

SLOVENIA

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Prior to 1991, Slovenia formed a part of the former Socialist Federative Republic of Yugoslavia. Slovenia seceded from Yugoslavia and became an independent State on 25 June 1991. In 1992, a new Industrial Property Act came into force and the Slovenian Intellectual Property Office (SIPO) was established. The Industrial Property Act of 1992 was replaced by the new Industrial Property Act on 7 December 2001. Amendments took effect on 11 March 2006 and on 21 December 2013. As of 1 May 2004, Slovenia became a member of the European Union and accepted its entire *acquis communautaire*.

PART 1 PATENTS

§1.01 SUMMARY

[A] Kinds of Patents

- National patent
- Short-term national patent
- Secret national patent
- European patent

[B] Duration of Patents

- 20 years from filing for national patents and secret national patents examined for substantive patentability requirements and for European patents validated in Slovenia
- 10 years from filing for national patents not examined for substantive patentability requirements and for short-term national patents

[C] Patentable / Not Patentable

- A patentable invention must be new, involve an inventive step and be industrially applicable.
- The exceptions of Rule 39 PCT apply.
- Computer programs as such are not patentable.
- Also not patentable are: the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene; processes for cloning human beings; processes for modifying the germ line genetic identity of human beings; uses of human embryos for industrial or commercial purposes; processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.
- A short-term patent cannot be obtained for processes. For obtaining a short-term patent, the condition of inventive step is replaced by the condition of *creative effort*.

[D] Novelty

- Absolute novelty is required.

[E] Requirements and Procedure

- Filing languages: Any
- Language of translation: Slovenian
- Time limit for filing translation: 3 months from SIPO's invitation
- National patents are granted after examination for formalities, but are enforceable only after substantive examination
- Short-term patents are granted and enforceable after examination for formalities.

[F] Specific Aspects of Regional Patents

- Validation of a European patent in Slovenia is possible.

[G] Specific Aspects of International Patent Applications (PCT)

- Direct national phase to Slovenia under the PCT is abolished for all PCT applications having an international filing date later than 1 December 2002. Such PCT applications can reach Slovenia only through validation of European patents in Slovenia.

[H] Governmental Websites

- www.uil-sipo.si (The Slovenian Intellectual Property Office)
- www2.uil-sipo.si/dse.htm (Register)

§1.02 DETAILED INFORMATION

[A] Conventions and Legislation

[1] Conventions

- Paris Convention for the Protection of Industrial Property (International Union), 1883–1967, effective 25 June 1991;
- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs);
- Convention Establishing the World Intellectual Property Organization (hereinafter ‘WIPO Convention’), 1967–1999, effective 25 June 1991;
- Patent Cooperation Treaty (PCT), 1970–2001, effective 1 March 1994;
- Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure, 1977–1980, effective 12 March 1998;
- International Convention for the Protection of New Varieties of Plants, 1961–1991, effective 29 July 1999;
- Convention on the Grant of European Patents of 5 October 1973 as last revised on 29 November 2000 and entered into force on 13 December 2007;
- Protocol on the Interpretation of Article 69 of the Convention on the Grant of European Patents of 5 October 1973;
- Protocol on the Centralisation of the European Patent System and on its Introduction;
- Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent;
- London Agreement dated 17 October 2000 on the application of Article 65 of the Convention on the Grant of European Patents, effective 1 May 2008;
- Act Revising the Convention on the Grant of European Patents of 29 November 2000;
- Implementing Regulations to the Convention on the Grant of European Patents, as last amended by decision of the Administrative Council of the EPO of 7 December 2006, and as applicable from 1 April 2008;
- Agreement between the Government of Slovenia and the European Patent Organisation on cooperation in the field of patents (applicable for requests for extension of European patents filed before 1 December 2002);
- Agreement implementing Article 3(3) of the Agreement between the Government of Slovenia and the European Patent Organisation on cooperation in the field of patents (applicable for requests for extension of European patents filed before 1 December 2002);
- Strasbourg Agreement Concerning the International Patent Classification, 1971–1979, effective 10 May 2002;
- EU Regulation No. 1768/92 EC of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products;
- EU Regulation No. 2100/94 EC of 27 July 1994 on Community plant variety rights;
- EU Regulation (EC) 1610/96 of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products;
- EU Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions;
- EU Directive 2004/27/EC of 31 March 2004 amending Directive 2001/83/EC on the Community code relating to medicinal products for human use;
- EU Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights;
- EU Regulation (EC) No. 1901/2006 of 12 December 2006 on medicinal products for paediatric use;
- EU Regulation (EC) No. 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products (Codified version);
- EU Regulation (EU) No 1257/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (not yet in force);

- EU Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements (not yet in force); and
- Agreement of 19 February 2013 on a Unified Patent Court (not yet in force).

[2] *Laws*

- Industrial Property Act published on 7 June 2001, which took effect on 7 December 2001, amendments effective since 11 March 2006 and 21 December 2013. This act covers patents, trademarks, appellations of origin and designs;
- Plant Variety Protection Act (published in Official Gazette of the Republic of Slovenia No. 86/98 on 18 December 1998);
- Integrated Circuit Topography Act of 2003;
- Rules on the registers of applications and industrial property rights and on the certificate of the priority right of 2001;
- Decree on the legal protection of biotechnological inventions of 2003;
- Decree implementing Council Regulations (EC) concerning the creation of a supplementary protection certificate for medicinal products and for plant protection products (reference to Council Regulation (EEC) No. 1768/92 of 18 June 1992 concerning the supplementary protection certificate for medicinal products is to be taken as a reference to Regulation (EC) No. 469/2009 of the European Parliament and of the Council of 6 May 2009 (Codified version), and should be read in accordance with the correlation table in Annex II hereto – 2. paragraph of Article 22);
- Decree on the extension of European Patents to Slovenia (Official Gazette RS, No. 15/2002) (applicable for requests for extension of European patents filed before 1 December 2002);
- Rules on the contents of patent applications and divisional patent procedure (Official Gazette RS, No. 102/2001);
- Penal Code of the Republic of Slovenia; and
- Act Implementing the Customs Regulations of the European Community.

[B] Kinds of Patents

The kinds of patents are as follows:

- National patent
- Short-term national patent
- Secret national patent
- European patent.

Short-term patents are granted for all subject matter for which a regular patent may be granted, except for processes. The requirements of novelty and industrial applicability are identical to requirements for a national patent, except for the requirement of sufficient inventive step necessary for the regular patent, which is replaced by a less strict requirement for short-term patents, namely the invention must be the result of creative effort. Short-term patents have duration of only ten years. Although short-term patents are not examined for substantive patentability requirements (novelty, industrial applicability, result of creative effort), these are enforceable against infringers. This is the main advantage in relation to national patents which are not enforceable, unless these have been examined for substantive patentability requirements.

Secret patents may be granted for inventions relating to the national defence or national security. These must be filed with the Ministry of Defence of the Republic of Slovenia. If the SIPO believes that a patent application fulfils the requirements for a secret patent, the applicant

is informed that the application must be filed with the Ministry of Defence. The SIPO will continue with the patent application procedure only if the Ministry of Defence declares that it does not wish to use the invention or that it agrees with the patent application to be filed with the SIPO. There are no provisions in the law how the Ministry of Defence should proceed with the secret patent.

Depending on ratification of the Agreement on a Unified Patent Court, a European patent granted after the entry into force may, at the applicant's choice, alternatively be registered as a European patent with unitary effect for a large number of EU member states ('EU patent'). See for more details the chapters 'European Union' and 'European Patent System' in the section 'Patents' under 'Conventions and Legislation'.

[C] Duration of Patents

The regular duration of a national patent, secret patent and European patent validated in Slovenia is twenty years from the date of filing the patent application, provided all annuities are paid.

However, national patents, which have not been examined for substantive patentability requirements, and short-term patents, have a duration of ten years, provided all annuities are paid.

[1] Supplementary protection certificate

Under the European Union Regulation No. 1768/92 EC of 18 June 1992, concerning the creation of a Supplementary Protection Certificate for Medicinal Products, the duration of protection of pharmaceutical inventions protected in Slovenia either by a national patent or by a European patent validated in Slovenia, may be extended by the grant of a supplementary protection certificate. The period with which the duration of protection may be extended under said Regulation is equal to that lapsed between the date of filing the European patent application or Slovenian national patent application and the date of grant of the first marketing authorization in any of the EU member countries, less five years, provided, however, that the extension period may not exceed five years.

Furthermore, EU Regulation No. 1901/2006 EC has been introduced whereby a fixed extra six months extension of the duration of a supplementary protection certificate may be obtained for some (adult) medication which is prescribed to children and which has been specifically tested on this population group.

The foregoing implies that:

- if the first marketing authorization in the EU has been granted within five years of the date of filing the patent application, no supplementary protection certificate can be obtained;
- if the first such authorization in the EU has been granted between five and ten years of the date of filing the patent application, the duration of the certificate may be between zero and five years, depending on when that authorization was granted;
- if the first such authorization in the EU has been granted between ten and twenty years of the date of filing the patent application, a certificate with a duration of five years may be obtained; and
- for medication prescribed to children, a fixed six months extension may be obtained on top of the maximum five-year SPC.

The period of validity for the certificate runs from expiration of the basic patent.

The Regulation applies to products protected by patent in the territory of EU Member States (Slovenia) which, before they may be brought onto the market, are submitted as medicine to an administrative authorization procedure according to Council Directive 65/65/EEC or

Directive 81/851/EEC. ‘Product’ in this context means: the active ingredient or composition of active ingredients of a medicine. ‘Medicine’ in this context means: any substance or combination of substances, presented for treating or preventing disease in human beings or animals, and any substance or combination of substances which may be administered to human beings or animals with a view to making a medical diagnosis or to restoring, correcting or modifying physiological functions in human beings or animals.

Furthermore, under Regulation No. 1610/96 EC, which came into force on 8 February 1997, the duration of an invention relating to a plant protection product covered by a Slovenian national patent or by European patent valid in Slovenia may be extended by the grant of a supplementary protection certificate. The provisions of this Regulation are similar to those of the above-mentioned Regulation No. 1768/92 EC for Medicinal Products.

The possibility of extension of protection under said Regulation applies to any product protected in the Member States (Slovenia) by a patent which is subject, prior to being brought into the market as a plant protection product, to an administrative authorization procedure as laid down in Article 4 of Directive 91/414/EEC. ‘Plant protection products’ are – active substances and preparations containing one or more active substances, put up in the form in which they are supplied to the user, and intended:

- (a) to protect plants or plant products against all harmful organisms or prevent the action of such organisms, insofar as such substances or preparations are not otherwise defined hereafter;
- (b) to influence the life processes of plants, other than as a nutrient;
- (c) to preserve plant products, insofar as such substances or products are not subject to special EU Council or Commission provisions on preservatives;
- (d) to destroy undesirable plants; or
- (e) to destroy parts of plants, check or prevent undesirable growth of plants.

‘Active substances’ means, substances (i.e., chemical elements and their compounds as they occur in nature or by manufacture, including any impurity inevitably resulting from the manufacturing process) or micro-organisms including viruses, having general or specific action:

- (a) against harmful organisms; or
- (b) on plants, parts of plants or plant products.

The inventions whose protection may be extended as aforesaid are those covered by a basic patent for a product as such (defined as the active substance or combination of active substances of a plant protection product), or by a basic patent for a process for obtaining such product, or by a basic patent for an application of such product, or by a basic patent for a preparation (defined as a mixture or solution composed of two or more substances, of which at least one is an active substance, intended for use as plant protection product).

[D] Requirements for Renewal

For national patents and short-term national patents, the application fee covers the first three years of maintenance. Annuities for the maintenance of national patents and short-term patents are due in respect of the fourth year and the following years from filing the application. Annuities are due on the anniversary of the filing date. Apart from payment of the maintenance fees and delivering to the SIPO evidence on payment together with details of the respective patent, there are no further requirements.

Annuities must be paid also for European patents extended to Slovenia for each year following that in which the granted European patent was published. Please note that with European patents, only the first and the second year annuities (and not the third as with national patents) are deemed to be paid with the application fee.

If the annuity is not paid within mentioned period, it may still be paid within an additional six-month grace period, but an additional fine of 50% of the basic annuity must be paid. If the annuity is not paid in due time nor, with the applicable fine, within the six-month grace period, the patent will lapse. As to the possibility of restoring a lapsed patent (application), see ‘Restoration’.

[E] Patentable / Not Patentable

- Patents are granted for inventions which are new, involve an inventive step and are susceptible to industrial application.
- An invention involves an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.
- An invention is considered as susceptible to industrial application if it can be made or used in any kind of industry, including agriculture.
- The exceptions as mentioned in Rule 39 PCT are not patentable.
- Short-term patents are granted for all subject matter for which a regular patent may be granted, except for processes. The requirements of novelty and industrial applicability are identical to requirements for a national patent, except for the requirement of sufficient inventive step necessary for the regular patent, which is replaced by a less strict requirement for short-term patents, namely the invention must be the result of creative effort.

[1] Chemical compositions

Chemical products may be patented.

[2] Pharmaceuticals

Pharmaceuticals may be patented.

[3] Second use

The first, second and further medical use or non-medical use of a known substance or composition may be patented, although not explicitly defined in the Industrial Property Act. The SIPO and Slovenian courts would be guided by relevant provisions of the European Patent Convention and by case law of the European Patent Office.

[4] Treatment of the human body

Inventions of surgical or diagnostic methods or methods of treatment practised directly on the living human (or animal body) are not patentable.

[5] Biological materials

According to the EU Biotechnology Directive of 1998, microbiological or other technical processes or products obtained by means of such processes may be patentable.

An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element. The

industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

The following are also not patentable (see under ‘Immoral inventions or inventions contrary to public order’):

- (a) processes for cloning human beings;
- (b) processes for modifying the germ line genetic identity of human beings;
- (c) uses of human embryos for industrial or commercial purposes; and
- (d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

[6] Plant varieties

Plant (and animal) varieties, as well as essentially biological processes for the production of plants or animals, may not be patented. Inventions which concern plants or animals may however be patentable if the technical feasibility of the invention is not confined to a particular plant or animal variety.

According to the EU Biotechnology Directive of 1998 plant variety rights for the European Union may be obtained under the Regulation No. 2100/94 EC of 27 July 1994. As plant variety is considered, any plant grouping within a single botanical tax on of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety right are fully met, can be:

- (1) defined by the expression of the characteristics that results from a given genotype or combination of genotypes;
- (2) distinguished from any plant grouping by the expression of at least one of the said characteristics; or
- (3) considered as a unit with regard to its suitability for being propagated unchanged.

[7] Software-related inventions

Computer programs as such are not patentable. However, an invention involving the use of a computer program may be patentable if the invention leads to a technical result and provided that the requirements for patentability are met, then a patent may be granted. The Slovenian Courts and the SIPO will in doubt very likely follow the practice of the European Patent Office (EPO).

[8] Business methods

Rules, schemes, methods and processes for performing mental acts as such are not patentable.

[9] Immoral inventions or inventions contrary to public order

According to the EU Biotechnology Directive of 1998, inventions shall be considered unpatentable where their commercial exploitation would be contrary to public order or morality; however, exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation.

The following, in particular, shall be considered unpatentable:

- (a) processes for cloning human beings;
- (b) processes for modifying the germ line genetic identity of human beings;
- (c) uses of human embryos for industrial or commercial purposes; and
- (d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

[10] Semiconductors

Protection for integrated circuit topographies may be obtained under the Integrated Circuit Topography Act of 2003.

[F] Novelty

Absolute novelty applies. An invention is considered to be new if it does not form part of the state of the art. The state of the art comprises everything made available to the public by means of an oral or written description, by use, or in any other way, before the date of filing or if the priority is claimed, before the priority date of the patent application.

The contents of the following applications, which have been filed before the date referred to in the previous paragraph and which were published on or after that date, are also considered as comprised in the state of the art:

- (1) national patent applications, as originally filed with the SIPO;
- (2) European patent applications, as originally filed with the EPO, requesting protection in the Republic of Slovenia; and
- (3) international applications, as originally filed under the PCT, received by the SIPO as the elected Office.

[1] Grace period

There is no general grace period.

A six-month grace period applies in certain circumstances. Therefore, disclosure of the invention is not a bar to novelty if it occurred no earlier than six months preceding the filing of the application and if it was due to, or in consequence of the following:

- (1) An evident abuse in relation to the applicant or his/her legal predecessor.
- (2) The fact that the applicant or his/her legal predecessor has displayed the invention at an official, or officially recognized, international exhibition under the Convention on International Exhibitions. If the applicant wants to benefit from the grace period based on the exhibition, he/she must indicate so (and provide appropriate evidence) already at the filing of a patent application.

[G] Applicant

One or several natural persons or legal entities may apply for and become a holder of a patent in Slovenia. It is not necessary that the applicant shows in the patent application any connection with the invention or inventors, for example the SIPO does not request any documents showing that the applicant is the assignee.

However, an inventor, his/her heir or other successor in title may, at any time during the

validity of a patent, file an action with a court requesting that he/she be declared owner of the patent, if the patent has been granted in the name of a person who is not the inventor, his/her heir or other successor in title.

Foreign applicants have equal rights as Slovenian applicants on the basis of an international agreement or convention which Slovenia is a member of or on the basis of reciprocity. A party invoking reciprocity must prove the existence thereof.

[H] Assignment

Both a granted patent and a pending application may be assigned. The assignor or the assignee may request that the assignment is recorded into the patent register. If the request is filed by the assignor, no documentation to prove the assignment is required. If the request is filed by the assignee, the assignment deed signed by the assignor and the assignee is required. Notarization or legalization of the assignment document is not necessary.

[I] Requirements for Filing

[1] Obligation to file first with national office

There is no obligation to first file a patent with the SIPO, but applications concerning national security must be filed first with the Slovenian Ministry of Defence.

[2] Minimum requirements for obtaining filing date / Provisional applications

The following requirements must be met to obtain a filing date:

- (1) a statement, in Slovenian, French, German, Spanish or English, to the effect that the acquisition of a patent is requested;
- (2) indications, in Slovenian, French, German Spanish or English, allowing the identity of the applicant to be established or allowing the applicant to be contacted by the SIPO; and
- (3) a description, in any language, provided a translation into Slovenian is filed within three months from receiving the SIPO's request to submit the translation.

The law does not provide for any special type of provisional applications.

[3] Request for grant

An application on prescribed form must be signed by the applicant or the agent, stating the following information:

- full name and address of the applicant(s);
- name and address of the inventor(s);
- title of the invention defining its subject matter; and
- priority date, country and application number, if priority is claimed. Priority Certificate is required only upon request, usually not requested.

The application form must be accompanied by:

- a description of the invention;
- one or more claims;

- a short summary of the subject matter of the invention (the abstract); and
- if necessary, one or more drawings of the invention.

[4] Appointment of Representative

Foreign applicants must appoint an authorized registered patent attorney in Slovenia to represent them before the SIPO.

[5] Power of Attorney / Designation of inventor / Other documents

The power of attorney must be signed by the applicant and filed within three months of any official request. Notarization or legalization is not required.

Naming of the inventors in the application is compulsory.

[6] Priority

Convention priority may be claimed. Priority must be claimed on filing the application by stating at least the date of the priority application. The number of the priority application and the country may be submitted subsequently within three months from the filing date.

The priority period is twelve months from the filing date of the application whose priority is claimed. Multiple and partial priorities are allowed. A Priority Certificate may be required upon request. If the translation is requested by the SIPO, the certification of the translation is not necessary. However, if the translation is requested later within a court procedure (e.g., infringement action, invalidation action), the translation must be done and certified by a court interpreter.

[7] Allowable language(s) upon filing / Language(s) of procedure

At the filing:

- a statement to the effect that the acquisition of a patent is requested must be in Slovenian, French, German, Spanish or English;
- indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the SIPO, must be in Slovenian, French, German, Spanish or English; whereas
- a description, claims, abstract and other details may be in any language, provided a translation into Slovenian is filed within three months from receiving the SIPO's request to submit the translation.

The language of the procedure is Slovenian. The entire patent application, including application form with the required data, description, claims and abstract must be translated into Slovenian and filed with the SIPO within three months from receiving the SIPO's request for the translation.

[8] Description

The description must describe the invention sufficiently clear and in sufficient detail so as to enable a person skilled in the art to execute the invention on the basis thereof. The specification must begin with the title of the invention as given in the application form, and must include a presentation of the technical problem to be solved, details of the state of the art or of other

solutions to the problem being available and the disadvantages of those solutions, and a description of the solution of the problem offered by the invention.

If an invention relates to biological material which is not available to the public and cannot be described in a manner to be carried out by a person skilled in the art to which the subject matter of the invention relates, the description of the invention must be supplemented by a certificate of the deposit of biological material with an international depository authority under Article 7 of the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure of 28 April 1997, and amended on 26 September 1980 (Official Gazette RS-MP No. 21/97).

[9] Claims

The claims define the subject matter for which protection is sought. These must be clear and concise and be supported by the description. Plurality of independent claims is allowed, provided the unity requirement is met.

Multiple dependency of claims is permitted.

[10] Abstract

The abstract serves the purpose of technical information only and is published in the Official Bulletin. If the application contains drawings, the drawing that most closely characterizes the invention should accompany the abstract.

[11] Drawings

The drawings must be filed if the same are necessary for understanding the invention.

[12] Payment of fees

Payment of the application fees must be submitted with the application, or subsequently within three months from receiving the SIPO's invitation. This time limit is extendable by three months upon filing a special request.

For national patents, application fee covers also publication, grant and the first three years of maintenance. Annuities for the maintenance of patents or short-term patents are due in respect of the fourth year and the following years from filing the application.

[J] Procedure

[1] Filing Authority

Patent applications are filed with the Slovenian Intellectual Property Office (SIPO).

[2] Online filing

Online filing is not available.

[3] Formal examination

Patent applications are examined for formal requirements, unity of invention and whether or not the invention is obviously unpatentable. If these requirements are not met, the applicant will be informed thereof and invited to remedy the defects within three months. This period may be extended by an additional three months. If the applicant fails to amend the application in due time, the patent application will be refused.

[4] Search

No official search by the SIPO for prior patents or published applications on the Register is made.

[5] Obligation to submit corresponding foreign search results and/or application numbers

If no European patent application has been filed, the patent holder must submit foreign search results and/or application numbers following substantive examination by any authority having the status of a Preliminary Examination Authority under Article 32 of the PCT. However, this obligation is applicable only for national Slovenian patents within the procedure of submitting the written documents.

[6] Substantive examination

The SIPO does not perform an examination of substantive requirements for granting a national or short-term national patent (novelty, inventive step/creative effort, and susceptibility to industrial application).

Within twelve months from the application date, the applicant must indicate whether the application should be regarded as a short-term patent application. For the national patent to become enforceable in court and to acquire its full duration of twenty years, written evidence must be submitted to the SIPO.

Such evidence must prove that the patented invention fulfils all substantive patentability requirements.

The written evidence should be submitted before the end of the ninth year from the application date. If it is not submitted in due time, the patent expires by the end of the tenth year from the application date. The written evidence is not required for short-term patents and for granted European patents validated in Slovenia.

The written evidence can be any one of the following documents:

- (1) A Slovenian translation of a European patent (or several European patents) granted for the same invention by the EPO. The entire patent specification must be translated into Slovenian.
- (2) Only if no application for a European patent has been filed, the written evidence can be a Slovenian translation of a patent for the same invention granted, following substantive examination, by any authority having the status of a Preliminary Examination Authority under Article 32 of the PCT or by Patent Office of the UK, Germany, Romania and Hungary with which SIPO has concluded a relevant treaty. The entire patent specification must be translated into Slovenian.
- (3) Only if the patent holder has no document indicated under items (1) or (2) above, he/she may request that the SIPO obtain relevant data and opinions from any of the authorities or offices listed under item (2) above, which will be considered as the written evidence.

If a document indicated under item (2) is submitted as the written evidence, the patent holder

must also submit a list and copies of all corresponding foreign patents for the same invention which will form part of the written evidence and should also include those patent applications and patents which have been refused. If this list and the corresponding copies are not submitted with the written evidence, the written evidence is deemed not to be submitted.

For short-term patents, the requirement for written evidence does not apply. The short-term patents are enforceable already without the written evidence.

[7] Accelerated examination

Usually the unexamined national patent or short-term national patent is granted after eighteen months from the application date. Upon special request, the national patent or short-term national patent may be granted three months from the application date at the earliest.

PPH agreements are not applicable.

[8] Amendments and corrections

A patent application may be amended up until publication and grant of the patent. The SIPO may require the application to be amended. Amendments, which broaden the scope of the originally filed application, are not allowed.

[9] Third party observations

The law does not provide for any third-party observations.

[10] Grant

The average processing time from filing to grant is eighteen months. The patent is granted if all formal requirements are met, and at the same time the patent application is published in the Official Bulletin. Upon special request, the national patent or short-term national patent may be granted three months from the application date at the earliest.

[11] Re-examination

The law does not provide for a re-examination procedure.

[12] Opposition

The law does not provide for an opposition procedure.

[13] Appeal

If a patent application is refused, an appeal in the form of an administrative action may be lodged with the Administrative Court within thirty days from the day the applicant or his/her representative received the decision on refusal.

[14] Continuation applications

Not applicable in this jurisdiction.

[15] Unity of invention / Divisional applications

A patent application must relate to one invention or to a group of inventions so linked together as to form a single inventive concept. Divisional applications may be filed before the SIPO issues a decision on the publication of the application and will, if duly filed, retain the filing and priority date of the parent patent application.

[16] Conversion

Within twelve months from the application date of a regular patent, the applicant may request that the application should be regarded as a short-term patent application. The conversion from a short-term patent application into a regular patent application is not allowed.

[17] Publication / Public File Inspection

If the application passes the formal examination, it is granted and published in the Official Bulletin of the SIPO after eighteen months from the filing date or from the priority date if priority is claimed. The applicant may request early publication of the application, but the application may not be published before the expiration of three months from the date the application was received in correct form.

The files relating to patent applications, which have not yet been published in the Official Journal are subjected to official secrecy. They are made available for inspection only with the consent of the applicant. However, any person who can prove that, in relation to his/her acts, the applicant informed him/her in writing about his/her application and the scope of requested protection, may obtain inspection of the files which are otherwise officially secret without the consent of the applicant.

Even prior to the publication of the patent application in the Official Journal, the Office may publish the following data or communicate them to third parties:

- the number of the application;
- the date of filing of the application and, where the priority is claimed, the date, State or Office and file number of the previous application;
- data concerning the applicant (surname, forename and address, or firm and seat); and
- the title of the invention.

[18] Withdrawal to prevent publication

An applicant may, at any time in the course of a proceeding, withdraw a patent application, which will be deemed to be withdrawn as of the date when the Office receives the withdrawal request. The withdrawn patent application will not be published, except when the patent application is withdrawn after technical preparations for publication of the application have been completed. If the applicant withdraws a request for the grant of a patent after technical preparations for publication of the application have been completed, and the application has been published, the publication of the application shall not be deemed to form part of the state of the art.

[K] Nullity and Lapse

Anyone at any time during the duration of a patent may sue the patent holder before the Circuit Court in Ljubljana to invalidate a granted patent (including a European patent validated in Slovenia).

The grounds for invalidation are as follows:

- invention was granted contrary to substantive patentability requirements (novelty, industrial applicability, inventive step) and patentability exclusions;
- the invention was insufficiently disclosed in the patent specification; or
- the scope of the granted patent extends beyond the originally filed patent application.

Depending on ratification of the Agreement on a Unified Patent Court, the Unified Patent Court will have jurisdiction concerning the validity of European patents registered in the EU Member States that ratify or adopt the Agreement. During a transitional period of at least seven years patentees will however have the option to file an ‘opt-out’ notice that nationally registered European patents do not fall under the jurisdiction of the Unified Patent Court, but under the jurisdiction of the respective national courts. See for more details the chapters ‘European Union’ and ‘European Patent System’ in the section ‘Patents’ under ‘Conventions and Legislation’.

[L] Use Requirement

Not applicable in this jurisdiction; the law defines no use requirements.

[M] Marking

Not applicable in this jurisdiction; the law defines neither obligation nor prohibition of the use of any symbol in connection with the patent, and marked products have no implications for awarding compensation in case of past infringement.

[N] Licenses

Exclusive and non-exclusive voluntary licenses may be granted under a patent as well as under a patent application. License agreements must always be in writing. A license agreement must in particular specify the duration of the license, its scope and whether the license is exclusive or non-exclusive.

Upon request, the court may grant a compulsory license when:

- such license is in the public interest concerning, in particular, national security, nutrition, health or the development of other vital sectors of the national economy; or
- the holder of the patent or his/her licensee abuses the patent rights, in particular where the manner of exploitation, contrary to the legislation, restrains competition.

The plaintiff must prove that he/she has made efforts to conclude a license contract with the holder of the patent on reasonable commercial terms, and those efforts failed to succeed within a reasonable period of time.

If granted, the compulsory license is issued under the following terms:

- scope and duration of the license are limited with regard to its purpose;
- it is non-exclusive;
- it cannot be sublicensed;

- it is granted primarily for the supply of the Slovenian market; and
- the patent holder is entitled to compensation for compulsory license.

[O] Pledge and Seizure

The patent can be pledged in accordance with Article 190 of the Property Code published in Official Gazette of the Republic of Slovenia No. 87/02 on 17 October 2002).

Although not explicitly defined in the law, it is advisable to have the pledge agreement recorded into the patent register in order to have effect towards third persons.

The patent can be seized in accordance with Articles 162 and 163 of the Enforcement and Securing of Civil Claims Act published in Official Gazette of the Republic of Slovenia No. 51/98 on 17 July 1998 as amended).

[P] Infringement

[1] Infringing acts / Non-infringing acts

The scope of protection conferred by a patent is determined by the claims, whereas the description and drawings are used to interpret the claims.

The patent holder has the following rights:

- (1) where the subject matter of a patent is a product, to prevent third parties not having the holder's consent from the acts of making, using, offering for sale, selling or importing for these purposes that product; and
- (2) where the subject matter of a patent is a process, to prevent third parties not having the holder's consent from the act of using the process, and from the acts of offering for sale, selling or importing for these purposes the product obtained directly by that process.

The use of a patented substance as a medicine for humans or animals is not deemed infringement if the corresponding patent application was filed before or on 31 December 1992, or claimed priority from an application filed before or on 31 December 1992.

Furthermore, the following is not considered infringement of a patent:

- (1) Acts done privately and for non-commercial purposes.
- (2) Acts done for research and experimental purposes of any kind relating to the subject matter of the patent irrespective of their final purpose.
- (3) The extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with neither a medical prescription nor acts concerning the medicine so prepared.
- (4) The use on board vessels of other countries in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of the Republic of Slovenia, provided that the invention is used there exclusively for the needs of the vessel.
- (5) The use of the patented invention in the construction or operation of aircraft or land vehicles of other countries, or of accessories to such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the territory of the Republic of Slovenia.
- (6) The acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944, where these acts concern the aircraft of a State benefiting from the provisions of that article.

Experiments and trials, both pre-clinical and clinical, conducted in pursuance of seeking regulatory approval for a generic or similar biological medicinal product, do not constitute

infringement. Also, manufacture/importation of the active ingredient and batches in order for such tests to be performed does not constitute infringement.

Exhaustion of patent rights: Not infringing are acts concerning the product covered by that patent which are carried out within the country after that product has been put on the market in the European Economic Area by the proprietor of the patent or with his/her consent, unless there are legitimate grounds for the proprietor to oppose further commercialization of the product.

[2] Prior user rights

Any person who, before the filing date (or if the priority is claimed, before the priority date), had already in good faith been using the invention in Slovenia, or had made the necessary preparations for such use, may continue such use within its limits.

[3] Remedies

If an infringement lawsuit is based on a national patent which has not been examined for substantive patentability requirements, the court will suspend the proceedings until the SIPO decides whether the written evidence filed by the patent holder is appropriate.

Short-term patents are enforceable, even though these are unexamined for substantive patentability requirements.

The Circuit Court in Ljubljana has exclusive jurisdiction over all patent infringement cases in Slovenia.

The plaintiff may claim the following:

- (1) that the infringer be prohibited from future infringing acts;
- (2) that the infringer removes the objects of the infringement from the channels of commerce, or destroys these where there is no other way to cease the infringement;
- (3) that the infringer removes the means of the infringement that are used or intended exclusively or almost exclusively for the creation of the infringing goods, or destroys these where there is no other way to cease the infringement;
- (4) that the final judgment be published in public media at the infringer's expense, to the extent and in the manner determined by the court; and
- (5) damages according to general tort regulations.

Damages may be collected for a period later than five years prior to initiating a lawsuit.

The person entitled to sue for infringement is the patent holder and the exclusive licensee.

If a patent covers a process for obtaining a new substance, such substance is deemed, in the absence of proof to the contrary, to be of an identical composition or identical and made under the protected process. The burden of proof rests with the defendant or alleged infringer whose legitimate interests in protecting his/her business secrets must be taken into account.

A temporary injunction will be granted upon request if the following conditions are met and proved by the plaintiff:

- (1) the plaintiff is a holder or an exclusive licensee of the respective patent;
- (2) patent rights are already being infringed, or it is very likely that infringement will take place; and
- (3) the plaintiff requested the temporary injunction within three months after he/she had learnt of the alleged infringement.

For temporary injunction, the plaintiff must also prove at least one of the following conditions:

- danger plaintiff would have.

Depending on ratification of the Agreement on a Unified Patent Court, a European patent granted after the entry into force may, at the applicant's choice, alternatively be registered as a European patent with unitary effect for a large number of EU members ('EU patent'). The Unified Patent Court will have jurisdiction concerning the infringement (and validity) of EU patents, as well as European patents registered in the EU Member States that ratify or adopt the Agreement. During a transitional period of at least seven years patentees will however have the option to file an 'opt-out' notice that nationally registered European patents do not fall under the jurisdiction of the Unified Patent Court, but under the jurisdiction of the respective national courts. See for more details the chapters 'European Union' and 'European Patent System' in the section 'Patents' under 'Conventions and Legislation'.

[4] Penal provisions

Unjustified and intentional use of the patented invention in the course of trade is sanctioned with imprisonment of up to three years.

[5] Enforcement and Customs

Enforcement of the patent rights is available through border measures. Upon the right holder's request, the Customs will suspend the release of the suspected goods. Border measures relating to infringement of patent is regulated by the Regulation (EU) No 608/2013 of the European Parliament and of the Council. Goods suspended at the customs are destroyed upon the patent holder's request and expense, unless the owner or the holder of the suspected infringing goods declares (within ten working days from receiving the customs decision on temporary suspension) that the goods are genuine or that they do not infringe any right. If this declaration is given, the right holder is obliged to file the infringement lawsuit to achieve the destruction of goods, otherwise the goods are released.

[Q] Restoration

Restoration of priority right for a national patent application is possible within two months from the expiration of a regular priority time limit if the applicant shows that the delay occurred in spite of all due care required by the circumstances having been taken.

Provided that a PCT application and a request for restoration is filed at the Receiving Office in this jurisdiction within 14 months from the priority date, restoration of priority right under Rule 26bis.3 in the international phase of the PCT application may be possible.

The restoration of the expired time limit for the fulfilment of the obligations required in the proceedings for the acquisition of a right (e.g., to submit document or pay the application fee) is possible if the restoration request is filed within two months from the removal of the cause of non-compliance with the time limit, or, if the party only learned subsequently about that non-compliance, from the day when the party learned, but no later than six months from the expiration of the time limit. Simultaneously with the restoration request, the omitted act must be carried out, e.g., document submitted or fee paid.

There is no provision for restoration of failure to pay a maintenance fee.

[R] Specific Aspects of Regional Patents

A European patent may be extended to and/or validated in Slovenia. For European patent applications filed before 1 December 2002, this is only possible if extension to Slovenia has been requested.

A European patent application for this purpose is an application which may be filed under

the European Patent Convention, as well as an international patent application filed under the PCT for which the EPO acts as a designated or elected office, and in case of PCT applications filed before 1 December 2002 in which Slovenia is also designated.

Slovenia has been a party to the London Agreement effective since 1 May 2008; however, even before only the claims needed to be translated into Slovenian for validation.

Depending on ratification of the Agreement on a Unified Patent Court, a European patent granted after the entry into force may, at the applicant's choice, alternatively be registered as a European patent with unitary effect for a large number of EU Member States ('EU patent'). See for more details the chapters 'European Union' and 'European Patent System' in the section 'Patents' under 'Conventions and Legislation'.

[1] Filing Authority

A European patent application may be filed with the SIPO or directly with the EPO.

[2] Appointment of Representative

If the applicant is from a Member State of the EPC, it may file the patent application without any representative. Otherwise, the applicant must be represented by the European patent attorney.

[3] Validation

To validate the European patent in Slovenia, an applicant must designate Slovenia in the application form already before the EPO and pay the required fee to the EPO.

A request for validation should be filed with the SIPO within three months from the publication date of a granted European patent. The request should contain the following details and enclosures:

- (1) Exact and full (company) name and address of the holder.
- (2) Title of invention.
- (3) Number and date of European patent application.
- (4) Number of European patent publication.
- (5) Publication date of granted European patent.
- (6) Translation of the patent claims into Slovenian language. Translation of the entire patent specification is not required.
- (7) Evidence on payment of publication fee.
- (8) Power of attorney, duly signed by the patent holder. Notarization or legalization is not required.

Requirements (1) to (7) have to be fulfilled at the time of filing the request. The power of attorney may be filed subsequently, within three months from the SIPO's invitation.

[4] Authentic text

Where the submitted translation of the patent claims confers protection which is narrower than that conferred by a European patent application or European patent in the language of the proceedings, that translation shall be regarded as the authentic text, except for opposition proceedings before the EPO.

[5] Amendments and corrections

The owner of the European patent may file a corrected translation of claims at any time. The corrected translation shall take effect only after it has been published by the SIPO.

Any person who, in good faith, is using or has made effective and serious preparations for using an invention, the use of which would not constitute infringement of the patent in the original translation, may, after the corrected translation takes effect, continue such use in the course of his/her business and for the needs thereof without payment.

[6] Publication

After the translation of the validated European patent claims is submitted, it is published by the SIPO.

[7] Provisional protection

A published European patent application requesting protection in the Republic of Slovenia shall confer the right to claim damages reduced according to the circumstances as from the date on which a translation of the claims of that application as published has been communicated by the applicant to the person using the invention in the Republic of Slovenia.

[8] Simultaneous protection

Where a European patent and a national patent having the same date of filing or, if priority is claimed, date of priority, have been granted to the same person, the national patent shall have no legal effect, to the extent that it covers the same invention as the European patent, as from the date on which the time limit for filing an opposition to the European patent has expired without an opposition having been filed, or as from the date on which the opposition procedure has resulted in a final decision maintaining the European patent.

[9] Conversion

A European patent application requesting protection in the Republic of Slovenia may be converted into a national patent application, where the European patent application is deemed to be withdrawn pursuant to Article 77(3) of the EPC or, because the translation of the application under Article 14(2) of the EPC has not been filed in due time, pursuant to Article 90(3) of the EPC. Requirements and time limits are defined in Articles 135 and 137 of the EPC.

[10] Payment of fees

Annuities for the European patent validated in Slovenia must be paid to the SIPO for the validation, and each year following that in which the granted European patent was published, except for the first and the second year annuities which are deemed to be paid with the application fee. General rule for paying annuities is that these should be paid before each anniversary of the application date. Notwithstanding this general rule, the first European patent annuity that should be paid to the SIPO is deemed timely paid, if it is paid before the expiration of the two months period starting from the publication date of the granted European patent. If none of the mentioned terms for paying the European patent annuity is observed, the annuity may still be paid within the additional six-months grace period starting from the general due

date (i.e., anniversary of the application date); however, the annuity fee is increased by an additional fine of 50%.

[S] Specific Aspects of International Patent Applications (PCT)

[1] Receiving Office

A PCT application may be filed with the SIPO or with the International Bureau of the WIPO.

[2] International Searching Authority

The International Searching Authority for PCT applications coming from Slovenia is the EPO.

[3] International Preliminary Examining Authority

The International Preliminary Examining Authority for PCT applications coming from Slovenia is the EPO.

[4] National phase / Regional phase

The direct national phase to Slovenia under the PCT is abolished for all PCT applications with the international filing date later than 1 December 2002. Such PCT applications can reach Slovenia only through validation of European patents to Slovenia.

[5] Payment of fees

Not applicable because direct national phase to Slovenia under the PCT is abolished.

[T] Fees

[1] Table of official fees

	EUR
Application fee (including the publication, grant and first three years of maintenance).....	110
3rd year for maintenance (only for European patent)	30
4th year for maintenance.....	34
5th year for maintenance.....	42
6th year for maintenance.....	50
7th year for maintenance.....	60
8th year for maintenance.....	70
9th year for maintenance.....	80
10th year for maintenance.....	110
11th year for maintenance.....	154

12th year for maintenance.....	200
13th year for maintenance.....	234
14th year for maintenance.....	274
15th year for maintenance.....	310
16th year for maintenance.....	390
17th year for maintenance.....	510
18th year for maintenance.....	654
19th year for maintenance.....	870
20th year for maintenance.....	1,100

[U] Transitional Provisions

The Industrial Property Act took effect on 7 December 2001. All relevant provisions of this act concerning patent granting procedure and the scope of patent rights also applies retrospectively to those patents and patent applications that had been applied for or granted before the Industrial Property Act came into force.

The exception to this general rule is the duration of the novelty grace period. Under the previous Act, the grace period available in the specific circumstances was twelve months, this is now six months.

[V] Specific Patent Issues

There are no specific patent issues.

[W] Governmental Websites

- www.uil-sipo.si (The Slovenian Intellectual Property Office)
- www2.uil-sipo.si/dse.htm (Register)

PART 2 TRADEMARKS**§2.01 SUMMARY****[A] Duration of Registration**

- 10 years from the application date with unlimited renewals of 10 years.

[B] Registrable / Not Registrable

- A trademark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

[C] Procedure

- Trademark applications are examined ex officio for the formal requirements and for the absolute grounds for refusal.
- An opposition procedure on relative grounds is provided before registration.

[D] Governmental Websites

- www.uil-sipo.si (The Slovenian Intellectual Property Office)
- www2.uil-sipo.si/dse.htm (Register)

§2.02 DETAILED INFORMATION**[A] Conventions and Legislation***[1] Conventions*

- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs);
- Paris Convention for the Protection of Industrial Property (International Union), 1883–1967, effective 25 June 1991;
- Convention Establishing the WIPO Convention, 1967–1999, effective 25 June 1991;
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter ‘Nice Agreement’), 1957–1967, effective 25 June 1991;
- Madrid Agreement Concerning the International Registration of Marks (hereinafter ‘Madrid Agreement’), 1891–1967, effective 25 June 1991;
- Protocol to the Madrid Agreement Concerning the International Registration of Marks (hereinafter ‘Madrid Protocol’), 1989, effective 12 March 1998;
- Nairobi Treaty on the Protection of the Olympic Symbol (hereinafter ‘Nairobi Treaty’), 1981;
- Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (hereinafter ‘Vienna Agreement’), 1973–1985, effective 10 August 2001;
- Trademark Law Treaty and Regulations, 26 May 2002;
- EU Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trademarks;
- EU Council Regulation (EC) No. 40/94 of 20 December 1993, on the Community Trademark, as amended by Regulation (EC) No. 3288/94, Council Regulation (EC) No. 1653/2003 of 18 June 2003 and Council Regulation (EC) No. 422/2004 of 19 February 2004;
- EU Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community Trademark, entered into force on 13 April 2009; and
- EU Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights.

[2] Laws

- Industrial Property Act published on 7 June 2001, which took effect on 7 December 2001, amendments effective since 11 March 2006 and 21 December 2013. This act covers patents, trademarks, appellations of origin and designs;
- Rules on the registers of applications and industrial property rights and on the certificate of the priority right of 2001;
- Decree implementing Council Regulation (EC) on Community designs and Council Regulation (EC) on Community trademarks (Official Gazette RS, No. 4/2007);
- Rules on the contents of trademark applications (Official Gazette RS, No. 102/2001);
- Rules on the procedure concerning requests for the international registration of trademarks (Official Gazette RS, No. 124/2006);
- Penal Code of the Republic of Slovenia; and
- Act Implementing the Customs Regulations of the European Community.

[B] Duration of Registration

The initial and renewed terms are ten years, counted from the application date. The duration is unlimited if maintenance fees are regularly paid every ten years.

[C] Requirements for Renewal

Renewal of a registration is made by the payment of the renewal fee, which may be paid one year before the expiration of the running period. An evidence of fee payment should be enclosed to the renewal request letter sent to the SIPO.

If the renewal fee is not paid within this period, it may be paid within additional six months, with a fine of 50%. As to the possibility of restoring a lapsed trademark due to non-payment of the renewal fee, see 'Restoration'.

[D] Registrable / Not Registrable

A trademark may consist of any signs capable of being represented graphically, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

In particular, the following may be registered as a trademark:

- (1) Words.
- (2) Personal names.
- (3) Designs.
- (4) Letters.
- (5) Numerals.
- (6) The shape of goods or of their packaging.

The following shall not be registered or, if registered, shall be liable to be declared invalid (absolute grounds for refusal):

- (a) Signs which cannot constitute a trademark.
- (b) Trademarks which are devoid of any distinctive character.
- (c) Trademarks which consist exclusively of signs or indications which may serve, in trade, to designate 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) Trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.
- (e) Signs which consist exclusively of:
 - (i) the shape which results from the nature of the goods themselves;
 - (ii) the shape of goods which is necessary to obtain a technical result; and
 - (iii) the shape which gives substantial value to the goods.
- (f) Trademarks which are contrary to public policy or to accepted principles of morality.
- (g) Trademarks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.
- (h) Trademarks which have not been authorized by the competent authorities and are to be refused or invalidated pursuant to Article 6^{ter} of the Paris Convention.

A trademark shall not be refused registration or be declared invalid in accordance with points (b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character.

A trademark shall not be registered or, if registered, shall be liable to be declared invalid (relative grounds for refusal):

- (a) if it is identical with an earlier trademark, and the goods or services for which the

- trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected; or
- (b) if because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.
 - (c) if it is identical with, or similar to, an earlier trademark and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation and where the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark, or if it would indicate a connection between the goods or services of the owners of both trademarks.
 - (d) if its use would contradict an earlier right or if it would indicate a connection between the goods or services and the owner of the earlier mark 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.

‘Earlier trademarks’ in this respect means:

- (a) Trademarks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trademark, taking account, where appropriate, of the priorities claimed in respect of those trademarks:
 - (i) EU trademarks (previously known as Community Trademarks, or CTMs);
 - (ii) national registered trademarks; and
 - (iii) trademarks registered under international arrangements which have effect in the Member State.
- (b) EU trademarks which validly claim seniority from a trademark referred to in (a)(ii) and (iii), even when the latter trademark has been surrendered or allowed to lapse.
- (c) Applications for the trademarks referred to in points (a) and (b), subject to their registration.
- (d) Trademarks which, on the date of application for registration of the trademark, or, where appropriate, of the priority claimed in respect of the application for registration of the trademark, are well known, in the sense in which the words ‘well known’ are used in Article 6*bis* of the Paris Convention.

[1] *Colour marks*

Colour marks may be registered as trademarks. In practice, any combination of colours, or colours and shapes will be deemed as inherently distinctive. However, a mark claiming a single colour as such will not be registered unless the applicant proves that it acquired a distinctive character, so that the consumers recognize the colour as information about the source of goods or services.

[2] *Three-dimensional marks*

A three-dimensional mark may be registered, unless it consists exclusively of the shape which results from the nature of the goods as such, or is necessary to obtain a technical result or gives substantial value to the goods.

[3] Collective marks

Collective trademarks may be registered in the name of associations of legal and natural persons, chambers, business associations, and communes and larger local communities and State authorities.

On filing an application for the registration of a collective trademark, the regulations governing the grant of the right to use the trademark must be filed.

These regulations must at least contain the following:

- (1) the name and seat of the applicant;
- (2) indication of the applicant's business and information concerning the person whom he/she officially and by law represents;
- (3) the conditions of membership;
- (4) data concerning the group of persons having authority to use the collective trademark; and
- (5) provisions concerning the rights and obligations of the members in the event of infringement of the collective trademark.

A collective trademark cannot be assigned, and cannot be the subject of a license.

[4] Certification marks

Not applicable in this jurisdiction.

[5] Associated marks

Not applicable in this jurisdiction.

[6] Series of marks

Not applicable in this jurisdiction.

[7] Other marks

According to the SIPO practice, sound marks, represented by a musical stave, may be registered. It is very likely that the SIPO will follow the case law of the OHIM regarding unconventional marks, such as sounds, smells and similar.

Tastes and fragrances are generally considered to be unregistrable.

[E] Applicant

One or several natural persons or legal entities may apply for and become a holder of a trademark in Slovenia.

Foreign applicants have equal rights as Slovenian ones on the basis of an international agreement or convention which Slovenia is a member of (Slovenia is a member of the Paris Convention, and TRIPs Agreement) or on the basis of reciprocity. A party invoking reciprocity must prove the existence thereof.

[F] Assignment

Both a registered trademark and a pending application may be assigned. The assignor or the assignee may request that the assignment is recorded into the trademark register. If the request is filed by the assignor, no documentation to prove the assignment is required. If the request is filed by the assignee, the assignment deed signed by the assignor and the assignee is required (no notarization or legalization required).

[G] Requirements for Filing*[1] Request for registration*

The requirements for registration of a trademark application are as follows:

- (1) Application on prescribed form, signed by the applicant or the agent, stating the full name and address of the applicant(s), showing the appearance of the trademark, and priority date, country and application number, if priority is claimed. Priority Certificate is not required.
- (2) List of goods or services classified according to the International Classification (Tenth edition), in Slovenian language, two copies. A trademark application may cover more than one class.

[2] Appointment of Representative

Foreign applicants must appoint an authorized registered patent or trademark attorney in Slovenia to represent them before the SIPO.

[3] Power of Attorney

The power of attorney must be signed by the applicant and filed within three months of any request from SIPO. Notarization or legalization is not required.

[4] Priority

Convention priority may be claimed. If priority is claimed, it must be made on filing the application and must at least state the date of the priority application. The number of the priority application and the country may be subsequently submitted within three months from the filing date. The priority term is six months from the filing date of the application whose priority is claimed. Multiple and partial priorities are allowed. A Priority Certificate maybe required upon request.

[5] Graphical representations

Six prints of the representation of the trademark are needed. The size of prints must not be larger than 8 cm × 8 cm and not smaller than 15 mm in diameter. No prints are needed for word marks.

[H] Procedure*[1] Filing Authority*

A national trademark application must be filed with the Slovenian Intellectual Property Office (SIPO).

[2] Online filing

Online trademark filing is possible.

[3] Classification

This is the International Classification of Goods and Services under the Nice Agreement (Tenth edition), containing thirty-four classes of goods and eleven classes of services.

[4] Search

The SIPO does not perform a search for similar trademarks.

[5] Examination

Trademark applications are first examined for the formal requirements. If formal defects are found, the applicant will be invited to remedy these within three months. Upon request, this period may be extended for an additional three months. If the defects are not sufficiently remedied in time, the application will be rejected.

If the application is formally in order, the SIPO will examine it for the absolute grounds for refusal (but not relative grounds). If the sign is found not registrable, the SIPO will invite the applicant to file his/her comments within three months. Upon request, this period may be extended for additional three months. If the applicant does not timely reply or if the reply is unsatisfactory, the application will be refused.

Upon the application meeting the formal requirements and not being refused on absolute grounds, the application is published in the SIPO's Official Bulletin.

[6] Registration

If no opposition is filed within three months after the publication of the application, or if the opposition is refused, the trademark will be registered and registration will be published in the SIPO's Official Bulletin.

[7] Opposition

Within three months from the publication of the application, any person may file an opposition against the trademark based on relative grounds for refusal. The SIPO notifies the applicant on the opposition and gives him/her a chance to file his/her observations. If the opposition is justified, the SIPO will refuse the trademark; otherwise, the SIPO will refuse the opposition and register the trademark.

[8] Appeal

If a trademark application or an opposition is refused, an appeal in the form of an administrative action may be filed with the Administrative Court within thirty days from the receipt of the decision on refusal.

[9] Alteration after Registration

It is not allowed for the appearance of the trademark to be changed in any way.

Upon request of the holder (or the applicant), the following changes may be entered into the register of trademarks:

- change of name or company name of the applicant or holder;
- change of address or company seat;
- transfer of right;
- information on license and licensee;
- information on the pledge and the creditor; and
- limitation of the list of goods and services.

The requirements for alteration are as follows:

- (1) power of attorney if the application is filed through a representative and if the representative is not already stated as a representative in the register;
- (2) written consent of the previous holder or an evidence on the legal basis for the alteration if the request is filed by someone who is not listed as a holder in the register;
- (3) confirmation of payment of fees; and
- (4) if the change in the register relates to transfer of rights and the new holder is a foreign entity or foreign citizen, also the power of attorney for the representative of the new holder is needed.

[10] Publication / Public File Inspection

After examination for formalities and absolute grounds, the trademark application is published in the SIPO's Official Bulletin.

Particulars and documents of pending trademark applications are immediately after filing available to public inspection.

[I] Nullity and Lapse

- (1) A trademark shall be liable to be declared invalid on absolute grounds:
 - (a) If the signs cannot constitute a trademark.
 - (b) If the trademark is devoid of any distinctive character.
 - (c) If it consists exclusively of signs or indications which may serve, in trade, to designate 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) If 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.
 - (e) If the sign consist exclusively of:
 - (i) the shape which results from the nature of the goods themselves;

- (ii) the shape of goods which is necessary to obtain a technical result; and
 - (iii) the shape which gives substantial value to the goods.
- (f) If it is contrary to public policy or to accepted principles of morality.
 - (g) If it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.
 - (h) If it has not been authorized by the competent authorities and is to be invalidated pursuant to Article 6ter of the Paris Convention.

There is no time limit to file an action to invalidate the trademark on the absolute grounds.

- (2) A trademark shall be liable to be declared invalid on relative grounds:
- (a) if it is identical with an earlier trademark, and the goods or services for which the trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected.
 - (b) if because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.
 - (c) if it is identical with, or similar to, an earlier trademark and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation and where the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark, or if it would indicate a connection between the goods or services of the owners of both trademarks.
 - (d) if its use would contradict an earlier right or if it would indicate a connection between the goods or services and the owner of the earlier mark 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.

The action to invalidate the trademark on relative grounds must be filed within five years after the registration.

- (3) A trademark shall be liable to be declared invalid if the applicant filed the application in bad faith. There is no time limit to file an action to invalidate the trademark on the grounds of bad faith.
- (4) A trademark shall be liable to revocation if, after the date on which it was registered:
- (a) in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered; and
 - (b) in consequence of the use made of it by the proprietor of the trademark or with his consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
- (5) A trademark shall be liable to revocation if, within a continuous period of five years from the date of the registration, or from the day it was last genuinely used, the proprietor has not put the trademark to genuine use in the country in connection with the goods or services in respect of which it is registered, unless there are proper reasons for non-use. However, no person may claim that the proprietor's rights in a trademark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trademark has been started or resumed. The commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the

continuous period of five years of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed. A trademark may not be declared invalid on the ground that there is an earlier conflicting trademark if the latter does not fulfil the use requirements.

Where grounds for refusal of registration or for revocation or invalidity of a trademark exist in respect of only some of the goods or services for which that trademark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

Where the seniority of an earlier trademark which has been surrendered or allowed to lapse is claimed for an EU trademark, the invalidity or revocation of the earlier trademark may be established a posteriori.

[J] Use Requirement

If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trademark to genuine use in the country in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trademark shall be liable to revocation, unless there are proper reasons for non-use.

The following shall also constitute use:

- (a) of the trademark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered; and
- (b) affixing of the trademark to goods or to the packaging solely for export purposes.

Use of the trademark with the consent of the proprietor or by any person who has authority to use a collective mark shall be deemed to constitute use by the proprietor.

[K] Marking

Not applicable in this jurisdiction; the law defines neither obligation nor prohibition of the use of any symbol in connection with the registered or unregistered trademark, and marked products have no implications for awarding compensation in case of past infringement.

[L] Licenses and Registered Users

A trademark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the country. A license may be exclusive or non-exclusive.

The proprietor of a trademark may invoke the rights conferred by that trademark against a licensee who contravenes any provision in his/her licensing contract with regard to:

- (a) its duration;
- (b) the form covered by the registration in which the trademark may be used;
- (c) the scope of the goods or services for which the license is granted;
- (d) the territory in which the trademark may be affixed; or
- (e) the quality of the goods manufactured or of the services provided by the licensee.

[M] Pledge and Seizure

The trademark can be pledged in accordance with Article 190 of the Property Code published in Official Gazette of the Republic of Slovenia No. 87/02 on 17 October 2002.

Although not explicitly defined in the law, it is advisable to have the pledge agreement recorded into the trademark register in order to have effect towards third persons.

The trademark can be seized in accordance with the Articles 162 and 163 of the Enforcement and Securing of Civil Claims Act published in Official Gazette of the Republic of Slovenia No. 51/98 on 17 July 1998 as amended.

[N] Infringement*[1] Infringing acts / Non-infringing acts*

The registered trademark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his/her consent from using in the course of trade:

- (a) any sign which is identical with the trademark in relation to goods or services which are identical with those for which the trademark is registered; and
- (b) any sign where, because of its identity with, or similarity to, the trademark and the identity or similarity of the goods or services covered by the trademark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trademark.

The following, *inter alia*, may be prohibited:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under the sign; and
- (d) using the sign on business papers and in advertising.

The trademark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

- (a) his/her own name or address;
- (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services; and
- (c) the trademark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts; provided he/she uses them in accordance with honest practices in industrial or commercial matters.

Exhaustion of the rights conferred by a trademark: the trademark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the European Economic Area under that trademark by the proprietor or with his/her consent. This shall however not apply where there exist legitimate reasons for the proprietor to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

[2] Remedies

The Circuit Court in Ljubljana has exclusive jurisdiction over all infringement cases in Slovenia.

The plaintiff may claim the following:

- (1) the infringer be prohibited from future infringing acts;
- (2) the infringer remove the objects of the infringement from the channels of commerce, or destroys these where there is no other way to cease the infringement;
- (3) the infringer remove the means of the infringement that are used or intended exclusively or almost exclusively for the creation of the infringing goods, or destroys these where there is no other way to cease the infringement;
- (4) the final judgment be published in public media at the infringer's expense, to the extent and in the manner determined by the court; and
- (5) damages which are assessed according to general tort regulations. The person entitled to sue for infringement is the trademark holder or the exclusive licensee. Damages may be collected for a five year period prior to initiating a lawsuit.

A temporary injunction will be granted upon request if the following conditions are met and proved by the plaintiff:

- the plaintiff is a holder or an exclusive licensee of the respective trademark; and
- trademark rights are already being infringed or it is very likely that infringement will take place.

For a temporary injunction, the plaintiff must also prove at least one of the following conditions:

- (1) danger that a delay may render the lawsuit claims unenforceable;
- (2) the plaintiff is likely to suffer irreparable damage; or
- (3) a temporary injunction, which may prove unfounded in the course of the proceedings, does not have more detrimental consequences for the defendant than the non-adoption of such measure for the plaintiff would have.

[3] Penal provisions

Unjustified and intentional use of the trademark in the course of trade is sanctioned with imprisonment of up to three years.

[4] Enforcement and Customs

Enforcement of the trademark rights is also possible through border measures. Upon the right holder's request, the Customs will suspend the release of the suspected goods. Border measures relating to infringement of trademarks is regulated by Regulation (EU) No 608/2013 of the European Parliament and of the Council. Goods suspended by customs are destroyed at the trademark holder's request and expense, unless the owner or the holder of the suspected infringing goods declares (within ten working days from receiving the customs decision on temporary suspension) that the goods are genuine, or that they do not infringe any right. If this declaration is given, the right holder is obliged to file the infringement lawsuit to achieve the destruction of goods, otherwise the goods are released.

[O] Well-known and Reputed Marks

Well-known trademarks, although unregistered, are protected by Article 6*bis* of the Paris Convention, Article 16(3) of the TRIPS, and Article 44(1)(d) of the Industrial Property Act.

Reputed marks are protected according to Article 44(1)(c) and Article 47(1)(c) of the Industrial Property Act. They enjoy protection also for goods or services which are not similar if the use without due cause of that sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the mark.

[P] Trademarks and Trade Names

In Slovenia, company names are protected in accordance with the Company Act. According to the SIPO's practice, a company name may be an obstacle to the trademark registration. The SIPO bases the refusal of the trademark due to existence of the earlier company name on Article 44(1)(f) of the Industrial Property Act, namely the existence of the earlier right to a name.

[Q] Trademarks and Domain Names

Any Slovenian or foreign natural person or legal entity may acquire a domain name registration.s*i*. According to Article 17.2.1 of the General Conditions for Registration of Domain names .SI, the trademark owner can achieve cancellation or transfer of a domain.s*i* in the alternative domain name dispute resolution if the following conditions are met:

- (1) the domain has to be identical or deceptively similar to a trademark;
- (2) the domain holder/registrant does not have the right to a particular domain name; and
- (3) the domain has been registered or used in bad faith.

[R] Trademarks and Appellations of Origin / Trademarks and Geographical Indications

Geographical indications and trademarks are separate IP rights.

Geographical indications eligible for registration are indications which identify a good as originating in a territory, or a region or a locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

The name of a product, which has become generally known through long-term use in the course of trade as the name indicating that the product originates in a specific place or region, is also eligible for registration as a geographical indication.

Geographical indications relating to a product of special historic or cultural importance may be protected by a decree issued by the Government of the Republic of Slovenia.

Applications for registration of geographical indications for agricultural products and foodstuffs as well as for wines and other products obtained from grapes or wine are filed with the Ministry of Agriculture.

A geographical indication shall not be eligible for registration if:

- (a) it indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;
- (b) although literally true as to the territory, region or locality in which the good originates, it falsely represents to the public that the good originates in another territory;
- (c) it has become generally known through long-term use in the course of trade as a designation for a specific kind of goods; or

- (d) in the light of a mark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.

The registration of a trademark will be refused (or declared invalid) if:

- 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, 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.
- Its use would infringe an earlier right to a geographical indication.

Even when a trademark is identical with or similar to a registered geographical indication, it shall not be cancelled nor its use prohibited, if the trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith before the geographical indication has been registered.

[S] Restoration

Restoration of a trademark application is available if the restoration request is filed within two months from the removal of the cause of non-compliance with the time limit, or, if the party only learned subsequently about that non-compliance, from the day when the party learned, but no later than six months from the expiration of the time limit.

Restoration of a registered trademark is not possible after failure to pay the renewal fee.

[T] Specific Aspects of Regional Trademark Registration

Community trademarks (CTM) took effect in Slovenia on 1 May 2004 when Slovenia became a member of the European Union. The application for a CTM can be filed with the SIPO or with the Office for Harmonization in the Internal Market (OHIM).

[U] Specific Aspects of International Trademark Registration

Slovenia is a member of the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol.

National trademark legislation applies also to the international trademarks, namely provisions relating to the scope of rights, enforcement of rights, contesting the validity of a trademark (invalidation, nullification and cancellation) and opposition.

[V] Fees

[1] Table of official fees

	EUR
Application fee (including the fee for three Int. Cl.).....	100
Application fee for every further Int. Cl.....	20

Registration fee (including the fee for maintenance for ten years, for three Int. Cl.)	150
Registration fee for every further Int. Cl.....	50
Opposition against registration.....	75
Collective Trademark:	
Application fee (including the fee for three Int. Cl.)	250
Application fee for every further Int. Cl.....	50
CTM:	
Sending the application to OHIM.....	50
International Trademark:	
Sending the application for international registration.....	60
Opposition against registration.....	85

[W] Transitional Provisions

Not applicable in this jurisdiction.

[X] Specific Trademark Issues

There are no specific trademark issues.

[Y] Governmental Websites

- www.uil-sipo.si (The Slovenian Intellectual Property Office)
- www2.uil-sipo.si/dse.htm (Register)

PART 3 UTILITY MODELS

The protection of utility models is not possible in this jurisdiction.

PART 4 INDUSTRIAL DESIGNS AND MODELS

§4.01 SUMMARY

[A] Duration of Registration

- 5 years from the filing date, 4 times renewable up to a maximum of 25 years from the filing date.

[B] Registrable / Not Registrable

- A design is required to be new and to have individual character.
- Registrable is the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.

[C] Novelty

- For the purpose of determining the novelty and individual character, a design will be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the filing or priority date, except where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union.
- A 12-month grace period applies.

[D] Procedure

- The application is examined as to compliance with the formal requirements and whether the subject matter of the application is obviously not registrable.

[E] Governmental Websites

- www.uil-sipo.si (The Slovenian Intellectual Property Office)
- www2.uil-sipo.si/dse.htm (Register)

§4.02 DETAILED INFORMATION**[A] Conventions and Legislation***[1] Conventions*

- Paris Convention;
- Agreement on Trade-Related Aspects of Intellectual Property Rights ('TRIPs') with effect from 1 January 1995;
- EU Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community Designs, in force since 6 March 2002;
- EU Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights;
- EU Directive 98/71/EC of 13 October 1998 on the legal protection of designs;
- Convention Establishing the WIPO Convention, 1967–1999, effective 25 June 1991;
- The Hague Agreement Concerning the International Deposit of Industrial Designs (hereinafter 'The Hague Agreement'), 1960, effective 13 January 1995, and Geneva Act 1999 effective 23 December 2003; and
- Locarno Agreement Establishing an International Classification for Industrial Designs (hereinafter 'Locarno Agreement'), 1968, effective 25 June 1991.

[2] Laws

- Industrial Property Act published on 7 June 2001, which took effect on 7 December 2001, amendments effective since 11 March 2006 and 21 December 2013 (this Act covers patents, trademarks, appellations of origin and designs);
- Rules on the registers of applications and industrial property rights and on the certificate of the priority right of 2001;
- Decree implementing Council Regulation (EC) on Community designs and Council Regulation (EC) on Community trademarks of 2001;
- Rules on the contents of industrial design applications of 2004;
- Penal Code of the Republic of Slovenia; and
- Act Implementing the Customs Regulations of the European Community.

[B] Duration of Registration

The duration of registration is five years from the date of filing the application for registration and four times renewable with another five-year period, up to a maximum of twenty-five years from the filing date.

[C] Requirements for Renewal

Renewal must be made before the expiration of the running registration period. If the renewal fee is not paid within this period, it may be paid within six months of the due date, with payment of a fine of 50% of the maintenance fee. As to the possibility of restoring a lapsed design due to non-payment of the renewal fee, see 'Restoration'.

[D] Registrable / Not Registrable

A design can be protected only to the extent that it is new and has individual character.

A design shall be considered to have individual character if the overall impression it produces

on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing the application or if priority is claimed, before the priority date. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

Registrable is the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of a product itself and/or its ornamentation. In this context, 'product' means any industrial or handicraft item, including, among others, parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs. 'Complex product' is to be considered as a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

Not registrable are features of appearance of a product which are solely dictated by its technical function or features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected or to be placed in, around or against another product so that either product may perform its function. A registrable design shall not subsist in a design which is contrary to public policy or to accepted principles of morality. Furthermore, a design shall not be registered if containing a State or other official armorial bearing, flag or emblem, or the name of a country or international organization or an abbreviation or imitation thereof, except where approval of the competent authority of the country or organization concerned has been obtained.

[E] Novelty

A design will be considered new if no identical design has been made available to the public before the date of filing of the application for registration or if priority is claimed, before the priority date. In this context, designs shall also be deemed to be identical if their features differ only in immaterial details.

For the purpose of determining the novelty and individual character, a design will be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the filing or priority date, except where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union. A design will, however, not be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

A design shall also not be registrable if the design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority, and which is protected from a date prior to the said date by a registered EU design (previously known as a Community Design) or an application for a registered EU design or by a national design registration, or by an application for such a right.

A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

- If the component part after it has been incorporated into the complex product, remains visible during normal use of the complex product. Normal use means use by the end user, excluding maintenance, servicing or repair work.
- Insofar as those visible features of the component part themselves are new and have individual character.

[1] Grace period

For the purpose of determining the novelty and individual character, a disclosure shall not be taken into consideration if a design has been made available to the public:

- (a) by the designer, his/her successor in title, or a third person as a result of information provided or action taken by the designer, or his/her successor in title; and
- (b) during the twelve-month period preceding the date of filing of the application or, if priority is claimed, the date of priority.

This also applies if the design has been made available to the public as a consequence of an abuse in relation to the designer or his/her successor in title.

[F] Applicant

One or several natural persons or legal entities may apply for and become a holder of a design in Slovenia. It is not necessary that the applicant shows in the design application any connection with the designer or author, for example the SIPO does not request any documents showing that the applicant is the assignee.

However, the designer/author, his/her heir or other successor in title may, at any time during the validity of an industrial design, file an action with a court requesting that he/she be declared owner of the right, if the industrial design was registered in the name of a person who is not the designer, his/her heir or other successor in title.

[G] Assignment

Both a registered model and a pending application may be assigned. The assignor or the assignee may request that the assignment is recorded into the models register. If the request is filed by the assignor, no documentation to prove the assignment is required. If the request is filed by the assignee, the assignment deed signed by the assignor and the assignee is required (no notarization or legalization required).

[H] Requirements for Filing*[1] Request for registration*

The filing requirements are as follows:

- (1) Application, on prescribed form, signed by the applicant or the agent, stating the following information:
 - (a) full name and address of the applicants;
 - (b) name and address of the author (optional);
 - (c) title of the design; and
 - (d) priority date, country and application number, if priority is claimed. Priority Certificate is required only upon request; usually not requested.
- (2) Graphical representation of the design.
- (3) Locarno classification.

The applicant may request, when filing the application, that the essential data of the application shall not be published before the expiration of twelve months from the date of filing of the

application or, if a priority is claimed, the date of priority. The multiple applications cannot contain a request for deferment of publication for only some products.

A design registration and application may cover unlimited number of designs if they are all in the same class of the Locarno Classification.

[2] Appointment of Representative

Foreign applicants must appoint an authorized registered patent or trademark attorney in Slovenia to represent them before the SIPO.

[3] Power of Attorney

The power of attorney must be signed by the applicant and filed within three months of official request. Notarization or legalization is not required.

The designation of the creator is not obligatory.

[4] Priority

Convention priority may be claimed. Priority must be claimed on filing the application by stating at least the date of the priority application. The number of the priority application and the country may be submitted subsequently within three months from the filing date. The priority term is six months from the filing date of the application whose priority is claimed. Multiple and partial priorities are allowed. A Priority Certificate is required upon request.

As to the possibility of restoring priority right, see 'Restoration'.

[5] Description

A description is not required.

[6] Graphical representations

A maximum of six different views is allowed per design. Three copies of photographs or drawings (black-and-white or colour) for each view of the design must be submitted. The industrial design should be clearly presented, and it should not be a technical drawing with dimensions, measurements or explanations and/or legend. The size of the graphical representations must not be larger than 16 cm × 16 cm.

[7] Multiple deposits

An application may contain unlimited number of designs provided they belong in the same class of Locarno Classification.

[I] Procedure

[1] Filing Authority

A national design application must be filed with the Slovenian Intellectual Property Office (SIPO).

[2] Online filing

Online filing is possible.

[3] Classification

The design(s) must be classified in accordance with the Locarno Agreement Establishing an International Classification for Industrial Designs, 1968.

[4] Search

The SIPO does not conduct a search of earlier registered designs, as part of official examination of the application.

[5] Examination

Applications for the registration of a design are first examined as to compliance with the formal requirements. If the formal requirements are not met, the applicant will be invited to remedy the defects within a period of three months. This period may be extended by an additional three months. If the defects are not or not satisfactorily remedied in time, the application will be rejected.

If the application is found formally in order, it will be examined whether the subject matter of the application is obviously not registrable. Beside the formalities, the SIPO will examine for example whether the applied design shows the appearance of the product at all, if it is contrary to public order or morality, or if it is merely functional. The SIPO will not examine the design application for novelty or individual character.

In case the design is found not registrable, the applicant will be notified and invited to file his/her observations within three months. This period may be extended by an additional three months. If the applicant fails to reply or if his/her reply is unsatisfactory, the application will be refused.

[6] Registration

After the examination, the design will be registered and published in the Official Bulletin.

[7] Opposition

Not applicable in this jurisdiction.

[8] Appeal

If a design application is refused, an appeal in the form of an administrative action may be filed with the Administrative Court within thirty days from the receipt of the decision on refusal.

[9] Publication / Deferred Publication / Public File Inspection

The files relating to design applications, which have not been published in the Official Journal,

are official secrecy. The files which are official secrecy are made available for inspection only with the consent of the applicant.

Any person who can prove that, in relation to his/her acts, the applicant informed him/her in writing about his/her application and the scope of requested protection, he/she may inspect the files which are otherwise officially secret, without the consent of the applicant.

Design data can be viewed in Designview.

The applicant may request the deferment of the publication, namely that the essential data of the design application shall not be published before the expiry of twelve months from the date of filing of the application or, if a priority is claimed, the date of priority.

[J] Nullity and Lapse

An author or his/her legal successor may at any time during the duration of a design sue the design holder before the Circuit Court in Ljubljana to be declared the holder of a design if the design had been registered in the name of another person who is not the author or his/her legal successor.

Anyone at any time during the duration of a design may sue the design holder before the Circuit Court in Ljubljana to invalidate a registered design.

The grounds for invalidation are as follows:

- (1) design was registered contrary to requirements for registration; and
- (2) the applicant or the holder was not entitled to the design registration.

[K] Use Requirement

Use of a registered design is not obligatory.

[L] Marking

Not applicable in this jurisdiction; the law defines neither obligation nor prohibition of the use of any symbol in connection with the registered design, and marked products have no implications for awarding compensation in case of past infringement.

[M] Licenses

Exclusive and non-exclusive voluntary licenses may be granted under a design as well as under a design application. License agreements must always be in writing. A license agreement must in particular specify the duration of the license, its scope and whether the license is exclusive or non-exclusive.

The law does not provide for compulsory licenses.

[N] Pledge and Seizure

The design can be pledged under the same formalities required for the transfer (pursuant to the Article 190 of the Property Code published in Official Gazette of the Republic of Slovenia No. 87/02 on 17 October 2002).

Although not explicitly defined in the law, it is advisable to have the pledge agreement recorded into the design register in order to have effect towards third persons.

The design can be seized (pursuant to the Articles 162 and 163 of the Enforcement and

Securing of Civil Claims Act published in Official Gazette of the Republic of Slovenia No. 51/98 on 17 July 1998 and amended several times).

[O] Infringement

[1] Infringing acts / Non-infringing acts

A registered design confers upon its owner the exclusive right to use the design and to prevent any third party not having his/her consent from using it. In particular the following acts done without the consent of the owner of a registered design are considered infringement: making, offering, putting on the market, importing, exporting or using of a product in which the design, or a design which does not produce on the informed user a different overall impression, is incorporated or to which it is applied, or stocking such a product for those purposes. In assessing the scope of protection, the degree of freedom of the designer in developing his/her design is to be taken into consideration.

The following is not considered infringement of a design:

- (1) acts done privately and for non-commercial purposes;
- (2) acts done for research and experimental purposes of any kind relating to the design irrespective of their final purpose;
- (3) the use on board vessels of other countries, in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of the Republic of Slovenia, provided that the design is used exclusively for the needs of the vessel;
- (4) the use of the design in the construction or operation of aircraft or land vehicles of other countries, or of accessories to such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the territory of the Republic of Slovenia;
- (5) the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944, where these acts concern the aircraft of a State benefiting from the provisions of that Article; and
- (6) acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

Furthermore, the rights conferred by a design cannot be exercised in respect of the equipment on ships and air craft registered in a third country when these temporarily enter the territory of Slovenia or the importation into Slovenia of spare parts and accessories for the purpose of repairing such craft or the execution of repairs on such craft.

Exhaustion: not considered infringement are acts done in relation to a product in which a design protected by registered design right is incorporated or to which it has been applied, after the product has been put onto the market in the European Economic Area by the owner of the design or with his/her consent.

[2] Prior user rights

Any person who, before the filing date or if the priority is claimed, before the priority date, had already in good faith been using the design in Slovenia, or had made the necessary preparations for such use, may continue such use.

[3] Remedies

The Circuit Court in Ljubljana has exclusive jurisdiction over all infringement cases in Slovenia.

The plaintiff may claim the following:

- (1) that the infringer be prohibited from future infringing acts;
- (2) that the infringer remove the objects of the infringement from the channels of commerce, or destroys these where there is no other way to cease the infringement;
- (3) that the infringer removes the means of the infringement that are used or intended exclusively or almost exclusively for the creation of the infringing goods, or destroys these where there is no other way to cease the infringement;
- (4) that the final judgment be published in public media at the infringer's expense, to the extent and in the manner determined by the court; and
- (5) damages according to general tort regulations.

The person entitled to sue for infringement is the design holder and the exclusive licensee. Damages may be collected for a period later than five years prior to initiating a lawsuit.

A temporary injunction will be granted upon request if the following conditions are met and proved by the plaintiff:

- (1) the plaintiff is a holder or an exclusive licensee of the respective design; and
- (2) design rights are already being infringed or it is very likely that infringement will take place.

For a temporary injunction, the plaintiff must also prove at least one of the following conditions:

- (1) danger that a delay may render the lawsuit claims unenforceable;
- (2) the plaintiff is likely to suffer irreparable damage; and
- (3) a temporary injunction, which may prove unfounded in the course of the proceedings, does not have more detrimental consequences for the defendant than the non-adoption of such measure for the plaintiff would have.

[4] Penal provisions

Unjustified and intentional use of the design in the course of trade is sanctioned with imprisonment of up to three years.

[5] Enforcement and Customs

Enforcement of the design rights is possible through border measures. Upon the right holder's request, the Customs will suspend the release of the suspected goods. Border measures relating to infringement of design is regulated by Regulation (EU) No 608/2013 of the European Parliament and of the Council. Goods suspended by customs are destroyed, at the design holder's request and expense, unless the owner or the holder of the suspected infringing goods declares (within ten working days from receiving the customs decision on temporary suspension) that the goods are genuine or that they do not infringe any right. If this declaration is given, the right holder is obliged to file the infringement lawsuit to achieve the destruction of goods; otherwise, the goods are released.

[P] Restoration

Restoration of priority right is not possible.

Restoration of a design application is possible if the restoration request is filed within two months from the removal of the cause of non-compliance with the time limit, or, if the party only learned subsequently about that non-compliance, from the day when the party learned, but no later than six months from the expiration of the time limit.

Restoration of a registered design after failure to pay the renewal fee is not possible.

[Q] Specific Aspects of Regional Design Registration

In Slovenia, Community designs (registered and unregistered) took effect on 1 May 2004 when Slovenia acceded to the European Union. The application for Community design registration may be filed with the SIPO or with the OHIM.

[R] Specific Aspects of International Design Registration

Slovenia is a member of The Hague Agreement Acts of 1960 and 1999. Consequently, persons entitled to benefit from these Acts of the Hague Agreement may obtain design protection in Slovenia by filing an international design application designating Slovenia.

[S] Design and Copyright Protection

The designer/author, his/her heir or other successor in title may, at any time during the validity of an industrial design, file an action with a court requesting that he/she be declared owner of the right, if the industrial design was registered in the name of a person who is not the designer, his/her heir or other successor in title (Article 115 of the Industrial Property Act).

The designer/author of a registered design may also file an action with a court requesting that he/she be named as a designer/author in the application and in all documents and that the judgment is published (Article 118 of the Industrial Property Act).

Article 39 of the Industrial property Act states:

- (1) Provisions of this Act concerning industrial designs shall be without prejudice to provisions of other Acts relating to unregistered industrial designs, marks or other distinctive signs, patents, utility models, typefaces, civil liability or unfair competition.
- (2) An industrial design shall be eligible for copyright protection as from the date on which the design was created or fixed in any form if it fulfils the conditions under which such a protection is conferred under the Act regulating copyright and related rights.

[T] Fees

[1] *Table of official fees*

	EUR
Application fee (including the fee for maintenance for 5 years, for one appearance).....	80
Application fee for every further appearance.....	65
Fee for maintenance for further 5 years (for every appearance).....	70

[U] Transitional Provisions

The Industrial Property Act took effect on 7 December 2001. All relevant provisions of this Act concerning design granting procedure and the scope of design rights also applies retrospectively to those registered designs and design applications that had been applied for or registered before the Industrial Property Act came into force.

[V] Specific Industrial Design and Model Issues

There are no specific industrial design and model issues.

[W] Governmental Websites

- www.uil-sipo.si (The Slovenian Intellectual Property Office)
- www2.uil-sipo.si/dse.htm (Register)

