Question Q231

National Group: AIPPI Poland

Title: **The interplay between design and copyright protection for Industrial products**

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Questions

I. Analysis of current law and case law

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

Cumulative Protection

1) Can the same industrial product be protected by both a design right and a copyright? In other words, is the cumulative protection of the same industrial product by copyright and design law allowed in your country?

Yes, industrial products can be protected by both a design right and a copyright. The so called industrial design works are explicitly listed in Article 1. 2 of Law of February 4, 1994, on Copyright and Neighboring Rights (hereinafter referred to as the Polish Copyright Law) as a possible subject of copyright protection. The conditions which have to be met by an industrial product to enjoy the copyright protection are the same as for other copyrighted works.

The protection granted to industrial products on the basis of Polish Copyright Law is independent of the protection granted on the basis of Polish Industrial Property Law of 30 June 2000 (hereinafter referred to as the Polish IP Law) and vice versa.

Article 2(7) RBC

2) In your country, has copyright protection for applied art ever been refused for a work with a foreign country of origin pursuant Article 2 (7) RBC?

No known verdict to that effect, defense raised in settled litigations.

Registration/Examination

3) In order to enjoy design right protection for industrial products, is registration of a design necessary? In order for the design to be registered, is a substantial examination necessary?

The designs have to be registered in order to enjoy design right protection as industrial designs under the Polish IP Law or registered Community designs under Council Regulation (EC) No 6/2002 on Community designs (hereinafter referred to as the Community Designs Regulation). Generally, there is no substantial examination. The only exception is Article 110. 3 of the Polish IP Law, where the design right can be refused by the Polish Patent Office (hereinafter referred to as the PPO) if it is obvious that the design product for which protection is sought is not novel or have no individual character.

The Community Designs Regulation (Article 11) provides for protection of unregistered designs for a period of three years as from the date on which the design was first made available to the public within the European Community. This however seems to have little significance as the applicability in practice of this ground of protection is limited.

Since the protection under Community Designs Regulation is similar to provisions of Polish IP Law which are harmonized by EU Directive 98/71/EC of 13 October 1998 on the legal protection of designs, we focus, in the further part on this report, on provisions of Polish IP Law.

Requirements

4) What are the requirements to obtain industrial design protection or copyright protection, respectively, for industrial products in each country? What are the differences between these requirements?

Pursuant to Article 102 of the Polish IP Law, any new and having individual character appearance of the whole or a part of a product resulting from the features of, in particular, the lines, colors, shape, texture or materials of the product and its ornamentation shall constitute an industrial design.

Novelty and individual character of the design are necessary for an industrial design to be registered. An industrial design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available before the date according to which priority is determined.

In assessing individual character the degree of freedom of the designer in developing the design have to be taken into consideration.

An industrial design shall be considered new if before the date according to which priority to obtain a right in registration is determined, no identical design has been made available to the public, i.e. used, exhibited or otherwise disclosed.

A design shall be deemed to be identical with a prior design made available to the public also if it differs from the prior design only in immaterial details. The Polish IP Law provides also for a 12-months “grace period” preceding the date according to

which priority to obtain a right in registration is determined, which does not destroy novelty of the design.

On the basis of the Polish Copyright Law, any expression of creative activity having an individual character and manifested in any form, regardless the value, intended purpose or manner of expression can enjoy copyright protection. The Polish Copyright Law can protect only the effect of the creative expression, i.e. the form of expression, and does not protect ideas, concepts or themes alone.

Although both definition include the requirement of individual character as a statutory conditions of protection the assessment of each of them is different. Individual character under the Polish IP Law is assessed from the point of view of the informed user whereas the individual character of a copyrighted work is meant as a subjective originality of a work. Also novelty is a statutory condition for an industrial product to be registered as a design, thus public disclosure of the work can deprive the designer of the ability to register the design , whereas prior disclosure of the copyrighted work by the author has no influence on the copyright protection.

5) Are the requirements for copyright protection for industrial products different from the requirements for copyright protection for other ordinary artistic products (fine arts)?

There is no express legal provision in Polish law discriminating between copyright protection for industrial projects and for other artistic products. It is underlined that the standard criteria of creative activity and originality (subjective novelty, creation not determined by the aim and function of the work) should be assessed very carefully in case of works of industrial design.

Scope of Protection and Assessment of Infringement

6) Is the scope of the copyright protection for industrial products different than that for other ordinary artistic products (fine arts)? If so, in what ways?

Generally the scope of the copyright protection for industrial products is the same as for ordinary artistic products. However, in practice the utile nature of industrial products, the necessity for such products to be useful and functional put some limitation in determining the scope of copyright protection for industrial products in comparison to fine arts for example where the scope of freedom of the artist is unlimited.

7) Are the criteria for assessing infringement of copyright protected industrial products different from the criteria for assessing infringement of a design right?

Yes, there are some difference between the scope of protection of the copyright and design right and therefore in the assessment of infringement acts.

To prove infringement of **copyright** it has to be shown that (1) the earlier work on which plaintiff bases claims enjoys copyright protection (manifestation of the creative activity of individual nature), and (2) that the earlier work as a whole or in part (which is copyright protected) has been taken over unmodified or modified into the later work used by the defendant.

To prove infringement of **right to industrial design**, **the overall impression** on informed user of the protected design and the design used by the defendant must be

proven **not to be different.** The right is limited to products with regard to which the application was made.

8) Is it a relevant defense under copyright or design law that the industrial product was created independently of the older work or design?

Parallel creation is a defense under Polish Copyright law. Theoretically it is burden of proof of the plaintiff to show not only (1) that the creative and original elements of the earlier work are contained in the later work but also that (2) this is actually due to the earlier work being known and taken over as a whole or in part (which is copyright protected) by creators oft he later work. Practically showing common features constitutes a prima facie proof and the defendant has to establish parallel creation.

On the contrary, parallel creation is not a defense under industrial design law.

Duration of Protection

9) How long is the duration of industrial design protection or copyright protection for industrial products, respectively?

The duration of right in registration for an industrial design is 25 years counted from the date of filing an application for registration of the design, said term is divided into 5-year periods.

As a general rule, the economic copyrights of the author under the Copyright Law shall expire after the lapse of seventy years from the death of the author. The latter shall apply for the copyrighted industrial products which are not registered designs (please see comments to point 10).

10) What happens upon expiration of the IP right having the shorter term? In other words, after the term for industrial design protection expires, does the copyright protection continue?

The duration of the copyright protection for industrial products that are simultaneously protected as registered design is limited by the Polish IP Law and may last no longer than the duration of the right in registration of the industrial design (setting the protection of such products to maximum 25 years). Pursuant to Article 116 of the Polish IP Law products manufactured by means of an industrial design and put on the market after the lapse of the right in registration granted for such a design shall not benefit from the copyright protection (economic rights of the author). The motives for newest draft amendment to Polish IP law signalize that Article 116 is likely to be deleted.

Measures for adjustment

11) In your country, is there any measure for adjustment so that the same industrial product may not be protected, by both a design right and a copyright or, by a copyright after the design right expires?

Article 116 of the Polish IP Law - see comments to point 10.

II. Proposal for Harmonisation

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the protection of the appearance, shape, or ornamentation of industrial products. More specifically, the Groups are invited to answer the following questions:
What should be the requirements for obtaining copyright protection for industrial products?

The Polish group is of the opinion that the requirements for obtaining copyright protection for industrial products shall be the same as for other copyrightable works.

12) For industrial products, should there be any cumulative protection by industrial design rights and copyright?

There should be possibility of cumulative protection by industrial design rights and copyright for those designs which are eligible for protection under both systems.

13) If so, should there be any measures to resolve this overlap? What measures should be taken? For example, once a certain artistic work has enjoyed industrial design protection, should copyright protection be denied for the same work?

Both systems allow for protection of works of industrial design, though from different angles. As indicated in point 10, current Article 116 of Polish IP Law provides that copyright protection to work of industrial design does not apply with regard to products manufactured according to a industrial design and introduced into trade after expiry of the right to industrial design. However, the currently prepared amendment to Industrial Property Law is expected to delete Art 116.

14) National Groups are invited to comment on any additional issue concerning the relationship between design and copyright protection for industrial products that they deem relevant.

The Polish group believes that any provisions of copyright laws discriminating against protection of the works of industrial design including as provided in Articles 2 (7) and 7(4) of RBC, should be abolished as they cause uncertainties in international relationships as to the degree of protection in country of origin and resulting unnecessary formal problems (eg examination by infringement court of relevant international laws). Deletion of Articles 2 (7) and 7(4) of RBC should also be considered.

Summary

Polish law provides for possibility to protect the same industrial product by both industrial design right and a copyright. There is a number of differences in details between both models. Copyright protection requires no formal **registration** (with side effect that proving title to copyright may be complicated). Industrial design protection requires registration which is however not preceded by substantial analyse of criteria for protection and therefore involves a risk of retaliatory invalidation.
Criteria for copyright protection are creative character and subjective originality (subjective novelty, creation not determined by the aim and function of the work) with relatively low threshold required for protection
Term of copyright protection is generally 70 years from the author's death while industrial designs are protected 25 years from filing date. However, Article 116 of Polish Industrial Property Law which stipulates that after the lapse of protection term of industrial design, copyright can not be claimed in designs that were registered. This provision is controversial and likely to be repealed

Polish group believes that both models for protection should be available for industrial products without discrimination against works due to their industrial character. The current provisions such as Articles 2 (7) and 7(4) of RBC and internal laws of provide grounds for such discrimination which makes it more difficult to protect internationally works of applied art.

Zusammenfassung

Das polnische Recht sieht die Möglichkeit den gleichen industriellen Produkt sowohl als Geschmackmuster und durch Urheberrecht zu schützen. Es gibt eine Reihe von Unterschiede zwischen beiden Modellen. Copyright-Schutz erfordert keine formale Anmeldung (mit Nebeneffekt, dass Titel des Urheberrechts kompliziert zu beweisen werden kann). Industriedesign Schutz erfordert eine Registrierung wo jedoch wesentliche Kriterien für den Schutz nicht analysiert werden und beinhaltet daher eine Gefahr von Vergeltungsmaßnahmen zu Ungültigkeitserklärung.
Kriterien für den urheberrechtlichen Schutz sind schöpferisch und subjektiver Charakter Originalität (subjektive Neuheit, die Schöpfung nicht durch das Ziel und Funktion der Tätigkeit bestimmt wird) mit einem relativ niedrigen Niveau für den Schutz erforderlich. Schutzdauer des Urheberrechts ist in der Regel 70 Jahre nach dem Tod des Autors, während die gewerblichen Muster 25 Jahre ab Anmeldetag geschützt sind. Allerdings Artikel 116 der polnischen Gewerblicher Rechtsschutz, dass nach Ablauf der Schutzfrist des industriellen Designs, Urheberrecht nicht in Designs, die registriert wurden geltend gemacht werden sieht. Diese Bestimmung ist umstritten und die aufgehoben werden müssten. Die Polnische Gruppe glaubt, dass beide Modelle für den Schutz der Industrieerzeugnisse verfugbar werden sollten ohne Diskriminierung aufgrund industriellen Charakter der Werke. Die derzeitigen Bestimmungen wie die Artikel 2 (7) und 7 (4) von RBC und internen Gesetze liefern Gründe für eine solche Diskriminierung, die es schwieriger macht Werke der angewandten Kunst international zu schützen.

Résumé

La loi polonaise prévoit la possibilité de protéger le même produit industriel à la fois par le droit des dessins et modèles et droit d'auteur. Il ya un certain nombre de différences dans les détails entre les deux systemes. La protection du droit d'auteur ne nécessite aucun enregistrement formelle (avec des effets secondaires que le titre prouvant le droit d'auteur peut être compliqué). La protection des dessins et modèles nécessite l'enregistrement qui n'est cependant pas précédé par d'importantes analyse des critères de protection et implique donc un risque d'invalidation comme rétorsion.
Les critères pour la protection du droit d'auteur sont un caractère créatif et l'originalité subjective (la nouveauté subjective, la création n'est pas déterminée par le but et la fonction du travail) avec un seuil relativement faible requis pour la protection.
La durée de la protection des droits d'auteur est généralement de 70 ans a partir de la mort de l'auteur tandis que les dessins et modèles sont protégés 25 ans à compter de la date de dépôt. Toutefois, l'article 116 du droit de la propriété industrielle polonaise stipule que, après l'expiration de protection des dessins et modèless, les droits d'auteur ne peuvent être invoques. Cette disposition est discutable et susceptibles d'être changé.
Le groupe polonais estime que les deux systemes de protection devrait être disponible pour les produits industriels sans discrimination contre des ouvrages en raison de leur caractère industriel. Les dispositions actuelles telles que les articles 2 (7) et 7 (4) de RBC et les lois internes fournient des motifs de discrimination qui rendent plus difficile la protection des œuvres d'arts appliqués au niveau international.