

Question Q228

National Group: Poland
Title: Prior User Rights
Author: Wojciech Trybowski, Sławomir Mazur
Date: May 7, 2014

Questions

I. Analysis of current law and case law

Groups are invited to answer the following questions under their national laws:

- 1. Is there a provision in your national patent law that makes an exception to the exclusive right of a patent holder for parties who have used the invention before the filing/priority date of the patent (“prior user rights”)?**

Yes, such provision exists. Article 71 of the Industrial Property Law of June 30, 2000 (“IPL”) states that:

1. Any person who, on the date according to which the priority for the grant of a patent is determined, has exploited the invention on the territory of the Republic of Poland in good faith, may continue to exploit it in his enterprise free of payment to the extent to which he had previously exploited the invention. This right shall also belong to a person who at the same date had already made substantial preparations for the exploitation of the invention.

2. The rights referred to in paragraph (1) shall, at the request of the person concerned, be recorded in the Patent Register. The rights may be transferred to another party only together with the enterprise.
- 2. How frequently are prior user rights used in your country? Is there empirical data on how often prior user rights are asserted as a defense in negotiations or court proceedings?**

No, no such statistical information or/and official explanations or empirical data on prior user rights have been made public.

- 3. To what degree must someone claiming a prior user right have developed the embodiment which is asserted as having been used prior to the filing/priority date of the patent? Is it sufficient to have conceived of the embodiment, or must it have been reduced to practice or commercialized?**

A prior user claim may be relied on by a person who, before the priority date, has been using the invention or prepared all machines fundamental for use of the invention.

4. Does it make a difference in your country if

- the prior use occurred before the priority date; or
- it occurred after the priority date, but before the filing date?

Yes, it makes a difference. See the regulation of Art.71.1 IPL (answer to q.1). The prior use must occur before/on the priority date.

5. Is there a territorial limitation with regard to the scope of prior user rights in your country? In other words, if a party has used the patented invention before the filing/priority date in a foreign country, can it then claim a prior user right in your country?

The territory of Poland exclusively is significant with regard to the prior user right.

6. Is there a provision that excludes prior user rights for those who have derived their knowledge of the invention from the patent holder and/or the inventor?

No specific provision. However, the idea of prior user is based on the assumption that there are two independent inventors who made independently the same invention, prior user acts in good faith and is not aware of the existence of the filed patent application. For that reason prior user rights are excluded for those who have derived their knowledge of the invention from the patent holder and/or the inventor (for example on the basis of the prior user – inventor/applicant agreement).

7. Is it necessary that the prior user has acted in good faith to be granted a prior user right?

Yes, it is. However in accordance with the general civil law principles there is an assumption of good faith.

8. Is there a material limitation with regard to prior user rights in your country? More specifically, if someone has used an embodiment of a patented invention before the filing/priority date of the patent, can he then claim a prior user right to anything covered by the patent? In particular, is the owner of a prior user right entitled to alter/change the embodiment of the patented invention used before the filing/priority date of the patent to other embodiments that would also fall within the patent's scope of protection or is he strictly limited to the concrete use enacted or prepared before the patent's application or priority date? In the event that changes/alterations are permitted by your national law, to what degree?

The material limitation with regard to prior user rights in this matter is not explicitly stated in Polish law. In our opinion the prior user may, in the course of operation, change the directions for use of the solution. In addition, the prior user may use

the invention not only in the very shape in which it was used at the priority date, but also to use equivalent means in relation to the ones previously implemented or prepared to be implemented in order to use the invention. However, in practice, the prior user rights are disputable and in many cases the civil court has to decide whether the rights should be granted or not. Thus, the registration is possible upon the final decision of the court.

9. Does a prior user right in your country require the continued use (or the necessary preparations of the use) of the invention claimed by the patent at the moment in which the objection of the prior user right is asserted or is it sufficient if the invention claimed by the patent has been used before the priority/filing date of the patent but has been abandoned at a later stage?

The use of prior user rights is a privilege of prior user, which must be tolerated within the period of the validity of a patent. Duration of using the privilege in this period depends on prior user; continued use is not required by law.

10. Is a prior user right transferable and/or licensable in your country? If yes, under what circumstances?

The prior user right may be transferred only together with the enterprise.

11. Does your national law provide any exceptions or special provisions with regard to a prior user right owned by a company within a corporate group? In particular, can a prior user right be transferred or licensed to another group company?

Such exception/ special provision does not exist. See also answer to q.10 above.

12. Are there any exceptions for any specific fields of technology or types of entity with regard to prior user rights in your country?

No.

13. The Groups are invited to explain any further requirements placed on prior user rights by their national law.

Polish law distinguishes two situations to create the prior user right: first, the use of the invention, and second undertaking appropriate preparations for such use. With reference to the first one, it covers undertaking for profit or for professional purposes. Undertaking appropriate preparations stands for such preparations of devices/equipment which mean the use of the invention for profit, or to show serious will to quickly begin using the invention.

II. Policy considerations and proposals for improvements to your current system

14. Should a prior user right exist in any legal system? If yes, what is the main le-

gal justification for a prior user right?

Yes. The prior user clause has the purpose to guarantee fairness in a legal system that rewards the first to file at the expense of other persons that could develop and use the invention independently of the patentee.

15. What is the perceived value of prior user rights in your country?

Prior user right guarantees economic stability and certainty, in particular in economy of small and medium enterprises – which is very characteristic for Poland. Due to character of their business and need of swift adjustment of business for market demand, small and medium enterprises in Poland often employ innovations without filing for patent protection. So if they are made to stop production because an innovation has been filed by another entity, they may suffer from significant economical loss (unbearable for such small/medium enterprise).

16. Are there certain aspects that should be altered or changed with regard to the existing implementation of the prior user right in your country? In particular, are there certain measures or ways that could lead to an improvement and/or strengthening of your current system?

The institution of prior user exists in Poland Since 1919 (while Poland regained its independence in 1918 after its disappearance in the end of 18th century). Current model sufficiently protects rights of prior user. However, legal proceedings to confirm existence of such right – to be held before civil courts – could be shortened to facilitate acquiring such right. This would also made legal situation of potential prior users clearer and firmer without exposing to the risk of patent infringement. It is the opinion of the Polish group that such goal would be best achieved via procedural changes rather than substantive law and so specific proposals are outside the scope of the present question.

Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to prior user rights. More specifically, the Groups are invited to answer the following questions:

17. Is harmonization of “prior user rights” desirable?

Yes. Harmonization, in particular in the field of “critical date” (date upon which prior user’s rights are determined). This would bring identical and equal rules in each country and would support economical exchange between these countries.

18. What should be the standard definition of “use” in relation to prior user rights? Must the use be commercial?

By “use” one shall understand genuine and real use, i.e. such use which in lack of prior user right could be qualified as patent infringement.

19. What should be the definition of “date” (or “critical date”) for prior user rights? (i.e. when must the invention have been used to establish a prior user right?)

The filing date seems to be reasonable. Since in most countries there is no grace period for patent filing, until the date of publication about patent application the applicant keeps the invention as his own secret and third parties may not learn about it. So one may assume that any identical solutions created before the publication date are independent and bona fides creations.

20. Should a prior user right persist in the event that the use and/or preparation for use of the invention has already been abandoned at the time of the patent application/priority date or should the prior user right lapse upon the termination of the use and/or preparation of use?

It is the opinion of the Polish group that the prior user’s right shall persist in the event that the use and/or preparation for use of the invention has already been abandoned at the time of the patent application/priority date. This is because of the idea of respect for acquired rights seems to be applicable (i.e. a right which was once obtained shall be continued).

21. What should be the territorial scope of a prior user right? In particular, if a party has used the patented invention before the decisive date in a foreign country, should it then be entitled to claim a prior user right?

Prior user’s rights should be valid in the territory in which he used the invention and in which territory that invention was registered by a third party. This follows the territoriality principle, which is a corner stone of all IP rights. Foreign use may be an important element of justifying preparations (but not sufficient independently).

22. Should there be a provision that excludes prior user rights for those who have derived their knowledge of the invention from the patent holder and/or the inventor? If yes, should it be necessary that the prior user has acted in good faith to be granted a prior user right?

Yes, such exclusion provision should exist. As mentioned above, the idea of prior user is based on the assumption that there are two independent inventors who made independently the same invention, so deriving the knowledge from the patent holder/inventor is not an act of individual and independent creation.

23. Should there be material limitation with regard to prior use rights? In particular, if someone has used an embodiment of a patented invention before the filing/priority date of the patent, should he then be entitled to claim a prior user right to anything covered by the patent?

No. Prior user’s rights should be limited only to the solutions covered by the patent which in the “critical date” have been used by the prior user. Anything that is out of evidenced prior use but is not covered by the patent claims is result of applicant’s innovative efforts and shall belong only to him (with exception of

equivalent means).

24. Should a prior user right be transferable and/ or licensable?

Polish solution seems to be the most adequate (transfer only with the enterprise). But in more liberal approach right of prior use to transfer/license should be significantly limited (eg. heritage). Otherwise, it could be misused and in result lead to avoiding license agreement with the patent owner (who bears all costs relating to obtaining and maintenance of patent)

25. Should there be any exceptions for any specific fields of technology or types of entity with regard to prior user rights?

It seems that there should be no exceptions.

26. The Groups are also invited to present all other suggestions which may appear in the context of the possible international harmonization of "prior user rights".

If there was an international harmonization of "prior user rights" on agenda, the following question could ponder. If a patent is registered in various jurisdictions and in one jurisdiction an entrepreneur is registered as a prior user, this shall be taken into account also in the other jurisdiction, especially in terms of infringement/legitimate use.