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Legal status of spare part in intellectual property law

S U M M A R Y

(Sytuacja prawna części zamiennej w prawie własności intelektualnej)

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Component parts of complex products are separately available on the market and act as spare parts in relation to other components that have been worn or damaged. In the modern world, the existence of spare parts for objects and devices composed of many elements is natural. Their presence on the market results from the demand related to the faultiness of items made of many parts and the natural vulnerability of things to damage. Replacing one damaged or worn out device component is usually more favorable than buying a new product. Spare parts are therefore an independent object of trade that serves to restore the usefulness or original appearance of a complex item.

The phenomenon and market presence of products, which can be described as spare parts, is a source of particular problems at the level of legal regimes that protect intellectual property. In particular, two reasons which are the source of the aforementioned problems can be taken into consideration: firstly, the existence of a special need, which is served by spare parts. It is the willingness to repair a product in which one item has been broken or worn out. Secondly, the specificity of the so-called secondary market with spare parts ought to be considered. In connection with the above, there is a justified need to look more broadly at the issue of spare parts in the context of many intellectual property rights. It is related to the fact that the problem of access to the market of spare parts and the legitimacy of protection of intellectual property rights that may be contained therein occurs irrespectively of the type of protection under which the subject of the study will be considered. This makes it necessary to assess their consistency. The research that has been carried out in connection with this issue is aimed at determining how the possibility of taking up activities in the business, which are the subject of spare parts, is shaped in the light of the field of intellectual property law.

The dissertation is divided into six chapters. Prior to Chapter I, a question is asked about what a spare part is and what it looks like from the perspective of the property law. The analysis carried out for the purpose of the dissertation shows that this category cannot be treated as a synonym of classic construction of property law, such as the component part of item (Article 47 §2 of the Polish Civil Code). Spare parts can be a physical substrate for intellectual property. The distinguishing feature of spare parts from other items of trade, i.e. their intended purpose, is not an obstacle in this respect. From the above rule, one can point to the exception existing within the industrial design law regime. The legislative technique adopted by the Polish legislator causes that the form of component parts of complex products - that are not visible during the normal use of things - will not be considered as an industrial design. As a result, the form of invisible products that can be used as spare parts does not fall within the definition of an industrial design that can be protected. It should also be assumed that intangible goods may have a complex structure, due to the possibility of extracting

individual elements from it within the framework of thought operations. The presented assumption is the starting point for the assessment of the acceptability of activities whose subject matter are spare parts, which are the carrier of constituent elements of intangible goods.

Chapter II is devoted to the analysis of possible consequences that may result from the fact that a spare part can be, in principle, a carrier of various intellectual property goods or their elements. The problem related to the protection of intellectual property goods, the carrier of which are spare parts, is being developed. It is worth to point out the attempt to use the abuse of the dominant position as a measure to ensure the balance of interests of right-holders and producers who want to gain access to the post-sales market. However, case law of the ECJ shows that this is not the right way to solve the problem of protection of intangible goods on the secondary market. These observations have influenced the European legislator, which introduced restrictions aimed at narrowing the limits of exclusive rights to intangible goods.

Chapters III, IV, V and VI contain the broad analysis of the current legal order in terms of the protection of intangible goods or their fragments in a situation where they are carried by spare parts. An assessment of the acceptability of behaviour such as repair by means of spare parts, their manufacture and placing on the market is carried out. Chapter III deals with patent law and the scope of exclusivity resulting from a patent, in the context of behaviours that have spare parts for their subject, which are carriers of inventions or parts of inventions. A special place is also occupied by considerations related to the admissibility of repairs. In Polish patent law, there are no regulations that would modify the protection of inventions due to the problem of spare parts and the secondary market. The holder of a patent for the invention, the carrier of which will be a spare part, will be subjected to full protection. However, this situation should not be considered a legislative asymmetry and should be treated as an oversight. It should rather be assumed that the legislator came to the conclusion that the reasons justifying the restrictions of protection are not convincing enough in the case of patent law. The value of maintaining a strong incentive in the form of a patent, over the interests of competing entrepreneurs and consumers who are interested in freeing the spare parts market from intellectual property rights is raised above. The interests of these groups should, however, be taken into account when the spare part is only the carrier of the element according to the invention. The permissibility of repairs and the necessity to replace used elements for the use of purchased devices justifies the admissibility of manufacturing and marketing individual components of the invention.

Chapter IV is devoted to the law of industrial designs, in which the problem of protection of spare parts is particularly timely and focuses the attention of the legislator and the doctrine. This is due to the fact that it affects a particularly important category of products, which are car parts particularly susceptible to damage in road accidents (the so-called crash

parts), the replacement of which is necessary to restore the original appearance of the vehicle. Special regulations are discussed, which the legislator decided to introduce as a response to the arguments raised on the lack of proper balancing of interests on the aftermarket of spare parts and current case law, which is important for their interpretation. In particular, the so-called repair clause. The considerations show, therefore, that under the law of industrial designs, the problem of the spare parts market has met with a resolute response from the legislator.

Chapter V deals with the copyright regime, which may constitute an alternative basis for the protection of the external form of the product. This leads to reference to the law of industrial designs, which prompts to consider the coherence of the compared protection systems. In article 33 paragraph 4 of the copyright law the legislator introduced the restriction as part of fair use. According to its content, the use of other people's work is permitted when it is necessary "in connection with the repair of the equipment". Such explanation raises doubts. In this paper, it is argued that this provision should become the equivalent of the repairs clause in article 106¹ of industrial property law. His broad interpretation is justified by reasons related to the need to ensure the internal coherence of the intellectual property rights protection system.

Chapter VI addresses the problem of using someone else's markings to indicate the intended use of spare parts, which come from producers competing with the trader who manufactured a device requiring replacement of parts. If the spare part is used to replace an element closely matching the aggregate, the possibility of referring to someone else's markings is essential for the product to have a chance to meet the interest of buyers. Effective and proper informing about the intended use of a spare part requires precise indication of both the product and its manufacturer. Due to the above, and also within this regime, the legislator decided to introduce a special regulation in the trademark law, which allows the use of third-party protected markings (Article 156 paragraph 1 point 3 of industrial property right mentioned above). Its application depends on the premise of necessity, the meaning of which has been elaborated in case law. The conditions allowing for the use of someone else's catalogue number in relation to own products were also indicated. Another problem discussed in the chapter is the use of third-party trademarks to recreate the external form of the product.

Analysis of the legal status allows to draw conclusions from a historical perspective. A clear trend can be observed, which consists in limiting - against the interests of entitled entities – of the effectiveness of exclusive rights in areas related to the post-sales market of repairs and

spare parts. As a result, they are gradually expanding in the possibilities of manufacturing and marketing spare parts.

The existence of specific restrictions in the intellectual property rights regimes is not enough, however, that *de lege lata* it is difficult to talk about the existence of the principle of law, that is norms of directive meaning and certain supremacy, the content of which would be the freedom to perform repairs. If the repair is combined with an act that would constitute an infringement, then it cannot be effectively opposed to intellectual property rights. The above does not mean, however, that the right to the proprietor of a copy for repairs may be denied on the basis of intellectual property rights. It should first of all be noted that the very concept of repair is also important where the legislator did not explicitly foresee any limitation of the effectiveness of exclusive rights, i.e. within patent law and utility models. In these regimes, the limits of what can be called repair become the determinant of allowed activities, because their transgression determines that the given activity is considered as a reconstruction, which in turn is equated with production.

In addition, limitations to the effectiveness of exclusive rights related to repairs are a sign of the legislator's recognition of the right of owners to carry them out. Standards liberalizing the aftermarket of spare parts can be seen in this regard as an indirect instrument. In the absence of appropriate exclusions the repair could be impossible, difficult due to difficulties in obtaining spare parts or more expensive. As a result of the above, it should be stated that on the basis of various regimes, the legislator recognizes the interests of owners of products requiring repair and entrepreneurs who want to produce "non-original" spare parts and - in some situations – offers them an advantage over the interest of those entitled to exclusive rights.

The broader meaning of the owner's right to carry out repairs can also be seen in the light of the interpretation of binding legal norms, which does not mean that the clearly allowed sphere of action introduced in one regime of intellectual property rights may be "neutralized" by other norms.

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