing under Art. 74 has been narrowed in comparison to Art. 89 and is recognized only with respect to the "entitled person".

**The grounds for the invalidation of a patent may also be procedural.** It should be remembered that the provision of Art. 256(2) of the IPL prohibits the application of the provisions of the Code of Administrative Procedure on the invalidation of a decision, if the circumstances justifying the invalidation may be raised in the invalidation proceedings. If it is not possible to refer to the objective and subjective grounds discussed in this section in the invalidation dispute, it will be permissible to raise the grounds for invalidity referred to in Art. 156 of the Code of Administrative Procedure, such as, e.g., issuing a decision in violation of the rules on jurisdiction, issuing a decision without a legal basis or in gross violation of the law, or addressing a decision to a person who is not a party to the case.

## Invalidation of a patent through an opposition

In the introduction, it was mentioned that a patent may also be invalidated through an opposition. The proper regulation of this issue can be found in Art. 256 of the IPL, which states that **anyone may raise a reasoned opposition to a final decision of the Patent Office to grant a patent** (or a utility model protection right or a right in registration) **within 6 months from the date of publication in "The Patent Office Bulletin" of information about the grant of the right** (pa-

paragraph 1). The provision indicates that **the grounds for the opposition are the circumstances that justify the invalidation of the patent** (or the right of protection for a utility model or the right in registration) — therefore, a reference is made to the grounds presented above.

The opposition is a measure that can be brought by anyone. Until the amendment, it was, therefore, clearly different from the action under Art. 89 in terms of how it defined the circle of persons eligible to bring an action. Now, the elimination of the "legitimate interest" condition from Art. 89 has, to some extent, brought the two procedures closer together.

If an opposition is filed, the PPO shall immediately notify the entitled person and set a deadline for them to issue a response (Art. 247(1)). Next, two scenarios are possible: either the patent-holder considers the opposition justified and then the PPO decides to invalidate the decision to grant the patent and discontinue the proceedings (paragraph 2), or the holder argues that the opposition is unjustified or does not respond to it at all— then we enter the path of contentious proceedings (paragraph 3).

## Jurisdiction of the Patent Office

**The Patent Office of the Republic of Poland is competent to decide on the invalidation of a patent - it issues such decisions in contentious proceedings** (Article 255 points 1 and 9). Proceedings may be conducted only **upon request**, never *ex officio*. If the PPO, on its own initiative, grows suspicious of the validity of a given patent, its President can submit the application pursuant to Art. 89(2) — so only if it is justified by the reasons of the public interest. It should be noted that when issuing a decision, the PPO is bound by the application and the legal basis indicated by the applicant (Art. 255(4)) — the patent may be invalidated by them in whole or in part, depending on the request formulated in the application.

In consequence, this will not be civil courts that will assess the validity of patents. In the commentary to IPL by prof. Sieńczyło-Chlabcz, we can encounter a categorical statement that "in the case of a patent infringement claim, the court cannot resolve this issue on its own". On the other hand, the invalidation proceedings may be preliminary in relation to infringement proceedings — the civil court will therefore be able to stay pending proceedings before it pursuant to Art. 177 § 1 point 3 of the Act of 17 November 1964 - the Code of Civil Procedure (the court may suspend the proceedings *ex officio* if the settlement of the case depends on the prior decision of the public administration body). Administrative courts, on the other hand, will be competent to consider complaints against decisions and orders issued by the PPO (Art. 257 of the IPL).