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The unofficial consolidated version of the Industrial Property Act comprises:

- Industrial Property Act – ZIL-1 (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 45/01 of 7 June 2001),
- Act Amending the Industrial Property Act – ZIL-1A (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 96/02 of 14 November 2002),
- Industrial Property Act – Official Consolidated Text – ZIL-1-UPB1 (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 7/03 of 23 January 2003),
- Act Amending the Industrial Property Act – ZIL-1B (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 37/04 of 15 April 2004),
- Industrial Property Act – Official Consolidated Text – ZIL-1-UPB2 (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 102/04 of 21 September 2004),
- Act Amending the Industrial Property Act – ZIL-1C (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 20/06 of 24 February 2006),
- Industrial Property Act – Official Consolidated Text – ZIL-1-UPB3 (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 51/06 of 18 May 2006),
- Act Amending the Industrial Property Act – ZIL-1D (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 100/13 of 6 December 2013),
- Act Amending the Industrial Property Act – ZIL-1E (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 23/20 of 14 March 2020).

INDUSTRIAL PROPERTY ACT (ZIL-1)

(Unofficial consolidated version No. 8)

Chapter One FUNDAMENTAL PRINCIPLES

Article 1 (Subject of the Act)

(1) This Act lays down the types of industrial property rights under this Act and procedures for granting and registering these rights, judicial protection of rights and the representation of parties in proceedings under this Act.

(2) Industrial property rights under this Act shall be patents, supplementary protection certificates, industrial designs, trade marks and geographical indications.

(3) This Act shall transpose the following into the legislation of the Republic of Slovenia:

- Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions (OJ L 213, 30.7.1998, p.13),
- Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ L 289, 28.10.1998, p. 28),
- Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ L 157, 30.4.2004, p. 45), and

- Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ L 336, 23.12.2015, p. 1).

Article 2 (Equality of foreign and domestic entities)

(1) Legal and natural entities from other countries shall, in respect of the protection of industrial property rights in the Republic of Slovenia, enjoy the same rights as domestic legal or natural persons or entities, this in accordance with the Agreement on Trade-Related Aspects of Intellectual Property Rights of 15 April 1994 (Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS–MP*], No. 10/95; hereinafter: the TRIPS Agreement) or the principle of reciprocity.

(2) The existence of reciprocity shall be proven by the person who invokes it.

Article 3 (Applications for the acquisition of industrial property rights)

(1) Subject to Article 17 of this Act, the acquisition of an industrial property right in the Republic of Slovenia shall be requested by filing a national application with the Slovenian Intellectual Property Office (hereinafter: the Office) in accordance with this Act.

(2) The acquisition of industrial property rights in the Republic of Slovenia may also be requested on the basis of applications filed abroad if this is in accordance with an international treaty that is binding on the Republic of Slovenia. The legal effect of the industrial property rights granted or registered on the basis of such applications shall be the same as that of the industrial property rights granted or registered on the basis of national applications, unless otherwise provided by the international treaty.

(3) A person cannot acquire an industrial property right on the basis of a national application if prior to this they have filed an application under the preceding paragraph for the acquisition of the same right.

(4) The acquisition of industrial property rights abroad may also be requested on the basis of applications filed with the Office if this is in accordance with an international treaty that is binding on the Republic of Slovenia.

Article 4 (Priority of first application)

When two or more applicants file applications to acquire protection for the same invention, design or sign in the Republic of Slovenia, the applicant whose date of filing of the application or, if priority is claimed, the earliest date of priority shall have priority over the other applicant.

Article 5 (Office)

- (1) The main tasks of the Office shall be:
- a) to accept applications for the acquisition of industrial property rights;

- b) to autonomously and independently conduct procedures for granting patents and registering industrial designs, trade marks and geographical indications and to grant patents and register industrial designs, trade marks and geographical indications;
- c) to keep the registers of industrial property rights and other registers provided for by this Act;
- d) to provide information services with regard to industrial property rights;
- e) to represent the Republic of Slovenia in foreign and international organisations operating in the field of industrial property, pursuant to the positions, instructions and authorisations issued by the Government of the Republic of Slovenia;
- f) to perform other tasks falling within its competence.

(2) The Office shall issue its official journal containing information on applications and industrial property rights.

(3) The Office shall autonomously conduct and record financial transactions relating to the payment of fees under this Act and payments for services provided pursuant to Article 7 of this Act.

(4) The Office shall be managed by the Director, who shall be responsible for its operation and shall be appointed by the Government of the Republic of Slovenia.

Article 6 (Decisions of the Office)

(1) In proceedings for the granting or registration and maintenance of industrial property rights and in proceedings concerning the keeping of registers of rights and other registers, the Office shall issue decisions and other acts pursuant to this Act. In the absence of relevant provisions in this Act, the Act governing general administrative procedure shall apply subsidiarily.

(2) Proceedings concerning applications under paragraphs two or four of Article 3 of this Act shall be conducted by the Office pursuant to international treaties that are binding on the Republic of Slovenia and rules and instructions issued to implement the international treaties concerned. In the absence of relevant provisions in the relevant international treaty that is binding on the Republic of Slovenia and rules and instructions issued to implement the international treaty concerned, the provisions of this Act shall apply *mutatis mutandis*.

Article 7 (Provision of information)

(1) Subject to Article 8 of this Act, the Office shall allow any person access to files concerning applications and to information on applications and rights granted or registered.

(2) Against payment, the Office shall provide information on the state of the art contained in patent documents and other services related to information and documentation.

(3) The minister responsible for industrial property shall issue an order on tariff, fixing the types and amounts of payments referred to in the preceding paragraph.

Article 8 (Secrecy and access to applications)

(1) Files related to patent and industrial design applications shall be considered an official secret until the publication of the patent application in the official journal of the Office or the registration of the industrial design.

(2) Access to the files that are an official secret shall only be possible with the consent of the applicant.

(3) Access to a file that is an official secret without consent of the applicant shall only be allowed to a person who can prove that, in relation to their acts, the applicant informed them in writing about the application and the scope of protection sought.

(4) If a patent application concerning a deposited biological material has been refused or withdrawn and if the applicant so requests, access to the deposited biological material shall only be permitted to an independent expert until the expiry of 20 years from the date of filing of the application.

(5) The Office may publish or communicate to third parties the following data before the publication of the patent application in the official journal of the Office:

- a) the number of the application;
- b) the filing date of the application and, if priority is claimed, the date, country or office and the number of the first application;
- c) information on the applicant (full name and address or business name and registered office);
- d) the title of the invention.

Article 9 (Fees)

(1) Fees shall be paid in relation to the acquisition and maintenance of rights under this Act. Fees shall be paid within the time limits provided by this Act. The amounts of fees shall be determined by the Government of the Republic of Slovenia by way of a decree.

(2) In procedures in which fees under the preceding paragraph are paid, the fees under the Act governing administrative fees shall not be payable.

(3) If procedural fees are not paid in due time or are not paid in full, they shall be deemed not to have been paid and the application to be withdrawn, unless otherwise provided by this Act. At a payer's request, the Office shall reimburse the amount paid.

Chapter Two PATENTS

Section 1 Patents and short-term patents

Article 10 (Subject of patent protection)

(1) A patent shall be granted for any invention from any field of technology that is new, involves an inventive step and is industrially applicable.

(2) Detailed conditions for granting patents in respect of individual technical fields with specific technical or technological characteristics shall be defined by a decree issued by the Government of the Republic of Slovenia.

Article 11 (Exceptions to patent protection)

(1) Discoveries, scientific theories, mathematical methods, and other rules, schemes, methods and processes for performing mental acts as such shall not be considered inventions under Article 10 of this Act.

- (2) A patent may not be granted for:
- a) any invention whose application is contrary to public order or morality;
 - b) any invention of a surgical, diagnostic or treatment procedure applied directly on a live human or animal body, except inventions concerning products, in particular substances and mixtures, used in such procedures.

Article 12 (Novelty of invention)

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be considered to comprise everything made available to the public by means of oral or written description, by use, or in any other way before the date of filing of the patent application. The effect of priority right shall be that the date of priority right shall be considered as the date of the filing of the application for the purposes of this Article.

(3) The state of the art shall also include the subject-matter of the following applications that have been filed before the date referred to in the preceding paragraph and published on or after that date:

- a) national patent applications, as originally filed with the Office;
- b) European patent applications, as originally filed with the European Patent Office (hereinafter: the EPO) under the European Patent Convention of 5 October 1973 (hereinafter: the EPC), if seeking protection in the Republic of Slovenia;
- c) international applications, as originally filed under the Patent Cooperation Treaty of 19 June 1970, as amended on 2 October 1979 and 3 February 1984 (Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS–MP*], No. 19/93; hereinafter: the PCT), received by the Office as the elected office in accordance with Article 39 of the PCT.

(4) Notwithstanding the provisions of paragraphs one, two and three of this Article, a substance or mixture that forms part of the state of the art may be protected by a patent for an invention related to the substance or mixture to be used in a treatment procedure referred to in point b) of paragraph two of Article 11 of this Act if such use is not comprised in the state of the art.

Article 13 (Non-prejudicial disclosure of invention)

(1) In applying Article 12 of this Act, a disclosure of invention shall not be taken into account if it occurred not earlier than six months prior to the filing of the patent application and was directly or indirectly due to:

- a) an evident abuse in relation to the applicant or their legal predecessor or
- b) the fact that the applicant or their legal predecessor has displayed the invention at an official or officially recognised international exhibition referred to in Article 62 of this Act.

(2) The provision of point b) of the preceding paragraph shall only apply if the applicant states in the application that the invention has been so displayed and submits a relevant certificate thereof in accordance with paragraph two of Article 62 of this Act.

Article 14 (Inventive step)

(1) An invention shall be considered as involving an inventive step if it is obvious to an expert that the subject of the invention is not a result of the state of the art within the meaning of paragraph two of Article 12 of this Act.

(2) If the state of the art also includes documents referred to in paragraph three of Article 12 of this Act; such documents shall not be taken into account in assessing an inventive step.

(3) If an applicant, in addition to the first patent application which has not yet been published, files another patent application concerning the same subject of invention, the first patent application shall not be taken into account in assessing an inventive step with regard to the second patent application.

Article 15 (Industrial applicability)

An invention shall be considered as industrially applicable if the subject of the invention can be made or used in an industry of any kind, including agriculture.

Article 16 (Subject of short-term patent protection)

(1) With the exception of the inventions of processes, plant varieties and animal breeds, a short-term patent may be granted for inventions that are new, industrially applicable and the result of a creative effort.

(2) An invention shall be considered to be the result of a creative effort if it exhibits either particular effectiveness or practical advantage in industrial use.

(3) The provisions of this Act concerning patents shall apply *mutatis mutandis* to short-term patents, unless otherwise provided by this Act.

Article 17 (Confidential inventions)

(1) Inventions that are important for the defence or security of the Republic of Slovenia shall be considered confidential and shall be registered with the ministry responsible for defence.

(2) The conditions for the exploitation of confidential inventions, in particular compensation for exploitation, shall be agreed directly between the inventor and the ministry responsible for defence.

(3) The application for an invention referred to in paragraph one of this Article may be filed with the Office if the ministry responsible for defence does not wish to exploit it or if it consents to the filing of the patent application.

Article 18 (Patent rights)

- (1) A patent shall confer the following exclusive rights on its holder:
- a) if the subject of a patent is a product: to prevent third parties not having the holder's consent from making, using, offering for sale or selling the product concerned or importing it for these purposes;
 - b) if the subject of a patent is a process: to prevent third parties not having the holder's consent from using the process and from offering for sale, selling or importing for these purposes a product obtained directly by this process.

(2) The scope of patent protection shall be determined by the content of patent claims. The description and any drawings shall also be used to interpret patent claims.

Article 19 (Limitation of patent rights)

The rights referred to in Article 18 of this Act shall not apply to:

- a) acts done privately and for non-commercial purposes;
- b) research and experiments of any kind relating to the subject of the patent irrespective of their final purpose;
- c) the extemporaneous individual preparation of a medicine in a pharmacy in accordance with a medical instruction or prescription, nor acts concerning the medicine so prepared;
- d) the use of the subject of patented invention on the ships of other countries, in the ship's hull, machinery, block and tackle, deck gear and other apparel, when such ships temporarily or accidentally enter the waters of the Republic of Slovenia, provided that the invention is used there exclusively for the needs of the ship;
- e) the use of the patented invention in the construction or operation of aircraft or land vehicles of other countries, or in the accessories of such aircraft or vehicles, when these aircraft or vehicles temporarily or accidentally enter the territory of the Republic of Slovenia;
- f) the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944 (Official Gazette of the Federal People's Republic of Yugoslavia – International Treaties [*Uradni list FLRJ – MP*], Nos 3/54, 5/54, 9/61, 5/62, 11/63, 49/71, 62/73, 15/78 and 2/80, and Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS – MP*], No. 9/92), if these acts concern the aircraft of a country to which the provisions of the aforementioned Article of the convention applies.

Article 20 (Right of prior use)

(1) The rights of the patent holder under Article 18 of this Act shall have no legal effect on a person who has been using the invention in the Republic of Slovenia in good faith before the date of the application or, if priority is claimed, the date of priority or has been making

preparations for such use and who is continuing such use. Such a person retains the right to use the invention but has no right to grant licence or otherwise dispose of the invention.

(2) The right of the person referred to in the preceding paragraph to continue using the invention may only be transferred together with the enterprise or business in which the invention has been used or preparations for its use have been made.

Article 21 (Exhaustion of patent rights)

(1) Patent rights shall not apply to acts concerning a product covered by the patent which are performed in the Republic of Slovenia after that product has been placed on the market in the Republic of Slovenia by the holder of the patent or with the holder's express consent, unless there are grounds which, under the law of the Republic of Slovenia, would justify the extension of patent rights to such acts.

(2) The exhaustion of patent rights referred to in the preceding paragraph may be extended beyond the territory of the Republic of Slovenia if this is in accordance with an international treaty that is binding on the Republic of Slovenia.

Article 22 (Term of a patent)

(1) Subject to paragraph three of Article 91 and relevant provisions of Article 109 of this Act, the term of a patent shall be 20 years from the date of filing of the application.

(2) Immediately on expiry, the term of a patent may be extended once if a state of war or similar state of emergency is declared, this for the duration of such state or situation but not for more than five years.

(3) Immediately on expiry of the term of the patent, a supplementary protection certificate may be granted in accordance with a Decree of the Government of the Republic of Slovenia for the invention, this once and for no more than five years, if the subject of the patent is a product or a process of manufacturing or using a product that has to undergo an official approval procedure prescribed by an Act before it can be used for commercial purposes.

Article 23 (Term of a short-term patent)

Subject to relevant provisions of Article 109 of this Act, the term of a short-term patent shall be ten years from the date of filing the application.

Section 2 European patent applications and European patents

Article 24 (Application of law)

(1) Unless otherwise provided by the EPC, the provisions of this Act shall apply to patents granted by the EPO in accordance with the EPC (hereinafter: European patents) and

to applications for a European patent filed in accordance with the EPC (hereinafter: European patent applications) where protection in the Republic of Slovenia is sought.

(2) In the event of conflict between the provisions of the EPC and the provisions of this Act, the provisions of the EPC shall apply in respect of European patent applications and European patents.

Article 25 (Filing of European patent applications)

(1) European patent applications, other than divisional applications, may be filed with the Office in any language allowed by paragraphs one and two of Article 14 of the EPC.

(2) Article 17 of this Act shall apply to European patent applications for inventions that may affect the national security in the Republic of Slovenia.

Article 26 (Validity of European patent applications)

(1) A European patent application seeking protection in the Republic of Slovenia to which a filing date has been accorded shall be equivalent to a national patent application, taking into account any priority claimed for the European patent application, regardless of its later outcome.

(2) A published European patent application seeking protection in the Republic of Slovenia shall confer the protection provided under paragraph four of Article 122 of this Act from the date when the applicant notified the person using the invention in the Republic of Slovenia of a Slovenian translation of the patent claims of the published European patent application.

Article 27 (Validity of European patents)

(1) A European patent seeking protection in the Republic of Slovenia shall, subject to paragraphs two and four of this Article, confer the same rights as a national patent granted by the Office under Article 18 of this Act from the date when the EPO publishes the decision on the granting of the patent.

(2) The holder of a European patent must provide the Office with a Slovenian translation of the European patent claims and pay the prescribed fee for publication within three months of the publishing of the decision on the granting of the European patent.

(3) If, as a result of an opposition filed with the EPO, a European patent is maintained with amended claims, the preceding paragraph shall apply *mutatis mutandis*.

(4) If claims contain reference codes used in drawings, such drawings shall be attached to the translation referred to in paragraphs two and three of this Article and any text in the drawings shall also be translated.

(5) The Office shall publish any translation filed in accordance with paragraphs two, three or four of this Article.

(6) If the holder of a European patent complies with paragraph two of this Article, the Office shall issue a decision on the entry of the European patent in the Office's patent register.

(7) If the translation referred to in paragraphs two, three or four of this Article is not filed in due time or the prescribed fee is not paid in due time, the European patent seeking protection in the Republic of Slovenia shall be considered invalid.

Article 28

(Authentic texts of European patent applications or European patents)

(1) If a translation referred to in Articles 26 and 27 of this Act provides protection which is narrower than that provided in the language of the proceedings, the translation shall be considered the authentic text, except in opposition proceedings before the EPO.

(2) The applicant for or holder of a European patent may file a corrected translation of claims at any time. The corrected translation shall take legal effect on the date when the Office publishes it or on the date when the applicant for or holder of the European patent notifies the person using the invention in the Republic of Slovenia of the corrected translation.

(3) Any person who is using or has made effective and serious preparations to use the invention in good faith, and such use would not constitute infringement of the application or patent in the original translation, may continue such use in their business and for the needs thereof without payment even after the corrected translation takes effect.

Article 29

(Fees for European patents)

(1) The fees for the maintenance of European patents in the Republic of Slovenia for years following the year in which the decision on the granting of the European patent was published shall be paid to the Office, subject to Articles 109 and 110 of this Act. If the maintenance fee for the third year of the European patent term has not been paid to the EPO, it shall be paid to the Office.

(2) Notwithstanding the preceding paragraph, the first maintenance fee for a European patent shall fall due two months after the publication of the decision on the granting of the European patent.

(3) Pursuant to Article 39 of the EPC, a share of fees paid under this Article shall be remitted to the European Patent Organisation.

Article 30

(Conversion into a national patent application)

(1) A European patent application seeking protection in the Republic of Slovenia may be converted into a national patent application, if the European patent application is considered to be withdrawn pursuant to paragraph five of Article 77 of the EPC or because the translation of the application under paragraph two of Article 14 of the EPC has not been filed in due time, as provided by paragraph three of Article 90 of the EPC.

(2) The applicant shall pay the prescribed fee and file a Slovenian translation of the application with the Office within the prescribed time limit.

Article 31
(Simultaneous protection)

If a European patent and a national patent granted to the same person have the same filing date or date of claimed priority, and the national patent applies to the same invention as the European patent, the national patent shall have no legal effect from the date when the time limit for filing an opposition to the European patent expires without an opposition having been filed or from the date when final decision on the validity of the European patent is issued in opposition proceedings.

Section 3
Patent applications under the PCT

Article 32
(Applications under the PCT)

- (1) The Office shall act as a receiving Office under the PCT.
- (2) The Office shall accept international applications filed by nationals of the Republic of Slovenia or persons with permanent residence or registered office in the territory of the Republic of Slovenia.
- (3) International applications under the PCT shall be filed in English, French or German. They may also be filed in Slovenian if an English, French or German translation is submitted to the Office within the time limit prescribed by the rules and instructions issued to implement the PCT.
- (4) The Office shall collect fees in respect of applications under this Article on behalf and for the account of the International Bureau of the World Intellectual Property Organization.
- (5) The EPO shall be the authority competent for the international searching and preliminary examinations of international applications under the PCT filed with the Office.
- (6) A designation or election of the Republic of Slovenia in an international application under point (viii) of Article 2 of the PCT shall be considered as a request for the granting of a European patent having effect in the Republic of Slovenia pursuant to an international treaty that is binding on the Republic of Slovenia.

Chapter Three
INDUSTRIAL DESIGNS

Section 1
Industrial designs

Article 33
(Subject of industrial design protection)

- (1) An industrial design shall be registered for a design that is new and has an individual character.

(2) A design shall mean 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 or its ornamentation.

(3) A product shall mean an industrial or handicraft product, including, *inter alia*, parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs. A complex product shall mean a product composed of multiple components which can be replaced, permitting disassembly and reassembly of the product.

(4) A design relating to a component of a complex product shall only be considered to be new and to have an individual character:

- a) if the component, once it has been incorporated into the complex product, remains visible during the normal use of the complex product and
- b) if the visible features of the component in themselves fulfil the requirements as to novelty and individual character.

(5) Normal use within the meaning of point a) of the preceding paragraph shall mean the use by the end user, excluding maintenance, servicing or repair.

Article 34 (Novelty and individual character)

(1) A design shall be considered new if no identical design has been made available to the public before the filing date of the industrial design application or, if priority is claimed, the date of priority. Designs shall be considered identical if their features differ only in immaterial details.

(2) A design shall be considered to have individual character if the overall impression it produces on an informed user differs from the overall impression produced by any other design that has been made available to the public before the filing date of the application or, if priority is claimed, the date of priority.

(3) In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into account.

Article 35 (Disclosure of a design)

(1) In applying Article 34 of this Act, a design shall be deemed to have been available to the public if it has been published in registration proceedings or otherwise, exhibited, used in trade or otherwise disclosed before the filing date of the application or, if priority is claimed, the date of priority, unless these events could not have become known in the normal course of business to the circles specialised in the sector concerned operating within the European Union. A design shall not be deemed to have been available to the public for the sole reason that it has been disclosed to a third party under explicit or implicit conditions of confidentiality.

(2) In applying Article 34 of this Act, a disclosure shall not be taken into account if a design for which industrial design protection is sought has been made available to the public in the European Union:

- a) as a result of information provided or action taken by the designer, their successor in title or a third party and

- b) during the 12-month period preceding the filing date of the application or, if priority is claimed, the date of priority.

(3) The preceding paragraph shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or their successor in title.

Article 36 (Refusal of an industrial design)

- (1) A design may not be registered as an industrial design if:
- a) it is not in accordance with paragraph two of Article 33 of this Act;
 - b) it does not meet the conditions referred to in paragraph one or four of Article 33 or Articles 34 or 35 of this Act or is in conflict with an industrial design having effect in the Republic of Slovenia on the basis of an application with an earlier filing date;
 - c) it must be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property of 20 March 1883, last revised on 14 July 1967 (Official Gazette of the Socialist Federal Republic of Yugoslavia – International Treaties [*Uradni list SFRJ – MP*], Nos 5/74 and 7/86; Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS – MP*], No. 9/92; hereinafter: the Paris Convention) because an authorisation of the competent authorities has not been issued;
 - d) it includes or imitates badges, emblems or escutcheons, other than those covered by Article 6ter of the Paris Convention, that are of particular public interest, unless the competent authorities have given consent to the registration thereof;
 - e) it is contrary to public order or morality.

(2) An industrial design may not be registered for the features of appearance of a product that are solely dictated by its technical function.

(3) An industrial design may not be registered for the features of appearance of a product that must be reproduced in their exact form and dimensions in order to allow the product to which the design relates to be mechanically connected to or placed in, around or against another product so that each product can perform its function.

(4) Notwithstanding the preceding paragraph, a design allowing multiple assembly or connection of mutually interchangeable products within a modular system may be registered as an industrial design under the conditions set out in Article 34 of this Act.

Article 37 (Industrial design rights)

(1) The holder of an industrial design shall have the exclusive right to use it and to prevent any third party not having their consent from using it. The aforementioned use shall cover, in particular, the making, offering, placing on the market, importing, exporting or using the product to which the design relates, or stocking such a product for such purposes.

(2) The scope of protection shall include any design that does not produce a different overall impression on an informed user. In assessing the scope of protection, the degree of freedom of the designer in developing the design shall be taken into account.

- (3) The rights referred to in paragraph one of this Article shall not apply to:
- a) the importation of spare parts and accessories for the purpose of repairing a ship or aircraft temporarily entering the territory of the Republic of Slovenia, the execution of repairs on

- such a ship or aircraft, and *mutatis mutandis* the acts referred to in Article 19 of this Act, with the exception of point c);
- b) acts of reproduction for the purposes of citing or teaching, provided that such acts are in accordance with good business practice and do not unduly harm the normal exploitation of the design, and that the source is acknowledged.

(4) Any third person may exercise the right of prior use of an industrial design. The provisions of Article 20 of this Act shall apply *mutatis mutandis* to such cases.

Article 38 **(Exhaustion of industrial design rights)**

(1) Industrial design rights shall not apply to acts related to a product to which the design which is the subject of industrial design relates if the product has been placed on the market in the Republic of Slovenia by the holder of the industrial design or with the holder's consent.

(2) The exhaustion of industrial design rights under the preceding paragraph may be extended beyond the territory of the Republic of Slovenia if this is in accordance with an international treaty that is binding on the Republic of Slovenia.

Article 39 **(Other forms of industrial design protection)**

(1) The provisions of this Act concerning industrial designs shall be without prejudice to the provisions of other acts concerning unregistered industrial designs, trade marks or other distinctive signs, patents, utility models or marks, civil liability, or unfair competition.

(2) An industrial design may be the subject of copyright protection from the date when the design was created or fixed in any form if it fulfils the conditions under which such protection is granted under the Act governing copyright and related rights.

Article 40 **(Term of an industrial design)**

(1) The term of an industrial design shall be one or several five-year periods from the date of filing of the application.

(2) Subject to the relevant provisions of Article 109 of this Act, the holder of an industrial design may renew the industrial design for one or more five-year periods, up to a total of 25 years from the date of filing of the application.

(3) If an industrial design relates to more than one product, it may be renewed, in accordance with the preceding paragraph, as a whole or in a limited scope only for some products.

Section 2 **International deposit of industrial designs**

Article 41 **(Requests under the Hague Agreement)**

(1) Requests under the Hague Agreement Concerning the International Registration of Industrial Designs of 28 November 1960, as completed on 14 July 1967 and amended on 28 September 1979 (Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS – MP*], No. 20/94; hereinafter: the Hague Agreement), shall be filed, in accordance with the Hague Agreement and rules and instructions issued to implement it, directly with the International Bureau.

(2) In accordance with Article 8 of the Hague Agreement, the provisions of this Act, with the exception of paragraph two of Article 96 thereof, shall apply *mutatis mutandis* to requests under the Hague Agreement seeking protection of an industrial design in the Republic of Slovenia.

Chapter Four TRADE MARKS

Section 1 Trade marks and collective marks

Article 42 (Subject of trade mark protection)

(1) A trade mark may consist of any signs, in particular words, including personal names, or images, letters, numerals, colours, the shape of a good or its packaging, or sounds, provided that:

- a) such signs make the goods or services of an undertaking distinguishable from those of other undertakings and
- b) such signs can be represented in the register in a manner which enables the Office and other competent authorities and the public to clearly and precisely determine the subject of protection afforded to its holder.

(2) In assessing whether a sign may be registered as a trade mark, all actual circumstances, in particular the duration of its use, shall be taken into account.

(3) The nature of the goods or services on which a trade mark is to be used shall in no way hinder the registration of the trade mark.

Article 43 (Absolute grounds for trade mark refusal)

(1) A sign shall not be registered as a trade mark if:

- a) it cannot constitute a trade mark;
- b) it is devoid of any distinctive character;
- c) in trade, it serves solely to designate the type, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or provision of the service or other characteristics of the goods or services;
- d) it consists solely of signs or indications which have become customary in the current language or in the bona fide and established trade practices;
- e) it consists solely of the shape or other characteristic that results from the nature of the goods themselves, is necessary to obtain a technical effect, or gives substantial value to the goods;
- f) it is contrary to public order or morality;

- g) it deceives the public, in particular as to the nature, quality or geographical origin of the goods or services;
- h) it has not been authorised by the competent authorities and must be refused pursuant to Article 6ter of the Paris Convention;
- i) it includes or imitates badges, emblems or escutcheons, other than those covered by Article 6ter of the Paris Convention, that are of particular public interest, unless the competent authorities have given consent to the registration thereof;
- j) it is excluded from the registration in accordance with the legislation of the Republic of Slovenia or the European Union or with international treaties to which the Republic of Slovenia or the European Union are parties which provide protection for designations of origin and geographical indications;
- k) it is excluded from the registration in accordance with the legislation of the European Union or with international treaties to which the European Union is party which provide protection for traditional terms for wine;
- l) it is excluded from the registration in accordance with the legislation of the European Union or with international treaties to which the European Union is party which provide protection for traditional specialities guaranteed;
- m) it consists of a plant variety name that has been previously registered in accordance with the legislation of the Republic of Slovenia or the European Union or with international treaties to which the Republic of Slovenia or the European Union are parties which provide protection for plant variety rights and relates to plant varieties of the same or closely related species or contains the essential elements of such a name.

(2) Notwithstanding points b), c) and d) of the preceding paragraph, a trade mark registration shall not be refused if through use the sign has acquired a distinctive character before the date of filing of the application.

Article 44 (Relative grounds for trade mark refusal)

(1) If an opposition has been filed in accordance with Article 101 of this Act, a trade mark shall not be registered in respect of a sign:

- a) that is identical to the sign of an earlier trade mark and the goods or services for which the trade mark is applied for are identical to the goods or services for which the earlier trade mark is protected;
- b) whose identity or similarity to the sign of an earlier trade mark, and the identity or similarity of the goods or services on which the sign and the trade mark are to be used, lead to the possibility of confusion among the public, which includes the possibility of association with the earlier trade mark;
- c) that is identical to the sign of an earlier trade mark, regardless of whether the goods or services for which the trade mark is applied for are identical or similar to the goods or services for which the earlier trade mark is protected if the earlier trade mark has a reputation in the Republic of Slovenia and the use of the later trade mark without due cause would take unfair advantage of or be detrimental to the distinctive character or the reputation of the earlier trade mark;
- d) if its use may be prohibited on the basis of the right to an unregistered sign used in trade that was obtained before the filing date of the trade mark application or the date of priority if priority is claimed;
- e) that an agent or representative of the holder of the trade mark has registered as a trade mark in their own name without the holder's consent, unless the agent or representative justifies their action;
- f) if its use may be prohibited on the basis of a registered designation of origin or geographical indication for which an application has been filed in accordance with the legislation of the Republic of Slovenia or the European Union concerning the protection of designations of

- origin or geographical indications before the filing date of the trade mark application or the date of priority if priority is claimed;
- g) if its use may be prohibited on the basis of an earlier right to a name, personal portrayal, copyright or other industrial property right, unless the holder of the earlier right has given express consent to the registration of such a trade mark.

(2) An earlier trade mark shall mean:

- a) a trade mark that was registered in the Republic of Slovenia on the basis of a national application before the filing date of the application for the later trade mark or, if priority is claimed, the date of priority;
- b) a European Union trade mark (hereinafter: EU trade mark) that was registered before the filing date of the application for the later trade mark or, if priority is claimed, the date of priority;
- c) a trade mark that was registered on the basis of international treaties that are binding on the Republic of Slovenia before the filing date of the application for the later trade mark or, if priority is claimed, the date of priority;
- d) trade mark applications referred to in points a), b) and c) of this paragraph that were filed before the filing date of the application for the later trade mark or, if priority is claimed, the date of priority, provided they are registered;
- e) an unregistered sign that, on the filing date of the trade mark application or, if priority is claimed, the date of priority, is a known trade mark in the Republic of Slovenia under Article 6bis of the Paris Convention.

Article 45 (Collective marks)

(1) A collective mark shall mean a trade mark that is described as such upon the filing of the application and whose sign allows distinguishing the goods or services of the members of the holder of such mark from the goods or services of other undertakings.

(2) An applicant for or holder of a collective mark may be a legal entity acting as an association of manufacturers, producers, suppliers of services or traders or a legal entity under public law.

(3) The members of a collective mark holder may use the collective mark in accordance with the regulations referred to in Article 46 of this Act.

(4) The provisions of this Act shall apply to the acquisition of collective marks, unless otherwise provided by this Act. Notwithstanding point c) of paragraph one of Article 43 of this Act, a sign indicating the geographical origin of goods or services may be registered as a collective mark.

Article 46 (Regulations on a collective mark)

(1) An applicant for a collective mark must enclose with the application the regulations on the collective mark.

(2) The regulations referred to in the preceding paragraph shall include at least:

- a) the name and registered office of the applicant;
- b) the applicant's business and information on whom it officially and statutorily represents;
- c) the conditions of membership;
- d) conditions for the use of the collective mark;

- e) information on the group of persons entitled to use the collective mark;
- f) provisions concerning the rights and obligations of the members in the event of infringement of the collective mark rights.

(3) An applicant for or a holder of a collective mark shall notify the Office of any amendments to the regulations and submit a clean copy thereof. The Office shall make an entry in the register on the amendment to the regulations, unless the amended regulations do not fulfil the requirements referred to in the preceding paragraph or any of the grounds referred to in Article 46a of this Act exist. An amendment to the regulations takes effect on the date of entry of the amendment in the register.

(4) The regulations shall be public and any person shall be allowed access to them.

Article 46a **(Grounds for collective mark refusal)**

(1) A collective mark shall not be registered if any of the grounds referred to in Articles 42, 43 or 44 of this Act exist and also if:

- a) it fails to meet the conditions referred to in Articles 45 and 46 of this Act;
- b) it could mislead the public as to its character or significance, particularly if it is likely to be taken to be something other than a collective mark;
- c) regulations referred to in Article 46 of this Act are contrary to public order or morality.

(2) Notwithstanding point c) of the preceding paragraph, the registration of a collective mark shall not be refused if the applicant remedies the established deficiencies by amending the regulations referred to in Article 46 of this Act.

Article 47 **(Trade mark rights)**

(1) A trade mark shall confer on the holder exclusive right to use the trade mark and other exclusive rights under this Act. Without prejudice to the holder's rights that have been acquired before the filing date of the trade mark application or priority date, the holder of a trade mark has the right to prevent third parties not having the holder's consent from using in trade in relation to goods or services any sign:

- a) that is identical to the trade mark on the same goods or services as those covered by the trade mark;
- b) whose identity or similarity to the trade mark, and the identity or similarity of the goods or services covered by the trade mark and the sign, lead to the possibility of confusion among the public, which includes the possibility of association between the sign and the trade mark;
- c) that is identical to the trade mark, regardless of whether the goods or services are identical or similar to the goods or services covered by the trade mark, if the trade mark has a reputation in the Republic of Slovenia and the use of such a sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the reputation of the trade mark.

(2) The right referred to in the preceding paragraph to prevent third parties from using a sign shall include in particular the prohibition against:

- a) affixing the sign to goods or their packaging;
- b) offering goods bearing the sign, placing such goods on the market or stocking them for these purposes or offering or supplying services under the sign;
- c) importing or exporting goods under the sign;

- d) using the sign on business documents and in advertising;
- e) using the sign as a trade name or company name or a part of trade name or company name;
- f) using the sign in comparative advertising in a manner contrary to the legislation of the Republic of Slovenia or the European Union concerning misleading and comparative advertising.

(3) Without prejudice to the holder's rights acquired before the filing date of the trade mark application or priority date, the holder of a trade mark has the right to prevent third parties from bringing goods, in the course of trade, into the Republic of Slovenia, without the goods being released for free circulation, if such goods, including the packaging thereof, come from countries that are not members of the European Union or European Economic Area and bear, without the authorisation of the trade mark holder, a sign that is identical to the trade mark registered for such goods or which cannot be distinguished in its essential aspects from that trade mark.

(4) A trade mark holder shall no longer have the right referred to in the preceding paragraph if, during infringement proceedings initiated in accordance with the legislation of the European Union concerning customs measures relating to infringements of intellectual property rights, the declarant or holder of the goods proves that the holder of the trade mark has no right to prohibit the placing of the goods on the market in the country of final destination.

Article 47a

(Prohibition of preparatory acts related to packaging or other means)

If there is a risk that the packaging, labels, tags, security or authenticity features or devices, or any other means to which a trade mark is affixed could be used in relation to goods or services and that use would infringe on the rights of the holder of a trade mark referred to in paragraphs one or two of Article 47 of this Act, the holder of that trade mark shall have the right to prohibit the following acts if carried out in the course of trade:

- a) affixing a sign identical or similar to the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark may be affixed;
- b) offering or placing on the market, stocking for these purposes, or importing or exporting packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed.

Article 48

(Limitation of trade mark rights)

(1) The holder of a trade mark may not prohibit a third party from using in the course of trade and in accordance with good business practice:

- a) their own name or address;
- b) signs or indications that are not distinctive or indications concerning the type, quality, quantity, intended purpose, value, geographical origin or the time of production of goods or provision of service, or other characteristics of goods or services;
- c) the trade mark for the purpose of identifying or referring to goods or services as those of the holder of the trade mark concerned, in particular if the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular with regard to accessories or spare parts;
- d) any sign that is identical or similar to the trade mark, if the third party started to use it in good faith before the filing date of the application or the date of priority if priority is claimed in the application.

(2) A trade mark shall not give the holder the right to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular area if the earlier right is recognised in the Republic of Slovenia and the use is within the limits of the territory in which it is recognised.

Article 49
(Limitation of collective mark rights)

(1) A collective mark indicating the geographical origin of goods shall not give the holder the right to prohibit a third party from using such a sign in the course of trade if they use it in accordance with good business practice or to prohibit the use of the geographical origin by a third party entitled to the use thereof.

(2) The holder of a collective mark indicating the geographical origin of goods or services shall enable any person whose goods or services originate in the geographical area concerned and meet the conditions for the use of a collective mark laid down by the regulations referred to in Article 46 of this Act to become a member of the holder of the collective mark.

Article 50
(Exhaustion of trade mark rights)

(1) A trade mark shall not give the holder the right to prohibit its use in relation to the goods that have been placed on the market in the European Economic Area by the holder or with the holder's consent.

(2) The preceding paragraph shall not apply if valid reasons exist for the holder to oppose further commercialisation of the goods, especially if the condition of the goods has changed or deteriorated after they have been placed on the market.

Article 51
(Reproduction of trade marks in dictionaries)

If the reproduction of a trade mark in a dictionary, encyclopaedia or similar publication gives the impression that it constitutes the generic name of the goods or services for which the sign is registered, the publisher of the work shall, at the request of the holder of the trade mark, ensure that, at the latest in the next edition of the publication, the reproduction of the trade mark is accompanied by an indication that it is a trade mark. If the work is in electronic form, the publisher shall ensure this immediately.

Article 52
(Term of a trade mark)

(1) The term of a trade mark shall be ten years from the filing date of the application.

(2) Subject to the relevant provisions of Article 109 of this Act, the holder of a trade mark or any person authorised to do so by an Act or contract may renew the trade mark for another ten years, counting from the filing date of the application, an unlimited number of times.

(3) A trade mark may be renewed in accordance with the preceding paragraph for all goods or services or in a limited scope for only some goods or services.

Article 52a

(Prohibition of the use or transfer of a trade mark registered in the name of an agent or representative)

(1) If a trade mark has been registered in the name of the agent or representative of the trade mark holder without the holder's consent, the trade mark holder has the right to request that their agent or representative be prohibited from using the trade mark and that the trade mark be transferred to them.

(2) The trade mark holder shall not have the right referred to in the preceding paragraph if the agent or representative justifies their action.

Article 52b

(Use of a trade mark)

(1) If, within a period of five years following the date of the entry of the trade mark in the register, the holder has not put the trade mark to genuine use in the Republic of Slovenia on the goods or services for which it is registered, or if such use has been interrupted in the period of five consecutive years, the trade mark shall be subject to the limitations and sanctions referred to in Articles 52c, 102a, 120 and 122a of this Act, unless justified reasons exist for non-use.

(2) The following shall also be considered as the use of a trade mark:

- a) the use of a trade mark in a form differing from the form in which it has been registered in elements which do not alter the distinctive character of the trade mark, regardless of whether the trade mark has been registered in the name of the holder of the trade mark in the form in which it is used;
- b) the affixing of a trade mark to goods or the packaging thereof in the Republic of Slovenia solely for export purposes.

(3) It shall be considered that the holder uses a trade mark if it is used with their consent.

(4) A collective mark shall be considered to be used by the holder if it is used by at least one person entitled to use it.

Article 52c

(Non-use as defence in invalidation proceedings)

(1) A holder of a later trade mark whose invalidation is requested by the holder of an earlier trade mark may request that the holder of the earlier trade mark provide evidence that, during the five-year period preceding the date of the application for invalidity, they had genuinely used their trade mark that is subject to the application for invalidity, in accordance with Article 52b of this Act, on the goods or services for which it is registered, or that there are justified reasons for non-use, provided that the earlier trade mark was entered in the register at least five years before the filing date of the application for the later trade mark to be declared invalid.

(2) If on the filing date of the application for the later trade mark or on the date of priority, the five-year period within which the holder of the earlier trade mark should have put it to genuine use in accordance with Article 52b of this Act had expired, the holder of the earlier trade mark shall, in addition to the evidence referred to in the preceding paragraph, provide evidence that they had put the trade mark to genuine use during the five-year period preceding

the filing date of the application for the later trade mark or the date of priority, or that justified reasons for non-use existed.

(3) If the holder of the earlier trade mark fails to prove, at the request of the holder of the later trade mark, the existence of circumstances referred to in paragraphs one and two of this Article, the application for the later trade mark to be declared invalid on the basis of an earlier trade mark shall be rejected.

(4) If the earlier trade mark has only been used on some of the goods or services for which it is registered, it shall, for the purpose of the examination of the merits of the application for invalidity, be considered to only be registered for such goods or services.

Article 52d
(Cessation of right to apply for invalidity of a trade mark)

(1) If, in a period of five consecutive years, the holder of an earlier trade mark has not opposed the use of the later trade mark while being aware of such use, they shall no longer have the right to apply, on the basis of their earlier trade mark, for the later trade mark to be declared invalid for the goods or services on which the later trade mark is being used, unless the later trade mark has not been applied for in good faith.

(2) The holder of the later trade mark shall prove that they have used their trade mark for at least five consecutive years and that the holder of the earlier trade mark was aware of this use.

(3) In the case referred to in paragraph one of this Article, the holder of the later trade mark shall no longer have the right to oppose the use of the earlier trade mark even though the earlier trade mark may no longer be invoked against the later trade mark.

Article 52e
(Distinctive character and declaration of trade mark invalidity)

(1) A trade mark shall not be declared invalid under points b), c) or d) of paragraph one of Article 43 of this Act if through use it has acquired a distinctive character before the filing date of the application for invalidity.

(2) An application based on an earlier trade mark for a later trade mark to be declared invalid shall not be granted on the filing date of the application for invalidity if such an application would not have been granted on the filing date of the application for the later trade mark or the date of priority for the following reasons:

- a) the earlier trade mark can be declared invalid under points b), c) or d) of paragraph one of Article 43 of this Act, as it has not yet acquired a distinctive character;
- b) the application for invalidity is based on point b) of paragraph one of Article 44 of this Act and the earlier trade mark has not yet become sufficiently distinctive to support the claim of the likelihood of confusion under point b) of paragraph one of Article 44 of this Act; or
- c) the application for invalidity is based on point c) of paragraph one of Article 44 of this Act and the earlier trade mark has not yet acquired a reputation within the meaning of point c) of paragraph one of Article 44 of this Act.

Article 52f
(Subsequent establishment of invalidity or revocation of a trade mark)

If seniority of an earlier trade mark registered on the basis of a national application or international treaties that are binding on the Republic of Slovenia which the holder has surrendered or allowed to lapse is claimed for an EU trade mark, the invalidity or revocation of the trade mark which serves as providing the basis for the seniority claim may also be established after its expiry if the invalidity or revocation of the trade mark could have been established at the time the holder surrendered it or allowed it to lapse. In such a case, the seniority of the earlier trade mark shall cease to have effect.

Section 2
International registration of trade marks

Article 53
(Filing of application with the Office)

(1) The Office shall accept applications under the Madrid Agreement Concerning the International Registration of Marks of 14 April 1891 as last revised on 14 July 1967 (Official Gazette of the Socialist Federal Republic of Yugoslavia – International Treaties [*Uradni list SFRJ – MP*], No. 2/74, and Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS – MP*], No. 9/92; hereinafter: the Madrid Agreement) and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 27 June 1997 (Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS – MP*], No. 21/97; hereinafter: the Madrid Protocol).

(2) A corresponding fee shall be paid upon filing the application or within three months of the service of the Office's request. If the fee is not paid within this time limit, the application shall be considered to be withdrawn.

(3) The application for international registration of a trade mark shall be accompanied by a list of goods or services in a language as prescribed by the Madrid Agreement or the Madrid Protocol and the rules and instructions for their implementation.

(4) If the application is not drawn up in accordance with the Madrid Agreement or the Madrid Protocol, the rules and instructions for their implementation, this Act and implementing regulations, the Office shall invite the applicant to amend the application accordingly within three months of the service of the invitation. If the applicant fails to amend the application within this time limit, the application shall be considered to be withdrawn.

(5) The minister responsible for industrial property shall, by way of an implementing regulation, determine in greater detail the content of the application referred to in paragraph one of this Article and procedures relating thereto.

Article 54
(Examination of international trade marks)

(1) In accordance with Article 5 of the Madrid Agreement or Article 5 of the Madrid Protocol, the provisions of this Act, with the exception of Article 103 thereof, shall apply *mutatis mutandis* to applications under the Madrid Agreement or the Madrid Protocol seeking trade mark protection in the Republic of Slovenia.

(2) The publication of information on the international registration of a trade mark in the journal of the International Bureau shall be considered as the publication of the trade mark application in the Republic of Slovenia.

(3) If the holder of the trade mark for which protection is sought in the Republic of Slovenia under the Madrid Agreement or the Madrid Protocol does not state their position on the intended refusal of the protection of the trade mark, their having been notified in accordance with Article 5 of the Madrid Agreement or Article 5 of the Madrid Protocol, the Office shall, notwithstanding paragraph five of Article 129 of this Act, serve the decision by mail directly to the holder of the trade mark.

Article 54a **(Use of international trade marks)**

(1) With regard to trade marks registered pursuant to international treaties that are binding on the Republic of Slovenia, the period of five years referred to in Article 52b of this Act shall run from the date when the Office's statement on the recognition of protection of an internationally registered trade mark in the Republic of Slovenia is published in the journal of the International Bureau.

(2) If, after the expiry of one year from the date of notification of the International Bureau of the application for the protection of an internationally registered trade mark in the Republic of Slovenia, the Office has not notified the International Bureau of the temporary refusal of protection of the internationally registered trade mark in the Republic of Slovenia or has not sent to the International Bureau a statement on the recognition of the protection of the internationally registered trade mark in the Republic of Slovenia, the period of five years referred to in Article 52b of this Act shall run from the first day following the expiry of a period of one year from the date of notification of the International Bureau of the application for the protection of internationally registered trade mark in the Republic of Slovenia.

Chapter Five **GEOGRAPHICAL INDICATIONS**

Article 55 **(Subject of registered geographical indication protection)**

(1) Geographical indications that may be registered shall be indications which identify a good as originating in a certain territory, or a region or a place in that territory, if the quality, reputation or other characteristic of the good depends to a significant extent on its geographical origin.

(2) The name of a good that has become generally known through long-term use in the course of trade as the name indicating that the good originates in a specific place or region may also be registered as a geographical indication.

(3) Geographical indications related to a good of special historic or cultural importance may be protected directly by a decree of the Government of the Republic of Slovenia.

(4) Geographical indications for agricultural products and food products and for wine and other grape and wine products may not be registered as geographical indications under this Act.

Article 56 **(Grounds for refusing the registration of a geographical indication)**

- A geographical indication may not be registered if:
- a) it indicates or suggests that the good in question originates in a geographical area other than its 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 place in which the good originates, it falsely represents to the public that the good originates in another region;
 - c) it has become generally known through long-term use in the course of trade as a designation for a specific type of good;
 - d) due to the indication's reputation and renown and the duration of its use, registration could mislead the consumer as to the true identity of the product.

Article 57
(Protection of a registered geographical indication from general use)

Registered geographical indications may not be converted into generic or commonly known names that could be freely used in trade.

Article 58
(Registered geographical indication rights)

(1) A registered geographical indication is a collective right and may be used in trade by persons who, in accordance with the specification referred to in paragraph two of Article 104 of this Act, produce or place on the market goods protected by the geographical indication.

(2) A registered geographical indication may not be used by persons not entitled to do so.

(3) The use of a registered geographical indication shall be prohibited if the goods do not originate in the place indicated by the geographical indication even if the true origin of the goods is indicated or if the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.

Article 59
(Limitation of registered geographical indication rights)

(1) A trade mark that is identical or similar to a registered geographical indication may not be revoked nor its use prohibited if it has been applied for or registered in good faith or if has been acquired through use in good faith before the geographical indication was registered.

(2) A registered geographical indication shall not exclude the right of any person to use in trade their own name or the name of their predecessor in business, except if the name is used in such a manner as to mislead the public.

Article 60
(Term of a registered geographical indication)

The term of a registered geographical indication shall be unlimited.

Article 61 **(Union right of priority)**

(1) Any person who has duly filed the first application for a patent, industrial design or trade mark in a member country of the Union established under the Paris Convention (hereinafter: the Paris Union) or of the World Trade Organisation (hereinafter: the WTO) shall have the right of priority upon filing an application in the Republic of Slovenia. The time limit for exercising the right of priority shall for patents be 12 months and for industrial designs and trade marks six months from the filing date of the first application.

(2) When filing an application in the Republic of Slovenia, a person claiming the right of priority referred to in the preceding paragraph shall indicate the date of the claimed priority. Within three months of the filing of the application, the number and country or office of the first application shall be communicated to the Office. If the applicant fails to comply with the provisions of this paragraph, the priority shall be deemed not to have been claimed.

(3) At the request of the Office or, in case of dispute, at the request of the court, the person claiming the right of priority shall submit a copy of the first application, certified by the competent authority in the member country of the Paris Union or the WTO in which the first application was filed. A copy of the first application may not be required before the expiry of 16 months from the filing date of the first application.

(4) If the copy of the first application referred to in the preceding paragraph is not in Slovenian and the validity of the claimed priority is relevant to determine whether the invention concerned is patentable, the Office or, in case of dispute, the court may request that the person claiming priority submit a Slovenian translation of the first application within three months of the service of the request.

(5) An applicant may claim multiple priorities based on several previous applications filed in one or several countries.

(6) An applicant may claim the right of priority in a patent application on the basis of a utility model application.

(7) On request and against payment of the fee prescribed by the Act governing administrative fees, the Office shall issue a priority right certificate. The minister responsible for industrial property shall, by way of an implementing regulation, determine in greater detail the content of a priority right certificate and the procedure for the issuing thereof.

Article 62 **(Exhibition priority right)**

(1) A person who displays an invention or the design of a product or part thereof or uses a sign for marking goods or services at an official or officially recognised international exhibition under the Convention relating to International Exhibitions, signed on 22 November 1928 and last revised on 30 November 1972, in the Republic of Slovenia or other member country of the Paris Union or the WTO, may, within three months of the closing of the exhibition, claim in their application the right of priority as of the first day of the display of the invention or the design of a product or part thereof or of the use of the sign.

(2) When filing the application in the Republic of Slovenia, a person claiming the right of priority referred to in the preceding paragraph must provide information on the type of exhibition, the place where it was held, the opening and closing dates, and the first day of display or use and submit a written certificate of a competent authority in the member country

of the Paris Union or the WTO that the exhibition was an official or officially recognised international exhibition. If the applicant fails to comply with the provisions of this paragraph, the priority shall be deemed not to have been claimed.

(3) The claiming of priority under paragraph one of this Article shall not extend the time limit for claiming the union right of priority referred to in paragraph one of Article 61 of this Act.

Article 63 (Amendment of a priority claim)

(1) An applicant may request a priority claim in a patent application to be amended within 16 months of the date of priority claimed or the amended date of priority claimed, if the amendment would result in a change in the date of priority, provided that such a request is filed within four months of the filing date of the patent application.

(2) When filing the request, the applicant shall pay a fee, otherwise the request shall be deemed to be withdrawn.

(3) If an applicant has requested publication under paragraph two of Article 89 of this Act and subsequently also filed a request referred to in paragraph one of this Article, the request referred to in paragraph one of this Article shall be deemed not to have been filed, unless the applicant withdraws the request under paragraph two of Article 89 of this Act before the technical preparations for publication of the application are completed.

(4) If the amendment of a priority claim results in a change in the date of priority, the time limits shall start to run from the amended date of priority claimed.

Article 64 (Establishment of priority right)

(1) If the filing date of a patent application in which the priority of the first application could be claimed is later than the last date of the time limit for claiming priority, but not by more than two months, the applicant may request the establishment of priority right if they were not able to file the application within the time limit referred to in paragraph one of Article 61 of this Act despite taking all due care considering the circumstances.

(2) The applicant must file the request for the establishment of priority right within two months of the last date of the time limit for claiming priority and before technical preparations for publication of the application are completed. When filing the request, the applicant shall pay a fee, otherwise the request shall be deemed to be withdrawn.

Article 65 (Prohibition to extend the scope of an application)

(1) After the filing date, the subject matter of a patent application may not be extended beyond the subject matter of the application initially accepted.

(2) After the filing date of an industrial design application, the appearance of the product or part thereof may not be substantially modified or the number of products increased.

(3) After the filing date of a trade mark application, the sign may not be substantially modified or the original number of goods or services increased.

Article 66
(Extension of time limits)

(1) Before a time limit under this Act expires, the applicant or holder may once request for it to be extended by three months.

(2) The time limits for filing an action and time limits referred to in paragraph one of Article 13, paragraph two of Article 27, paragraph two of Article 35, paragraph one of Article 61, paragraph one of Article 62, paragraph one of Article 63, paragraph two of Article 64, paragraph two of Article 67, paragraph two of Article 68, paragraph three of Article 80, paragraph three of Article 86, paragraph one of Article 91, paragraph three of Article 92, paragraphs two and three of Article 94, paragraphs one and four of Article 101, Article 109, Article 110, paragraph one of Article 117, paragraph two of Article 130, and paragraph two of Article 137 shall not be extendable.

Article 67
(Continuation of proceedings after missed time limit)

(1) An applicant who has missed a time limit for the fulfilment of the obligations required in the proceedings for the acquisition of a right may request that the missed time limit be deemed to have been complied with, that the legal consequences of missed time limit be waived and that the Office continues the proceedings concerning the acquisition of the right.

(2) The request for the continuation of proceedings shall be filed within two months counting from the date when the reasons for which the applicant missed the deadline ceased to exist, or, if the applicant only later learned that the time limit was missed, from the date when they learned about it but not later than six months from the day the time limit was missed. When filing the request, the applicant shall complete the omitted act and pay a fee for the continuation of proceedings. If the omitted act is not completed or if the fee for the continuation of proceedings is not paid in the aforementioned time limit, the request shall be deemed not to have been filed.

(3) The continuation of proceedings may not be requested if the missed time limit is the time limit referred to in the preceding paragraph or the time limit for filing an opposition or action, or if a request for restitution, a request for the amendment of a priority claim or a request for the establishment of priority right has been filed.

(4) If the Office grants a request for the continuation of proceedings, paragraphs six or seven of Article 68 of this Act shall apply *mutatis mutandis*.

Article 68
(Restitution)

(1) In proceedings before the Office, a party may request restitution on justified grounds if, despite taking all due care considering the circumstances, they were unable to fulfil in due time the obligations required by the Office in accordance with this Act and the implementing regulations issued pursuant to this Act, and this resulted in any of their applications being considered withdrawn or being rejected or refused or the right lapsing.

(2) The request for restitution shall be filed within three months counting from the date when the reasons for which the party missed the deadline ceased to exist or, if the party only later learned that the time limit was missed, from the date when they learned about it. When filing the request, the omitted act shall be completed and a fee shall be paid. If the

omitted act is not completed or the fee not paid on filing the request, the request shall be deemed to be withdrawn.

(3) The Office may not refuse the request for restitution, wholly or partly, without previously notifying the party in writing of the reasons for the intended total or partial refusal and without inviting the party to, within three months from the service of the invitation, state their position on the reasons for refusal.

(4) After the expiry of one year from the date of a missed time limit, a request for restitution may no longer be filed.

(5) A restitution may not be requested for missing the time limit for filing a request for restitution, a request for the continuation of proceedings, an opposition or action, a priority right claim and the copy of the first application, a request for amending a priority claim, or a request for the establishment of priority right.

(6) Any person who in good faith has used or made effective and serious preparations for using an invention or an industrial design that is the subject of a published application may, without compensation, continue such use in the course of their business or for the needs thereof during the period between the loss of the right under paragraph one of this Article and the publication of the notice of restitution of this right.

(7) If an applicant for or holder of a trade mark has restored their right to the trade mark by restitution, they may not exercise their right against any person who has in good faith placed goods on the market or supplied services under a sign that is identical or similar to the trade mark concerned during the period between the loss of the right under paragraph one of this Article and the publication of the notice of the restitution of the right.

Article 69 (Withdrawal of a request)

(1) A party to proceedings before the Office may withdraw their application at any time during the proceedings.

(2) An application is deemed to be withdrawn as of the date when the Office receives the request for its withdrawal.

(3) On the basis of the request for application withdrawal, the Office shall issue a decision on the closure of the proceedings.

(4) If an applicant withdraws a patent application after technical preparations for the publication of this application have been completed and the application published, the publication of the application shall not be deemed to form part of the state of the art under Article 12 of this Act.

Article 70 (Notification of the applicant before the refusal of a right)

(1) The Office may not issue a decision on the refusal or partial refusal of a request for the granting or registration of a right without previously informing the applicant in writing of the reasons for not being able to grant or register the right or not being able to grant or register the right in the requested scope and without inviting the applicant to, within three months of the service of the invitation, state their position on the reasons for refusal or amend the filed request.

(2) If the applicant states their position on the reasons for the total or partial refusal of their request or amends their request, the Office shall, before issuing a decision, verify whether the reasons for the total or partial refusal of the request for the granting or registration of the right still exist.

Article 71
(Administrative dispute)

There shall be no appeal against a decision of the Office; however, an action in the administrative dispute may be filed with the Administrative Court of the Republic of Slovenia in Ljubljana. The court shall decide on the case at its seat in Ljubljana.

Article 72
(Procedure concerning actions)

(1) The court shall immediately notify the Office of the receipt of an action under this Act and of its final decision. The court shall send its judgement, together with the confirmation that it is final, to the Office for execution.

(2) The Office shall issue a decision by which it executes the court decision.

(3) Procedures concerning actions under this Act shall be expedited. The court shall consider the actions under this Act as a priority.

(4) Paragraphs one and two of this Article shall not apply to disputes concerning the infringement of rights.

Article 73
(Inventor, designer)

(1) In the proceedings for the granting of a patent, the inventor referred to as such in the application shall be deemed to be the inventor, unless otherwise decided by the court.

(2) Paragraph one of this Article shall apply *mutatis mutandis* to the designer of a design.

(3) The Office shall not verify the accuracy of information on the inventor or designer.

Article 74
(Holder of a right)

(1) Patents shall be granted and industrial designs or trade marks registered in the name of the person who is designated as the applicant upon the granting or registration.

(2) If several persons are designated as applicants, the provisions of the preceding paragraph shall apply *mutatis mutandis*. The Office shall not determine mutual relations among the persons designated as applicants.

Article 75
(Transfer of rights)

(1) The holder of a patent, industrial design or trade mark may transfer their right, wholly or partly, by a contract, separately from the transfer of the undertaking.

(2) A transfer of an undertaking as a whole agreed by a contract shall include the transfer of patents, industrial designs and/or trade marks of this undertaking, unless otherwise agreed or clearly indicated by the circumstances.

(3) Paragraphs one and two of this Article shall apply *mutatis mutandis* to the applicants and applications for patents, industrial designs and trade marks.

(4) A collective mark may only be transferred to a person meeting the conditions referred to in paragraph two of Article 45 of this Act.

(5) A transfer of a geographical indication to another person shall not be permitted.

Article 75a (Real rights)

(1) A patent, industrial design or trade mark may be given as security or be the subject of real rights separately from the undertaking.

(2) The preceding paragraph shall apply *mutatis mutandis* to patent, industrial design and trade mark applications.

Article 75b (Enforcement)

(1) Patents, industrial designs and trade marks may be subject to enforcement.

(2) The preceding paragraph shall apply *mutatis mutandis* to patent, industrial design and trade mark applications.

Article 75c (Licences)

(1) Patents, industrial designs and trade marks may be licensed, wholly or partly, for the entire territory of the Republic of Slovenia or a part thereof. A licence may be exclusive or non-exclusive.

(2) The preceding paragraph shall apply *mutatis mutandis* to patent, industrial design and trade mark applications.

(3) A holder of a trade mark may exercise the trade mark rights against a licensee who acts contrary to a provision of the licence agreement with regard to:

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

(4) Collective marks and geographical indications may not be the subject of a licence agreement.

Article 76
(Date of the acquisition of a right)

(1) Subject to paragraph two of this Article, the rights referred to in Articles 18, 37, 47 and 58 of this Act shall be acquired on the date of their entry in the relevant register.

(2) Subject to Article 122 of this Act, the right referred to in paragraph one of Article 18 of this Act may not be enforced by an action under Article 121 of this Act for infringement of a patent before the date of the issue of a declaratory decision under point a) or b) of paragraph one of Article 93 of this Act or before the date of the entry of a European patent in the Office's register.

Article 77
(Lapse)

The granted or registered rights shall lapse before the time limits laid down in Articles 22, 23, 40 and 52 of this Act:

- a) if the holder surrenders their right – on the day following the receipt of the surrender application by the Office;
- b) if the prescribed fees are not paid in accordance with this Act;
- c) pursuant to a final decision of the court or a decision of the Office in the cases provided by this Act – on the date specified in such a decision.

Article 78
(Correction of errors)

(1) The Office may at any time, *ex officio* or on request, correct errors in names, dates and numbers and other obvious errors in its acts, published documents and registers.

(2) Corrections of errors in published documents shall be published in the official journal.

Chapter Seven
PROCEDURE FOR THE ACQUISITION OF RIGHTS

Section 1
Filing of applications and formalities examination

Article 79
(Elements of an application)

(1) An application shall contain a statement to the effect that the acquisition of a specific right is requested and:

- a) for patents – all the elements listed in paragraph one of Article 86 of this Act;
- b) for industrial designs – all the elements listed in paragraph one of Article 94 of this Act;
- c) for trade marks – all the elements listed in paragraph one of Article 97 of this Act and for collective marks also the regulations referred to in Article 46 of this Act.

(2) The application shall also contain:

- a) a power of attorney if the application is filed by a representative;

- b) the Slovenian translation of the application if the application was originally filed in a foreign language in accordance with paragraph two of Article 81 of this Act;
- c) the receipt of payment of the full amount of the application fee.

(3) The minister responsible for industrial property shall, by way of implementing regulations, determine in greater detail the content of applications and the procedures for granting patents and registering industrial designs and trade marks.

Article 80 (Form of applications and the method of filing)

(1) An application for the acquisition of a right shall, in terms of form and content, comply with this Act and the regulations issued pursuant to this Act and shall contain all the information required. The application shall be legible and submitted so that its content can be clearly and suitably reproduced.

(2) The application shall be filed in writing, by hand or post, or by fax or other electronic means. The minister responsible for industrial property shall, by way of an implementing regulation, determine in greater detail the method of filing applications by other electronic means.

(3) If an application which has been filed by fax or other electronic means is not legible or cannot be clearly and suitably reproduced, the Office shall invite the applicant to submit a new copy of the application in writing within three months of the service of the invitation. If the Office does not receive the requested copy of the application within this time limit, the application shall be deemed to be withdrawn.

(4) An application fee shall be paid upon filing an application or within three months of the service of the Office's request. If the fee is not paid in full in due time, the application shall be deemed to be withdrawn.

Article 81 (Language of applications)

(1) Applications shall be filed in Slovenian, unless otherwise provided by this Act or an international treaty that is binding on the Republic of Slovenia.

(2) An application may be filed in a foreign language, provided that it includes at least the indication of the right requested and the information allowing the Office to contact the applicant in Slovenian or in one of the official languages of the EPC, the Madrid Agreement, the Madrid Protocol or the Hague Agreement.

(3) If an application is filed in a foreign language, the applicant shall submit to the Office a Slovenian translation thereof within three months of the service of the request. If the Office does not receive a Slovenian translation of the application in due time, the application shall be deemed to be withdrawn.

(4) The Office shall conduct the proceedings on the basis of the application in Slovenian.

Article 82 (Accordinging of the filing date of application)

(1) Subject to paragraph two of Article 81 of this Act, the Office shall accord the date of filing and a number to any application containing at least:

- a) a statement to the effect that the acquisition of a specific right is requested;
- b) information allowing the Office to establish the identity of the applicant or contact them;
- c) the essential elements of an application for the requested right referred to paragraph two of this Article.

(2) The essential elements referred to in point c) of the preceding paragraph shall be the following:

- a) for patent applications: the part of the application which at first glance appears to be a description of invention;
- b) for industrial designs: a photograph or graphical representation of the appearance of the product or, in the case of two-dimensional products, a specimen of the product or a part thereof if a deferment of publication under paragraph two of Article 94 of this Act is requested;
- c) for trade marks: a representation of the sign and a list of the goods or services for which the protection is sought, and for collective marks also the regulations referred to in Article 46 of this Act.

(3) The filing date of an application shall be deemed to be the date when the Office received all the elements referred to in paragraph one of this Article, subject to Article 83 of this Act, unless otherwise provided by this Act or by an international treaty that is binding on the Republic of Slovenia. The Office shall issue to the applicant a confirmation of the receipt of the application indicating the date of filing and the number of the application.

(4) If the application does not contain all the elements referred to in paragraph one of this Article and cannot be accorded the date of filing and number, the Office shall, as soon as it receives the information allowing it to make contact with the applicant, notify the applicant accordingly and invite them to amend the application within three months of the service of the invitation, so that it at least fulfils the conditions laid down in paragraph one of this Article.

(5) If the application referred to in the preceding paragraph is amended in due time so that it contains all the elements referred to in paragraph one of this Article, the Office shall accord to the application a number and the date of filing, which is the date of receipt of all the elements referred to in paragraph one of this Article, and shall issue a certificate to that effect to the applicant.

(6) If the application referred to in paragraph four of this Article is not amended in due time or is not appropriately amended in full, it shall be deemed to be withdrawn, and the Office shall notify the applicant thereof.

Article 83

(Specifics concerning the filing date of patent applications)

(1) If, in according the filing date to a patent application, it appears that a part of the description of the invention or a drawing to which the applicant refers to in the application is missing from the application, the Office shall promptly notify the applicant thereof and invite them to amend the application accordingly within three months of the service of the invitation.

(2) If the applicant submits the missing part of the description of the invention or the missing drawing within the time limit referred to in the preceding paragraph, this part of the description or this drawing shall be included in the application, and the date of filing of the application shall be considered to be the date when the Office received this part of the

description or this drawing or the date when the Office received all of the elements referred to in paragraph one of Article 82 of this Act, whichever is later.

(3) If the applicant claims priority right under Article 61 of this Act in respect of an application from which a part of the description of the invention or a drawing appears to be missing, the missing part of the description or the missing drawing must be contained in full in the first application.

(4) If the applicant claims priority right under Article 61 of this Act, the essential elements of the application referred to in point a) of paragraph two of Article 82 of this Act shall be deemed to have been filed for the purposes of according the filing date to the application if the applicant, when filing the application in the Republic of Slovenia, indicates the date, number and country or office of the application to which they refer. In such a case, the applicant shall submit to the Office a copy of the first application referred to in paragraph three of Article 61 of this Act within three months of the service of the invitation, unless the first application was filed with the Office or the Office can access it in a digital library acceptable to the Office for this purpose. If the applicant fails to do so, the priority right shall be deemed not to have been claimed.

Article 84 (Invitation to submit all elements)

(1) If an application to which the date of filing and number have been accorded does not contain all the elements referred to in Article 79 of this Act, the Office shall invite the applicant to amend the application and remedy the deficiencies found within three months of the service of the invitation.

(2) If the application referred to in the preceding paragraph is not amended in due time or is not appropriately amended in full, it shall be deemed to be withdrawn, except in cases referred to in paragraph four of Article 128 and paragraph five of Article 129 of this Act.

Article 85 (Formalities examination of an application)

(1) If an application contains all the elements referred to in Article 79 of this Act, the Office shall examine whether all the elements of the application and any enclosures or evidence submitted therewith are drawn up as prescribed by this Act and the regulations issued pursuant to this Act in terms of their content and form.

(2) In the case of a patent application, the Office shall also examine whether the claimed invention fulfils the requirements referred to in paragraphs two and four of Article 87 of this Act and whether all fees have been paid, including any maintenance fees under paragraph four of Article 109 or paragraph four of Article 110 of this Act.

(3) If the Office establishes with regard to a trade mark application that a good or service on the list of goods or services is not classified according to the international classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised on 14 July 1967 (Official Gazette of the Socialist Federal Republic of Yugoslavia – International Treaties [*Uradni list SFRJ – MP*], No. 51/74, and Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS – MP*], No. 9/92; hereinafter: the Nice Classification), or is classified in the wrong class of Nice Classification, the Office may, in the case of minor irregularities in the list of goods or services, classify the good or service or correct the

classification according to the Nice Classification on its own and inform the applicant thereof. If the Office classifies or corrects more than five classifications of goods or services according to the Nice Classification on its own, it shall request the applicant to pay the classification fee within one month of the service of the request. If the applicant fails to pay the required fee in due time, the application shall be deemed to be withdrawn for the goods or services whose classification according to the Nice Classification was made or corrected by the Office.

(4) If the Office establishes with regard to a trade mark application that the indication of a good or service on the list of goods or services is unclear, or if the Office does not act pursuant to the preceding paragraph, it shall invite the applicant to remedy the lack of clarity and deficiencies regarding the classification of goods or services according to the Nice Classification within three months of the service of the invitation. If the applicant fails to remedy the lack of clarity and deficiencies on the list of goods and services in due time, the application shall be deemed to be withdrawn for the goods or services that the applicant did not clearly indicate or correctly classify according to the Nice Classification.

(5) If the Office finds any deficiencies in an application or in the enclosures or evidence submitted therewith, it shall invite the applicant to remedy the deficiencies found within three months of the service of the invitation.

(6) If the applicant fails to remedy in due time all the deficiencies found, the application shall be deemed to be withdrawn, except in the cases referred to in paragraphs three and four of this Article and paragraph four of Article 128 and paragraph five of Article 129 of this Act.

(7) If the Office establishes that all the elements of the application and any enclosures or evidence submitted therewith are in accordance with the provisions of this Act and the regulations issued pursuant to this Act in terms of their content and form, the proceedings shall continue:

- a) for patent application – pursuant to the provisions of Article 88 and subsequent Articles of this Act;
- b) for industrial design applications – pursuant to the provision of Article 96 of this Act;
- c) for trade mark applications– pursuant to the provisions of Article 99 and subsequent Articles of this Act.

Article 85a

(Signature of administrative acts and other documents and documents in electronic form)

(1) A decision in electronic form shall indicate that it is signed with an electronic signature and provide information about the signatory, the time of signature, the issuer and the electronic certificate identification number.

(2) The certification of a physical copy of a decision issued in electronic form shall not be necessary if the Office includes in the decision the web address where the information on the verification procedure is published.

(3) A physical copy of the decision referred to in the preceding paragraph shall have the same probative value as the original.

(4) The original of the decision shall be kept by the Office.

(5) This Article shall apply to any other documents issued by the Office in electronic form in administrative proceedings under this Act.

Section 2
Special provisions for patents

Article 86
(Elements of a patent application)

- (1) A patent application shall contain the following elements:
- a) a request for the granting of a patent;
 - b) a description of the invention;
 - c) one or more patent claims;
 - d) a short summary of the subject matter of the invention (abstract);
 - e) if necessary, one or more drawings of the invention.

(2) Not later than by the issue of a decision on the publication of the application, the applicant may file a patent application whose subject is excluded from the initial patent application (hereinafter: divisional application) and does not extend beyond the subject matter of the initial application. It shall be deemed that the divisional application was filed on the same date as the initial application. The same priority right may be claimed for the divisional application as for the initial application.

(3) Short-term patents shall be requested when filing the patent application or within 12 months of the filing date thereof. After the expiry of this time limit, the request may not be withdrawn.

Article 87
(Content of patent application elements)

(1) A request for the granting of a patent shall contain information on the applicant (full name and address or business name and registered office), the title of the invention, defining its subject, and other information related to the application as prescribed by an implementing regulation.

(2) The description of the invention shall include the presentation of the problem, information on the state of the art, and other solutions available by that time and their deficiencies, as known to the applicant, together with a description of the new solution to the problem. The description of the invention shall be sufficiently clear and complete for the invention to be applied by a person skilled in the art to which the subject of the invention relates.

(3) If an invention relates to biological material determined by an implementing regulation which is not available to the public and cannot be described in a manner that would allow a person skilled in the art to which the subject of the invention relates to apply it, the description of the invention shall 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 Microorganisms for the Purposes of Patent Procedure of 28 April 1977, as amended on 26 September 1980 (Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS – MP*], No. 21/97).

(4) Patent claims shall define the subject for which protection is sought. They must be clear and concise and supported by the description.

(5) The abstract shall serve merely as technical information and may not be used for other purposes, particularly not for interpreting the scope of the protection sought.

(6) A patent application may include several inventions which are so linked as to form a single inventive concept.

Article 88
(Examination of conditions for the granting of a patent)

(1) With regard to a patent application, the Office shall examine:

- a) whether the subject of the claimed invention is patentable, subject to Article 11 of this Act;
- b) whether the claimed invention appears, at first glance, to comply with the requirements referred to in Articles 12, 14 and 15 of this Act.

(2) With regard to a short-term patent application, the Office shall examine:

- a) whether the subject of the claimed invention may be protected by a short-term patent, subject to paragraph one and point a) of paragraph two of Article 11 of this Act;
- b) whether the claimed invention appears, at first glance, to comply with the requirements referred to in Articles 12, 15 and 16 of this Act.

(3) If the Office establishes that the claims in a patent application fulfil all the requirements referred to in paragraph one of this Article, or that the claims in a short-term patent application fulfil all the requirements referred to in the preceding paragraph, it shall adopt a decision on the publishing of the application in its official journal.

(4) If the Office establishes that the claims in a patent application do not fulfil all the requirements referred to in paragraph one of this Article, or that the claims in a short-term patent application do not fulfil all the requirements referred to in paragraph two of this Article, it shall refuse the request to grant a patent.

(5) If the Office establishes that some of the claims in a patent application do not fulfil all the requirements referred to in paragraphs one or two of this Article, it shall reject the application only in the part concerned.

Article 89
(Publication of a patent application)

(1) The Office shall publish a patent application after the expiry of 18 months from the filing date of the application or, if priority has been claimed, the date of priority.

(2) An applicant may request that the application be published before the time limit referred to in the preceding paragraph, but not earlier than after the expiry of three months from the filing date of the application or, if priority has been claimed, the date of priority.

(3) The Office shall publish the notice of the granting of the patent together with the patent application.

Article 90
(Granting of a patent)

(1) The Office shall issue a decision on the granting of a patent and enter the patent in the register of patents. The date of the publication of the patent application shall be considered to be the date of the granting of the patent.

(2) Until a decision under Article 93 of this Act is issued, the scope of protection shall be determined by the content of the published patent claims.

Article 91
(Time limit for the provision of written evidence)

(1) Not later than by the end of the ninth year of the patent term, the holder of a patent or exclusive rights to a patent shall provide the Office with written evidence that the patented invention fulfils all the requirements of Articles 10, 12, 14 and 15 of this Act.

(2) When providing the evidence referred to in the preceding paragraph or within three months of the service of the Office's request, the holder of the patent or exclusive rights to the patent shall pay a fee for the issuing of a declaratory decision. If the fee is not paid in due time, the evidence shall be deemed not to have been provided.

(3) If the holder of a patent or exclusive right to a patent fails to act in accordance with paragraph one of this Article, the patent shall lapse on the date of the expiry of the tenth year of its term.

(4) If the holder of a patent provides the evidence referred to in paragraph one of this Article due to an action under Article 121 of this Act, the Office shall issue one of the decisions referred to in Article 93 of this Act as a priority.

(5) The provisions of this Article shall not apply to short-term patents.

(6) In the case of a European patent which is valid in the Republic of Slovenia on the basis of a European patent application filed in accordance with paragraph two of Article 3 of this Act, the provisions of this Article and Articles 92 and 93 of this Act are directly complied with as of the date on which the EPO publishes the notice of its granting.

Article 92
(Types of written evidence)

(1) A Slovenian translation of a European patent or several European patents granted for the same invention by the EPO shall be considered as evidence referred to in Article 91 of this Act.

(2) If no application for a European patent has been filed for the same invention, the Slovenian translation of a patent for the same invention granted, following a complete examination, by any other authority having the status of an International Preliminary Examining Authority under Article 32 of the PCT or by any other patent office with which a relevant agreement has been concluded may be provided as evidence under Article 91 of this Act.

(3) If the proceedings for granting the patent that is to serve as evidence under paragraphs one or two of this Article have not yet been concluded, the applicant shall notify the Office accordingly within the time limit provided in paragraph one of Article 91 of this Act. On the basis of that notification, the Office shall suspend the proceedings. The proceedings shall continue if the holder of the patent provides evidence under this Article within three months of the granting of the patent. If the evidence under this Article is not provided in the aforementioned time limit, the patent shall be deemed to lapse on the date of the expiry of the tenth year of its term.

(4) A Slovenian translation of a patent which serves as the evidence referred to in Article 91 of this Act shall not provide a greater scope of protection than the original text of the translated patent.

(5) If the Office doubts the correctness of the translation, it may request that the holder of the patent or exclusive right to the patent provide a certified Slovenian translation of

the patent serving as the evidence referred to in Article 91 of this Act within three months of the service of the request. If the certified Slovenian translation is not provided in due time, it shall be deemed that the evidence has not been provided.

(6) If the evidence is provided pursuant to paragraph two of this Article, the holder of the patent or exclusive right to the patent shall submit a list and copies of all other patents that could be considered as evidence, including the information on patent applications and patents that have been rejected. If the list and copies of the documents are not enclosed with the evidence, it shall be deemed that the evidence has not been submitted.

(7) If the Office establishes that the evidence under this Article is forged or false, it shall, by way of a decision, declare the patent invalid.

(8) If the holder of a patent or exclusive right to a patent does not have the evidence referred to in paragraphs one or two of this Article, they may request, against payment of a special fee, that the Office obtain relevant information or opinions to be used as the basis for issuing one of the decisions under Article 93 of this Act from any of the authorities or offices indicated in paragraph two of this Article.

Article 93 (Issuing of declaratory decisions)

(1) On the basis of the provided evidence and other documents under Article 92 of this Act, the Office shall issue:

- a) a declaratory decision that the invention fulfils the requirements referred to in Articles 10, 12, 14 and 15 of this Act and that the claims of the granted patent entirely fulfil the same requirements;
- b) a declaratory decision that the invention only partly fulfils the requirements referred to in Articles 10, 12, 14 and 15 of this Act, due to which the claims of the granted patent are amended accordingly; or
- c) a declaratory decision that, on the filing date of the patent application, the invention did not fulfil the requirements referred to in Articles 10, 12, 14 and 15 of this Act, due to which the patent is declared invalid.

(2) The Office cannot issue a decision under points b) or c) of the preceding paragraph without previously notifying the holder of the patent of the intended amendment of patent claims or invalidity of the patent and inviting them to state, within three months of the service of the invitation, their position thereon or amend the patent claims accordingly. If the holder of the patent states their position or amends the patent claims in due time, the Office shall, before issuing the decision under points b) or c) of the preceding paragraph, verify if the reasons for the issuing thereof still exist. If the holder of the patent fails to state their position in due time, it shall be deemed that they agree with the opinion of the Office.

(3) Patent claims that are amended by way of a decision referred to in point b) of paragraph one of this Article may not provide a greater scope of protection than the claims of a patent granted by a decision under Article 90 of this Act.

(4) If the Office establishes, on the basis of the evidence provided under paragraph one of Article 92 of this Act, that the patent granted does not fulfil the requirement referred to in paragraph six of Article 87 of this Act, it shall divide the initial patent into several patents, which shall retain the filing date of the application and the date of any claimed priority of the initial patent.

Section 3
Special provisions for industrial designs

Article 94
(Elements of an industrial design application)

- (1) An application for an industrial design shall contain the following elements:
- a) a request for the registration of an industrial design;
 - b) a photograph or graphical representation of the appearance of the whole or a part of the product or products, if the application relates to multiple products, in the number of copies prescribed by an implementing regulation.

(2) In the application, the applicant may request that the main information of the application not be published before the expiry of 12 months from the filing date of the application or, if priority is claimed, the date of priority. If the application relates to multiple products, the deferral of publication may not be requested for only some of the products.

(3) If the application relates to a two-dimensional product, this including textile patterns or holograms, or a part thereof and a deferral of publication under the preceding paragraph is requested, a specimen of that product or a part thereof may be enclosed with the application instead of a photograph or graphical representation of the appearance of the product or a part thereof. The applicant shall submit a photograph or graphical representation of the product concerned in the number of copies prescribed by an implementing regulation, this not later than two months before the expiry of the time limit for the requested deferral of publication under the preceding paragraph, otherwise the application shall be deemed to be withdrawn.

Article 95
(Content of the elements of industrial design application)

(1) An application for the registration of an industrial design shall contain information on the applicant (full name and address or business name and registered office), an indication of the product to which the subject of the application relates, the classification according to the international classification established by the Locarno Agreement on International Classification for Industrial Designs of 8 October 1968 (Official Gazette of the Socialist Federal Republic of Yugoslavia – International Treaties [*Uradni list SFRJ – MP*], No. 51/74, and Official Gazette of the Republic of Slovenia – International Treaties [*Uradni list RS – MP*], No. 9/92; hereinafter: the Locarno Classification), and other information prescribed by an implementing regulation.

(2) One industrial design application may cover several products if they belong to the same class of the Locarno Classification.

(3) The photograph or graphical representation of the appearance of the product or part thereof shall clearly show the novelty and the individual character of the appearance of the product for which protection is sought.

Article 96
(Examination of conditions for the registration of an industrial design)

(1) With regard to an industrial design application, the Office shall examine whether the design applied for may be registered as an industrial design, subject to the provisions of Article 36 of this Act, with the exception of point b) thereof.

(2) If the Office establishes that the design applied for fulfils the requirements of the preceding paragraph, it shall issue a decision on the registration of the industrial design, enter the industrial design in the register and publish the notice of the registration of the industrial design.

(3) If the Office establishes that the design applied for does not fulfil the requirements referred to in paragraph one of this Article, it shall refuse the application for the design, either wholly or partly.

Section 4 Special provisions for trade marks

Article 97 (Elements of a trade mark application)

(1) A trade mark application shall contain the following elements:

- a) a request for the registration of a trade mark;
- b) a list of the goods or services for which the protection is sought;
- c) a representation of the sign, which shall fulfil the requirements referred to in point b) of paragraph one of Article 42 of this Act and be in a format accepted by the Office.

(2) A collective mark application shall contain, in addition to the elements set out in the preceding paragraph, also the regulations referred to in Article 46 of this Act.

(3) A separate application shall be filed for each sign. An applicant may request the registration of a trade mark for several types of goods or services in a single application. An applicant may also file several applications requesting the registration of several different or similar trade marks for the same type of goods or services.

(4) At the request of the applicant, a trade mark application may be divided into several applications. Each application shall retain the filing date of the initial application and, if priority is claimed, the date of priority. This provision shall apply *mutatis mutandis* to the division of a trade mark.

Article 98 (Content of the elements of a trade mark application)

(1) An application for the registration of a trade mark shall contain information on the applicant (full name and address or business name and registered office), an indication of the sign applied for and the indication of whether the application concerns a collective mark.

(2) The goods and services in the list of goods or services shall be classified according to the Nice Classification. If the registration for goods or services of more than one class is requested, the goods and services shall be grouped in classes according to the Nice Classification, with the number of the class to which the group of goods or services belongs stated before each group or groups, these listed in the order of the classes.

(3) The applicant shall identify goods and services with sufficient clarity and precision so that the scope of protection sought can be established solely on this basis. The applicant may use general indications used in the class headings of the Nice Classification or other general terms if they comply with the required standards of clarity and precision provided by this Article.

(4) It shall be deemed that the use of general terms, including general indications used in the class headings of the Nice Classification, includes all goods or services clearly covered by the literal sense of the indication or term. The use of such terms or indications shall not cover a request for goods or services that cannot be so understood.

(5) The goods and services classified in the same class under the Nice Classification shall not be presumed to be similar. The goods and services classified in different classes under the Nice Classification shall not be presumed to be dissimilar.

Article 99
(Examination of application as to absolute grounds for trade mark refusal)

(1) Before publishing a trade mark application, the Office shall examine whether the sign applied for may be registered as a trade mark, subject to Articles 42 and 43 of this Act. If the application concerns a collective mark, the Office shall also examine whether the collective mark may be registered in accordance with Articles 45, 46 and 46a of this Act.

(2) If the Office establishes that the sign applied for fulfils the requirements referred to in the preceding paragraph, it shall publish the trade mark application.

(3) If the Office establishes that the sign applied for or the regulations referred to in Article 46 of this Act do not fulfil the requirements referred to in paragraph one of this Article, it shall reject the trade mark application, either wholly or partly.

Article 100
(Opposing opinion of third parties)

(1) Any person may submit to the Office their observation that the sign applied for may not be registered as a trade mark in accordance with Article 43 of this Act, stating the reasons therefor. A person may also submit their observation that a collective mark may not be registered in accordance with Article 46a of this Act, stating the reasons therefor.

(2) The person submitting such an observation to the Office shall not be a party to the proceedings before the Office.

(3) The Office shall inform the applicant of the observations of third parties referred to in paragraph one of this Article. The applicant may reply to the Office and state their reasons regarding the received observations of the third party.

Article 101
(Opposition to the registration of a trade mark)

(1) Within three months of the publication of a trade mark application, the holder of an earlier trade mark may file a written opposition to the registration of the trade mark. An opposition filed in electronic form shall also be considered as a written opposition.

(2) An opposition may only be based on the grounds referred to in Article 44 of this Act and must contain appropriate evidence. An opposition may be based on one or more previous rights if their holder is the same person and if they wholly or partly relate to the goods or services for which the opposed trade mark is applied for.

(3) An opposition under paragraph one of this Article may also be filed by:

- a) a holder of a previously acquired unregistered sign that is used in trade, as referred to in point d) of paragraph one of Article 44 of this Act;
- b) a holder of a trade mark referred to in point e) of paragraph one of Article 44 of this Act which the holder's agent or representative has registered in their own name without the holder's consent;
- c) a person entitled to use a designation of origin or a geographical indication referred to in point f) of paragraph one of Article 44 of this Act;
- d) a holder of other previously acquired right referred to in point g) of paragraph one of Article 44 of this Act.

(4) When filing the opposition, or not later than three months from the service of the Office's request, the opposition fee shall be paid and a power of attorney shall be submitted if the opposition has been filed by a representative.

(5) If the person who files the opposition later withdraws it, this withdrawal may not be cancelled later on.

(6) If the opposition does not fulfil the requirements referred to in this Article, it shall be deemed not to have been filed.

Article 102 (Notification of opposition)

The Office shall notify the trade mark applicant of any opposition filed. The applicant may, within three months of the receipt of the notification, state their position on the grounds stated in the opposition.

Article 102a (Non-use as defence in opposition proceedings)

(1) The applicant for a trade mark to which an opposition under paragraph one of Article 101 of this Act was filed may, within the time limit referred to in Article 102 of this Act, request that the holder of the earlier trade mark who filed the opposition to the registration of their trade mark provide evidence that, during the five consecutive years immediately before the filing date of the application or the date of priority for their trade mark that motivated the opposition, they had put the trade mark to genuine use in accordance with Article 52b of this Act on the goods or services for which it is registered or that there were justified reasons for non-use, provided that the earlier trade mark was entered in the register at least five years before the filing date of the application or priority date of the later trade mark.

(2) The Office shall invite the holder of the earlier trade mark to state, within three months of the service of the invitation, their position on the request referred to in the preceding paragraph and provide relevant evidence.

(3) If the holder of the earlier trade mark fails to prove the use of their trade mark in accordance with Article 52b of this Act or the existence of justified reasons for non-use within the time limit referred to in preceding paragraph, the Office shall, by way of a decision, reject the opposition.

(4) If the earlier trade mark has only been used on some of the goods or services for which it is registered, it shall be considered for the purposes of the examination of the merits of the opposition that it is only registered for such goods or services.

Article 102b
(Suspension of proceedings)

(1) At the joint request of the person who filed the opposition referred to in Article 101 of this Act and the trade mark applicant that they wish to consider the possibilities of settlement, the Office shall, by way of a decision, suspend the trade mark registration proceedings for six months.

(2) If, during the suspension of the trade mark registration proceedings, the person who filed the opposition does not withdraw their opposition in full, the registration proceedings shall continue and the Office shall verify whether the opposition is justified.

(3) The time limits referred to in Articles 102 and 102a of this of this Act shall not run during the suspension of proceedings. If the proceedings continue, these time limits continue to run until their expiry.

Article 102c
(Deciding on opposition)

(1) The Office shall verify whether the opposition is justified within the limits of the statements of the person who filed it and the trade mark applicant and the evidence provided.

(2) If the Office establishes that the opposition is not justified, it shall reject it, by way of a decision, and continue the registration proceedings.

(3) If the Office establishes that the opposition is justified and that the trade mark may not be registered in respect of all of the goods or services for which the sign is applied for, the Office shall, by way of a decision, reject the application in full.

(4) If the Office establishes that the opposition is justified and that the trade mark may not be registered in respect of some of the goods or services for which the sign is applied for, the Office shall, by way of a decision, reject the application for such goods or services and continue the trade mark registration proceedings for the remaining goods or services.

Article 103
(Registration of trade marks)

(1) If no opposition to the registration of a trade mark has been filed or the opposition has been rejected or has been deemed not to have been filed, the Office shall request the applicant to pay, within three months of the service of the request, the trade mark registration fee. This fee shall include the fee for the first ten years of the term of the trade mark.

(2) Following the payment of the fee referred to in the preceding paragraph, the Office shall issue a decision on the registration of the trade mark, enter the trade mark in the register and publish the notice of the trade mark registration.

(3) If the applicant fails to pay the fee referred to in paragraph one of this Article in due time, the application shall be deemed to be withdrawn.

Article 104
(Registration of geographical indications)

(1) An application for the registration of a geographical indication may be filed by associations of legal or natural persons, chambers, municipalities, wider local communities or state authorities.

(2) The request referred to in the preceding paragraph shall be accompanied by a specification including, in particular:

- a) the indication to be registered as a geographical indication;
- b) an indication of the good to which the proposed geographical indication relates;
- c) a description of the good, including the raw materials and principal physical, chemical, microbiological, organoleptic or other characteristics of the good;
- d) an indication of relevant location or region, including borders;
- e) a description of the method of obtaining the good and, if necessary, the authentic and unvarying local methods;
- f) a description of the link between the good and the location or region;
- g) details of inspection authorities;
- h) labelling details.

(3) If the application complies with the provisions of this Article and Articles 55 and 56 of this Act, the Office shall issue a decision on the registration of the geographical indication, enter the geographical indication in the register and publish the notice of the registration of the geographical indication.

(4) The provisions of this Article shall not apply to geographical indications protected pursuant to paragraph three of Article 55 of this Act.

Chapter Eight
REGISTERS AND MAINTENANCE OF RIGHTS

Article 105
(Registers)

(1) The Office shall keep registers of patents, supplementary protection certificates, industrial designs, trade marks and geographical indications and registers of applications for the aforementioned rights. Registers shall be public, unless otherwise provided by this Act.

(2) The date of the granting of a patent or a supplementary protection certificate or the date of issue of a decision on the registration of an industrial design, trade mark or geographical indication shall be considered as the date of entry in the register.

(3) On request and against payment of a fee prescribed by the Act governing administrative fees, the Office shall issue extracts from registers.

(4) The minister responsible for industrial property shall, by way of an implementing regulation, determine in greater detail the content of the registers, the content of requests for entering changes in the registers, the content of extracts from the registers and the procedure for issuing extracts from the registers.

Article 106
(Content of registers)

(1) The register of patents shall include, in particular, the following: registration number; the filing date and number of the application; the right of priority claimed; the date of publication; the date of entry in the register; the number and date of the issue of a declaratory decision under Article 93 of this Act; information on the holder (full name and address or business name and registered office); the type of the patent; information on the inventor (full name and address); the title of the invention; information on the maintenance of the patent; and the date of expiry of the patent.

(2) The register of supplementary protection certificates shall include, in particular, the following: registration number; the filing date and number of the application; the date of publication of the application and the supplementary protection certificate; the date of entry in the register; information on the applicant and the holder of the supplementary protection certificate (full name and address or business name and registered office); the title of the product; the registration number of the patent on the basis of which the supplementary protection certificate was granted; the number and date of the first authorisation to place the product on the market in the Republic of Slovenia or the European Union or the European Economic Area as a medicinal or phyto-pharmaceutical product; an indication of the issuing state if the authorisation was not issued by a competent EU authority under a centralised procedure; the date until which the certificate is valid; information on the maintenance of the certificate; and the date of expiry of the certificate.

(3) The register of industrial designs shall include, in particular, the following: registration number; the filing date of the application; the right of priority claimed; the date of publication; the date of entry in the register; information on the holder (full name and address or business name and registered office); information on the designer (full name and address) if the designer so wishes; an indication of the product; the number of products; the classification code according to the Locarno Classification; information on the renewal of the industrial design; and the date of expiry of the industrial design.

(4) The register of trade marks shall include, in particular, the following: registration number; the filing date of the application; the right of priority claimed; information on the regulations referred to in Article 46 of this Act and any amendments thereto; the date of publication of the application and of the notice of registration of the trade mark; information on opposing observations by third parties; information on an opposition and the person who filed it; the date of entry in the register; information on the holder (full name and address or business name and registered office); the appearance of the trade mark; the list of goods or services and their classification according to the Nice Classification; information on the division of the trade mark; information on international registration; information on the renewal of the trade mark; information on the revocation of the trade mark; and the date of expiry of the trade mark.

(5) The register of geographical indications shall include, in particular, the following: registration number; the filing date of the request; the date of publication; the date of entry in the register; the geographical indication; the type of the good; and the location to which the indication relates.

(6) Information on litigation of which the Office is notified and final judgements shall be entered *ex officio* in the registers referred to in paragraph one of Article 105 of this Act.

(7) The provisions of this Article shall apply *mutatis mutandis* to the registers of applications.

Article 107 **(Entry of changes in the registers)**

(1) On request, any subsequent changes regarding a right or the holder of a right shall be entered in the register referred to in paragraph one of Article 105 of this Act. This paragraph shall apply *mutatis mutandis* to applications and applicants.

(2) The transfers of rights or licences shall be entered in the corresponding register at the request of one of the parties to the agreement.

(3) The person who was registered as the holder of a right before the entry of a change may contest any change entered in the register without their consent by filing an action in administrative dispute with the Administrative Court of the Republic of Slovenia in Ljubljana, as the court having exclusive territorial jurisdiction, and providing relevant evidence.

Article 108 (Procedure for the entry of changes)

(1) A request for the entry of changes may include several changes in the register. A single request shall also be sufficient when the change or changes relate to more than one application and/or right of the same person if the change or changes are the same for all applications and rights concerned and the numbers of all applications and rights concerned are indicated in the request.

(2) A fee for the entry of each change for each application or right in the register shall be paid upon filing the request or within three months of the service of the Office's request. If the fee is not paid in due time, the request shall be deemed to be withdrawn.

(3) If the request for the entry of a change is filed by the person who is registered as the holder of the right, the Office shall immediately issue a decision on the entry of the change and enter the change in the register.

(4) If the request for the entry of a change is filed by a person who is not registered as the holder of the right, that person shall, when filing the request or within three months of the service of the Office's request, submit the consent of the holder of the right to the entry of the requested change in the register or any other documents of their own choosing showing the legal basis for the entry of the change. If the Office doubts the veracity of the information contained in the request for the entry of a change or if the documents submitted are in a foreign language, it may request that the requesting party provide additional documents or a Slovenian translation of the submitted documents within three months of the service of the Office's request.

(5) If the requesting party fails to submit additional documents or the translation referred to in the preceding paragraph in due time, the request for entry of a change shall be deemed to be withdrawn.

(6) The Office shall decide on the entry of a change by way of a decision.

Article 109 (Maintenance fees)

(1) Fees shall be paid for the maintenance of rights; these shall fall due, counting from the filing date of the application:

- a) for patents: every year for the subsequent year of validity;
- b) for industrial designs: every five years for the subsequent five years of validity;
- c) for trade marks: every ten years for the subsequent ten years of validity.

(2) The fees under the preceding paragraph shall be paid within one year preceding the due date. The Office shall notify the holder of a trade mark of the due date of the fee at least six months before the due date.

(3) The patent application fee shall include the maintenance fee for the first three years of its term. The industrial design application fee shall include the maintenance fee for the first five years of its term.

(4) If the proceedings for the granting of a patent last more than three years from the filing date of the application or the proceedings for the registration of an industrial design more than five years from the filing date of the application, the provisions of paragraphs one and two of this Article shall apply *mutatis mutandis* to the patent application or the industrial design application.

Article 110 **(Payment of maintenance fees in a grace period)**

(1) If the fee for maintaining a right is not paid in accordance with the provisions of Article 109 of this Act on the due date or before, it can be paid within the grace period of six months, counting from the due date for the fee, together with an additional late payment fee. The late payment fee shall amount to 50% of the total prescribed fee that has not been paid in due time.

(2) The Office shall remind the holder of the right that the maintenance fee referred to in paragraph one of Article 109 of this Act has not been paid in due time, of the possibility of payment under the preceding paragraph and of the consequences of the non-payment of fees.

(3) If the maintenance fees are not paid by the due date or, following the reminder of the Office, not even within the grace period referred to in paragraph one of this Article, together with the late payment fee, the right shall lapse on the day following the due date referred to in paragraph one of Article 109 of this Act.

(4) Paragraphs one and two of this Article shall apply *mutatis mutandis* in the cases referred to in paragraph four of Article 109 of this Act. If in such cases the maintenance fee and the late payment fee are not paid within the grace period, the application shall be deemed to be withdrawn.

Chapter Nine JUDICIAL PROTECTION AND ENFORCEMENT OF RIGHTS

Section 1 Judicial protection

Subsection 1 Invalidity of rights

Article 111 **(Actions for invalidation)**

Any interested party may file an action with the competent court to declare a patent, short-term patent, industrial design or trade mark invalid.

Article 112 (Actions for the invalidation of patents)

(1) An action for the invalidation of a patent may be filed if one of the following reasons applies:

- a) on the filing date of the application, the invention did not fulfil all the requirements referred to in Articles 10, 11, 12, 14 and 15 of this Act or, in the case of a short-term patent, the requirements referred to in Article 16 of this Act;
- b) the description of the invention is not sufficiently clear and complete for the invention to be applied by a person skilled in the art to which the subject of the invention relates;
- c) the subject matter of the protection extends beyond the subject matter of the first application received or, if the patent was granted on a divisional application, beyond the subject matter of the initial application.

(2) An action for the invalidation of a patent may also be filed after the issuing of a declaratory decision under points a) or b) of Article 93 of this Act or after the expiry of the patent.

(3) If an action for the invalidation of a European patent which is valid in the Republic of Slovenia pursuant to an international treaty and to which an opposition has been filed with the EPO is filed during the opposition proceedings before the EPO, the court shall suspend the proceedings until the final decision of the EPO in the opposition proceedings.

Article 113 (Actions for the invalidation of industrial designs)

An action for the invalidation of an industrial design may be filed if, taking into account the filing date of the application, one of the following reasons applies:

- a) the industrial design has been registered contrary to Article 36 of this Act;
- b) the applicant for or the holder of the industrial design was not entitled to an industrial design protection.

Article 114 (Actions for the invalidation of trade marks)

(1) An action for the total or partial invalidation of a trade mark may be filed if one of the following reasons applies:

- a) taking into account the filing date of the application, the trade mark was registered contrary to Articles 42 and 43 of this Act;
- b) taking into account the filing date of the application, the trade mark was registered contrary to Article 44 of this Act, unless the earlier trade mark is an EU trade mark that has been applied for or registered before the accession of the Republic of Slovenia to the European Union; or
- c) the applicant did not act in good faith when filing the application.

(2) An action for the invalidation of a collective mark may also be filed if, taking into account the filing date of the application, the collective mark was registered contrary to Articles 45, 46 or 46a of this Act.

(3) If the reason for an action referred to in the preceding paragraph was the registration of a collective mark contrary to Article 46 of this Act, the court shall reject the action if the holder of the collective mark appropriately amends the regulations referred to in Article 46 of this Act before the court decision is issued.

- (4) An action under point b) of paragraph one of this Article may be filed by:
- a) a holder of an earlier trade mark;
 - b) a holder of a previously acquired unregistered sign that is used in trade, as referred to in point d) of paragraph one of Article 44 of this Act;
 - c) a holder of a trade mark referred to in point e) of paragraph one of Article 44 of this Act which the holder's agent or representative has registered in their own name without the holder's consent;
 - d) a person entitled to use the designation of origin or the geographical indication referred to in point f) of paragraph one of Article 44 of this Act;
 - e) a holder of other previously acquired right referred to in point g) of paragraph one of Article 44 of this Act.

Subsection 2 Contesting of rights

Article 115 (Contesting of the right to a patent or industrial design)

(1) An inventor, their heir or other successor in title may, at any time during the term of a patent, file an action with a competent court requesting that they be declared the holder of the patent if the patent has been granted in the name of a person who is not the inventor, their heir or other successor in title.

(2) The designer of a design, their heir or other successor in title may, at any time during the term of an industrial design, file an action with a competent court requesting that they be declared the holder of the right if the industrial design was registered in the name of a person who is not the designer, their heir or other successor in title.

(3) The action referred in paragraphs one or two of this Article may also be filed by a person who is entitled to the patent or industrial design rights if the patent was granted or industrial design registered in the name of the inventor or designer or a third person for whom the inventor or the designer wrongly allowed that the patent be granted or industrial design be registered in their name.

Article 116 (Contesting of the right to a trade mark)

(1) Legal or natural persons may file an action with a competent court requesting the court to establish that a sign which they use in trade to mark their goods or services is identical or similar to a trade mark used by a third person to mark their goods or services of the same or similar type and that the sign had been generally known as the designation of the goods or services of the legal or natural person before the defendant filed their trade mark application and also requesting the court to issue a decision declaring the plaintiff to be the holder of the trade mark.

(2) The court shall rule against the request referred to in the preceding paragraph if the defendant, who is the holder of the trade mark, proves that they had used the contested

sign for the same or similar goods or services for as long as or longer than the plaintiff before filing the application.

(3) The action referred to in paragraph one of this Article may not be filed after the expiry of five years from the date of entry of the trade mark in the register.

Article 117 **(Entry of new holder in the register)**

(1) Within three months of the service of a final judgement granting the plaintiff's request referred to in Articles 115 or 116 of this Act, the plaintiff may request to be entered in the register as the holder of the patent, industrial design or trade mark and to be issued a certificate to that effect.

(2) If the person whose request was granted fails to submit a request to be entered in the register as the holder of the right within the time limit referred to in the preceding paragraph, the right shall be removed *ex officio* from the register.

(3) Any rights acquired by a person who is not the person registered as the holder of the right before the judgement referred to in paragraph one of this Article shall still apply against the new holder of the rights if they had been entered in the relevant register or correctly applied for registration before the action was filed.

Subsection 3

Recognition of the right of the inventor or designer to be mentioned

Article 118 **(Actions of inventors or designers for mention)**

(1) An inventor or designer may file an action with a competent court requesting:

- a) to be mentioned in the application and in all documents;
- b) the final judgement to be published at the defendant's expense.

(2) The action referred to in the preceding paragraph may be filed at any time during the term of validity of the patent or industrial design.

Subsection 4

Removal and revocation of trade marks

Article 119 **(Actions for the removal of trade marks from the register)**

(1) An action for the removal of a trade mark from the register and prohibition of the use of the sign may be filed with the competent court if one of the following reasons applies:

- a) owing to the actions of the holder or because the latter allowed it, the trade mark has become the generic name in the trade for goods or services in respect of which it is registered;
- b) the trade mark is used by the holder of the trade mark or another person with the holder's consent on the goods or services for which it is registered in a way that is misleading to the public, particularly as to the nature, quality or geographical origin of the goods or services concerned.

(2) Apart from the reasons referred to in the preceding paragraph, an action for the removal of a collective mark from the register and the prohibition of the use of the sign may also be filed if one of the following reasons applies on the date of the filing of the action:

- a) the holder of the collective mark fails to implement reasonable measures to prevent the use of the mark in a way that is not in accordance with the conditions for use provided by the regulations referred to in Article 46 of this Act, including any amendment to the regulations entered in the register;
- b) persons entitled to use the collective mark have used the mark in a way that was misleading to the public under point b) of Article 46a of this Act; or
- c) the amendment to the regulations referred to in Article 46 of this Act has been entered in the register contrary to paragraph three of Article 46 of this Act, unless the holder of the collective mark amends the regulations referred to in Article 46 of this Act so that they comply with the requirements referred to in paragraph three of Article 46 of this Act.

(3) In the case referred to in point c) of paragraph two of this Article, paragraph three of Article 114 of this Act shall apply *mutatis mutandis*.

(4) The mark shall be removed from the register on the date when the judgement becomes final.

Article 120

(Actions for the revocation of trade marks due to non-use)

(1) Any person may file an action with a competent court requesting the revocation of a trade mark if the holder has not genuinely used the trade mark in accordance with Article 52b of this Act in the Republic of Slovenia on the goods or services for which it is registered for an uninterrupted period of five years without justified reason.

(2) The revocation of a trade mark may not be requested if the holder has started or resumed genuinely using the trade mark during the interval between the expiry of the uninterrupted period of five years referred to in paragraph one of this Article and the filing of the action for revocation of the trade mark. This circumstance may not be invoked by the holder of a trade mark who started or resumed using the trade mark within the period of three months preceding the filing of the action, counting not earlier than from the expiry of the time limit referred to in paragraph one of this Article, if they started the preparations for the use or resumed use only after becoming aware that an action for the revocation of their trade mark might be filed.

(3) In the revocation proceedings, the holder of the trade mark shall prove the use of the trade mark.

(4) On the date the judgment becomes final, the trade mark shall be revoked for the goods or services for which it was established that the trade mark has not been used on them in the territory of the Republic of Slovenia.

Section 2 Enforcement of rights

Article 120a **(Standing)**

(1) The rights to enforce judicial protection belonging to a holder of a right referred to in Articles 18, 37, 47 and 58 of this Act also belong *mutatis mutandis* to:

- a) a person entitled to use a collective mark if the holder of the collective mark consents to this or does not initiate infringement proceedings within the relevant period following the notification;
- b) a person entitled to use a geographical indication;
- c) a licensee, to the extent to which the holder's rights are transferred to them by an Act or a legal transaction, if the holder of the right consents to this;
- d) an exclusive licensee if the holder of the right does not initiate infringement proceedings within the relevant period following the notification;
- e) a professional association established to protect industrial property rights, to the extent to which the holder's rights are transferred to it by an Act or through a legal transaction.

(2) The holder of a collective mark may claim, in the name of the persons entitled to use the collective mark, compensation for the damage they suffered as a result of the unauthorised use of the collective mark.

Article 121 (Actions following the infringement of rights)

(1) The holder of a right may file an action with a competent court against a person who infringes on their rights referred to in Articles 18, 37, 47 or 58 of this Act without their consent, requesting that:

- a) the infringement and any future infringements be prohibited;
- b) the infringing items be recalled from the channels of commerce, taking into account the interests of bona fide third parties;
- c) the situation caused by the infringement be rectified;
- č) the infringing items be irrevocably removed from the channels of commerce;
- d) the infringing items be destroyed;
- e) the means of infringement that are owned by the infringing party and intended or used exclusively or principally for the infringement be destroyed;
- f) the infringing items be surrendered to the plaintiff against the reimbursement of the costs of their production;
- g) the judgment be published.

(2) In considering the claims referred to in points b) to f) of the preceding paragraph, the court shall take into account all the circumstances of the case, in particular proportionality between the seriousness of the infringement and the claim, and the interest of the holder of the right to ensure an effective protection of rights.

(3) In proceedings against a person whose services have been used to infringe on the right, and the existence of such infringement has already been established by way of a final decision in proceedings against a third party, the infringement shall be presumed to exist.

Article 121a (Compensation for damage)

(1) General rules governing the causing of damage shall apply to infringements under this Act, unless otherwise provided by this Act.

(2) The infringing party shall pay to the holder of the right damages in an amount to be defined under general rules on compensation for damage or in an amount equal to an agreed or customary licence fee.

Article 121b (Intervener)

(1) It shall be deemed that a licensee has legitimate interest in entering the proceedings initiated by the holder of the right in order to claim compensation for the damage they suffered.

(2) The preceding paragraph shall apply *mutatis mutandis* to persons entitled to use a collective mark.

Article 122 (Additional provisions on the infringement of patent rights)

(1) If infringement concerns a patent protecting a process for the production of a new substance, it shall be deemed that any substance is of identical composition or identical and made according to the protected process until proven to the contrary. The burden of proof shall be on the defendant or alleged infringing party, taking into account their legitimate interests in protecting their business secrets.

(2) If an action under Article 121 of this Act refers to an infringement of a patent or a published European patent application whose protection in the Republic of Slovenia is sought, the court shall suspend the proceedings until the Office issues a declaratory decision under points a) or b) of paragraph one of Article 93 of this Act or until the European patent is entered in the Office's patent register.

(3) If infringement concerns a patent for which a declaratory decision under points a) or b) of paragraph one of Article 93 of this Act has not yet been issued, the court shall impose on the infringing party the payment of compensation for the use of the invention during the interval between the granting of the patent and the issue of the declaratory decision, reduced with regard to the circumstances.

(4) The preceding paragraph shall apply *mutatis mutandis* to a published patent application filed abroad under paragraph two of Article 3 of this Act for the use of the invention during the interval between the publication of the application and the granting of the patent or, if the European patent has been entered in the Office's register, the date on which the EPO published its decision on the granting of the European patent.

Article a122a (Non-use as defence in trade mark infringement proceedings)

(1) The holder of a trade mark shall have the right to prohibit the use of the sign to the extent to which the reasons referred to in Article 120 of this Act for trade mark revocation due to non-use do not apply at the time of the filing of the action for trade mark infringement.

(2) The defendant may request that the holder of the trade mark who filed the action for trade mark infringement against them provide evidence that, during the five consecutive years immediately preceding the filing date of the action, they had genuinely used the trade mark that motivated the action, in accordance with Article 52b of this Act, on the goods or services for which it is registered, or that there are justified reasons for non-use, provided that the trade mark was entered in the register at least five years before the filing date of the action for infringement.

Article b122a

(Defence of the holder of a later trade mark in trade mark infringement proceedings)

(1) In trade mark infringement proceedings, the holder of the trade mark shall have no right to prohibit the use of a later trade mark if the later trade mark would not be found invalid taking into account paragraph three of Article 52c, Article 52d or paragraph two of Article 52e of this Act or, if it is an EU trade mark, European Union legislation concerning the registration of EU trade marks.

(2) If, in accordance with the preceding paragraph, a holder of a trade mark has no right to prohibit the use of a later trade mark, the holder of the later trade mark shall have no right to prohibit in infringement proceedings the use of the earlier trade mark, even though the earlier trade mark may no longer be invoked against the later trade mark.

Article 122a (Provision of evidence)

(1) If the court decides to take proposed evidence and the evidence concerned is in the possession of the opposite party, the opposite party shall provide any evidence at their disposal at the request of the court.

(2) The preceding paragraph shall also apply to banking, financial and business documents under the control of the opposite party if the infringement was committed on a commercial scale. An act shall be deemed to be carried out on a commercial scale if it is carried out for direct or indirect economic benefit.

(3) The provisions of the Act governing contentious procedure shall apply to the proceedings for the provision of evidence, unless otherwise provided by this Act.

(4) After taking the evidence referred to in paragraph one of this Article, the court shall ensure that the confidential information of the parties to the proceedings is protected and that judicial proceedings are not used in bad faith with the sole purpose of obtaining confidential information of the opposite party.

Article 123 (Interim injunction)

(1) The court shall issue an interim injunction to secure non-monetary claims under this Act if the applicant shows that there are grounds for believing that:

- a) they are the holder of the right referred to in Articles 18, 37, 47 or 58 of this Act and
- b) their right has been infringed or there is a real risk that it will be infringed.

(2) The applicant shall also show that there are grounds for believing that one of the following applies:

- a) there is a risk that the enforcement of claims will be made impossible or very difficult;
- b) the interim injunction is necessary to prevent damage difficult to repair; or
- c) in the event that the interim injunction is issued but subsequently proves unfounded in the course of the proceedings, the harm to the alleged infringing party would not be greater than the harm to the holder of the right if such an injunction were not to be issued.

(3) An applicant who requests the issuing of an interim injunction without the prior notification and hearing of the opposite party shall show, in addition to the requirements of paragraphs one and two of this Article, that there are grounds for believing that any delay in issuing the interim injunction would cause the holder of the right damage difficult to repair. In

this case, the opposite party shall be notified not later than immediately after the execution of the injunction.

(4) The holder of the right shall not be obliged to prove that there is a risk that the enforcement of claims will be made impossible or very difficult if they show that there are grounds for believing that the proposed injunction would cause the infringing party only negligible damage. Such a risk shall be deemed to exist when the claims are to be enforced abroad, unless a claim is to be enforced in another Member State of the European Union.

(5) To secure non-monetary claims under paragraph one of this Article, the court may issue any interim injunction with which the purpose of security can be achieved, in particular:

- a) to prohibit the alleged infringing party from continuing the alleged infringement or committing any future infringements;
- b) to seize, remove from circulation and hold the infringing items and the means of the infringement that are intended or used exclusively or principally for the infringement.

(6) The court shall decide on an objection to the decision on the interim injunction within 30 days of the date of filing the response to the objection or of the expiry of the time limit for filing the response to the objection.

(7) The provisions of the Act governing claim enforcement and security shall apply to proceedings for the issuing of an interim injunction, unless otherwise provided by this Act. The proceedings shall be urgent.

Article 123a **(Issuing of interim injunctions in patent infringements)**

If the application for the issuing of an interim injunction under the preceding Article is related to a patent infringement, the court shall issue the interim injunction if the following two conditions are also fulfilled:

- a) the holder of the right submits a declaratory decision under points a) or b) of Article 93 of this Act and
- b) the holder of the right applies for the issuing of an interim injunction within three months after they learn of the alleged infringement.

Article 124 **(Preservation of evidence)**

(1) The court shall issue a decision to preserve evidence if the applicant provides reasonably available evidence that:

- a) they are the holder of the right referred to in Articles 18, 37, 47 or 58 of this Act;
- b) their right has been infringed or there is a real risk that it will be infringed; and
- c) the evidence of the infringement will be destroyed or it will be impossible to take such evidence at a later time.

(2) An applicant who requests the issuing of a decision to preserve evidence without prior notification or hearing of the opposite party shall show, in addition to the requirements of paragraph one, that there are grounds for believing that there is a risk of evidence of the infringement being destroyed as the result of the conduct of the opposite party or that it will be impossible to take such evidence at a later time. In this case, the opposite party shall be notified not later than immediately after the execution of the decision.

(3) By way of a decision referred to in paragraph one of this Article, the court may order the taking of any evidence and in particular:

- a) the inspection of premises, business documents, inventories, databases, computer memory units or other items;
- b) the seizure of samples of infringing items;
- c) the examination and seizure of documents;
- d) the appointment and examination of experts; and
- e) the examination of witnesses.

(4) The preservation of evidence may also be requested after the decision by which the proceedings are completed has become final if this is necessary before or during proceedings with extraordinary legal remedies.

(5) The provisions of the Act governing claim enforcement and security relating to interim injunctions shall apply *mutatis mutandis* to the proceedings for the preservation of evidence under this Article, unless otherwise provided by this Act. The proceedings shall be urgent.

(6) If it is subsequently found that the application was unfounded or that the applicant did not justify it, the opposite party shall have the right to request:

- a) the return of the seized items;
- b) the prohibition of the use of information obtained; and
- c) compensation for damage.

(7) In the proceedings for the preservation of evidence under this Article, the court shall ensure that confidential information of the parties is protected and that judicial proceedings are not used in bad faith with the sole purpose of obtaining confidential information of the opposite party.

Article 124a **(Preservation of evidence in patent infringements)**

If the application for the issue of a decision referred to in the preceding Article is related to a patent infringement, the court shall issue the decision if the following two conditions are also fulfilled:

- a) the holder of the right submits a declaratory decision under points a) or b) of Article 93 of this Act and
- b) the holder of the right applies for the issuing of a decision on the preservation of evidence within three months after they learn of the alleged infringement.

Article 124b **(Obligation to provide information)**

(1) In proceedings concerning an infringement of rights, the court may, upon a justified request by a party, order the alleged infringing party to provide information on the origin and distribution channels of the goods or services that infringe on a right referred to this Act.

(2) The court may order that the information referred to in the preceding paragraph also be provided by any person who, on a commercial scale:

- a) possesses the infringing goods;
- b) uses the infringing services; or
- c) provides services used in infringing activities.

(3) The court may order that information referred to in paragraph one of this Article also be provided by a person who was indicated by the person referred to in the preceding paragraph as being involved in the production, manufacture or distribution of the goods or the provision of the services.

- (4) The information referred to in paragraph one of this Article may include:
- a) the names and addresses or business names and registered offices of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or providers of services and any intended wholesalers and retailers and
 - b) information on quantities produced, manufactured, delivered, received or ordered and on the price obtained for the goods or services concerned.

Article 124c (Protection of other industrial property rights)

The provisions of this Section shall apply *mutatis mutandis* to business names and plant variety rights.

Chapter Ten COMPULSORY LICENCES

Article 125 (Compulsory licences)

(1) The court may decide that a third party or the Government of the Republic of Slovenia be permitted to exploit an invention without the consent of the patent holder:

- a) if this is required by the public interest, in particular with regard to national security, food, health or the development of other vital sectors of the national economy or
- b) if the court establishes that the holder of the patent or their licensee is abusing the patent rights, particularly by exploiting the invention in a way that limits competition contrary to applicable legislation.

(2) The court shall grant compulsory licences under the preceding paragraph taking into account the actual circumstances and after hearing the holder of the patent.

(3) A compulsory licence under paragraph one of this Article shall be granted if the applicant for a compulsory licence proves that they have made efforts to conclude a licence agreement with the holder of the patent under reasonable business terms and the efforts failed to succeed within a reasonable period of time.

(4) The preceding paragraph shall not apply if a state of war or similar state of emergency is declared, provided that in such a case the court notifies the holder of the patent of its decision as soon as possible.

Article 126 (Conditions for the granting of a compulsory licence)

(1) A compulsory licence under the preceding Article shall be granted under the following conditions:

- a) the scope and duration will be limited with regard to the purpose of the licence;
- b) it will not be exclusive;

- c) it will be non-transferable, with the exception of the transfer of the part of the business activity of the compulsory licensee to which the subject of the compulsory licence refers;
- d) it is intended primarily for the supply of the market of the Republic of Slovenia.

(2) If a patent (hereinafter: the second patent) cannot be exploited without infringing another patent (hereinafter: the first patent), the following conditions, in addition to those referred to in Article 125 of this Act and the preceding paragraph, shall also be met for the granting of a compulsory licence in respect of such a patent:

- a) the invention claimed in the second patent involves a technical advance of considerable economic significance compared to the invention claimed in the first patent;
- b) the holder of the first patent will, under reasonable conditions, be entitled to a cross-licence to use the invention claimed in the second patent;
- c) the permitted use in respect of the first patent will not be transferable without the simultaneous transfer of the second patent.

(3) The court shall decide that a compulsory licence expires if the circumstances owing to which it was granted cease to exist and are unlikely to recur.

Article 127 (Compensation for compulsory licences)

(1) The holder of a patent for which a compulsory licence has been granted shall be entitled to mandatory compensation.

(2) The amount of compensation shall be determined with regard to the circumstances of each case, while taking into account the economic value of the compulsory licence.

Chapter Eleven REPRESENTATION

Article 128 (Representation before the Office)

(1) Only representatives who are registered in the relevant register of representatives kept by the Office may be authorised to represent a party before the Office. The authorising person shall appoint their representative by a written power of attorney.

(2) The authorising person may authorise one or several representatives for all or only certain acts in proceedings before the Office. If the authorising person authorises several representatives and does not indicate to whom the Office should serve documents, the Office shall serve all documents on the representative who is named first.

(3) The authorising person may in one power of attorney (hereinafter: general power of attorney) authorise a representative to represent them with regard to all applications and rights filed with the Office. If a general power of attorney has been deposited with the Office, the reference number and a copy thereof shall be provided when filing any application with the Office.

(4) The power of attorney shall be submitted when filing an application or within three months of the service of the Office's request. If the power of attorney is not submitted in due time, the representative shall be deemed not to have been appointed and their acts not to have been carried out. The Office shall dismiss, by way of a decision, any application filed by

the alleged representative. The decision on dismissal shall be served on the alleged representative.

Article 129 (Representation of foreign persons)

(1) Foreign natural and legal persons having neither residence nor any real and effective industrial or commercial undertaking in the Republic of Slovenia (hereinafter: foreign persons) shall exercise their rights under this Act in proceedings before the Office through a representative, unless otherwise provided by an international treaty that is binding on the Republic of Slovenia.

(2) Notwithstanding the preceding paragraph and subject to paragraph three of this Article, a foreign person may file applications, perform acts relating to the according of the filing date of application, pay fees in proceedings before the Office, file a copy of first application when claiming the right of priority under Article 61 of this Act and receive documents from the Office relating to these proceedings without a representative.

(3) If, in cases referred to in the preceding paragraph, a foreign person does not have a representative in the proceedings before the Office, they shall provide the Office with a correspondence address, which must be in the territory of the Republic of Slovenia. It shall be deemed that, in cases referred to in the preceding paragraph, the Office has properly notified a foreign person if it has sent the document to the correspondence address.

(4) Notwithstanding paragraph one of this Article, any person may pay the fees for the maintenance of a right.

(5) If a foreign person, contrary to this Article, fails to appoint a representative in the proceedings before the Office or fails to provide a correspondence address that is in the territory of the Republic of Slovenia, the Office shall exceptionally invite them directly by post to appoint, within three months of the service of the invitation, a representative and submit a power of attorney or, in accordance with paragraph three of this Article, provide a correspondence address. If a foreign person fails to appoint a representative and to submit a power of attorney or fails to provide a correspondence address in accordance with paragraph three of this Article in due time, the Office shall dismiss any application by way of a decision, unless otherwise provided by this Act. The decision shall be served by way of a publication on the Office's notice board.

Article 130 (Withdrawal and termination of a power of attorney)

(1) The authorising person may, at any time, withdraw the power of attorney, and the representative may, at any time, terminate it.

(2) The withdrawal or termination shall be notified to the Office and shall be effective from the date of receipt of the notification by the Office. The representative shall be obliged to continue performing acts for the authorising person for three months following the termination of the power of attorney, unless the authorising person has another representative.

(3) If a foreign person no longer has a representative owing to the withdrawal or termination of a power of attorney, paragraph five of Article 129 of this Act shall apply *mutatis mutandis*.

Article 131 (Representatives)

(1) Parties may be represented in proceedings before the Office by patent representatives and by industrial design and trade mark representatives. Patent representatives shall represent parties to proceedings relating to the acquisition and maintenance of any right under this Act and other requests concerning such rights. Industrial design and trade mark representatives may only represent parties to proceedings relating to the acquisition and maintenance of industrial designs, trade marks and geographical indications and other requests concerning such rights.

(2) A patent representative may be:

- a) any person who has a university degree in technical or natural science and has passed an examination for patent representatives before the Office;
- b) any attorney or law firm employing or contracting a person who meets the conditions referred to in the preceding point;
- c) any legal person employing at least one person who meets the conditions referred to in point a) of this paragraph.

(3) An industrial design and trade mark representative may be:

- a) any person who has a university degree and has passed an examination for industrial design and trade mark representatives before the Office;
- b) any attorney or law firm;
- c) any legal person employing at least one person who meets the conditions referred to in point a) of this paragraph.

(4) Patent representatives, industrial design and trade mark representatives and authorised employees of a representative may also represent parties in proceedings relating to the rights under this Act before courts and other state authorities if they meet the conditions laid down by regulations governing representation before courts and other state authorities. In such cases, the representative shall be entitled to a payment for their work and reimbursement of costs related to the work performed, in accordance with the representative tariff. The representative tariff shall be adopted by the representative or a representative association in agreement with the minister responsible for justice.

Article 132 (Registration of representatives)

(1) The Office shall keep the register of patent representatives and the register of industrial design and trade mark representatives.

(2) A fee laid down by the Act governing administrative fees shall be paid for registration in the relevant register of representatives. Following the payment of the fee, the Office shall issue a decision on the entry in the register.

(3) A representative may request to be removed from the register of representatives and entered in the register of industrial design and trade mark representatives. An industrial design and trade mark representative may only request to be removed from the register of industrial design and trade mark representatives and entered in the register of patent representatives if they meet the conditions referred to in paragraph two of Article 131 of this Act.

(4) A representative shall be removed from the register if:

- a) they file a request for removal;

b) they are barred from acting as representatives by a final judgement.

(5) The register of patent representatives and the register of industrial design and trade mark representative shall include, in particular, the following: the registration number of the representative; information on the representative (full name and address or business name and registered office); the date of entry in the register; and information on the persons who fulfil the conditions referred to in point a) of paragraph two or point a) of paragraph three of Article 131 of this Act and are employed by the representative on a regular or contractual basis (full name, address and education).

(6) The minister responsible for industrial property shall, by way of an implementing regulation, determine in greater detail the content of a request for the registration of a representative, the registration procedure, the type of data entered in the register and the procedure for entering changes in the register of representatives.

Article 133 (Examination)

(1) An examination referred to in paragraphs two or three of Article 131 of this Act shall be taken before the Office. A fee laid down by the Act governing administrative fees shall be paid before the examination.

(2) The Office shall keep a list of persons who have passed the examination.

(3) The minister responsible for industrial property shall, by way of an implementing regulation, determine in greater detail the manner of conducting examinations referred to in paragraphs two or three of Article 131 of this Act.

Chapter Twelve PENALTY PROVISIONS

Article 134 (Minor offences)

(1) Legal persons shall be fined from EUR 4,000 to EUR 40,000 for the offences of:

1. submitting to the Office forged or false evidence under Article 92 of this Act or requesting a suspension of proceedings under paragraph three of Article 92 of this Act by a forged or false notification;
2. representing a third party in the proceedings before the Office without being registered in the register referred to in Article 132 of this Act.

(2) Sole traders or individuals who perform independent activities shall be fined from EUR 400 to EUR 4,000 for the offences referred to in the preceding paragraph.

(3) The responsible person of the legal person or of a sole trader or individual who performs an independent activity shall be fined from EUR 400 to EUR 2,000 for the offences referred to in paragraph one of this Article.

(4) An individual shall be fined from EUR 400 to EUR 1,000 for the offences referred to in paragraph one of this Article.

SHOW CONSOLIDATED TRANSITIONAL AND FINAL PROVISIONS

The Industrial Property Act – ZIL-1 (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 45/01) contains the following transitional and final provisions:

"Chapter Thirteen TRANSITIONAL AND FINAL PROVISIONS

Article 135

(Use of substances as medication)

(1) The use of a substance as medication for humans and animals shall not constitute an infringement of a patent for the invention of this substance if the patent application for this invention was filed on or before 31 December 1992, or if a right of priority was claimed for such application on or before 31 December 1992.

(2) The use of a substance as medication within the meaning of the preceding paragraph shall be its production and processing into the medicine under a process that is not the subject of the patent protection concerned, and the placing of this substance or medication on the market.

(3) As of the date of the accession of the Republic of Slovenia to the European Union, paragraph two of Article 21 of this Act shall only apply to a substance or medicine referred to in paragraph one of this Article if the consent of the holder of the patent under which the substance or medicine is protected has been obtained.

Article 136

(Treatment of applications and validity of rights)

(1) The proceedings concerning the recognition or granting of industrial property rights with respect to applications filed before the date of entry into force of this Act shall continue in accordance with the provisions of this Act, unless otherwise provided by this Act.

(2) The industrial property rights that are valid on the date of entry into force of this Act shall continue to be valid in accordance with the provisions of this Act, unless otherwise provided by this Act.

Article 137

(Patent applications and patents)

(1) The provisions of Articles 10, 77, 78 and 112 of the Industrial Property Act (Official Gazette of the Republic of Slovenia [*Uradni list RS*] Nos 13/92, 27/93, 34/97 – Constitutional Court Decision, 75/97) shall continue to apply to patent applications filed before this Act entered into force or patents granted before this Act entered into force.

(2) The provisions of paragraphs two and three of Article 22 of this Act shall apply to patents applied for after 1 January 1993.

(3) As of the date of the accession of the Republic of Slovenia to the European Union, paragraph three of Article 22 of this Act shall be implemented in accordance with the European Union regulations.

(4) Within six months of the accession of the Republic of Slovenia to the European Union, a supplementary protection certificate may be requested for the patents applied for after 1 January 1993 for which the time limit referred to in Article 7 of EU Regulation No. 1768/92 of 18 June 1992 or Article 7 of EU Regulation No. 1610/96 of 23 June 1996 expired.

(5) The provisions of Articles 24 to 31 of this Act shall begin to apply on entry into force of the EPC in the Republic of Slovenia.

(6) The provision of paragraph five of Article 32 of this Act shall not apply to applications under the PCT that have been filed before this Act entered into force.

Article 138

(Industrial design and utility model applications and industrial designs and utility models)

(1) Article 58 of the Industrial Property Act shall continue to apply to the applications for industrial designs and utility models published before this Act entered into force and for which opposition to the issue of the decision on the recognition of industrial design or utility model has been filed.

(2) If an industrial design or utility model application was published before this Act entered into force, but opposition to the issue of the decision on the recognition of the industrial design or utility model under Article 58 of the Industrial Property Act has not been filed, the Office shall issue a decision on the registration of the industrial design, enter the industrial design in the register and publish the notice of the registration of the industrial design.

(3) Industrial designs and utility models valid on the date of entry into force of this Act shall be treated as industrial designs under this Act.

Article 139

(Opposition on the basis of a trade mark applied with the Office for Harmonization in the Internal Market (Trade Marks and Designs))

(1) Until the accession of the Republic of Slovenia to the European Union, a trade mark that was applied for or registered with the Office for Harmonization in the Internal Market (Trade Marks and Designs) before the date of application of the later trade mark in the Republic of Slovenia shall also be considered an earlier trade mark under paragraph one of Article 44 of this Act.

(2) The holder of the earlier trade mark referred to in the preceding paragraph may file an opposition under Article 101 of this Act, provided that they also file a correct application for the protection of their trade mark in the Republic of Slovenia within the time limit for the opposition.

(3) If the holder of the earlier mark referred to in paragraph one of this Article, when filing an opposition under Article 101 of this Act, fails to also file a correct application for the protection of their trade mark in the Republic of Slovenia in due time, the opposition shall be deemed not to have been filed.

Article 140
(Designation of origin)

The designations of origin valid on the date of entry into force of this Act shall be treated as geographical indications under this Act, unless otherwise provided by another Act.

Article 141
(Examinations and representatives)

(1) Examinations passed or recognised up to the date of entry into force of this Act shall be considered equal to the examinations for patent representatives and examinations for industrial design and trade mark representatives.

(2) The Office shall *ex officio* enter in the register of patent representatives all representatives who have been registered in the register of representatives on the date of entry into force of this Act.

Article 142
(Implementing regulations)

(1) The implementing regulations under this Act and the order on the tariff referred to in paragraph three of Article 7 of this Act shall be issued within six months of entry into force of this Act, with the exception of the regulation referred to in paragraph two of Article 80 of this Act, which shall be issued when the Office sets up the necessary technical facilities.

(2) Until the issue of new regulations, the following regulations issued pursuant to the Industrial Property Act shall apply *mutatis mutandis*:

- a) Rules on the procedure for the granting of patents (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 49/93);
- b) Rules on the procedure for the recognition of industrial designs and utility models (Official Gazette of the Republic of Slovenia [*Uradni list RS*] Nos 49/93, 37/95 – Constitutional Court Decision);
- c) Rules on the procedure for the recognition of trade marks (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 49/93);
- d) Rules on the procedure for international trade mark registration (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 15/93);
- d) Rules on the manner of conducting examinations and entry in the register of representatives (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 20/92);
- f) Decree on the fees of the Slovenian Intellectual Property Office for the acquisition and protection of industrial property rights (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 14/95);
- g) Decree on the fees of the Slovenian Intellectual Property Office for information and other services (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 57/96).

Article 143
(End of validity)

- (1) On the day this Act enters into force, the following shall cease to be in force:
- a) Industrial Property Act;
 - b) Rules on the transfer of industrial property rights applied for with the Federal Patent Office to the Slovenian Intellectual Property Office (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 49/93).

(2) Notwithstanding point a) of the preceding paragraph and subject to paragraph one of Article 137 and paragraph one of Article 138 of this Act, the provisions of Articles 10, 58, 77, 78 and 112 of the Industrial Property Act shall continue to apply.

Article 144
(Entry into force)

This Act shall enter into force six months after its publication in the Official Gazette of the Republic of Slovenia."

The Act Amending the Industrial Property Act – ZIL-1A (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 96/02) contains the following final provision:

"Article 2

This Act shall enter into force on the fifteenth day following its publication in the Official Gazette of the Republic of Slovenia."

The Act Amending the Industrial Property Act – ZIL-1B (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 37/04) contains the following final provision:

"Article 2

This Act shall enter into force on the date of accession of the Republic of Slovenia to the European Union."

The Act Amending the Industrial Property Act – ZIL-1C (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 20/06) contains the following transitional and final provisions:

"TRANSITIONAL AND FINAL PROVISIONS

Article 23
(Proceedings in progress)

Proceedings conducted pursuant to Chapter Nine of the Act that are in progress upon entry into force of this Act shall be concluded according to the provisions of the Act applicable to date.

Article 24
(Entry into force)

This Act shall enter into force on the fifteenth day following its publication in the Official Gazette of the Republic of Slovenia."

The Act Amending the Industrial Property Act – ZIL-1D (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 100/13) contains the following final provision:

"Article 2

This Act shall enter into force on the fifteenth day following its publication in the Official Gazette of the Republic of Slovenia."

The Act Amending the Industrial Property Act – ZIL-1E (Official Gazette of the Republic of Slovenia [*Uradni list RS*], No. 23/20) contains the following transitional and final provisions:

"TRANSITIONAL AND FINAL PROVISIONS

Article 39
(Proceedings in progress)

Cases in relation to which a legal remedy has been filed or judicial proceedings initiated prior to entry into force of this Act shall be concluded according to the regulations applicable to date.

Article 40
(Harmonisation of implementing regulations)

(1) The Rules on the content of trade mark application (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 102/01), the Rules on electronic applications in procedures for the registration of trade marks and designs (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 3/15) and the Rules on the register of applications and industrial property rights and priority right certificate (Official Gazette of the Republic of Slovenia [*Uradni list RS*] No. 102/01) shall be harmonised with this Act within three months of entry into force of this Act.

(2) The Rules referred to in the preceding paragraph shall apply until they are harmonised with this Act unless they are in conflict with the provisions of this Act.

Article 41
(Entry into force)

This Act shall enter into force on the fifteenth day following its publication in the Official Gazette of the Republic of Slovenia."