

## Intellectual Property Law



### Karolina Marciszyn

Trademark & Patent Attorney

k.marciszyn@kochanski.pl

+48 883 323 468

### Do opposition proceedings in a European patent case have an impact on the Polish equivalent of this patent?

The Regional Administrative Court (WSA) rendered a judgment regarding the significant relationship of European patents granted by the European Patent Office and their Polish equivalents.

The said judgment was rendered in the following state of facts. One of the parties to the proceedings (a Polish company) filed with the Patent Office (PPO) for cancellation in whole on Polish territory of the European patent titled “The window and a set of isolation frame” granted by the decision of the European Patent Office (EPO) to the benefit of the Danish company. Thereafter, the Danish company, the patentee, filed for suspension of the proceedings on cancellation of

the aforementioned patent on Polish territory on the grounds that the Polish company filed with the EPO an opposition against the decision on granting of the said patent and the result of those proceedings had a direct impact on the cancellation proceedings.

One of the mandatory conditions for suspension of cancellation proceedings in the PPO is the presence of the prejudicial question. Therefore, it should be determined whether opposition proceedings conducted in the EPO is of the said prejudicial character with respect to the cancellation proceedings of the equivalent of this patent in the PPO. The authority (PPO) following the guidelines contained in current jurisprudence held that in this case there are no grounds to deem the proceedings in the EPO as a prejudication with respect to the one conducted in the PPO and refused to suspend the proceedings. The authority noted *inter alia* that the preliminary question is understood as consisting of several essential elements, *inter alia* it requires a “prior” settlement i.e. it must precede examination of the case and delivering a decision as well as requiring the existence of a relationship between the prior settlement of the preliminary question and the examination of the case and delivering a decision.

In the opinion of the PPO, the result of the proceedings before the EPO is not a condition for substantive settlement in a case pending before the PPO, and that without the completion of proceedings before the EPO, settlement of the case before the PPO is not possible. The authority

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held that the proceedings conducted by the EPO may constitute one element of the facts of this case, however it is not a legal issue, the examination of which determines settlement of the case by the PPO.

The Danish company does not agree with the PPO and has appealed to the WSA. It explained the specificity of the European patent underlining that the result of opposition proceedings or cancellation proceedings of the European patent which examines the patentability of previously patented solution, causes *ex tunc* the cancellation or limitation of the scope of the rights of the patent on Polish territory. The proceedings are of a centralized character, and their result influences the existence and scope of the patent in all Member States- Parties to the European Patent Convention, in which the patentee was granted protection, because as a consequence of the proceedings before the EPO, the European patent may be cancelled or its scope may be limited with an effect in the territory of all Member States - Parties to the Convention. The opposition proceedings before the EPO will resolve whether the patent is valid "in general", and consequently, whether it is valid in each of these countries separately.

The Danish company has underlined that in the case of cancellation of the right, the issue of existence and scope of this right is a fundamental legal issue, determining the possibility and scope of examination of the case by the PPO.

The WSA, however, disagreed with the position of the Danish company and agreed with the PPO pointing out that the pending proceedings before the EPO, which may lead to cancellation of the disputed patent, or changing its scope, does not constitute a preliminary question in the proceedings before the PPO for cancellation of this patent in the part relating to Polish territory, therefore the question of the effects of a future decision of the EPO does not constitute a prejudication.

In the opinion of the WSA, the PPO has statutory powers to settle the cases regarding cancellation of European patents in the part relating to Polish territory, and there are no grounds to wait until the proceedings are completed before the EPO. The position of the authority is correct also in that the fact of instituting opposition proceedings before the European Patent Office does not affect the existence or content of the disputed patent. Thus, there is no need to determine the scope of the disputed patent in separate proceedings, since it is known, unchanged and may be subject to independent proceedings before the Polish Patent Office. The decision of the WSA, although not yet final, may be particularly interesting from the standpoint of entrepreneurs, usually large foreign

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companies, which pursue proceedings on patents from the same group in different countries. In such a state of fact, it is easy to imagine a situation where the decision of the PPO as to the cancellation of a patent is different than the decision of the EPO relating de facto to the same patent. It seems, therefore, that it is worth following whether this test case is approved by the Supreme Administrative Court.

**Kochański Zięba Rąpała & Partners Sp.J.**

**Plac Piłsudskiego 1, 00-078 Warsaw**

**phone +48 22 326 9600**

**fax +48 22 326 9601**

**[www.kochanski.pl](http://www.kochanski.pl)**