

New regulation establishes official fees for trademark cancellation and invalidation proceedings

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- Following amendments to the Industrial Property Act, the competence to decide in cancellation and invalidation proceedings was transferred to the SIPO
- Official fees for filing cancellation and invalidation requests at the SIPO had not been established when the new act came into force
- The new Regulation on Official Fees came into force on 30 December 2023

Background

In 2023 the Slovenian Parliament adopted amendments to the Industrial Property Act, which came into force on 27 July 2023.

The amendments introduced important changes regarding proceedings for trademark cancellation and declarations of invalidity - namely, the competence to decide in these types of proceedings was transferred from the District Court in Ljubljana to the Slovenian IP Office (SIPO). In contrast to the requirements for court representation, which requires individuals to be licensed attorneys and to have passed the state bar examination, representation before the SIPO can be undertaken by patent or trademark attorneys registered on SIPO's list of IP attorneys.

Pursuant to the amendments to the Industrial Property Act, a new Regulation on Official Fees was due, which would introduce, for the first time, official administrative fees for submitting requests to the SIPO for the cancellation or a declaration of invalidity of a Slovenian trademark registered with the SIPO.

Although the official fees concerning these proceedings had not been established when the new act came into force, it was nevertheless possible to initiate such proceedings before the SIPO - namely, it was possible to file a cancellation request or a request for a declaration of invalidity with the SIPO, without paying the fee. Applicants were unofficially informed that they would be invited to pay the fee once the new regulation was issued and valid.

New regulation

When the new act had been in effect for nearly five months, the government of the Republic of Slovenia issued the new Regulation on Official Fees, which came into force on 30 December 2023.

During this interim period, several cancellation and invalidation requests had already been lodged with the SIPO; however, as the official fee had not been established, the SIPO was unable to proceed until the new regulation was adopted. As neither the official fees nor the timeframe of the procedures were known, such delay caused uncertainty among applicants.

The new regulation introduced an official fee of €500 for both types of proceedings.

Comment

Regardless of the delay and uncertainty, it is believed that turning cancellation and invalidation proceedings into administrative proceedings is a positive step, as this will reduce the burden on the District Court in Ljubljana (which will continue to handle trademark infringement cases). The redistribution of this burden will hopefully accelerate decision-making at the court and the SIPO.

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