

World Trademark Review Daily

SIPO confirms that company name may present obstacle to trademark registration
Slovenia - ITEM d.o.o

Examination/opposition
National procedures

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The [Slovenian Intellectual Property Office](#) (SIPO) has refused to register the trademark STA LJUBLJANA based on the earlier company name STA Ljubljana doo (Decision 31207-1312/2010-17, January 11 2013).

On September 14 2010 Slovenian company STAL doo filed an application with SIPO for the registration of the trademark STA LJUBLJANA for, among other things, “advertising, business management and business administration” in Class 35, “insurance, financial affairs” in Class 36 and “education and entertainment” in Class 41 of the [Nice Classification](#).

In February 2011 [Slovenska Tiskovna Agencija STA doo Ljubljana](#) filed an opposition based on three earlier trademarks and on an earlier company name under Article 44(1)(f) of the [Industrial Property Act](#). Article 44 (1)(f) states as follows:

“Further, a sign shall not be eligible for registration as a mark if:

...

(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.”

STA is a Slovenian press agency established in 1991 by the Slovenian government; ‘STA doo Ljubljana’ is a registered version of the company name, which is used to designate the company more often than its full name. The acronym ‘doo’ merely designates a type of company (ie, a limited liability company). Since its establishment, STA has been a key source of daily information for Slovenian media outlets and the Slovenian public, as well as the main source of information for foreign press agencies and major international media with regard to events in Slovenia. STA’s services (ie, the General News Service in Slovenian, the daily English Service and the Picture Service) are also used by state institutions, corporate users and embassies, among others. STA’s registered activities include those related to the news agency, business and administrative fields, as well as translation, advertising, marketing, film, radio, TV and education.

In its decision, SIPO applied Article 44(1)(f) and refused to register the trademark for all services in Classes 35, 36 and 41. In doing so, it confirmed the conditions for refusing to register a trademark based on an earlier company name, which were set forth in a decision issued by SIPO in 2006 (for further details please see [“Company name blocks trademark registration for the first time”](#)). In that case, SIPO had found that the test for assessing the similarity of conflicting trademarks can be applied by analogy to cases where the prior right is a company name. In the present case, SIPO again applied by analogy the test for assessing the similarity between two trademarks, and held that a trademark application will be refused if:

1. the company name is identical or confusingly similar to the mark; and
2. the registered activities of the company are essentially identical, similar or complementary to the goods/services covered by the opposed trademark.

Adding to its earlier decision, SIPO further explained that, when comparing a company’s registered activities to the goods and services covered by a trademark, it is irrelevant to what extent these activities are actually carried out by the company, or even whether they are carried out at all.

In the present case, SIPO established that the opposed trademark STA LJUBLJANA was confusingly similar, if not identical, to the short version of the company name STA doo Ljubljana, because the acronym ‘doo’ has no distinctive character. In addition, the company’s registered activities were essentially similar to the goods and services covered by the mark in Classes 35, 36 and 41. Therefore, SIPO refused to register the trademark in these classes.

This decision is important for two reasons. First, it confirmed the 2006 decision, thereby making existing case law more reliable. Second, SIPO explained that the issue of whether the company is actually carrying out its registered activities on the market has no influence on the decision in the opposition proceedings. This standpoint might be the subject of some controversy if the case reaches the courts:

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- On the one hand, SIPO applied by analogy the conditions for assessing the similarity of two conflicting trademarks. Under that test, it is relevant in certain circumstances whether the earlier trademark has been put to genuine use.
- On the other hand, SIPO explicitly held that it was irrelevant whether the registered activities of the company had actually been carried out on the market. This seems to put earlier company names in a more favourable position than earlier trademarks.

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