

**PAPER SUBMITTED TO STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS (SCT) AS AGREED AT ITS 20th SESSION BY THE SLOVENIAN INTELLECTUAL PROPERTY OFFICE**

**Grounds for refusal of all types of marks:**

The requirements for registration of trademarks are regulated by the Slovenian Industrial Property Act as in force from 11 March 2006

The requirements for registration are listed below:

Absolute grounds for refusal

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

- (a) it cannot constitute a mark;
- (b) it is devoid of any distinctive character;
- (c) it serves, in trade, to designate merely the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
- (d) it contains or consists of a geographical indication identifying wines or spirits, where the mark application relates to wines or spirits not having this origin;
- (e) it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;  
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- (f) it consists exclusively of the shape which results from the nature of the goods themselves or is necessary to obtain a technical result or gives substantial value to the goods;
- (g) it is contrary to public order or morality;
- (h) it deceives the public, in particular to the nature, quality or geographical origin of the goods or services;
- (i) it contains official signs or hallmarks for controlling or guaranteeing the quality of goods, or imitations thereof;
- (j) it has not been authorised by the competent authorities and should be refused pursuant to Article 6<sup>ter</sup> of the Paris Convention;
- (k) it includes or imitates badges, emblems or escutcheons other than those covered by Article 6<sup>ter</sup> of the Paris Convention and which are of particular public interest, unless the consent of the competent authorities to its registration has been given;
- (l) it contains or consists of a designation of origin or a geographical indication registered in accordance with the Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 208/92, p. 1), provided that the circumstances referred to in Article 13 of that Regulation exist and the sign does not relate to the same sort of product, and provided that the mark application has been filed after the date of filing of the application for the registration of a designation of origin or a geographical indication with the Commission.

(2) Paragraph 1(b), (c) and (e) shall not apply to marks which acquired a distinctive character through long-term use.

(3) A sign which is ineligible for registration because it contains the name or abbreviation of the name, State armorial bearing, emblem, flag or other official sign of the Republic of Slovenia, or a part thereof, which is in breach of the provisions of paragraph 1(j) and (k), shall not be used in the course of trade without the consent of the Government of the Republic of Slovenia.

Absolute grounds objections in Slovenia are raised ex-officio, or after, in invalidity actions before the court.

Relative grounds for refusal

(1) 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;

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(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 6bis 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 his express consent to the registration of such sign.