

# NEWSLETTER

April 2016

## The amendment to the Industrial Property Act in terms of trademarks

We would like to draw your attention that on April 15, 2016 the amendment to the Act of June 30, 2000 Industrial Property Law entered into force, which very significantly affects the system of examination of trademark applications to the Polish Patent Office.

In connection with the new regulation entrepreneurs, who have registered trademarks, in order to protect themselves against the registration of similar or identical signs, should regularly monitor the Bulletin of the Patent Office for a new submissions of possible applications to save a chance to file an opposition to such registration, which can effectively block the registration of the trademark by the competition.

I.

Under the existing rules governing the examination of trademark applications in Poland a system in which the Patent Office *ex officio* examined whether the mark could be considered as colliding with any of the already registered marks, was in force. If the assessment was successful for the applicant - the mark was granted the protection right.

After validation of the decision of the Patent Office on granting the protection right for a trademark everyone could file a reasoned objection to the decision - within 6 months from the date of publication in 'The Patent Office News' information about granting the right. The same opposition did not result in revocation of the decision to grant the protection right. The authorized was informed about opposition filed and had the right to raise an objection to the opposition. If such an objection was raised, the matter was transferred to the settlement of litigation proceedings.

Only upholding the opposition after the litigation or failure to invoke unfounded opposition resulted in the repeal of the decision on granting the protection right.

II.

The new regulation reverses the existing model of proceedings for trademark applications. **From April 15, 2016 the Patent Office do not investigate *ex officio* of the similarity of the mark filed to registration with already registered trademarks.** Each notified trademark - unless they overlap absolute obstacle to the grant of a protection right - will be published in the Bulletin of the Patent Office. **Within 3 months from the date of publication of the trademark application, body entitled to the earlier trademark may oppose the application for a trademark identical**

**or similar to the earlier mark. Only the lack of an objection or failure to take into account the opposition will result in granting the protection right for a trademark.**

What is important - it will be still possible to challenge final decisions of the Patent Office on granting the protection right. In this case, however - as yet - allowing the opposition or lack of opposition to invoke the groundlessness of operation will result in the repeal of the decision on granting the protection right.

The introduced changes to the conduct for the registration of trademarks in the Polish Patent Office approach the model of proceedings before the European Union Intellectual Property Office (EUIPO, until March 23, 2016: OHIM).

**The changes pose to entrepreneurs - who want to protect trademarks against registrations of similar marks by competitors - the requirement to demonstrate the activity, which the first step should be constant monitoring of the Bulletin of the Patent Office regarding information on new trademark applications. Obtaining timely information about filing the colliding mark will allow to save a deadline to file an objection to the application form, which can effectively block the registration of the mark by the competition.**

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