

WIPO SCT – Country Names

Comments and observation of the Patent Office of the Republic of Poland on several areas of convergence identified in document SCT/35/4

Area of Convergence No. 1

Notion of Country Name

As it is presented in the document SCT/35/4, Poland agrees that for the purpose of trade marks examination, a country name may cover the official or formal name of the State, the name in common use, translation to any foreign language and transliteration of the name, the short name of the State, as well as use of the name in abbreviated form, which is confirmed in many judgments of the Polish courts.

Example:

- Rzeczypospolita Polska – official name,
- Polska – official, short name,
- Poland/ Republic of Poland – translation,
- PL – short name, code

During the assessment of a country name, we often rely on the ISO 3166 standard published by the International Organization for Standardization (ISO) that defines codes for the names of countries, dependent territories, and special areas of geographical interest. Although following the ISO standards is optional, they are commonly approved in Poland. Polish courts often rely on these standards e.g. in case 6 II SA 433/03 of 28 May 2004, the court held that it is impossible to register a trade mark that consists of two-letter country codes defined in ISO standards.

Area of Convergence No. 2

Non-registrable if Considered Descriptive

Until November 2015, the Polish Industrial Property Act had absolute provisions that prevented registration of trade marks that contain the name “Poland” or its abbreviations, since there was no competent authority that would allow for the use of the country name i.e. Poland or the Republic of Poland. It was also impossible to register a trade mark that contained a short name/code of the State e.g. PL, UK, FR, DE, etc.

It is, however, important to underline that there has recently been adopted a new act that amends the Polish Industrial Property Act in terms of the registration of a country name. According to the new changes in the Polish Industrial Property law, the abovementioned provisions have been removed. The new act **entered into force on 1st December 2015**. Consequently, from the moment of the entry into force, trade marks that contain or consist of a country name may be granted protection on the territory of Poland. Currently, the Polish law does not contain specific provisions that prohibit registration of trademarks that contain or consist of country names and therefore, a

country name does not constitute a ground for refusal. On contrary, it now allows entrepreneurs to register trade marks that consists of a country name in order to promote the origin of goods and services.

It is worth noticing that article 6ter of the Paris Convention states that *(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, **of armorial bearings, flags, and other State emblems**, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.* Consequently, it seems that refusal of registration refers **only** to trademarks of armorial bearings, flags, and other State emblems and not country names.

Nonetheless, it must be explained that there are several opportunities available to third parties, before, during and after the trademark registration process where the protection of country names may be invoked.

Article 129¹ of Polish Industrial Property Act states that signs which:

- cannot constitute a trademark,
- are not capable of distinguishing, in trade, the goods for which they have been applied,
- consist exclusively or mainly of elements which may serve, in trade, to designate the kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function or usefulness of the goods,

cannot be registered.

Therefore:

- If a trademark consists solely of a country name, it would not be registered for being descriptive if it identifies the place of origin of the goods or services.

Example of non-registrable marks: *Poland, France, PL, FR* etc.

- If a trademark (word mark) contains a country name and some other elements which may serve to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, it wouldn't also be registered for being descriptive

Example of non-registrable marks:

Polish coffee – for coffee, artificial coffee, flavoured coffee, etc. in class 30

Japanese cars – for vehicles in class 12

- If a trademark contains a country name and some other descriptive elements but it also contains some graphic elements, **it may be registered** provided the graphic elements are sufficiently distinctive to indicate the origin of goods and services.

Example of registered marks:



For goods and services in class 16,40,42

Translation: Polish Print



For goods in class 29

Translation: Polish Poultry



For goods in class 5

Translation: Polish Product



For goods and services in class 30 and 35



For goods and services in class 29,30,31,35,43

Area of Convergence No. 5
Invalidation and Opposition Procedures

If a registered trade mark, that contains or consists of a country name, is considered descriptive (Convergence Area No. 2), it is possible to invalidate such trade mark based on grounds for refusal under Article 129¹ mentioned above.

Current Polish law does not foresee a possibility to file an opposition against a trade mark application based on absolute grounds i.a. to oppose trade marks for being descriptive. However, at any point before the trade mark registration process, third parties may submit to the office written observations, explaining on which grounds the trade mark should not be registered ex officio.

Area of Convergence No. 6
Use as a Mark

In order to prevent the use of country names if such use is likely to deceive the public, interested parties may rely on **unfair competition act**.

According to Article 8. Labelling products or services with false or deceitful geographic indication, directly or indirectly indicating country, region or locality of their origin, or the use of such indication in the commercial activity, advertising, business letters, invoices or other documents, shall be the act of unfair competition.

Article 9. states that where the product or service is protected in the place of its origin and its specific features or properties are connected with originating from a given region or locality, the false or deceitful use of such geographical regional indications shall be the act of unfair competition, even if the words “kind”, “type”, “method” are added.

Civil liability

Further, where the act of unfair competition is committed, the entrepreneur whose interest is threatened or infringed may request:

- 1) relinquishment of prohibited practices,
- 2) removing effects of prohibited practices,
- 3) making one or repeated statement of appropriate content and form,
- 4) repairing the damage, pursuant to general rules;
- 5) handing over unjustified benefits, pursuant to general rules,
- 6) adjudication of an adequate amount of money to the determined social goal connected with support for the Polish culture or related to the protection of national heritage – where the act of unfair competition has been deliberate.

The burden of proof of the veracity of marking or information placed on products or their packing or of statements contained in the advertising shall fall upon the person accused of the act of unfair competition connected with misleading.