



Our ref.: 5102-1/2010-1

Date: 29.1.2010

Submission by the Delegation of Slovenia

At its twenty-second session, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) invited SCT members to present submissions on individual items of document SCT/22/2 concerning, in particular, trademark office practice in specific cases and where available, specific graphic examples on grounds for refusal of all types of marks.

In this regard, the Delegation of Slovenia would like to provide the following information following the methodology of the document SCT/22/2, information relate to some paragraphs of the document.

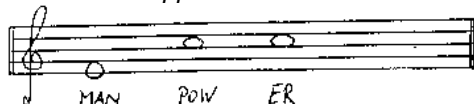
II (a) Signs not constituting a trademark

(ii) Visually perceptible signs - paragraph 11

Slovenia allows the registration of certain non-visible signs, e.g. sound marks, but only when they are represented graphically, for example, by musical notation. Sound marks must be filed in the form of a graphical representation, a sound file representing the sound itself is mandatory. However, the Office would be unlikely to accept the complete song.

Examples of Registered Sound Marks:

Sound mark applied for services in the classes 36, 37 and 38



II (b) Lack of distinctiveness – paragraphs 16-19)

Paragraph 19:

Other examples of non-distinctive signs – figurative representations commonly used

Figurative mark showing a graphic representation of a naturalistic reproduction of the goods themselves (live animals – class 31) was refused because it was not seen as being able to indicate a commercial origin.



Single letters and numerals

Under the Slovenian practice trademarks may consist of single letters and numerals provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

The assessment of the distinctive character of signs cannot be based on the assumption that they are by definition devoid of any distinctive character (in view of the limited number of letters or numerals available for other traders) or that they can acquire such character only through use.

II (c) Descriptiveness

(i) General – paragraphs 20-26

*Under the Slovenian practice descriptive marks are those that limit themselves to provide information about the goods and services in question. The trademark must consist *exclusively* of descriptive matter. Additional matter in the trademark that is not descriptive brings sufficient distinctiveness.*

The relationship between the descriptive meaning of the mark and the goods or services applied for must be concrete, direct and without further reflection.

The fact that the descriptive term does not appear in dictionaries – as one word or otherwise does not alter the finding of descriptiveness.

The circumstance of coupling together two elements or slight misspelling of a word is irrelevant and the mark remains objectionable under the grounds of descriptiveness.

Examples:

Word marks **PLAYBYSMS, PLAYBYNUMBERS, PLAYBYLETTERS** applied for classes 9, 16, 28, 41 were refused.

Slogans

Word signs applied for in a form of slogans are examined like any other word marks. Those slogans are non-distinctive which are limited to general invitations to buy, laudatory statements or seek to promote the superior quality of goods or services.

Examples:

The word mark **TEST IT** applied for goods and services in the classes 34 (cigarettes) and 35 (advertising services) was refused, because the mark was merely seen as a general advertising invitation to test the new product, and those describing the intended purposes of the goods and services. Such general statement/invitation also needs to be available for use by everyone, in particular for use by competitors.

On the other hand, slogans are distinctive if they contain an element of fancifulness, for example conveying interesting messages

Example:

MAČKE BI KUPILE WHISKAS (Cats would buy Whiskas)

Event marks

In most cases, these signs, if applied as word mark, are descriptive identifying the contents or purpose of the event. If combined with sufficiently distinctive figurative elements such sign could be accepted.

Examples:

MEDNARODNI POLKA FESTIVAL S KMEČKO OHČETJO (International Polka Festival with the farmer's wedding)

FESTIVAL RADIJSKIH POSTAJ-RADIO FESTIVAL (Broadcasting festival)

POLETNA HOKEJSKA LIGA BLED (Summer Hockey League of Bled)

all applied also for services in class 41 were refused.

However the following event marks were registered (wide range of classes):



Then, signs consisting of the usual/generic name of the establishment (institute, school, academy...), educational programmes, etc. shall be refused.

Examples:

TEHNOLOŠKI DESIGN CENTER (Technology Design Center), **EURO-MEDITERRANEAN UNIVERSITY**, **SLOVENSKI INŠTITUT ZA BANČNIŠTVO** (Slovenian Institute for Banking), **INNOVATIVE MEDICINE ACADEMY**, **JOGA CENTER LJUBLJANA** (Yoga Center Ljubljana), **LJUBLJANA RESORT**, **SURVEYING COMPANY**



Sign consisting of the business scheme was refused

II (c) Descriptiveness (ii-ix) – paragraphs 27-34

Description and examples of the various grounds of refusal based on the descriptiveness (type or nature, quality, quantity, purpose, value, geographical origin of goods or services).

Examples

Quality of goods and services:

Word marks **SELECTION ORIGINAL, PRIMA, THE BEST FROM SLOVENIA, BEST FOR YOU**, applied for a range of goods and services in different classes were refused.

Intended purposes of goods and services:

SENIOR SERVIS, PENZION SERVIS, applied for a range of goods and services in different classes were refused.

Kind/nature of goods and services:

BIFIDUS, LCA JUNIOR, 3 in 1, A+D+E, AVTOBORZA, POWDER SOFT, ETHNO DECOR applied for a range of goods and services in different classes were refused.

Value of goods and services:

ONE EURO SHOP, applied for a range of goods and services in different classes was refused

Geographical origin of goods and services:

Registration of geographical names is not excluded, when the average consumer is unlikely to believe that the category of goods concerned originate there. Objection under descriptiveness does not apply to those terms which are only suggestive or allusive as regards certain characteristics of the goods or services.

Examples:

MURA (Slovenian river), **PIRAN** (Slovenian small town), **PLANICA** (the name of the hill in Slovenian Alps) were registered for classes 29 in 30.

II (d) Genericness – paragraphs 35-39

Trademarks that consist exclusively of signs or indications which have become customary in the current language are excluded from registration.

Example:

The word marks **TELEKOM, GELBE SEITEN, GOLDEN PAGES** applied for classes 9, 16, 38 were refused.

II (f) Public order and morality – paragraphs 40-43

Under the Slovenian Trademark Law signs which are contrary to public policy or to accepted principles of morality are excluded from registration.

Examples of refused trademarks



The word "FUKOFF" is written in a large, bold, black, sans-serif font. The letters are slightly irregular and have a distressed, hand-painted appearance.



II (g) Deceptiveness – paragraphs 44-46

Under Slovenian practice deceptiveness objection would be raised if, due to some connotation contained in the mark, the registration of the trademark in relation to the goods and services applied for would be likely to deceive the public. The crucial element is not the seat of the applicant, but the connotation of the whole sign. The applicant may be required to limit the list of goods to those produced in line with specific indications.

Examples:



The applicant was required to limit the list of goods to the orange juices.

II (h) Article 6ter of the Paris Convention for the Protection of Industrial Property – paragraphs 47-48

Trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention shall not be registered.

Whether the sign suggests to the public that a connection exists between applicant and the organization the goods and services for which a mark is applied may be of influence.

Examples of refused trademarks (EU protected symbols)





Examples of refused trademarks (imitation of Slovenian State symbols):



Examples of registered trademarks (imitation from a heraldic point of view was not found):



(i) Specially protected emblems and symbols – paragraph 49-50

Examples for emblems or escutcheons which are not protected under Article 6ter of the Paris Convention but which are of particular public interest.

Example:

The sign was constituted of Carinthian historical symbol of particular interest in Slovenia (in last 20 years it has become very recognizable symbol of Slovenian patriotism. It is also used by Special Units of Slovenian Police. The trademark was refused on above mentioned grounds.



