

## Slovenian court adopts a fresh approach in TESLA revocation proceedings

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### SLOVENIA

Legal updates: case law analysis and intelligence

- Internet Group doo Beograd filed revocation suit against Slovenian designations of three international TESLA marks
- For the first time, Ljubljana Circuit Court adopted approach of replacing broader categories of goods with subcategories
- Was done without either party explicitly suggesting replacements

In *Internet Group doo Beograd v TESLA Holding AS* (Case IV Pg 1404/2021, 7 May 2024, released in June 2024), the Circuit Court in Ljubljana partly revoked the contested trademarks due to non-use. The court has, for what is likely the first time in Slovenian jurisdiction, replaced a few broad categories of goods in the list with subcategories of goods, without any of the parties explicitly suggesting these particular restrictions.

### Background

In 2021, plaintiff Internet Group doo Beograd filed a revocation lawsuit with the Ljubljana Circuit Court against Slovenian designations of three international registrations of TESLA Holding AS, comprising or consisting of the word 'TESLA', claiming that they had not been genuinely used in Slovenia five years before the filing of the lawsuit.

### Decision

After an exchange of several written briefs and following two oral hearings, the court issued a judgment partly revoking the contested trademarks due to non-use. In its decision, the court adopted the technique of replacing the existing (broad) categories of goods with subcategories of goods with respect to which, according to the court, the defendant managed to prove genuine use of the marks.

The court used this approach with regard to the following four categories of goods for which the contested trademarks had been registered:

- tubes (Class 9);

- machines (Class 7);
- electronic equipment for road vehicles (Class 9); and
- electronic toys (Class 28).

These were replaced with:

- electron tubes;
- vacuum cleaners;
- ignition cables for engines; and
- electronic toys for pets.

The judgment is subject to an appeal.

## Comment

Until now, the court's practice in revocation proceedings had been either:

- to revoke trademarks in respect of those (broad) categories of goods or services for which genuine use was deemed not to have been proven; or
- to leave the list unchanged with respect to those categories of goods or services for which the defendant was considered to have submitted sufficient evidence of use.

The respective proceedings seem to be the first in which the court has adopted the approach of replacing broader categories of goods with subcategories. Moreover, this was done without either of the parties explicitly suggesting the replacements (they merely invoked several EUIPO and General Court decisions dealing with similar situations).

It should be noted that following last year's amendments to the Industrial Property Act, the court will resolve only those remaining cases, which were initiated before the amendments came into force. Namely, in 2023 the competence to decide in trademark revocation and declarations of invalidity proceedings was transferred from the Circuit Court in Ljubljana to the Slovenian IP Office (SIPO). It will be interesting to see whether the SIPO will continue to use the approach adopted by the Circuit Court in this respective judgment.

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