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Registration of an industrial design – principle of specialty

ABSTRACT

The subject of the article is the principle of specialty which, in the Polish legal system, limits the scope of protection of the industrial design. In fact, the scope of protection of the industrial design in the Polish law is much narrower than the protection under the provisions of the Directive 98/71. In consequence, an increasing number of Polish applications in OHIM results from the principle of specialty and higher charges related to the protection of the industrial design.

Keywords: community design, industrial design, intellectual property, registration of industrial design, scope of protection



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Zakres prawa z rejestracji wzoru przemysłowego – zasada specjalności

STRESZCZENIE

Przedstawiony artykuł odnosi się do zasady specjalności ograniczającej prawo z rejestracji wzoru przemysłowego w prawie polskim. W konsekwencji charakter praw uzyskanych z rejestracji wzoru przemysłowego w Polsce jest ograniczony w porównaniu do prawa z rejestracji wzorów wspólnotowych.

Słowa kluczowe: wzór przemysłowy, własność przemysłowa



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GENERAL COMMENTS

The growing importance of industrial designs has already been brought to attention in the seventies of the twentieth century and it continues to evolve, among others, because of its economic nature¹. Registration of industrial designs is aimed at granting the exclusive right to use the design and obtain compensation for expenses incurred in connection with creating the designs and investments related to the search for new forms². The increased interest in the industrial design does affect the number of registered industrial designs: in 2010 1723 industrial design applications were filed with the Patent Office of the Republic of Poland, of which 1231 owned by domestic entities, and 17 owned by foreign entities were granted the right in registration³. However, stronger interest in the industrial design can also be observed in the statistics of the Office for Harmonization in the Internal Market (OHIM) in the years 2003–2011 in OHIM 158 039 Community design applications were filed, and in 2013 the number of applications reached 23 171⁴.

It also requires an emphasis that since the beginning of operation of the Office for Harmonization in the Internal Market, in the years 2003–2011 Polish entrepreneurs have filed 13 826 Community design applications⁵, which amounted to 2,93% of all applications filed by the European Union Members. By August 8, 2012 the Poles filed 1727 Community design applications,

¹ M. Poźniak-Niedzielska, *Problem ochrony prawnej wzorów zdobniczych*, [in:] *Problemy ochrony prawnej wzorów przemysłowych, Materiały międzynarodowego sympozjum zorganizowanego w Warszawie w dniach 3–4 października 1972 r.* [The problem of legal protection of decorative designs, [in:] *The issues of legal protection of industrial designs. The materials of the international symposium organized in Warsaw on 3–4 October, 1972*], Wrocław–Warszawa–Kraków–Gdańsk 1974, p. 71; E. Ferenc-Szydełko, *Warunki ochrony prawnej wzoru przemysłowego* [The conditions for legal protection of the industrial design.], *Rzecznik Patentowy*, No. 3/2001, p. 78–79.

² M. Poźniak-Niedzielska, *Wzory przemysłowe*, [in:] *Prawo własności przemysłowej*, ed. U. Promińska, [Industrial design, [in:] *The Industrial property law*], Warszawa 2004, p. 168.

³ Statistical data of the Polish Patent Office, http://www.uprp.pl/uprp/_gALLERY/39/98/39987/2010_raport_roczny.pdf.

⁴ Statistical data of OHIM <http://pmd.oami.europa.eu.edgesuite.net/Annual-Report/FINAL/ohim/en/designs.html>.

⁵ Statistical data of OHIM, [http://oami.europa.eu/country_reports/SSC003.1%20-%20Statistical%20travel%20pack%20by%20country%20\(PL\).pdf](http://oami.europa.eu/country_reports/SSC003.1%20-%20Statistical%20travel%20pack%20by%20country%20(PL).pdf).

which shows that 4,62% of the applications in the European Union were filed by Polish nationals⁶. This data show that currently Polish nationals occupy the eighth position among holders of the industrial designs filed with the Office for Harmonization in the Internal Market, among such countries as the United States of America, Japan, France and Denmark⁷.

The above data, apart from a noticeably increasing interest in the industrial design registrations, also show departure of Polish entrepreneurs from registration of industrial designs in the national office, choosing the EU registration. This may be due to development of their businesses, but also the cause of this may be the principle of specialty in the Polish legislation.

2

THE SCOPE OF THE RIGHT IN INDUSTRIAL DESIGN REGISTRATION

The right in registration of the industrial design belongs to a group of rights described as time-limited rights⁸. A characteristic feature of the indicated rights is a specific position of the right holder, whose right is subject to the suspending condition or date of commencement⁹. In accordance with Article 105 Section 6 of the Industrial Property Law Act dated June 30, 2000¹⁰, a right in registration of a design shall be granted for a period of 25 years from the date of filing of an application with the Patent Office, this period being divided into five-year periods. The period of 25 years has significantly extended the minimum protection period indicated in the *Green Paper*, and subsequently in *The Proposal of the European Parliament and of the Council on Community designs* which had a decisive influence on the shape of the Directive 98/71/EC of the European Parliament and of the Council dated

⁶ Statistical data of OHIM, http://oami.europa.eu/ows/rw/resource/documents/OHIM/statistics/ssc007-statistics_of_community_designs_2011.pdf.

⁷ Statistical data of OHIM, http://oami.europa.eu/ows/rw/resource/documents/OHIM/statistics/ssc007-statistics_of_community_designs_2010.pdf.

⁸ M. Staszów, *Prawo wynalazcze [Law on inventions]*, Warszawa 1989, s. 156.

⁹ M. Pyziak-Szafnicka, *Prawo podmiotowe*, [in:] *System prawa prywatnego [Subjective right, [in:] The private law system]*, ed. M. Safjan, Warszawa 2007, p. 748.

¹⁰ Industrial Property Law Act dated June 30, 2000 (consolidated text: Dz. U. 2003 r. No. 119, item 1117, as amended), hereinafter IPL.

October 13, 1998 on the legal protection of designs¹¹, which provided for a fifteen-year term of protection¹². The right in registration arises upon design registration, but with the retrospective effect, i.e. from the date of filing an application, provided that a fee for the first term is paid¹³. The date of filing a design application marks the beginning of a five-year period for which protection is granted. Time-limited nature of the right in registration means that this right cannot be extended for a longer period than 25 years¹⁴.

The twenty-five-year protection period was divided into five-year periods. This solution is also characteristic of other legislations, which provide for division of the right in registration into short periods¹⁵. This allows to examine and determine market interest in a given design and make a decision about extending the protection period by payment of a renewal¹⁶ fee or about its subsequent revocation by non-payment of the fee.

In the literature it is recognized that timely protection of industrial designs is dictated by economic, moral and political reasons¹⁷. The purpose of the industrial property law is, in fact, reconciling the interests of consumers and creators of a design¹⁸. At the same time, the five-year period of protection appears to be a sufficient period in certain industries such as fashion, electronic systems or toy industry¹⁹, which are characterized by significant and rapid variability and often do not require an extension (renewal) for more than five years. In addition, in case of the designs considered functional, there is a fairly strong expectation that they will be soon available on the market²⁰. It is in these areas that changes are made frequently, and

¹¹ Directive No. 98/71/WE of the European Parliament and of the Council dated October 13, 1998.

¹² M. du Vall, Ochrona wzorów przemysłowych w świetle ustawy Prawo własności przemysłowej [Industrial design protection in view of Industrial Property Law Act], *Rzecznik Patentowy*, No. 3/2000, p. 40.

¹³ A. Tischner, Komentarz do art. 105 p.w.p., [in:] *Prawo własności przemysłowej* [Commentary to Article 105 of IPL], ed. P. Kostański, Warszawa 2010, p. 593; M. Poźniak-Niedzielska, *Wzory przemysłowe..., op. cit.*, s. 176.

¹⁴ A. Szewc, *Naruszenie własności przemysłowej* [Intellectual Property Infringement], Warszawa 2003, p. 19.

¹⁵ A. Wojciechowska, *Treść i zakres prawa z rejestracji wzoru przemysłowego (Uwagi do ustawy Prawo własności przemysłowej)* [The content and scope of the right in registration of an industrial design], [in:] *Księga pamiątkowa ku czci Profesora Janusza Szwejca*, ed. E. Nowińska, M. du Vall, Kraków 2004, p. 180.

¹⁶ D. Musker, *Community Design Law Principles and Practice*, London 2002, p. 57.

¹⁷ H. MacQuenn, Ch. Waelde, G. Laurie, *Contemporary Intellectual Property. Law and Policy*, New York 2008, p. 8–10.

¹⁸ C. Colston, K. Middleton, *Modern Intellectual property law*, London 2005, p. 3.

¹⁹ D. Musker, *Community Design..., op. cit.*, p. 57.

²⁰ L. Bentley, B. Sherman, *Intellectual property law*, New York 2009, p. 664.

social expectations concerning freedom of using the design are high. It should be emphasized, however, which is also stressed in the legal doctrine, that in certain exceptional cases when the creator intends to create a strong brand, a 25-year protection period may be too short²¹.

The right in registration of the industrial design is also limited territorially, which is typical of industrial property rights²². On the basis of a decision granting the right in registration, an authorized entity, pursuant to Article 105 Section 2 of Industrial Property Law Act, acquires the right of exclusive use of the design for profit or for professional purposes throughout the territory of the Polish Republic. This means that the right acquired through registration made in Poland is effective only on the Polish territory²³. As a result – from the point of view of the granted protection – only infringement of the right in registration on the territory of the Polish Republic can be considered unlawful²⁴.

3

THE PRINCIPLE OF SPECIALTY

As regards the Industrial Property Law Act, however, one may point to a further limitation that does not apply to the Community design. The scope of the right in registration of the industrial design has been limited by virtue of Article 105 Section 5 of the IPL. According to this provision, the right in registration of this industrial design is limited to products of the type for which application has been filed. This solution is an expression of the principle of specialty and close connection with and limitation of the right in registration to the category of products for which the application for the design was filed. The authorized entity thus exclusively holds a right to a specific catalogue (type) of products and it is not possible to extend the

²¹ A. Cabroni, The overlap between registered Community designs and Community trademarks, *Journal of Intellectual Property Law & Practice*, vol. 1, No. 4/2006, p. 260.

²² M. Staszaków, *Prawo wynalazcze...*, *op. cit.*, p. 155.

²³ A. Szewc, *Naruszenie...*, *op. cit.*, s. 20; E. Szonert, *Wzory zdobnicze i ich ochrona...*, *op. cit.*, s. 169.

²⁴ A. Tischner, *Komentarz do art. 105 p.w.p...*, *op. cit.*, p. 593.

right to a different type of products²⁵. The provisions in force permanently bind the scope of protection of the design with the product type, class of goods or a specific industrial sector. This means that the scope of the right in registration is limited to certain products covered by the application. In case of any doubts, resolving the issue which products are of the same kind, will be the task of the adjudicative body²⁶.

In the legal doctrine it is argued that the use of the term „products of the same kind” is a solution modeled on the regulations concerning decorative designs. Assessment of the extent of the exclusive right should be made only according to the nature of the products or the industry which manufactures those goods. The term „goods of the same kind”, in turn, should be defined as referring to the products of the same nature or coming from the same industry, rather than products belonging to the same class of goods²⁷. However, they adds that the subjective scope of the right in registration is determined jointly by the design figure and its essential characteristics defined in the description of the design²⁸. Also they considers that a drawback of this solution is the possibility of „escaping” from liability for infringement of the right in registration in case of using an identical or a very similar design by choosing a different class of products.

It should be noted that the Directive 98/71 does not indicate the subjective scope of the right in registration. However, according to Article 12 of the Directive, one can infer that the scope of protection has not been limited to the product with respect to which the application has been filed. Withdrawal from the specialty principle follows directly from Article 36 Paragraph 6 of the Council Regulation (EC) No 6/2002 of December 12, 2001 on Community designs²⁹. Under this provision, an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied shall not affect the scope of protection of the design. The Regulation No 6/2002 breaks with the principle of specialty (specialization).

²⁵ E. Nowińska, *Wzory przemysłowe*, [in:] *Prawo własności przemysłowej* [Industrial design, [in:] *Industrial property law*], E. Nowińska, U. Promińska, M. du Vall, Warszawa 2011, p. 110.

²⁶ A. Wojciechowska, *Treść i zakres...*, *op. cit.*, p. 172.

²⁷ *Ibidem*, s. 172; A. Dereń, *Prawo własności przemysłowej*, Bydgoszcz 2001, p. 91–92; M. du Vall, *Ochrona wzorów przemysłowych...*, *op. cit.*, p. 40.

²⁸ A. Kisielewicz, *Prawo własności przemysłowej*, *Przemysł* 2008, p. 73–74.

²⁹ The Council Regulation (EC) No 6/2002 of December 12, 2001 on Community designs, hereinafter regulation No. 6/2002.

Consequently, the scope of protection of the design is not limited to the categories of items indicated in the application for registration. In the EU legislation, indication of the sector in which registration was made only helps the court to determine the industry in which the registration was made, but it does not affect the scope of the right in registration. Protection obtained on the basis of registration of the Community design consists in the protection of a particular external form or shape of the design, no matter for what product form or shape this design was registered. However, the design filed for registration in one class should not be used in another class, as this may result in it being invalidated. Limitation should apply only to items sold together, such as cups sold with other items of tableware³⁰. The protection derived from registration covers the design, rather than its appearance³¹. This position was also reflected in the judgment of the Court of the European Union dated March 18, 2010 in the case of *Grupo Promer Mon Graphic v OHIM – Pepsico*, which states that the class in which registration was made does not affect the scope of protection of the design³².

The literature based on the EU law expresses a critical opinion on the withdrawal from the principle of specialty in determining the scope of protection. This position is favored inter alia by G. Tritton³³, K. Wernick³⁴ and U. Koschtial³⁵. G Tritton claims that similarity of patterns disclosed should be assessed in the scope in which they are registered. The author derives this position from *the Green Paper* justifying that such a comparison has a direct impact on the scope of *prior art*. G. Tritton notes that despite the possibility of design registration in all classes, it is the intention of the applying entity to limit the scope of protection to the classes in which a given design

³⁰ D. Bainbridge, *Intellectual property*, Harlow 2010, p. 544.

³¹ R. Roy, J. Riedel, *The Role of Design and Innovation in Product Competition*, Design Innovation Group 1996, no. 10 p. 6.

³² Judgement in the Polish language <http://curia.europa.eu/>, the same position also indicated by the Board of Appeal in the case *Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.)* against the decision of the Department of the Community Design no No 000 204 763 – 0001, Item 19 of the decision of OHIM dated July 5, 2007, no. R 1421/2006-3

³³ *Intellectual Property in Europe*, G. Tritton (ed.), London 2008, p. 570.

³⁴ K. Wernicka, Nowość i indywidualny charakter wzoru przemysłowego w praktyce Urzędu ds. Harmonizacji Rynku Wewnętrznego, *Europejski Przegląd Sądowy*, No. 8/2008, p. 43.

³⁵ U. Koschtial, Design Law: Individual Character, Visibility and Functionality, *International Review of Intellectual Property and Competition Law*, No. 3/2005, p. 305.

has been registered³⁶. Similar views are expressed by some representatives of the Polish doctrine. M. Wernicka claims that comparison of the designs is made only on the basis of the industrial design from the same assortment from which the later design derives³⁷. Indication of the class affects the extent within which a general comparison is made and inventive freedom in creating a given product – assessed. Therefore U. Koschtial rightly notes that inventive freedom will be significantly limited in those classes in which many Community design are registered. In case of classes in which an insignificant number of products covered by a design is registered, creators are expected to be more inventive³⁸.

The principle of specialty adopted in the Polish legislation, seems unfounded. This is because it deprives the creators of industrial designs of protection against infringement of a design which is the effect of their creative efforts in relation to other classes of goods than products for which application has been made. However, this position is not entirely accepted. M. Pozniak-Niedzielska believes that limitation to the kind of creations indicated in the text of the application is not intended to draw a „demarcation line” between the protection granted on the basis of the industrial design under the provisions of industrial property law and the protection arising from copyright law. In addition, limiting the scope of protection, which in fact, does not afford the holder of the right in registration a possibility of prohibiting infringement of the design by third parties is contrary to the accepted concept of exclusive and absolute rights allowing to achieve a monopolist authorization to prohibit the use of the design by third parties in all industries. Limiting the scope of protection of the right in registration to the class in which the application was filed, also affects the scope of comparing designs in the assessment of their novelty. Application of the principle of specialty adopted in the Polish legislation adopted forces a comparison of the design registered as i.e. door handle design to other handles, not just to the door with handles that were disclosed. It will be possible, however, to use the same design as i.e. a car door handle or a refrigerator handle.

³⁶ G. Tritton, *Intellectual Property...*, *op. cit.*, p. 570.

³⁷ K. Wernicka, *Nowość i indywidualny...*, *op. cit.*, p. 43.

³⁸ U. Koschtial, *Design Law...*, *op. cit.*, p. 305.

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FINAL CONCLUSIONS

These considerations lead to a conclusion that introduction of the principle of specialty in the Polish legislation should be considered illegitimate, and in accordance with the legal doctrine, removal of the provision referred to in Section 5 Art. 105 of IPL should be applied for. Limiting protection to the class of products in which registration was made significantly restricts the rights of creators. For example, an industrial design registered in class 1 of the Locarno classification as a design for cookie can be used as a design for clothing in class 6 of the Locarno classification. Therefore, legitimacy of the EU regulations with this respect should be emphasized. Under the provisions of Directive 98/7, the right in the registration of an industrial design covers all the products on which a registered design has been placed, regardless of whether the registration covered only a specific class. The introduction of the principle of specialty in the Polish legal system should also be considered negative due to the fact that it excessively restricts the right in registration of an industrial design. The scope of protection of industrial designs in the Polish law is in fact much narrower than the protection under provisions of Directive 98/71.

It seems that the increased number of applications filed by Polish entities may point to the legitimacy of departure from the principle of specialty in legislation. Limitation of the registration right, which consequently may affect the ability to use the design by other businesses. The legitimacy of breaking with the principle of specialty is also emphasized in the case-law of the Office for Harmonization in the Internal Market. According to the practice of OHIM, the reason for cancellation of the design for a toy in the shape of Formula 1 is the existence of a Formula 1 car³⁹. However, according to the Industrial Property Law Act, such a solution does not apply, and the designs of an identical formula 1 car and a toy of the same shape shall be considered as new designs and with an individual character.

³⁹ Compare Decision of OHIM dated January 25, 2008, no. R 84/2007-3 in the case *Ferrari S. P.A. vs Dansk Supermarked A/S* http://oami.europa.eu/LegalDocs/BoA/2007/it/R0084_2007-3.pdf, Decision of OHIM dated September, 13, 2006, no. ICD 0000000842, in the case *Dansk Supermarked A/S vs Ferrari S. P.A.*, [http://oami.europa.eu/pdf/design/invaldec/ICD_000000842_decision_\(IT\).pdf](http://oami.europa.eu/pdf/design/invaldec/ICD_000000842_decision_(IT).pdf).

The departure of Polish entrepreneurs from registration of industrial designs in the Patent Office of the Republic of Poland, may also have purely pragmatic reasons. In accordance with the provisions of the Regulation of the Council of Ministers dated August 29, 2001 on charges related to the protection of inventions, utility models, industrial designs, trademarks, geographical indications and topographies of integrated circuits. According this regulation the fee for the fifth – last – period of protections arise to – PLN 4000. When, in accordance with Commission Regulation No 2246/2002 dated 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs, the fee arise to EUR 180.

Therefore, adoption in the Polish legislation of the principle of specialty, which in fact affects the scope of protection of the right in registration of an industrial design, and the introduction of higher charges related to the protection of industrial designs, significantly affect the number of applications filed by domestic entrepreneurs.

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Przesłanki i następstwa podziału zadań samorządu terytorialnego na własne i zlecone

STRESZCZENIE

Celem artykułu jest charakterystyka głównych przesłanek oraz konsekwencji podziału zadań samorządu terytorialnego na zadania własne i zlecone oraz wyeksponowanie pewnych kontrowersji z tym związanych. W szczególności krytycznej analizie poddano przyporządkowanie niektórych rodzajów zadań samorządowych (dotyczących najistotniejszych sfer działalności samorządowej, takich jak: pomoc społeczna, oświata czy ochrona zdrowia) do kategorii „własnych”.

Zasadniczym wnioskiem płynącym z przeprowadzonych rozważań jest to, że w wielu przypadkach o zakwalifikowaniu konkretnych spraw publicznych do jednej bądź drugiej grupy decyduje nie tyle ich specyficzna „natura”, co przede wszystkim związane z tym następstwa fiskalne, w tym przede wszystkim możliwość przerzucenia na samorządy obowiązku ponoszenia kosztów ich realizacji.

Główną metodą badawczą wykorzystaną w artykule jest krytyczna analiza aktów prawnych oraz orzecznictwa, jak również literatury z zakresu finansów samorządowych, prawa finansowego oraz administracyjnego poświęconej badanemu zagadnieniu.

Słowa kluczowe: zadania własne, zadania zlecone, jednostki samorządu terytorialnego

