World Trademark Review™ Daily

SIPO: limitation of goods/services within class not possible at renewal

Slovenia - ITEM d.o.o

Examination/opposition
National procedures

April 01 2015

In a decision dated February 26 2015 concerning the renewal of the Slovenian national trademark EVA, owned by Podravka dd, the Slovenian Intellectual Property Office (SIPO) has decided that it is not possible to limit the list of goods and services within a class when applying for the renewal of a trademark registration, even though Article 52(3) of the Industrial Property Act explicitly states that "a trademark may be renewed […] for all goods or services or […] only for some of the goods or services".

Although Article 52 of the Industrial Property Act, which explicitly allows the limitation of the list of goods and services when applying for the renewal of a trademark registration, has been valid since 2001, SIPO had not allowed such limitations until December 2013. Before that date, the trademark holder first had to file a request for the limitation of the list of goods and services and pay a separate recordal fee; only then could the trademark holder file for the renewal of the trademark.

The problem with such interpretation of the law was not only that it was obviously contrary to the Industrial Property Act, but also that Article 9(3) of the act states that, if a renewal fee is not paid entirely, it is deemed not to have been paid at all. As a result, trademark holders were hesitant to challenge this SIPO practice, even though it was obviously wrong, because they risked losing the entire trademark registration. For example, if a trademark holder paid the renewal fee only for three classes for a trademark which initially covered four classes, and indicated which three classes should be renewed, SIPO - according to its pre-2013 practice - would deem that no renewal fee had been paid.

In December 2013 SIPO changed its practice. A trademark holder, Kartuzija Pleterje, requested the renewal of the trademark KARTUZIJA PLETERJE (No 200371821) only for three classes (the registration initially covered six classes). For the first time, SIPO allowed such limitation at the time of renewal without requesting that the limitation be recorded and paid separately. Thus, it was clear that limitation at the time of renewal was possible when entire classes were removed from the list of goods and services.

In the present case, in February 2015 Podravka requested the renewal of the trademark EVA (No 200570395) and simultaneously requested the limitation of the list of goods and services within a class, meaning that the number of classes remained the same, but the content of the list was to be restricted. In its decision of February 26 2015, SIPO renewed the trademark registration but, surprisingly, did not limit the list of goods and services as requested. Although SIPO essentially denied the holder's request for limitation, it failed to explain in the decision why the limitation had not been recorded. The trademark holder decided not to contest the SIPO's decision, but instead filed a separate request for recordal of the limitation of the list of goods and services.

Given that the costs of contesting SIPO decisions before the Administrative Court are significantly higher than the costs of filing a separate request for recordal of the limitation of the list of goods and services, it is expected that such decisions will not be challenged, even though SIPO's existing practice is still contrary to the explicit provisions of Article 52(3) of the Industrial Property Act.

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