

Dear Sir/Madam

Following to the WIPO invitation of concerned countries to submit examples of trademark issues regarding the protection of names of countries we would like to submit two examples of matters relating to such situations with their brief description.

1)



Figurative trademark ID as shown above was filed at the Patent Office to designate the goods and services classified in classes: 3, 8, 37 40 and 42. The Patent Office refused to register a trade mark ID on the basis of Article 8, section 6 of the Trade Marks Act, which stipulated that "there must be no registration of a mark that contains the name or abbreviation of the state [...] that is a member of the Paris Union of Industrial Property Protection [...] unless the applicant demonstrates that he is entitled to use such mark in trade".

Justifying its decision, the Patent Office indicated that the abbreviation ID is the letter code of Indonesia. These codes are defined in international standard ISO 3166:1993, and in the Polish version of that standard which is ISO 3166 PN. In both of those standards were identified basic code names of countries, dependent territories and other areas of special interest, which were intended for international exchange.

The Patent Office took the view that the assessment of the trade mark must be made in respect of the trademark as a whole, but where the letters are the dominant component, the sign must be analyzed taking into account the semantic layer of the letters. In the analyzed case the abbreviation ID attracts attention of the recipient, being in the central part of the trade mark, in addition, being positioned in the centre of the ellipse.

Applicant appealed the decision of the office. The Board of Appeal upheld the decision of the Office to refuse registration of the mark. Then, on appeal the case went to court. The Supreme Administrative Court dismissed the applicant, with the position of the Patent Office.

The Court found that the standard of Article 8 paragraph 6 of the Law on Trademarks and the corresponding standard Article 6ter of the Paris Convention indicate a lack of opportunities to protect the states names abbreviations as elements of trademarks. In the court's opinion the term "abbreviations of names of countries" should not be interpreted restrictively, but you

should take into account the various abbreviations of names of countries appearing on the market. Established by the United Nations international standard ISO 3166:1993 specifying country codes should be taken into account when assessing the trade marks. In accordance with the standard, the codes of names of countries are for the purpose of international exchange. According to the court so broad a term as "international exchange" allows to recognize that the use of country code also covers situations in which there is use of a trademark, where the dominant component is encoded name of the country.

2)

MI CUBA

Word trademark MI CUBA was filed at the Patent Office to designate the goods classified in classes: 32, 33 and 34 (nonalcoholic beverages, beer, beverages on the basis of beer, mineral water, fruit juices, vegetable juices, powders and tablets for making beverages, energetic beverages; spirits, vodka, wine, liquors alcohol for consumption; cigarettes, cigars, tobacco, smokers' articles not included in other classes)

The Patent Office refused to register a trade mark under Article 131, paragraph 1, section 3 of the Act on Industrial Property Law. Under this provision, protection shall not be granted for trademarks, which by their nature may mislead the public, particularly as to the nature, characteristics and geographical origin of the products.

Trademark MI CUBA was filed by a Polish entrepreneur. Term MI CUBA means in Spanish "My Cuba" and despite the fact that Spanish is not a widely understood language in Poland, the meaning of MI CUBA can be correctly identified by Polish recipients. CUBA- Kuba in the Polish language, is pronounced the same as in Spanish and has the same meaning.

Justifying its decision, the Patent Office indicated that the average customer may be misled as to the origin of the goods labeled with the mark at issue. The Patent Office also noted that the danger of confusion is particularly strong in relation to goods classified in classes 33 and 34 Cuba is famous for the product of tobacco, especially cigars. It is also known for its production of alcoholic beverages. The potential buyer purchasing goods labeled with the mark MI CUBA could therefore be misled not only as to the geographical origin of goods, but also their quality.

Kind Regards,

Marta Czyż

Director of TM Department

Polish Patent Office