

SLOVENIAN INTELLECTUAL PROPERTY OFFICE

OPPOSITION PROCEDURE

SLOVENIAN INDUSTRIAL PROPERTY ACT

BASIC FACTS

- I. No ex officio examination on relative grounds (i.e. identity or similarity to earlier rights) for refusal of the registration of a trademark's application
- II. Pre-registration opposition procedure (bases: Industrial Property Act, articles 44, 101, 102) -> final decision of the SIPO (Slovenian Intellectual Property Office)
- III. Decisions of the SIPO can be challenged in the courts procedures

OPPOSITION PROCEDURE

- I. Time limit for filing an opposition:
3 months after the publication of an application of a trademark in the official gazette of the SIPO (Industrial Property Bulletin)
- II. Who can file an opposition:
 1. the owner of the earlier trademarks or trademarks' applications (national TM; CTM; internationally registered TM, designated to Slovenia)
 2. the owner of the earlier trademark or unregistered sign, which is in the Republic of Slovenia a well-known mark within the meaning of Article 6^{bis} of the Paris Convention or Article 16(3) of the TRIPS Agreement
 3. the owner of a trademark which has been registered in any Member State of the Paris Union or WTO and has been applied for in the Republic of Slovenia by his agent or representative without the owner's consent
 4. the owner of an earlier right to a name, personal portrayal, plant variety, geographical indication or other industrial property right, or an earlier copyright, unless the owner of the earlier right gives his express consent to the registration of such sign
- III. Bases for refusal:

Formal grounds for refusal are specified in Art. 44 of the Industrial Property Act - relative grounds for refusal (see below).

Together with the written notice of opposition the opponent has to submit all the supporting evidences (in the time limit of 3 months after the publication of a trademark's application).
- IV. Procedure before the SIPO:
 1. examination on formalities: date of filing an opposition, power of attorney, opposition fees
 2. sending the copy of a notice of opposition (together with evidences) to an applicant, giving him the opportunity of submitting the arguments in favour of the registration of the applied trademark (arguments have to be submitted in 3 months, possible prolongation for another 3 months)
 3. examination on substance on bases of grounds for opposition, evidences and counter-arguments -> making decision on opposition; in case of grounded opposition -> refusal of registration of applied trademark for all (total) or some (partial) goods or

SLOVENIAN INTELLECTUAL PROPERTY OFFICE

services; in case of groundless opposition -> refusal of opposition

4. the decisions of the SIPO can be appealed at Courts of First Instance (The Administrative Court of Ljubljana, The District Court of Ljubljana) and on second appeal at The Supreme Court

THE PROS AND CONS OF A PRE-REGISTRATION OPPOSITION PROCEDURE

1. PROS:

- a simple and cheap way to prevent the registration of an “inappropriate” trademark (no obligatory representative except for the foreign physical or legal persons)
- shorter time of solving an opposition (comparing with courts’ procedures)
- less possibility of infringement of prior rights of others (it is less likely to use an unregistered than a registered trademark or sign)

2. CONS:

- in case of opposition the whole registration procedure prolongs substantially
 - > problems and uncertainty for applicants and opponents
 - > organizing problems for the SIPO (personnel problems, backlogs, etc.)

Slovenian Industrial Property Act (Opposition Procedure - relevant articles):

Article 44 Relative grounds for refusal

(1) Further, a sign shall not be eligible for registration as a mark if:

(a) it is identical with an earlier mark of another owner, and the goods or services for which the registration is applied for are identical with the goods or services for which the earlier mark is registered;

(b) because of its identity with or similarity to the earlier mark of another owner and the identity or similarity of the goods or services covered by the sign and the mark there exist the likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark;

(c) because of its identity with or similarity to an earlier mark of another owner, registered for goods or services which are not identical with or similar to the goods or services for which the registration has been applied for, the use without due cause of such sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark, or if it would indicate a connection between the goods or services and the owner of the earlier mark, and provided that the interests of the owner of the earlier mark are likely to be damaged by such use;

(d) it is identical with or similar to a mark or unregistered sign, which is in the Republic of Slovenia a well-known mark within the meaning of Article 6^{bis} of the Paris Convention or Article 16(3) of the TRIPS Agreement;

(e) the owner of the mark registered in any Member State of the Union established under the Paris Convention, hereinafter referred to as “the Paris Union”, or the World Trade Organisation, hereinafter referred to as “the WTO”, proves that his agent or representative applied, without the owner’s consent, for the registration of the sign in his own name;

(f) its use would contradict an earlier right to a name, personal portrayal, plant variety, geographical indication or other industrial property right, or an earlier copyright, unless the owner of the earlier right gives

SLOVENIAN INTELLECTUAL PROPERTY OFFICE

his express consent to the registration of such sign.

(2) "Earlier mark" within the meaning of paragraph (1) means:

(a) mark which was applied for or registered in the Republic of Slovenia on the basis of a national application before the date of filing of the application for the later mark or, if priority is claimed, the date of priority;

(b) mark for which the protection was sought in the Republic of Slovenia on the basis of an international application before the date of filing of the application for the later mark or, if priority is claimed, the date of priority.

Article 101

Opposition against registration of a mark

(1) Within three months following the publication of a mark application, a written notice of opposition to registration of the mark may be filed with the Office by the owner of an earlier mark.

(2) The notice of opposition may only be given on the grounds referred to in Article 44 and shall contain supporting evidence.

(3) The opposition under paragraph (1) may also be filed by the owner of a mark which has been registered in any Member State of the Paris Union or WTO and has been applied for in the Republic of Slovenia by his agent or representative without the owner's consent.

(4) Where the ground for opposition is Article 44(1)(f), a notice of opposition under this Article may also be filed by an owner of the earlier right referred to in Article 44(1)(f).

(5) When filing the opposition, or no later than three months from the receipt of the invitation, the opposition fee shall be paid, and a power of attorney shall be submitted, if the opposition has been filed by a representative.

(6) If the opponent withdraws the opposition, the withdrawal may not be cancelled later on.

(7) If the opposition does not meet requirements under this Article, it shall be deemed not to have been filed.

Article 102

Examination of the application following the opposition

(1) The Office shall notify the applicant for a mark of an opposition filed. The applicant may, within three months from the receipt of the notification, comment on the opposition.

(2) On the basis of the opposition and any observations from the applicant for a mark, the Office shall examine the grounds for the opposition.

(3) Where the examination of the opposition reveals that the opposition is not grounded and that the mark may be registered in respect of the goods or services for which the application has been made, the Office shall refuse the opposition.

(4) Where the examination of the opposition reveals that the opposition is grounded and that the mark may not be registered in respect of all or some of the goods or services for which the application has been made, the Office shall refuse the application wholly or in part.

SLOVENIAN INTELLECTUAL PROPERTY OFFICE