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**Council for Trade-Related Aspects of
Intellectual Property Rights**

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REVIEW OF THE PROVISION OF ARTICLE 27.3(b)

Information from Members

Addendum

POLAND¹

The present document represents the information requested by the Council for Trade-Related Aspects of Intellectual Property Rights which the Secretariat has received from Poland, by means of a communication from its Permanent Mission, dated 16 February 1999.

The protection of plant and animal inventions is regulated in Poland with the provisions of two legal acts: the provisions of the Law of 19 October 1972 on Inventive Activity (as amended in 1993) and those of the Seed Industry Law of 24 November 1995 whereby a *sui generis* protection of plant varieties was established.

Replies to the questions of Part A relating to patent protection are based both on the still effective provisions of the Law on Inventive Activity as well as on the draft provisions of the new Industrial Property Law, the legislative works on which are nearing completion in the Parliament and the Law is anticipated to be adopted by the end of the first half of 1999. As regards patent protection for biotechnological inventions, the new Law does not provide for substantial changes in the respective regulations contained in the law still in force.

A. PATENT PROTECTION OF PLANT AND ANIMAL INVENTIONS

1. *To what extent are inventions concerning plants or animals, whether products or processes, patentable under your country's law, if they meet the conditions for patentability stipulated in Article 27.1 of the TRIPS Agreement?*

According to Article 12(1) of the present Law on Inventive Activity of 1972 (consolidated act of 1993), patents are not granted for new plant varieties and animal breeds as well as for biological processes for the cultivation of plants or breeding of animals. Although no explicit patentability of micro-organisms is provided for, in practice patents are granted also for microbiological inventions.

Under the new Industrial Property Law, which is likely to be adopted in the first half of 1999, patents will not be granted for plant varieties or animal breeds as well as essentially biological

¹ An illustrative list of questions prepared by the Secretariat in response to a request from the Council is available in document IP/C/W/122.

processes for the cultivation of plants or breeding of animals. It will also be explicitly stipulated that patents will be granted for microbiological processes and the products thereof.

2. *Where any such inventions are not patentable, even if they meet these conditions:*

- (i) *To what extent is this due to per se exclusions from patentability?*
- (ii) *To what extent is this based on other grounds (for example because conditions for patentability other than those stipulated in Article 27.1 are not met or in order to protect ordre public or morality (see Article 27.2 of the Agreement))?*

Both under the provisions of the present law and of this to be soon adopted, non-patentability of such inventions is due to the mentioning them in the group of non-patentable inventions, together with, for example, inventions whose exploitation is contrary to public order or morality. Although the both types of inventions are mentioned separately, however it may be assumed that if a patentable invention concerns, for example, a microbiological process whose exploitation would be contrary to public order or morality, in that case a patent for such invention would be refused.

3. *Please describe any specific provisions, guidelines, final judicial decisions and administrative rulings of general application concerning the application of the conditions for patentability stipulated in Article 27.1 to subject-matter addressed by Article 27.3(b).*

To subject-matter addressed by Article 27.3(b) the following are applicable:

- (1) Article 12 of the effective Law on Inventive Activity, which stipulates that patents shall not be granted for:
 - (i) new plant varieties and animal breeds as well as biological processes for the cultivation of plants or breeding of animals;
 - (...)
 - (vi) scientific theories and discoveries.
- (2) §35.1(i) of the Ordinance of the President of the Polish Patent Office of 23 March 1993, according to which

"Patent Office shall refuse to grant a patent(...) where it has found that

 - (i) the invention applied for protection is excluded from patentability (Article 12 of the Law)".
- (3) §3.2(v) of the above Ordinance, where an invention concerns a micro-organism and the applicant refers to the micro-organism deposited in a recognised international collection of micro-organisms. In that case the applicant is required to submit, for the purpose of the disclosure of the invention, a certificate confirming that the micro-organism concerned has been deposited in that collection.
- (4) Each invention, including biological inventions, must meet the criteria of patentability stipulated in Article 10 of the Law of Inventive Activity (novelty, non-obviousness, applicability).

- (5) Under the present legal order there are no court decisions in the matters in question, since at present no judicial review of Patent Office's administrative decisions exist. The system of judicial review is supposed to be established under the new Industrial Property Law.

4. *Where plant varieties are not as such patentable subject-matter under your country's law, please indicate the extent to which the scope of protection under patents for inventions concerning plants can nevertheless embrace plant varieties or a botanical taxon whose plants express a trait covered by the claims of a patent.*

Patentable are micro-biological processes for obtaining new plant varieties, provided that they are new, non-obvious and capable of practical application, as well as processes for obtaining genes and for transplantation thereof.

5. *Please provide any definitions used under your country's law with regard to subject-matter specifically excluded from patentability or specifically patentable (e.g. micro-organisms, microbiological processes, non-biological processes, plant varieties).*

In the national law and practice the following definitions are applied:

Micro-organisms – means both cellular organisms, such as: germs, low funguses, in vitro animal and plant cells, hybrids, and non-cellular organisms capable of self-replication in a living organism, such as: plasmids, viruses, phages.

Micro-biological processes – means any process involving micro-biological material.

Non-biological processes – means any process for the production of plants not involving mere selection and hybridising; any micro-biological process, any process applied in the techniques of field-crop production, zootechniques, forestry.

Plant variety – see the reply to question B.4(b).

6. *To what extent is subject-matter that is identical to what occurs in nature patentable under your country's law?*

This issue is not regulated in our law in an explicit manner, however the definition and interpretation of the notion "invention" exclude the possibility of patenting what occurs in nature. Instead, patentable may be a process for obtaining a substance which occurs in nature, and thereby a substance obtained directly by that process.

7. *Explain the requirements under your country's law for ensuring adequate disclosure of the patentable inventions referred to above.*

There are no special requirements in this respect regarding this type of inventions. As in case of other inventions, a patent application should include a description of the invention disclosing its nature in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. If the presentation of a micro-organism, which is not available to the public or can not be described in a complete manner, is required for carrying out the invention, the said presentation to this extent can be made by reference to the deposit of the micro-organism made in a collection of micro-organisms. For the purpose of recognising the deposit as meeting the conditions of invention's disclosure, a depositary institution is obliged to make the deposit accessible for any third parties throughout patent granting procedure and at least throughout the entire duration of the patent.

8. *What rights are conferred upon owners of the patents referred to above? Are product and process patents subject to the same rules as other patents? Do they benefit from the same protection as stipulated in Article 28 of the TRIPS Agreement?*

Owners of such patents enjoy the same rights as owners of other patents, i.e. the exclusive right to exploit the invention, for profit or for professional purposes, throughout the territory of the State. Under the new Industrial Property Law, a patentee will enjoy the right to prevent any third party not having his consent from exploiting his invention for profit or for professional purposes by way of:

- (i) making, using, offering for sale, selling or importing the product being the subject-matter of the patent for these purposes, or
- (ii) using a process which is the subject-matter of the patent, as well as using, offering for sale, selling or importing for these purposes the product obtained directly by a process which is the subject-matter of the patent.

Patent owners have and will continue to have, under the new law, the right to grant a license, by concluding a license contract, for exploiting his invention, to assign the patent or transfer it by succession.

Product and process patents are and will continue to be subject of the same rules as other patents and they benefit from the same protection as stipulated in Article 28 of the TRIPS Agreement.

9. *Are there any specific exceptions to these rights (affecting the scope or duration of the patents referred to above)? To what extent are exceptions, available in respect of plant variety rights (e.g. those referred to under question B.4(i) below), available in respect of rights conferred upon patent owners?*

From among the exceptions available in respect of plant variety rights, referred to under question B.4(i) below, there is an exception under the present law, which concerns the use of an invention for scientific purposes.

Under the new law an exception will be provided for concerning the use of an invention for scientific and experimental purposes, for its evaluation, analysis or teaching. In both laws compulsory licensing is also present, conforming the requirements of the TRIPS Agreement.

Another additional exception under the present law relates to the exploitation of an invention, against compensation, for national purposes, to the necessary extent and without detriment to the justified economic interests of the patentee, where it has been found indispensable to prevent or eliminate a state of emergency relating to security or public order. In the new law this provision will be modified by replacing the phrase: "...without detriment to the justified economic interests of the patentee ..." with the words "without the right of exclusivity".

10. *Are there any specific provisions under your country's law for compulsory licensing in respect of the patents referred to above?*

There are no specific provisions neither under the present law nor under the new law to be adopted soon, for compulsory licensing in respect of such patents. General provisions on compulsory licensing are and will remain applicable.

B. PROTECTION OF PLANT VARIETIES

1. *Does your country's law provide for the protection of plant varieties by plant breeder's rights, plant patents or any other sui generis system for the protection of plant varieties?*

In Poland there is the Plant Breeder's Rights (PBRs) system for plant variety protection.

2. (a) *If your country is a party to the International Convention for the Protection of New Varieties of Plants (UPOV), please indicate which Act or Acts of the UPOV Convention your country has signed; which it has ratified; to which it has acceded; and to the standards of which its law conforms but to which it has not (yet) adhered.*

Poland became a party to the UPOV Convention on 11 November 1989. We ratified the 1978 Act of the Convention. At present, the Polish Seed Industry Law based on the 1991 Act is in force. The process of ratification of the 1991 Act is in progress.

3. *Please indicate whether concurrent protection under your country's plant variety protection law and its patent law is available (see also question A.4 above).*

In Poland only the PBRs system exists.

4. *Please provide the following details of your country's sui generis system for the protection of plant varieties:*

(a) *the relevant laws and regulations and, if they have been notified to the Council for TRIPS, a reference to the relevant WTO documents;*

No laws or regulations on the PBR have been notified to the Council for TRIPS.

(b) *the definition of "plant variety";*

Plant variety means a population of plants within a botanical systematic unit of the lowest level known:

- (i) which is identifiable by its apparent characteristics resulting from a specific genotype or combinations of genotypes,
- (ii) which is distinguishable from any other plant population by at least one apparent characteristic,
- (iii) which does not change after propagation or at the end of its characteristics propagation or crossing cycle.

(c) *the conditions required for protection;*

- (i) novelty – according to Article 6 of the UPOV Convention (Act 1991)
- (ii) distinctness
- (iii) uniformity
- (iv) stability

(v) proper denomination

(d) *the extent to which subject-matter that is already known to the public or identical to what occurs in nature is protectable under your country's sui generis system for the protection of plant varieties;*

The duration of a variety's being known to the public is not taken into account. However, it must satisfy the novelty criterion. All varieties, including a variety which was not created by discovered must satisfy the criterion of distinctness according to Article 7 of the UPOV Convention (Act 1991).

(e) *the extent to which protection can be based on characteristics of germplasm, as opposed to characteristics of plant varieties derived from such germplasm;*

Basically, for the purpose of examination as to distinctness, uniformity and stability, botanical characteristics are used. In case of the botanical characteristics not being sufficient enough to ascertain that a variety meets the distinctness criterion – methods with the use of genotype characteristics are employed. The latter are taken as complementary characteristics.

(f) *who is entitled to the rights;*

The breeder of a variety. The definition of the breeder remains in accordance with Article 1 (IV) of the UPOV Convention (Act 1991).

(g) *the procedure for the acquisition of rights, including the authority in charge of administering the rights;*

Authority responsible for PBRs in Poland is the Research Centre for Cultivar Testing (COBORU).

Applications are submitted to COBORU. If application documentation meets the requirements of mandatory regulations and a variety satisfies the novelty criterion – provisional PBRs protection is granted. The provisional protection shall cease of the date of a decision to grant or refuse the (regular) PBRs protection. Afterwards, distinctness, uniformity and stability (DUS) testing is carried out. After the completion of DUS testing, a decision is taken by the director of COBORU on grant or refusal of PBRs protection.

(h) *the rights conferred;*

Maintenance of the breeding of a protected variety and with respect of its seed material:

- (1) production and multiplication as well as preparation for multiplication,
- (2) offering for sale, selling and any other form of disposal,
- (3) exportation and importation,
- (4) storage for the purposes mentioned in items 1-3.

(i) *exceptions to the rights conferred, such as:*

- *acts performed for research or experimental purposes;*
- *acts performed to develop new varieties of plants;*
- *acts performed to commercialize such newly developed varieties;*
- *any "farmer's privilege" (e.g. acts performed by a farmer on his own land in respect of seed saved from the previous harvest);*
- *acts done privately and for non-commercial purposes;*
- *compulsory licensing.*

(1) Plant Breeder's Rights are not applied to seed material or harvest material destined for:

- experimental and research purposes,
- the grower's private non-profit purposes,
- the creation of new varieties which are not varieties essentially derived from a protected variety.

(2) A land owner may, without the breeder's consent, use harvested material of a protected variety as a seed material on his own land ("farmer's privilege").

(3) Compulsory licensing – by a decision of the Minister for Agriculture and Food Economy.

(j) *the duration of protection;*

Plant Breeder's Rights protection starts from the date of grant and its term is:

- 30 years with respect to grape-wine varieties as well as trees and their rootstocks,
- 25 years with respect of other varieties.

(k) *transfer of rights;*

PBRs may be assigned or be subject to succession. The transfer contract must be in writing.

(l) *enforcement of the rights.*

Plant Breeder's Rights are enforceable under civil law provisions. There are also penal provisions in the Seed Industry Law, which stipulate that anyone:

- using the name of a protected variety for a seed material or a material derived from the harvest of another variety, or
- commercialising a seed material without a proper authorisation, or
- placing on the market a seed material which does not meet the requirements of the Law, or

- impeding or frustrating operation of the Seed Inspection's agencies is liable to arrest, limitation of freedom or a fine.

Anyone who:

- refrains from using the name of a variety in the circumstances as indicated in the Law,
- ignores the orders binding on a restricted area,
- produces a fruit-tree's or berry shrub's nursery material without authorisation,
- refrains from giving information concerning seed materials,
- uses information obtained in the course of inspection of preservation breeding with the purposes other than those provided for by the Law,

is liable to a fine. The acts as mentioned above are prosecuted under the provisions on procedures applied in the case of petty offences.
