

**REVIEW UNDER ARTICLE 24.2 OF THE APPLICATION OF THE
PROVISIONS OF THE SECTION OF THE TRIPS AGREEMENT
ON GEOGRAPHICAL INDICATIONS**

Checklist of Questions¹

Addendum

Responses from Poland

The present document represents the responses to the Checklist which the Secretariat has received from Poland, by means of a communication from its Permanent Mission, dated 26 March 2002.

I. RESPONSES OF THE REPUBLIC OF POLAND TO THE QUESTIONS IN DOCUMENT IP/C/13.

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

In Poland protection for geographical indications is provided through both measures mentioned above, i.e. there are three articles to that effect in the Act of 1993 on Combating Unfair Competition and a separate Part II in the Act of 2000 – Industrial Property Law which provides for the protection of geographical indications by way of registration.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

As indicated in response to question 1, there are two separate regimes which are complementary to each other.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

¹ Documents IP/C/13 and IP/C/13/Add.1

The regime under Unfair Competition Act applies both to goods and services, while the regime of protection under the provisions of Part II of the Industrial Property Law applies only to goods.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

The requirements of Article 22.2 are met by the provisions of Articles 185, 296-300 of the Industrial Property Law, as well as Article 3(2), Article 8 and Article 9 of Unfair Competition Act.

The strengthened protection of geographical indications for wines and spirits, as required by Article 23.1 of the TRIPS Agreement, is provided by Article 131(3) and (4) of the Industrial Property Law.

The texts both of the Act on Combating Unfair Competition and Industrial Property Law were notified to the WTO Secretariat pursuant to Article 63.2 of the TRIPS Agreement.

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

See the responses to questions 1-4 above.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Since the registration procedure for geographical indications, introduced by the provisions of the Industrial Property Law, started operating as from 22 August 2001, no geographical indication has been registered so far.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

According to Article 131(1)(iii) of the Industrial Property Law, the registration is refused in respect of a trademark whose use may mislead the public as to the nature, quality, properties of the goods (services) or as to their origin.

Article 131(3) of the Law states that in case of wines and spirits, any trademark, which incorporates geographical elements discordant with the true origin of the good shall be considered as a trademark misleading the public and therefore its registration is to be refused. The difference between the above two provisions is that the first one extends to any goods or services and constitutes a relative ground for refusal, while Article 131(3) is applicable only for wines and spirits and constitutes an absolute ground for refusal.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Pursuant to Article 175, the following constitute geographical indications:

(1) designations of origin used to describe products:

- (a) originating in a specific territory, and
 - (b) the properties of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and the production or processing of which takes place in that territory,
- (2) names of regions used to describe products:
- (a) originating in a specific territory, and
 - (b) the properties or other characteristics of which are essentially attributable to their geographical origin, that is the territory on which they are produced or processed.

Geographical indications also mean designations used to describe the products produced of raw materials or intermediate products coming from a defined area larger than the production or processing area, provided that special conditions for the preparation of the raw materials or intermediate products exist and there are inspection arrangements to ensure that those conditions are adhered to.

Geographical indications are also geographical designations which do not correspond to the true place, in which the product originates, or other traditional designations, if they are normally used in respect of the goods originating in a defined area.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

According to Article 174 of the Industrial Property Law of 2000, geographical indications are word indications which in an explicit or implicit manner designate the name of a place, locality, region or country (territory), which identify a good as originating in that territory, where a given quality, reputation or other characteristic of the good are essentially attributable to the geographical origin of that good.

10. *In determining whether recognition should be given to a geographical indication, what criteria are considered?*

See the responses to questions 8 and 9 above. Moreover, a given indication may not be registered, if in consequence of its use it has become a generic name.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

The human creativity is involved in the definition of designations of origin (see the response to question 8 above). The geographical environment and the human creativity are equally important.

12. *Are there any other intellectual property rights involved, such as patents for example?*

No other intellectual property rights are involved.

13. *What authority, if any, may define the geographical region or area for which rights are claimed and on what basis is such definition made?*

According to Article 176 of the Industrial Property Law, a geographical indication application should contain, among others, the detailed delimitation of the area to which it relates. Thus, it is for the applicant who defines the region, but it is controlled as a part of the product specification by the competent authority.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

According to Article 131(4) of the Law in part relating to trademark protection, in the case of homonymous geographical indications for wines and beers, protection shall be accorded on the condition that the subsequent applicant, who has later filed his application alters his trademark at the invitation of the Patent Office so as to make it distinguishable from the trademark earlier registered or applied for registration. Thus, distinguishability is the criterion for homonymous indications for wines and beers.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

Pursuant to Article 174(2) of the Industrial Property Law, a foreign geographical indication may only be granted protection in Poland, if it enjoys protection in the country of its origin. Under Article 176(5) of the Law, persons applying for registration of foreign geographical indications shall be required to refer to, or to complete the application with, a document confirming that the indication is provided protection in the country of its origin. In particular, any international agreement under which geographical indications are protectable may be considered as such confirmation document.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

Prohibition is implied by Article 174(2) cited in response to question 15 above, i.e. only those foreign geographical indications may be protected in Poland, which are protected in their countries of origin.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

According to Article 176 of the Law, an application may be filed by an organization entitled to represent interests of the producers running their business activities on a given territory, as well as by a state or local administration agency competent in respect of the territory, to which the geographical indication relates.

18. *What are the competent authorities where the protection of geographical indication can be obtained?*

Pursuant to Article 216(2) of the Industrial Property Law it is the Patent Office of the Republic of Poland which has authority in granting protection for geographical indications.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

The procedures must be based on the initiative of an organisation of producers or a state or local administration agency.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

According to the Regulation of the Council of Ministries of 29 August 2001, the filing fee amounts to PLN 200 (ca. 56 EURO) and the maintenance fee amounts to PLN 500 (ca. 138 EURO).

21. *If criteria must be set in an application for recognition of a geographical indication, are those criteria purely geographical in nature?*

The criteria also include human factors.

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

An application concerning a geographical indication shall include:

- (i) a detailed description of the indication and of the elements with which it is to be used in the course of trade, such as labels and the packaging;
- (ii) the specification of the goods for which the indication is intended;
- (iii) the detailed delimitation of the area, to which it relates;
- (iv) a description of the characteristic features or properties of the products as originating in the defined area;
- (v) the conditions of the use of the geographical indication, including: the production process, the characteristic features or properties of the products, other requirements to be fulfilled by the persons wishing to use that indication and, where applicable, the inspection arrangements;
- (vi) the specification of the undertakings which use or intend to use the indication.

23. *What information must be supplied in any application for rights in a geographical indication?*

See the response to question 22 above.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

See the response to question 22 above (item (ii)).

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

Pursuant to Article 246 of the Industrial Property Law, within six months from the publication in the official bulletin "Wiadomości Urzędu Patentowego" of the mention of the registration of a geographical indication, any person may give reasoned notice of opposition to a final decision of the Patent Office on the grant of a right in registration. The opposition may be filed on the same grounds, on which a right in registration may be invalidated.

Further action is the following: the Patent Office immediately communicates the opposition to the right holder and invites him to file his observations within a fixed time limit. Where, following

the communication of the Patent Office, the right holder claims the opposition to be unjustified, the case is submitted for examination in litigation proceedings. Otherwise, the Patent Office decides on reversal of the decision on the grant of a right in registration and discontinues the proceeding.

The decision taken by the Patent Office may be subject to complaint to the Supreme Administration Court.

26. *Who can oppose the recognition of a geographical indication?*

Any party.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The procedure for foreign applicants is the same as that applied in respect of Polish ones. There are only two differences: one is that, as indicated in the response to question 15, persons applying for registration of foreign geographical indications shall be required to refer to, or to complete the application with, a document confirming that the indication is provided protection in the country of its origin.

The second difference is that foreign applicants may act before the Polish Patent Office in registration procedure only when represented by a patent attorney domiciled in Poland.

D. MAINTENANCE

28. *How long does the recognition for a geographical indication continue?*

Term of protection for a geographical indication is unlimited in time and starts from the date of its entry in the Register of Geographical Indications kept by the Polish Patent Office.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

Not applicable.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

It is not explicitly stated in the Industrial Property Law that use is required to maintain rights. However, pursuant to Article 192(1), any party having a legitimate interest may demand that a decision be taken on the lapse of the right in registration for the geographical indication which ceased to satisfy the requirements for the grant of protection or has not been used for a period of five years and no serious reasons for non-use thereof exist. This shall not apply to indications, the protection of which follows from an international agreement.

The burden of proof that the geographical indication is used or that the justified reasons for non-use thereof exist shall be on the holder of the right in registration.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

A limit for non-use is five years – see the response to the question above.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

The authorities monitoring whether the use of geographical indications in respect of agriculture products and foodstuffs are in compliance with the product specification are the county centres for purchasing and processing of agriculture products.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

Under the Act of 21 December 2000 on the commercial quality of agriculture products and foodstuffs, county centres for purchasing and processing of agriculture products only check whether the products capable of being marked by a given geographical indication are so marked, but no particular legal procedures are stipulated for monitoring the use of geographical indications.

In the case provided for in Article 192(1) – see the response to question 30 above – it is for the holder of the right in registration to prove that the geographical indication is used or that the justified reasons for non-use thereof exist.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

See the response to question 30. At the demand of the interested party to declare the right in registration for the geographical indication lapsed, the Patent Office takes a respective decision in litigation procedure.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

On the initiative of the interested party (see above).

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

The recognised geographical indication may be used by the right holder, by the undertakings specified in the geographical indication application as those who use or intend to use that indication, as well as by any party, whose products satisfy the conditions for the use of that geographical indication. The latter may also request the Patent Office to be entered in the Register of Geographical Indications as a party authorised to use it.

Additionally, under Article 186 of the Law, any parties who, while operating on a given territory, earlier used a geographical indication in good faith, and whose products do not satisfy the requirements for the grant of a right in registration, may continue to use that indication, however for no longer than one year counted from the date of the grant of the right in registration.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

The entity that obtained the recognition.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

No official fees are involved.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

This kind of dispute may be settled by general dispute settlement procedures before civil courts as infringement cases.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

See the responses to questions 30 and 31.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

Not applicable.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

The protection regime does not allow geographical indications to be licensed.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4. of the TRIPS Agreement, applied in your country?*

The only provision to a similar effect is Article 186 of the Law under which any parties who, while operating on a given territory, earlier used a geographical indication in good faith, and whose products do not satisfy the requirements for the grant of a right in registration, may continue to use that indication, however for no longer than one year counted from the date of the grant of the right in registration.

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

The general rule, under the provisions governing trademark protection in the Industrial Property Law, is that a right of protection shall not be granted for a trademark that contains geographical elements which, although literally true as to the territory, region or locality, in which the goods originate, are of such a nature as to mislead the public by false representing that the goods originate in another territory famous of given goods.

Article 177 of the Law stipulates that a geographical indication, the use of which would encroach upon a right of protection for a trademark, shall only be eligible for registration, if the holder of the right of protection surrenders his right.

Surrender of the right of protection for a trademark shall not be required, where in the application of the geographical indication for registration, filed in agreement with the holder of the trademark registration, the latter is mentioned among the parties authorised to use that indication and

the maintenance of his right is not supposed to entail excessive restrictions on freedom to use the geographical indication by other authorised parties.

When assessing whether or not the protection of the trademark is supposed to entail excessive restrictions on freedom to use the geographical indication by other authorised parties, that indication's capability of being used in forms other than the form which is represented by the trademark shall, in particular, be taken into account.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

Conflicts between trademarks and geographical indications can arise in the context of opposition or cancellation proceedings before the Patent Office (litigation proceedings), or can arise in the context of a civil action for infringement in civil courts, in unfair competition proceedings in civil courts or in other types of private litigation.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

See the response to question 45.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

Rights in the geographical indications are enforceable under the Industrial Property Law of 30 June 2000 (Articles 296-300 and 302) and under the Act of 16 April 1993 on Combating Unfair Competition (Articles 18-22). Both acts were notified pursuant to Article 63.2 of the TRIPS Agreement.

48. *Who has the right to enforce a geographical indication?*

Under the Industrial Property Law, it is any party whose right of registration for a geographical indication has been infringed or any party enjoying the same status.

Under the Act on Combating Unfair Competition, it is an entrepreneur whose interest has been threatened or prejudiced by an act of unfair competition.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

Civil regional courts decide in infringement cases. Regular court fees are involved.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

Granted registrations for geographical indications are subject to publication in a monthly official bulletin "Wiadomości Urzędu Patentowego".

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

Under the Industrial Property Law, anyone marking goods not protected by a right in registration for a geographical indication, with statements or signs calculated to give the impression that the goods enjoy such protection, shall be liable to a fine or detention.

Anyone putting on the market, or preparing or stocking for that purpose the goods or providing by announcements, communications or otherwise, information calculated to give the impression that the goods enjoy legal protection, while being aware of their being falsely marked, shall be liable to the same penalties.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

No.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

For the time being, only the Paris Convention for the Protection of Industrial Property which provides means for preventing false geographical indications and the Madrid Agreement (The Hague Act) for the Repression of False or Deceptive Indications of Source on Goods (the accession procedure to the Lisbon Act having been initiated).

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like?*

According to Article 185 of the Industrial Property Law:

- (1) A geographical indication for which a right in registration has been granted may not be used on the territory of the Republic of Poland by parties, whose products do not satisfy the requirements for the grant of a right in registration. (...)
- (2) A geographical indication may not be used by the parties referred to in paragraph (1) even if such use is not intended to designate the geographical origin of the products or where the true place of the production of the product is indicated.
- (3) A geographical indication may not be used by the parties referred to in paragraph (1) even if accompanied by expressions indicating the kind of the product, such as "imitation", "type", "process".
- (4) The prohibition referred to in paragraphs (1) to (3) shall cover geographical indications in their original reading, in translations or in other related forms.

The above provisions are applicable to any products, including wines and spirits.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

See the response to question 8 under I above.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits?*

See the response to question 14 under I above.

F. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wines and spirits with respect to such wines or spirits not originating in the indicated territory?*

According to Article 131(1)(iii) of the Industrial Property Law, the registration is refused in respect of a trademark whose use may mislead the public as to the nature, quality, properties of the goods (services) or as to their origin.

Article 131(3) of the Law states that in case of wines and spirits, any trademark, which incorporates geographical elements discordant with the true origin of the good shall be considered as a trademark misleading the public and therefore its registration is to be refused.

Pursuant to Article 164 of the Law, a trademark registration may be invalidated in whole or in part at the request of any person having a legitimate interest therein, provided that that person is able to prove that the statutory requirements for the registration have not been satisfied.
