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Obligation to file regulations on use of international collective marks confirmed

Registration

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The **Slovenian Intellectual Property Office** (SIPO) has issued an opinion stating that the holders of international collective trademarks designating Slovenia must submit to SIPO the regulations governing the use of their marks together with a translation into Slovenian language.

Until now, it was not clear whether the holders of international collective trademarks were required to submit the regulations governing the use of their marks, or any amendments thereof, together with a translation into Slovenian language. In contrast, the Slovenian Intellectual Property Act explicitly sets out that this obligation applies to applicants and holders of national collective trademarks.

So far, SIPO had never requested that holders of international collective trademarks submit the regulations governing the use of their marks, even though the act states that the provisions relating to national trademarks apply by analogy to international trademarks designating Slovenia, pursuant to Article 5 of the **Madrid Agreement Concerning the International Registration of Marks** or the **Madrid Protocol**. However, SIPO recently adopted the view that the provisions of the act concerning the requirements for national collective trademarks apply by analogy to international collective trademarks designating Slovenia.

According to the act, the regulations governing the use of collective trademarks must be filed with SIPO, together with a translation, and must include at least the following:

- the holder's name and address;
- details about the holder's business activities and about whom it officially or legally represents;
- the conditions for membership;
- data concerning the parties having the right to use the collective trademark; and
- the rights and obligations of the members in the event of infringement of the collective trademark.

It is too early to say whether SIPO will apply the new practice only to new international collective trademarks, or whether it will require holders of existing international collective trademarks to provide their regulations.

According to the act, an action for invalidation of a collective trademark may be filed if the trademark has been registered contrary to the provisions on collective trademarks, including those defining the applicant/holder's obligation to provide the above mentioned regulations. Therefore, applicants/holders of international collective trademarks would be advised to submit these regulations to SIPO.

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