

**INDUSTRIAL PROPERTY ACT of
23 May 2001
as last amended on 6 February 2006**

(as in force from 11 March 2006)

**Chapter I
BASIC PRINCIPLES**

**Article 1
Scope of the Act**

(1) This Act defines the types of industrial property rights under this Act and proceedings for the grant and registration of these rights, judicial protection of rights and representation of parties in the proceedings under this Act.

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

(3) This Act integrates into the legal system of the Republic of Slovenia the provisions of the 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 July 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 October 1998, p. 28), First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ L 40, 11 February 1989, p. 1) and 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 195, 2 June 2004, p. 16).

**Article 2
National treatment**

(1) Legal and natural persons that are foreign nationals shall enjoy, in respect of the protection of industrial property rights in the Republic of Slovenia, the same rights as domestic legal or natural persons, or other domestic nationals, in conformity with the Agreement on Trade-Related Aspects of Intellectual Property Rights of 15 April 1994 (Official Gazette RS - MP, No 10/95), hereinafter referred to as "the TRIPS Agreement", or the application of the principle of reciprocity.

(2) The party invoking reciprocity shall be required to prove the existence of reciprocity.

Article 3

Applications for the acquisition of industrial property rights

(1) Subject to Article 17, the acquisition of an industrial property right in the Republic of Slovenia shall be requested by filing a national application with the Slovenian

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Unofficial translation.

Intellectual Property Office, hereinafter referred to as "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 conformity with an international treaty which is binding on the Republic of Slovenia. The legal effect of the rights conferred by such applications shall be the same as that of the rights conferred by national applications, unless otherwise provided by a respective international treaty.

(3) A national application shall not give rise to an industrial property right if a prior application has been filed, by the same person, under paragraph (2), 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 conformity with an international treaty which is binding on the Republic of Slovenia.

Article 4

Priority of the earlier application

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

Article 5

The Office

(1) The main tasks of the Office shall be:

(a) to receive applications by which the acquisition of industrial property rights is requested;

- (b) to carry out autonomously proceedings relating to the grant of patents and registration of industrial designs, marks and geographical indications, and to grant patents and register industrial designs, marks and geographical indications;
 - (c) to keep the registers of industrial property rights and other registers under this Act;
 - (d) to provide information services relating to industrial property rights;
 - (e) to represent the Republic of Slovenia, in conformity with the position, instructions and authorisation by the Government of the Republic of Slovenia, in foreign and international organisations in the field of industrial property;
 - (f) to perform other tasks which fall within its competence.
- (2) The Office shall publish its Official Journal containing data on applications and industrial property rights.
- (3) The Office shall be autonomous with respect to finances relating to payment of fees under this Act and payments for services supplied under Article 7, and shall verify those payments.
- (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 grant or registration of industrial property rights and maintenance thereof, and in proceedings concerning the keeping of registers of rights and other registers, the Office shall issue decisions, orders and other acts pursuant to this Act. In the absence of corresponding provisions in this Act, the Act regulating general administrative procedure shall apply.
- (2) Proceedings relating to applications under Article 3(2) or (4) shall be conducted by the Office in conformity with international treaties which are binding on the Republic of Slovenia and implementing rules and instructions relating thereto. In the absence of corresponding provisions in the relevant international treaty, the provisions of this Act shall apply *mutatis mutandis*.

Article 7

Information to the public

- (1) Subject to Article 8, the Office shall make possible for any person to inspect files relating to applications, and to have access to data relating to applications and rights granted or registered.
- (2) Against payment, the Office shall supply information on the state of the art comprised in patent documents, and other services in the field of information and documentation.
- (3) The Minister competent for the field of industrial property shall issue an order on the tariff fixing the kinds and the amount of payments under paragraph (2).

Article 8

Secrecy and inspection of applications

- (1) The files relating to patent and industrial design applications shall be official secrecy until the publication of the patent application in the Official Journal or the registration of the industrial design.
- (2) The files which are official secrecy shall be made available for inspection only with the consent of the applicant.
- (3) Any person who can prove that, in relation to his acts, the applicant informed him in writing about his application and the scope of requested protection may obtain inspection of the files which are official secrecy without the consent of the applicant.
- (4) Where a patent application relating to a deposited biological material has been refused or withdrawn, the deposited biological material shall only be available to an independent expert for twenty years from the date of filing of the application, if so requested by the applicant.
- (5) Even prior to the publication of the patent application in the Official Journal, the Office may publish the following data or communicate them to third parties:
 - (a) the number of the application;
 - (b) the date of filing of the application and, where the priority is claimed, the date, State or Office and file number of the previous application;
 - (c) data concerning the applicant (surname, forename and address, or firm and

seat);

(d) the title of the invention.

Article 9

Fees

(1) For the acquisition and maintenance of rights under this Act, fees shall be paid in time limits laid down by this Act. The amounts of fees shall be fixed by a decree issued by the Government of the Republic of Slovenia

(2) In proceedings in which fees under paragraph (1) shall be paid, the fees under the Act regulating administrative fees shall not be payable.

(3) If procedural fees are not paid in due time, or are not paid in full, they are deemed to be unpaid and the request to be withdrawn, unless otherwise provided by this Act. Upon request, the Office shall refund the amount which has been paid.

Chapter II

PATENTS

Section I

Patents and short-term patents

Article 10

Subject-matter of patent protection

(1) Patents shall be granted for any inventions, in all fields of technology, which are new, involve an inventive step and are susceptible of industrial application.

(2) Detailed conditions for the grant of patents in respect of individual fields of technology with certain 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 within the meaning of Article 10.

(2) A patent shall not be granted for:

(a) inventions, the exploitation of which would be contrary to public order or morality;

(b) inventions of surgical or diagnostic methods or methods of treatment practised directly on the living human or animal body, with the exception of inventions relating to products, in particular substances or compositions for use in any of these methods.

Article 12

Novelty

(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 held to comprise everything made available to the public by means of an oral or written description, by use, or in any other way, before the date of filing of the patent application. The right of priority shall have the effect that the date of priority shall count as the date of filing for the purposes of this Article.

(3) The contents of the following applications, which have been filed before the date referred to in paragraph (2) and which were published on or after that date, shall also be considered as comprised in the state of the art:

(a) national patent applications, as originally filed with the Office;

(b) European patent applications, as originally filed with the European Patent Office, hereinafter referred to as "the EPO", under the European Patent Convention of 5 October 1973, hereinafter referred to as "the EPC", requesting 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 modified on 3 February 1984 (Official Gazette RS - MP, No 19/93), hereinafter referred to as

"the PCT", received by the Office as the elected Office in accordance with Article 39 of the PCT.

(4) The provisions of paragraphs (1) to (3) shall not exclude from patentability any substance or composition comprised in the state of the art where it is intended for use in a method of treatment referred to in Article 11(2)(b) and such use is not comprised in the state of the art.

Article 13 **Non-prejudicial disclosures**

(1) For the purpose of applying Article 12, a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months preceding the filing of the application and if it was due to, or in consequence of:

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

(2) The provision of paragraph (1)(b) shall apply only if the applicant states, when filing the application, that the invention has been so displayed and files a supporting certificate in conformity with Article 62(2).

Article 14 **Inventive step**

(1) An invention shall be considered as involving an inventive step if, having regard to the state of the art within the meaning of Article 12(2), it is not obvious to a person skilled in the art.

(2) If the state of the art also includes documents within the meaning of Article 12(3), these documents are not to be considered in deciding whether there has been an inventive step.

(3) Where an applicant, after having filed an application which has not yet been published, files another application for the same invention, the first application is not to be considered in deciding whether there has been an inventive step in the second application.

Article 15
Industrial application

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

Article 16
Subject-matter of short-term patent protection

- (1) With the exception of processes, plant varieties and animal breeds, a short-term patent may be granted for inventions which are new, susceptible of industrial application and are 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 a practical industrial advantage.
- (3) The provisions of this Act relating to patents shall apply *mutatis mutandis* to short-term patents, unless otherwise provided by this Act.

Article 17

Secret inventions

(1) Invention which are important for the defence or security of the Republic of

Slovenia shall be deemed secret and shall be registered at the Ministry competent for the defence.

(2) The conditions of exploitation of secret inventions, in particular compensation for the exploitation, shall be subject to mutual agreement between the inventor and the Ministry competent for the defence.

(3) The application for the invention referred to in paragraph (1) may be filed with the Office if the Ministry competent for the defence does not wish to exploit it or if it consents to the filing of the patent application.

Article 18

Rights conferred by a patent

(1) A patent shall confer on its owner the following exclusive rights:

(a) where the subject-matter of a patent is a product, to prevent third parties not having the owner's consent from the acts of making, using, offering for sale, selling, or importing for these purposes that product;

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

(2) The scope of protection conferred by a patent shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

Article 19

Limitation of rights conferred by a patent

The rights conferred by a patent within the meaning of Article 18 shall not extend to:

- (a) acts done privately and for non-commercial purposes;
- (b) acts done for research and experimental purposes of any kind relating to the subject-matter of the patent irrespective of their final purpose;
- (c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription nor acts concerning the medicine so prepared;
- (d) the use on board vessels of other countries of the patented invention, in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of the Republic of Slovenia, provided that the invention is used there exclusively for the needs of the vessel;
- (e) the use of the patented invention in the construction or operation of aircraft or land vehicles of other countries, or of accessories to such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the territory of the Republic of Slovenia;
- (t) the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944 (Official Gazette FLRJ-MP Nos 3/54, 5/54, 9/61, 5/62, 11/63, 49/71,62/73, 15/78,2/80, Official Gazette RS-MP No 9/92), where these acts concern the aircraft of a State benefiting from the provisions of that Article.

Article 20

Right based on prior use

- (1) The rights conferred on the owner of a patent by virtue of Article 18 shall have no legal effect vis-a-vis a person who was using the invention in the Republic of Slovenia in good faith before the date of filing or, if priority is claimed, the date of priority, or was making preparations for such use, and who continues such use. Such person retains the right to use the invention, but has no right to give licence or otherwise use the invention.
- (2) The right of the person referred to in paragraph (1) to continue the use of the invention may only be transferred together with his enterprise or business in which the use or preparations for use have been made.

Article 21

Exhaustion of the rights conferred by a patent

(1) The rights conferred by a patent shall not extend to acts concerning a product covered by that patent which are done in the Republic of Slovenia after that product has been put on the market in the Republic of Slovenia by the owner of the patent or with his express consent, unless there are grounds which, under the law of the Republic of Slovenia, would justify the extension to such acts of the rights conferred by the patent.

(2) The exhaustion of the rights referred to in paragraph (1) may be extended beyond the territory of the Republic of Slovenia, if this is in conformity with an international treaty which is binding on the Republic of Slovenia.

Article 22

Term of a patent

(1) Subject to Article 91(3) and corresponding provisions of Article 109, the term of a patent shall be twenty years as from the date of filing of the application.

(2) Immediately on expiry, the term of a patent may be extended once in the case of a state of war or similar emergency conditions, for the duration of such state or conditions, but not for more than five years.

(3) Immediately on expiry of the term of the patent, a supplementary protection certificate may be granted once, in accordance with a decree issued by the Government of the Republic of Slovenia, if the subject-matter of the patent is a product or a process of manufacturing a product or a use of a product which has to undergo an administrative authorisation procedure required by law before it can be put on the market, but not for more than five years.

Article 23

Term of a short-term patent

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

Section II

European patent applications and European patents

Article 24 Applicable law

(1) Patents granted by the EPO in accordance with the EPC, hereinafter referred as "European patents", and applications for a European patent filed in accordance with the EPC, hereinafter referred to as "European patent applications", requesting protection in the Republic of Slovenia shall be governed by this Act, unless otherwise provided by the EPC.

(2) In case of conflict between the provisions of the EPC and those of this Act, the provisions of the EPC shall prevail 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 accepted under Article 14(1) and (2) of the EPC.

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

Article 26 Effects of a European patent application

(1) A European patent application requesting protection in the Republic of Slovenia which has been accorded a filing date shall be equivalent to a national application, where appropriate with the priority claimed for the European patent application, whatever its outcome may be.

(2) A published European patent application requesting protection in the Republic of Slovenia shall confer the protection conferred under Article 122(4) as from the date

on which a translation of the claims of that application as published has been communicated by the applicant to the person using the invention in the Republic of Slovenia.

Article 27
Effects of a European patent

- (1) A European patent requesting protection in the Republic of Slovenia shall, subject to paragraphs (2) to (4), confer as from the date of the mention of its grant by the EPO the same rights as a patent granted by the Office under Article 18.
- (2) The owner of the European patent shall furnish to the Office within three months after the mention of its grant a translation of the claims into the Slovene language and shall pay the prescribed fee for publication. .
- (3) Where, as a result of an opposition procedure before the EPO, the European patent is maintained as amended, paragraph (2) shall apply mutatis mutandis.
- (4) If the text of the claims contains reference signs used in drawings, those drawings shall be attached to the translation referred to in paragraphs (2) and (3). The text in the drawings, if any, shall also be translated into the Slovene language.
- (5) The Office shall publish any translation filed in conformity with paragraphs (2), (3) or (4).
- (6) Where the owner of the European patent complies with paragraph (2), the Office shall issue a decision on entry of the European patent in the Office's patent register.
- (7) If the translation referred to in paragraphs (2), (3) or (4) is not filed, or the prescribed fee is not paid, in due time, the European patent requesting protection in the Republic of Slovenia shall be deemed to be void.

Article 28
Authentic text of European patent applications or European patents

- (1) Where a translation referred to in Articles 26 and 27 confers protection which is narrower than that conferred by a European patent application or European patent in the language of the proceedings, that translation shall be

regarded as the authentic text, except for opposition proceedings before the EPO.

(2) The applicant for or owner of the European patent may file a corrected translation of claims at any time. The corrected translation shall take effect only after it has been published by the Office, or communicated to the person using the invention in the Republic of Slovenia by the applicant for or owner of the European patent.

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

Article 29 **Fees for European patents**

(1) Subject to Articles 109 and 110, renewal fees in respect of European patents requesting protection in the Republic of Slovenia shall be paid to the Office for each year following that in which the order on the grant of the European patent is published. Where the renewal fee for the third year of the maintenance of a European patent has not been paid to the EPO, it shall be paid to the Office.

(2) Notwithstanding paragraph (1), the first renewal fee in respect of a European patent shall fall due within two months after the order on the grant of the European patent is published.

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

Article 30 **Conversion into a national patent application**

(1) A European patent application requesting protection in the Republic of Slovenia may be converted into a national patent application, where the European patent application is deemed to be withdrawn pursuant to Article 77(5) of the EPC or, because the translation of the application under Article 14(2) of the EPC has not been filed in due time, pursuant to Article 90(3) of the EPC.

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

Article 31 **Simultaneous protection**

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

Section III **PCT patent applications**

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 having their residence or seat therein.
- (3) International applications under the PCT shall be filed in English, French or German language. They may also be filed in the Slovene language if a translation in English, French or German language is submitted to the Office within the time limit prescribed in implementing rules and instructions under 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 act as an International Searching Authority and International Preliminary Examining Authority in respect 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 Article 2(viii) of the PCT shall be considered as a request for the grant of a European patent having effect in the Republic of Slovenia under

an international treaty which is binding on the Republic of Slovenia.

Chapter In INDUSTRIAL DESIGNS

Section I Industrial designs

Article 33 Subject-matter of industrial design protection

- (1) An industrial design shall be registered for a design to the extent that it is new and has an individual character.
- (2) "Design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.
- (3) "Product" means any industrial or handicraft item, including, inter alia, parts intended to be assembled into a complex item, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programmes. "Complex product" means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product.
- (4) A design applied to a component part of a complex product shall only be considered to be new and to have an individual character:
- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter, and
 - (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.
- (5) "Normal use" within the meaning of paragraph (4)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

Article 34 Novelty and individual character

- (I) A design shall be considered new if no identical design has been made available to the public before the date of filing of the industrial design application or, if priority is claimed, the date of priority. Designs shall be

deemed to be 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 the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing 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 consideration.

Article 35 **Disclosure of a design**

(1) For the purpose of applying Article 34, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where 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 Community, before the date of filing of the application or, if priority is claimed, the date of priority. The design shall not, however, be deemed to have been available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

(2) For the purpose of applying Article 34, disclosure shall not be taken into consideration if a design for which protection is sought has been made available to the public in the European Community:

(a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer, or his successor in title, and

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

(4) Paragraph (2) 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 his successor in title.

Article 36 **Refusal of an industrial design**

(1) A design shall not be registered as an industrial design if:

- (a) it is not a design within the meaning of Article 33(2);
- (b) it does not fulfil the requirements of Article 33(1) or (4), or Articles 34 or 35, or is in conflict with a design having effect in the Republic of Slovenia on the basis of an application with an earlier date of filing;
- (c) it should be refused pursuant to Article 6^{ter} of the Paris Convention for the Protection of Industrial Property of 20 March 1883, last revised on 14 July 1967 (Official Gazette SFRJ-MP Nos 5/74, 7/86, Official Gazette RS-MP No 9/92), hereinafter referred as "the Paris Convention", on the ground that authorisation by the competent authorities has not been submitted;
- (d) it includes or imitates badges, emblems or escutcheons other than those covered by Article 6^{ter} of the Paris Convention and which are of particular public interest, unless the consent of the competent authorities to its registration has been given;
- (e) it is contrary to public order or morality.

(2) An industrial design shall not subsist in features of appearance of a product, which are solely dictated by its technical function.

(3) An industrial design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product to which the design is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

(4) Notwithstanding paragraph (3), an industrial design shall, under the conditions set out in Article 34, subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

Article 37

Rights conferred by an industrial design

(1) The industrial design shall confer on its owner the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product to which the design is

applied, or stocking such a product for those purposes.

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

(3) The rights referred to in paragraph (1) shall not extend:

(a) to 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, and to the execution of repairs on such ship or aircraft, and *mutatis mutandis* to acts referred to in Article 19, with the exception of subparagraph (c);

(b) to acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of source.

(4) Any third person may assert the right based on prior use in respect of an industrial design. In this case, provisions of Article 20 shall apply *mutatis mutandis*.

Article 38

Exhaustion of rights conferred by an industrial design

(1) The rights conferred by an industrial design shall not extend to acts relating to a product to which the design is applied, when the product has been put on the market in the Republic of Slovenia by the owner of the industrial design or with his consent.

(2) The exhaustion of rights referred to in paragraph (1) may be extended beyond the territory of the Republic of Slovenia, if this is in conformity with an international treaty which is binding on the Republic of Slovenia.

Article 39

Other forms of industrial design protection

(1) Provisions of this Act concerning industrial designs shall be without prejudice to provisions of other Acts relating to unregistered industrial designs, marks or other distinctive signs, patents, utility models, typefaces, civil liability or unfair competition.

(2) An industrial design shall be eligible for copyright protection as from the date on which the design was created or fixed in any form if it fulfils the conditions under which such a protection is conferred under the Act regulating copyright and related rights.

Article 40 **Term of an industrial design**

(1) The term of an industrial design shall be one or more periods of five years as from the date of filing of the application.

(2) Subject to corresponding provisions of Article 109, the owner of an industrial design may renew its term for one or more periods of five years each, up to a total term of 25 years from the date of filing of the application.

(3) The term of a multiple industrial design may be renewed, in conformity with paragraph (2), as a whole, or in limited scope for only some products.

Section II **International deposit of industrial designs**

Article 41 **Requests under the Hague Agreement**

(1) The requests under the Hague Agreement Concerning the International Deposit of Industrial Designs of 28 November 1960, as completed on 14 July 1967 and amended on 28 September 1979 (Official Gazette RS-MP No 20/94), hereinafter referred to as "the Hague Agreement" shall be filed, in accordance with the Hague Agreement and implementing rules and instructions thereto, with the International Bureau.

(2) In accordance with Article 8 of the Hague Agreement, provisions of this Act, with the exception of the provision of Article 96(2), shall apply mutatis mutandis to requests under the Hague Agreement by which protection of an industrial design is sought in the Republic of Slovenia.

Chapter IV **MARKS**

Section I
Marks and collective marks

Article 42
Subject-matter of mark protection

(1) Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of another undertaking, and capable of being graphically represented, in particular words, including personal names, letters, numerals, figurative elements, three dimensional images, including the shape of goods or of their packaging, combinations of colours as well as any combination of such signs, shall be eligible for registration as marks.

(2) In deciding whether a sign is eligible for registration as a mark, all circumstances, in particular the duration of its use, shall be taken into account.

(3) The nature of the goods or services to which a mark is to be applied shall in no case form an obstacle to the registration of the mark.

Article 43 Absolute grounds for refusal

(1) A sign shall not be eligible for registration as a mark if:

(a) it cannot constitute a mark;

(b) it is devoid of any distinctive character;

(c) it serves, in trade, to designate merely the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

(d) it contains or consists of a geographical indication identifying wines or spirits, where the mark application relates to wines or spirits not having this origin;

(e) it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

(t) it consists exclusively of the shape which results from the nature of the goods themselves or is necessary to obtain a technical result or gives substantial

value to the goods;

(g) it is contrary to public order or morality;

(h) it deceives the public, in particular to the nature, quality or geographical origin of the goods or services;

(i) it contains official signs or hallmarks for controlling or guaranteeing the quality of goods, or imitations thereof;

(j) it has not been authorised by the competent authorities and should be refused pursuant to Article 6^{k r} of the Paris Convention;

(k) it includes or imitates badges, emblems or escutcheons other than those covered by Article 6^{k r} of the Paris Convention and which are of particular public interest, unless the consent of the competent authorities to its registration has been given;

(1) it contains or consists of a designation of origin or a geographical indication registered in accordance with the Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 208/92, p. 1), provided that the circumstances referred to in Article 13 of that Regulation exist and the sign does not relate to the same sort of product, and provided that the mark application has been filed after the date of filing of the application for the registration of a designation of origin or a geographical indication with the Commission.

(2) Paragraph 1(b), (c) and (e) shall not apply to marks which acquired a distinctive character through long-term use.

(3) A sign which is ineligible for registration because it contains the name or abbreviation of the name, State armorial bearing, emblem, flag or other official sign of the Republic of Slovenia, or a part thereof, which is in breach of the provisions of

paragraph (1)(j) and (k), shall not be used in the course of trade without the consent of the Government of the Republic of Slovenia.

Article 44

Relative grounds for refusal

(1) Further, a sign shall not be eligible for registration as a mark if:

(a) it is identical with an earlier mark of another owner, and the goods or services for which the registration is applied for are identical with the goods or services for which the earlier mark is registered;

(b) because of its identity with or similarity to the earlier mark of another owner and
the identity or similarity of the goods or services covered by the sign and the mark there exist the likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark;

(c) because of its identity with or similarity to an earlier mark of another owner, registered for goods or services which are not identical with or similar to the goods or services for which the registration has been applied for, the use without due cause of

such sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark, or if it would indicate a connection between the goods or services and the owner of the earlier mark, and provided that the interests of the owner of the earlier mark are likely to be damaged by such use;

(d) it is identical with or similar to a mark or unregistered sign, which is in the Republic of Slovenia a well-known mark within the meaning of Article 6^{bis} of the Paris Convention or Article 16(3) of the TRIPS Agreement;

(e) the owner of the mark registered in any Member State of the Union established under the Paris Convention, hereinafter referred to as "the Paris Union", or the World Trade Organisation, hereinafter referred to as "the WTO", proves that his agent or representative applied, without the owner's consent, for the registration of the sign in his own name;

(f) its use would contradict an earlier right to a name, personal portrayal, plant variety, geographical indication or other industrial property right, or an earlier copyright, unless the owner of the earlier right gives his express consent to the registration of such sign.

(2) "Earlier mark" within the meaning of paragraph (1) means:

(a) mark which was applied for or registered in the Republic of Slovenia on the

basis of a national application before the date of filing of the application for the later mark or, if priority is claimed, the date of priority;

(b) mark for which the protection was sought in the Republic of Slovenia on the basis of an international application before the date of filing of the application for the later mark or, if priority is claimed, the date of priority.

Article 45

Subject-matter of collective mark protection

(1) Any sign which meets the requirements of Article 42 and is capable of distinguishing the goods or services of the members of the holder of the collective mark from those of another undertakings as to their origin in a given enterprise or their geographical origin, their nature, quality, or other properties, shall be eligible for registration as a collective mark.

(2) The applicant for or holder of a collective mark may be any association of legal or natural persons, including umbrella associations having legal personality, hereinafter referred to as "the associations", or legal persons governed by public law.

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

(4) The provisions of this Act shall apply to the registration of collective marks, unless otherwise provided by this Act.

Article 46

Regulations governing use of a collective mark

(1) An applicant for a collective mark must submit, when filing the application, regulations governing use of the collective mark.

(2) Regulations referred to in paragraph (1) shall include at least:

(a) the name and seat of the applicant;

(b) indication of the applicant's business and information concerning the person whom he officially and by laws represents;

(c) the conditions of membership;

(d) data concerning the group of persons having authority to use the collective

mark;

(e) provisions concerning the rights and obligations of the members in the event of infringement of the collective mark.

(3) The applicant for or holder of a collective mark shall immediately communicate to the Office any amendment to the regulations, which shall be examined by the Office as to its compliance with paragraph (2).

(4) Anyone may inspect the regulations governing use of a collective mark.

Article 47 **Rights conferred by a mark**

(1) A mark shall confer on the owner exclusive right to use the mark and other exclusive rights under this Act. The owner of a mark shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the mark in relation to goods or services which are identical with those for which the mark is registered;

(b) any sign where, because of its identity with or similarity to the mark and the identity or similarity of the goods or services covered by the mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the mark;

(c) any sign which is identical with or similar to the mark in relation to goods or services which are not similar to those for which the mark is registered, where the mark has a reputation in the Republic of Slovenia and where the use without due cause of that sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the mark.

(2) The following, inter alia, may be prohibited under paragraph (1):

(a) affixing the sign to the goods or to the packaging thereof;

(b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under that sign;

(d) using the sign on business papers and in advertising.

Article 48
Limitation of rights conferred by a mark

(1) The mark shall not entitle the owner to prohibit a third party from using in the course of trade and in accordance with honest practices in industrial or commercial matters:

(a) his own name or address;

(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering the service, or other characteristics of goods or services;

(c) the mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;

(d) any sign which is identical or similar to the mark, where the third party started to use it in good faith before the date of filing of the application or, if priority is claimed,

the date of priority.

(2) Where the owner of an earlier mark as referred to in Article 44(2) has not opposed, in a period of five successive years, the use of the later mark while being aware of such use, he shall no longer be entitled on the basis of the earlier mark to file an action under Article 114 or 119, or prohibit the use of the later mark in respect to the goods or services for which the later mark has been used, unless registration of the later mark was applied for in bad faith.

Article 49
Limitation of rights conferred by a collective mark

(3) The holder of a collective mark which consists also of an indication of the geographical origin shall enable any person whose goods or services originate in the geographical area concerned and meet the conditions for use set out in the regulations governing use of the collective mark to become a member of the association which is the holder of the mark.

Article 50
Exhaustion of rights conferred by a mark

(1) A mark shall not entitle the owner to prohibit its use in relation to goods which have been put on the market in the Republic of Slovenia by the owner or

with his consent.

(2) Paragraph (1) shall not apply where there exist legitimate reasons for the owner to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

(3) The exhaustion of rights referred to in paragraph (1) may be extended beyond the territory of the Republic of Slovenia, if this is in conformity with an international treaty which is binding on the Republic of Slovenia.

Article 51

Reproduction of marks in dictionaries

If the reproduction of a mark in a dictionary, encyclopaedia or similar reference work 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 owner of the mark, ensure that the reproduction of the mark at the latest in the next edition of the publication is accompanied by an indication that it is a mark.

Article 52

Term of a mark

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

(2) Subject to corresponding provisions of Article 109, the owner of a mark may renew its term an unlimited number of times, each time for ten years, computed from the date of filing of the application.

(3) The term of a mark may be renewed, in accordance with paragraph (2), as a whole, or in limited scope for only some goods or services.

Section II

International registrations of marks

Article 53

Filing of requests with the Office

(1) The Office shall accept requests under the Madrid Agreement Concerning the International Registrations of Marks of 14 April 1891 as last revised on 14 July 1967 (Official Gazette SFRJ-MP No 2/74, Official Gazette RS-MP No 9/92), hereinafter referred to as "the Madrid Agreement" and the Protocol Relating to the Madrid Agreement Concerning the International Registrations of Marks of 27 June 1997 (Official Gazette RS-MP No 21/97), hereinafter referred to as "the Madrid Protocol".

(2) Upon filing the request, or within three months after the receipt of the Office's invitation, the fee shall be paid. If the fee is not paid in due time, the request shall be deemed to be withdrawn.

(3) The request for international registration of a mark shall be accompanied by a list of goods or services in the language prescribed by the Madrid Agreement or the Madrid Protocol, and implementing rules and instructions thereto.

(4) If the request is not drawn up in conformity with the Madrid Agreement or the Madrid Protocol, implementing rules and instructions thereto, this Act and executive regulations thereto, the Office shall invite the person filing the request to amend the request within three months from the receipt of the invitation. If the request is not amended in due time, it shall be deemed to be withdrawn.

(5) An executive regulation issued by the Minister competent for the field of industrial property shall define, in greater detail, the contents of the request referred to in paragraph (1) and procedures relating thereto.

Article 54 **Examination of international marks**

(1) In accordance with Article 5 of the Madrid Agreement or Article 5 of the Madrid Protocol, the provisions of this Act, other than those of Article 103, shall apply mutatis mutandis to requests under the Madrid Agreement and the Madrid Protocol, by which the protection of a mark is sought in the Republic of Slovenia.

(2) The publication of data concerning the international registration of a mark in the Gazette of the International Bureau shall be construed as the publication of the mark application in the Republic of Slovenia.

(3) Where the owner of the mark for which protection is sought in the Republic of Slovenia under the Madrid Agreement or the Madrid Protocol does not

comment on the intended refusal of the protection of the mark, of which he has been notified in conformity with Article 5 of the Madrid Agreement or Article 5 of the Madrid Protocol, the Office shall, notwithstanding Article 129(5), mail the decision through a postal service directly to the owner of the mark.

Chapter V **GEOGRAPHICAL INDICATIONS**

Article 55

Subject-matter of protection of registered geographical indications

- (1) Geographical indications eligible for registration are indications which identify a good as originating in a territory, or a region or a locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.
- (2) The name of a good, which 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, is also eligible for registration as a geographical indication.
- (3) Geographical indications relating to a good of special historic or cultural importance may be protected by a decree issued by the Government of the Republic of Slovenia.
- (4) Geographical indications for agricultural products and foodstuffs as well as for wines and other products obtained from grapes or wine shall not be eligible for registration under this Act.

Article 56

Grounds for refusal

A geographical indication shall not be eligible for registration if:

- (a) it indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;
- (b) although literally true as to the territory, region or locality in which the good originates, it falsely represents to the public that the good originates in another territory;

(c) it has become generally known through long-term use in the course of trade as a designation for a specific kind of goods;

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

Article 57 **Protection against** **general use**

Registered geographical indications may not become generic or common names which would be freely used in the course of trade.

Article 58 **Rights conferred by a registered geographical indication**

(1) A registered geographical indication is a collective right and may be used as such in the course of trade only by those who, in accordance with the specification referred to in Article 104(2), produce or market the goods protected by the geographical indication.

(2) The use of a registered geographical indication by unauthorised persons shall be prohibited.

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

Article 59 **Limitation of rights conferred by a registered geographical indication**

(1) A mark shall not be cancelled nor its use prohibited where a mark which is identical with or similar to a registered geographical indication has been applied

for or registered in good faith, or where rights to a mark have been acquired through use in good faith before the geographical indication has been registered.

(2) A registered geographical indication shall not exclude the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such 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.

Chapter VI

GENERAL PROVISIONS CONCERNING PROCEDURES BEFORE THE OFFICE

Article 61

International right of priority

(1) Any person who has duly filed an application for a patent, industrial design or mark in any Member State of the Paris Union or WTO shall enjoy, for the purpose of filing the application in the Republic of Slovenia, a right of priority, for patents during a period of twelve months, and for industrial designs and marks during a period of six months following the date of filing of the first application.

(2) A person claiming the right of priority referred to in paragraph (1) shall indicate, when filing the application in the Republic of Slovenia, the date of the claimed priority. Within three months after the filing of the application, the number and State or Office of the first application shall be communicated to the Office. If the applicant fails to comply with the provision of this paragraph, the priority shall be deemed not to have been claimed.

(3) Upon the request of the Office or, in case of dispute, upon the request of the court, the person requesting the right of priority shall submit a copy of the first application, certified by the competent authority in the Member State of the Paris Union or WTO, in which such application was filed. A copy of the first application may not be required before the expiration of sixteen months from the filing of the

first application.

(4) Where the copy of the first application referred to in paragraph (3) is not the Slovene language and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the Office or, in case of dispute, the court may require that a translation of the first application in the Slovene language be filed by the person requesting priority within three months from the receipt of the invitation.

(5) Multiple priorities may be claimed in respect of several previous applications filed in one or several countries.

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

(7) Upon request and against payment of the fee prescribed by the Act regulating administrative fees, the Office shall issue a priority certificate. An executive regulation issued by the Minister competent for the field of industrial property shall define, in greater detail, the contents of the priority certificate and proceedings relating to the issuance thereof.

Article 62

Temporary protection at certain international exhibitions

(1) A person who displays an invention, appearance of the whole or a part of a product, or who uses a specific sign for marking goods or services, at an official or officially recognised international exhibition, falling within the terms of the Convention on International Exhibitions, signed on 22 November 1928 and last revised on 30 November 1972, in the Republic of Slovenia or other Member State of the Paris Union or WTO, may claim in his application, within three months after the closing of the exhibition, the right of priority as of the first day of the display of the invention or appearance of the whole or a part of the product, or of the use of the sign.

(2) A person claiming the right of priority referred to in paragraph (1) shall indicate, when filing the application in the Republic of Slovenia, the type of exhibition, the place at which it was held, the opening and closing dates and the first day of exhibition or use, and submit a written certificate issued by a competent authority in the Member State of the Paris Union or WTO, attesting to the official or officially recognised international nature of the exhibition. If the applicant fails to comply with the provision of this paragraph, the priority

shall be deemed not to have been claimed.

(3) The claiming of priority under paragraph (1) shall not extend the time limits of the international right of priority referred to in Article 61(1).

Article 63 **Correction or addition of a priority claim**

(1) The applicant may request a correction or addition of a priority claim with respect to a patent application within sixteen months from the date of priority or, where the correction or addition would cause a change in the date of priority, sixteen months from the date of priority as so changed, provided that such a request is filed within four months from the date of filing of the application.

(2) When filing the request, the applicant shall pay a fee. If the fee is not paid, the request shall be deemed to be withdrawn.

(3) Any request referred to in paragraph (1) received after the applicant has requested the publication under Article 89(2) shall be deemed not to have been filed, unless the request under Article 89(2) is withdrawn before the technical preparations for publication of the application have been completed.

(4) Where the correction or addition of a priority claim causes a change in the date of priority, the time limits shall be computed from the date of priority as so changed.

Article 64 **Restoration of the right of priority**

(1) Where a patent application which could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within two months from that date, the applicant may request the restoration of the right of priority, if he failed to file the application within the time limit referred to in Article 61(1) in spite of all due care required by the circumstances having been taken.

(2) The request for restoration of the right of priority shall be filed within two months from the date on which the priority period expired and before technical preparations for publication of the application have been completed. Upon filing the request, the fee shall be paid. If the fee is not paid, the request shall be deemed to be withdrawn.

Article 65

Prohibition to extend the scope of an application

(1) As from the date of filing, the subject-matter of a patent application may not be extended beyond the subject-matter of the application as initially filed.

(2) As from the date of filing, in the case of an industrial design application, the appearance of the whole or a part of a product shall not be substantially modified, or the number of products increased.

(3) As from the date of filing, in the case of a mark application, the sign shall not be substantially modified, or the original number of goods or services increased.

Article 66

Extension of time limits

(1) The applicant for or owner of a right may request, prior to the expiration of a time limit, its extension for up to three months.

(2) The time limits for filing an action as well as those referred to in paragraph (1) and in Articles 13(1), 27(2), 35(2), 61(1), 62(1), 63(1), 64(2), 67(2), 68(2), 80(3), 86(3), 91(1), 92(3), 94(2) and (3), 101(1) and (5), 109, 110, 117(1), 130(2) and 137(2) shall not be extended.

Article 67

Further processing after the non-observance of a time limit

(1) The applicant, who has failed to comply with a time limit set out for the fulfilment of the obligations required in the proceedings for the acquisition of a right, may request that the non-observed time limit be deemed to have been complied with, that

legal consequences of such non-observance be abolished, and that the Office continues the proceedings for the acquisition of the right.

(2) The request for further processing shall be filed, the omitted act must be completed, and the fee shall be paid within two months from the date on which the applicant was informed of the failure to comply with the time limit and the

legal

consequences of such non-observance. If the omitted act is not completed or if the fee is not paid in due time, the request shall be deemed to be withdrawn.

(3) The grant of further processing may not be requested for the non-observance of the time limit referred to in paragraph (2) and the time limit for filing an opposition or action, or if a request for the grant of restitutio in integrum or for correction or addition of a priority claim or for restoration of the right of priority has been filed.

(4) If the Office grants a request for further processing, Article 68(6) or (7) shall apply mutatis mutandis.

Article 68 **Restitutio in integrum**

(1) A party to the proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to observe any time limit set out for the obligations required by the Office in accordance with this Act and the

executive regulations issued pursuant to this Act, may request, on the basis of justifiable reasons, to have his rights re-established if the non-observance had the consequence of causing the deeming of the application, or of any request, to have been withdrawn, or the rejection or refusal, or the loss of the right.

(2) The request for the grant of restitutio in integrum shall be filed within three months from the removal of the cause of non-compliance with the time limit, or, if the party only learned subsequently about that non-compliance, from the day when the party learned. Upon filing the request, the omitted act shall be completed and a fee shall be paid. Failure to observe this condition shall lead to the request being deemed to be withdrawn.

(3) The request for the grant of restitutio in integrum may not be refused, wholly or in part, without previously notifying the requesting party in writing of the reasons for the intended refusal, in whole or in part, and without inviting him to react, within three months from the receipt of the invitation, to the reasons.

(4) The request for the grant of restitutio in integrum shall only be admissible within one year following the expiry of the unobserved time limit.

(5) The grant of restitutio in integrum shall not be requested for the non-observance of the time limit prescribed for the filing of the opposition or action, or the copy of the first application, the request for the grant of restitutio in integrum, the request for the grant of further processing, the request for the right of priority, the request for a correction or addition of priority claim, or the request for restoration of the right of priority.

(6) Any person who in good faith has used or made effective and serious preparations for using an invention or an industrial design which is the subject of a published

application in the course of the period between the loss of the right referred to in paragraph (1) and publication of the mention of re-establishment of that right, may, without payment, continue such use in the course of his business or for the needs thereof.

(7) Where the applicant for or owner of a mark has his right re-established, he may not invoke his rights to any person who, in good faith, has put goods on the market or supplied services under a sign which is identical with or similar to the mark in the course of the period between the loss of the right referred to in paragraph (1) and publication of the mention of re-establishment of that right.

Article 69 **Withdrawal of a request**

(1) A party to the proceedings before the Office may, at any time in the course of a proceeding, withdraw any request he might have filed.

(2) The request 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 the withdrawal of a request, the Office shall issue an order on the termination of the proceeding.

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

Article 70 **Notification of the applicant before refusal of a right**

(1) The Office may not issue a decision on refusal, in whole or in part, of a

request for the grant or registration of a right without previously informing the applicant in writing of the reasons and without inviting him to react, within three months from the receipt of the invitation, to the reasons or amend the submitted request.

(2) If the applicant reacts in due time to the reasons for refusal of his request, or amends the request, the Office shall, before issuing the decision, verify whether the reasons for the refusal, in whole or in part, still exist.

Article 71 Administrative litigation

There shall be no appeal against a decision or order issued by the Office; however, an action in the administrative litigation proceedings 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 Proceedings relating to actions

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

(2) The Office shall issue a decision through which the court decision is executed.

(3) Proceedings relating to actions under this Act shall be expeditious. The court shall accord priority to decisions relating to actions under this Act.

(3) Paragraphs (1) and (2) shall not apply to litigations concerning infringements of rights.

Article 73 Inventor, designer

(1) In the procedure for the grant of a patent, the inventor mentioned as such in the application shall be deemed to be the inventor, except when the court decides otherwise.

(2) Paragraph (1) shall apply mutatis mutandis to designers.

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

Article 74 **Owner of a right**

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

(2) Where several persons are designated as joint applicants, paragraph (1) shall apply *mutatis mutandis*. Mutual relations between the persons designated as joint applicants shall not be determined by the Office.

Article 75 **Transfer and licensing of rights**

(1) The owner of a patent, industrial design or mark may assign by contract, in part or in whole, his right and conclude licence agreements.

(2) Paragraph (1) shall apply *mutatis mutandis* to the applicant.

(3) Neither a collective mark nor a geographical indication may be transferred or be subject of a licence agreement.

Article 76 **Date of the acquisition of a right**

(1) Subject to paragraph (2), the rights under Articles 18, 37, 47 and 58 shall be acquired as of the date of their entry in the corresponding register.

(2) Subject to Article 122, the right under Article 18(1) may not be not enforceable by an action under Article 121 for infringement of a patent before the date of issuance of a declaratory decision under Article 93(l)(a) or (b), or before the date of the entry of a European patent already granted in the Office's register.

Article 77 **Lapse of rights**

Notwithstanding the terms laid down in Articles 22, 23, 40 and 52, the granted or registered rights shall lapse:

- (a) in case that the owner renounces his right, on the day following the date on which the request for renunciation is received by the Office;
- (b) if prescribed fees are not paid in conformity with the provisions of this Act;
- (c) pursuant to a final decision of the court or a decision of the Office in those cases provided by this Act, on the date specified in such decision.

Article 78 **Correction of errors**

- (1) The Office may at any time, ex officio or upon request, correct errors in names, dates and numbers, and other obvious errors in its acts, publications and registers.
- (2) Corrections of errors shall be published in the Official Journal.

Chapter VII **PROCEDURE FOR THE ACQUISITION OF RIGHTS**

Section I **Filing of applications and examination as to formal requirements**

Article 79 **Requirements of an application**

- (1) The application shall contain a statement to the effect that the acquisition of a right is requested, and:
 - (a) for patents, all items listed in Article 86(1);
 - (b) for industrial designs, all items listed in Article 94(1);
 - (c) for marks, all items listed in Article 97(1) and, for collective marks, also the regulations referred to in Article 46.
- (2) The application shall also contain:
 - (a) a power of attorney, if the application has been filed by a representative;

(b) the translation in the Slovene language of the application which has been filed in a foreign language in accordance with Article 81(2);

(c) receipt for payment of the full amount of the filing fee.

(3) Executive regulations issued by the Minister competent for the field of industrial property shall define, in greater detail, the contents of the application, and proceedings relating to the grant of patents and registration of industrial designs and marks.

Article 80

Form of the application and the means of filing

(1) The application for the acquisition of a right shall comply as to its contents and form with provisions of this Act and the regulations issued pursuant to this Act. It shall be legible and transmitted in a manner which enables a clear and proper reproduction of its contents.

(2) The application shall be filed in writing, either directly or by post, by facsimile machine or by other electronic means of communication. An executive regulation issued by the Minister competent for the field of industrial property shall define, in greater detail, the manner of filing applications by other electronic means.

(3) Where an application, which has been transmitted by facsimile machine or by other electronic means, is not legible or can not be clearly and properly reproduced, the Office shall invite the applicant to submit, within three months following the receipt of the invitation, a copy of that application in writing. If the requested copy is not transmitted in due time, the application shall be deemed to be withdrawn.

(4) When filing the application, or no later than three months after the date of receipt of the invitation, the filing fee shall be paid. 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 the Slovene language, unless otherwise provided by this Act or an international treaty which is binding on the Republic of Slovenia.

(2) Applications may be filed in a foreign language, provided that it includes at

least the indication of the right requested, and the indication allowing the applicant to be

contacted by the Office, in the Slovene language 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 the translation thereof in the Slovene language within three months following receipt of the invitation. If the Office does not receive the translation 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 the Slovene language.

Article 82

Date of filing

(1) Subject to Article 81(2), the Office shall accord the date of filing and number to any application containing at least:

- (a) a statement to the effect that the acquisition of a right is requested;
- (b) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office;
- (c) essential items of an application for the requested right referred to paragraph (2).

(2) Essential items referred to in paragraph (1)(c) are the following:

- (a) for patents, a part of the application which on the face of it appears to be a description;
- (b) for industrial designs, a photograph or graphical representation of the appearance of the whole or a part of the product or, with two-dimensional products, where deferment of publication under Article 94(2) has been requested, a specimen of that product or its part;
- (c) for 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.

(3) Subject to Article 83, the date of filing of an application shall be the date on

which the Office has received all items referred to in paragraph (1), unless otherwise provided by this Act or by an international treaty which is binding on the Republic of

Slovenia. The Office shall issue a receipt to the applicant to the effect that it received the application, indicating the date of filing and number of the application.

(4) If the application does not contain all items referred to in paragraph (1) and can not be accorded the date of filing and number, the Office shall, as soon as it receives the indication allowing it to make contact with the applicant, notify the applicant accordingly and invite him to amend the application within three months from the receipt of the invitation, to fulfil at least the conditions laid down in paragraph (1).

(5) If the application referred to in paragraph (4) is amended in due time so as to contain all items referred to in paragraph (1), the Office shall accord to the application the date of filing and number. The date of filing of such application shall be the date when the Office received all of the items referred to in paragraph (1), and shall issue a receipt to that effect to the applicant.

(6) If the application referred to in paragraph (4) is not amended in due time, or is not amended as requested, it shall be deemed to be withdrawn, and the Office shall notify the applicant accordingly.

Article 83 **Particularities concerning the filing date**

(1) Where, in establishing the filing date, it appears that a part of the description is missing from the application, or that the application refers to a drawing which appears to be missing from the application, the Office shall promptly notify the applicant accordingly and invite him to amend the application within three months from the receipt of the invitation.

(2) Where a missing part of the description or a missing drawing is filed with the Office within the time limit prescribed in paragraph (1), that part of the description or that drawing shall be included in the application, and the date of filing shall be the date on which the Office has received that part of the description or that drawing, or the date on which it has received all of the items referred to in Article 82(1), whichever is later.

(3) Where the applicant claims the priority under Article 61 in respect of an application from which a part of the description or a drawing appears to be

missing, the missing part of the description or missing drawing shall be completely contained in the earlier application.

(4) Where the applicant claims the priority under Article 61, the essential items of the application referred to in Article 82(2)(a) shall be deemed to have been filed, for the purposes of the date of filing, if the applicant, when filing the application in the Republic of Slovenia, indicates the date, number and State or Office of the previous application. In such case, the applicant shall submit the copy of the previous application referred to in Article 61(3) within three months from the receipt of the

invitation, unless the previous application was filed with the Office, or is available to the Office from a digital library which is accepted by the Office for that purpose. If

the applicant fails to submit the copy, the right of priority shall be deemed not to have been requested.

Article 84

Invitation to submit all items

(1) Where an application to which the date of filing and number were accorded does not contain all items referred to in Article 79, the Office shall invite the applicant to amend the application within three months from the receipt of the invitation, and to remedy deficiencies.

(2) If the application referred to in paragraph (1) is not amended in due time, or is not amended as requested, it shall be deemed to be withdrawn, except in cases referred to in Articles 128(4) and 129(5).

Article 85

Examination of an application as to formal requirements

(1) When an application contains all items referred to in Article 79, the Office shall examine whether the items of the application or supplements or evidence, if any, are, as to their contents and form, drawn up as prescribed by this Act and the regulations issued pursuant to this Act.

(2) In the case of a patent application, the Office shall also examine whether the invention meets the requirements of Article 87(2) and (4), and whether all fees have been paid, including any renewal fees under Articles 109(4) or 110(4).

(3) If, in the case of a mark application, the Office establishes that the list of goods and services contains a good or service which 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 SFRJ-MP No 51/74, Official Gazette RS-MP No 9/92), hereinafter referred as "the Nice Classification", or is classified in the wrong class, the Office may, in the case of minor irregularities, on its own motion, classify the good or service according to the Nice Classification, or correct the classification, and inform the applicant accordingly. Where the Office groups or corrects more than five classifications of goods or services according to the Nice Classification, it shall invite the applicant to pay, within one month from the receipt of the invitation, the fee for classification. If the applicant fails to pay the fee in due time, the application for the goods or services which the Office classified according to the Nice Classification or corrected the classification thereof, shall be deemed to be withdrawn.

(4) If, in the case of a mark application, the Office establishes that a good or service in the list of goods and services is indicated by a term that is too vague for the purposes of a correct classification according to the Nice Classification, or if the Office does not act according to paragraph (3), it shall invite the applicant to remedy irregularity within three months from the receipt of the invitation. If the applicant fails to remedy the irregularity in due time, the application for the goods or services which were not clearly indicated or correctly classified according to the Nice Classification shall be deemed to be withdrawn.

(5) If any deficiencies are noted in the application or in supplements or evidence, the Office shall invite the applicant to remedy deficiencies within three months from the receipt of the invitation.

(6) If the applicant does not remedy all deficiencies in due time, the application shall be deemed to be withdrawn, except in the cases referred to in paragraphs (3) and (4), and in Articles 128(4) and 129(5).

(7) If the Office establishes that all the items of the application or supplements or evidence, if any, comply, as to their contents and form, with the provisions of this Act and the regulations issued pursuant to this Act, the proceedings shall continue:

(a) for patent applications, under Article 88 and subsequent articles;

(b) for industrial design applications, under Article 96;

(c) for mark applications, under Article 99 and subsequent articles.

Section II **Special provisions for patents**

Article 86 **Requirements of a patent application**

(1) A patent application shall contain:

(a) a request for the grant of a patent;

(b) a description of the invention;

(c) one or more claims;

(d) a short summary of the subject-matter of the invention, hereinafter referred to as "the abstract";

(e) if necessary, one or more drawings of the invention.

(2) Not later than up to the issue of an order on the publication of the application, the applicant may file a divisional application in respect of subject-matter which does not extend beyond the content of the earlier application. The divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of the same right to priority *as* the earlier application.

(3) Short-term patents shall be requested when filing the patent application or within twelve months from the date of filing. After the expiry of this time limit, the request shall be irrevocable.

Article 87 **Substance of requirements of a patent application**

(1) The request for the grant of a patent shall contain data on the applicant (surname, forename and address, or firm and seat), the title of the invention defining its subject-matter, and other data relating to the application which

are prescribed by an executive regulation.

(2) The description of the invention shall include the presentation of the problem, information on the state of the art or of other solutions available by that time and their deficiencies which have been known to the applicant, together with a description of the new solution to the problem. The invention shall be described in a manner sufficiently clear and complete for it to be carried *out* by a person skilled in the art to which the subject-matter of the invention relates.

(3) If an invention relates to biological material defined by an executive regulation, which is not available to the public and can not be described in a manner to be carried *out* by a person skilled in the art to which the subject-matter of the invention relates, the description of the invention 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 Micro-organisms for the Purposes of Patent Procedure of 28 April 1997, and amended on 26 September 1980 (Official Gazette RS-MP No 21/97).

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

(5) The abstract shall merely serve for use *as* technical information; it may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought.

(6) A patent application may relate to several inventions, provided that they are so linked *as* to form a single inventive concept.

Article 88

Examination of requirements for the grant of a patent

(1) In the examination preceding the grant of a patent, the Office shall examine:

(a) whether, subject to Article 11, the subject-matter of the claimed invention is patentable;

(b) whether the claimed invention meets, at first sight, the requirements of Articles 12, 14 and 15.

(2) In the examination preceding the grant of a short-term patent, the Office

shall examine:

(a) whether, subject to Article 11(1) and (2)(a), the subject-matter of the invention to which the application relates may be protected by a short-term patent;

(b) whether the claimed invention meets, at first sight, the requirements of Articles 12, 15 and 16.

(3) If the Office establishes that the claims of the patent application meet all the requirements of paragraph (1), or that the claims of the short-term patent application meet all the requirements of paragraph (2), it shall decide to publish the application in the Official Journal.

(4) If the Office establishes that the claims of the patent application do not meet all the requirements of paragraph (1), or that the claims of the short-term patent application do not meet all the requirements of paragraph (2), it shall refuse the application.

(5) If the Office establishes that the claims of the patent application do not meet the requirements of paragraphs (1) and (2) only in part, it shall refuse the application only in that part.

Article 89

Publication of a patent application

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

(2) The applicant may request that the application be published before the expiry of the period referred to in paragraph (1), but no earlier than after the expiry of three months from the date of the filing or, if priority has been claimed, the date of priority.

(3) The Office shall publish a patent application together with the mention of the grant of the patent.

Article 90

Grant of a patent

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

(2) Until the issuance of a decision under Article 93, the scope of protection shall be determined by the contents of claims as published.

Article 91

Time limit for submission of a written evidence

(1) Owners of patents or exclusive rights from patents shall submit to the Office no later than the expiry of the ninth year of the patent term written evidence that the patented invention satisfies all the requirements of Articles 10, 12, 14 and 15.

(2) Owners of patents or exclusive rights from patents shall pay, when submitting the evidence under paragraph (1) or within three months from the receipt of the invitation, a fee for the declaratory decision. If the fee is not paid in due time, the evidence shall be deemed not to have been submitted.

(3) If the owner of a patent or exclusive right from a patent fails to act in accordance with paragraph (1), the patent shall lapse on the date of the expiry of the tenth year of the patent term.

(4) If the owner of a patent submits the evidence referred to in paragraph (1) with respect to an action under Article 121, the Office shall issue one of the decisions referred to in Article 93 using an expeditious procedure.

(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 Article 3(2), the provisions of this Article and of Articles 92 and 93 are directly fulfilled as of the date on which the EPO publishes the mention of its granting.

Article 92

Forms of written evidence

(1) A Slovene translation of a European patent, or several European patents,

granted for the same invention by the EPO shall be considered evidence as referred to in Article 91.

(2) If no application for a European patent has been filed for the same invention, the Slovene translation of a patent for the same invention, granted, following substantive examination, by another authority which, under Article 32 of the PCT, enjoys the status of International Preliminary Examining Authority, or by any other patent office with which a relevant treaty has been concluded, may be submitted as evidence under Article 91.

(3) If the granting proceedings, which constitute the evidence under paragraph (1) or (2), have not yet been finished, the applicant shall inform the Office accordingly in the time limit prescribed in Article 91(1). On the basis of that information, the Office shall interrupt the proceedings. The proceedings shall continue if the applicant submits evidence under this Article within three months after the grant of the patent. If the evidence under this Article is not submitted in due time, the patent shall lapse on the date of the expiry of the tenth year of the patent term.

(4) A Slovene translation of a patent which constitutes the evidence referred to in Article 91 shall not confer protection which is broader than that conferred by it in the original text.

(5) Where the Office doubts the correctness of the translation, it may request that the owner of a patent or exclusive right from a patent submits, within three months from the receipt of the invitation, a certified text of the Slovene translation which constitutes the evidence from Article 91. If the certified text of the Slovene translation is not filed in due time, the evidence is deemed not to have been submitted.

(6) When the evidence is submitted pursuant to paragraph (2), the owner of a patent or exclusive right from the patent shall submit a list and copies of all other patents which could be considered as evidence, including data on patent applications and patents which have been refused. If the list and copies of the patents do not supplement the evidence, the evidence is deemed not to have been submitted.

(7) If the Office establishes that the evidence under this Article is forged or is not true, it declares the patent to be void.

(8) When the owner of a patent or exclusive right from a patent does not have an evidence referred to in paragraph (1) or (2), he may request, against payment of a fee, that the Office obtains relevant data or opinions to be used as the basis for the issuing of one of the decisions under Article 93 from any of the authorities or offices listed in paragraph (2).

Article 93 **Issuing declaratory decisions**

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

(a) a declaratory decision stating that the invention meets the requirements of Articles 10, 12, 14 and 15, and that the claims of a patent granted entirely meet those requirements; or

(b) a declaratory decision stating that the invention meets the requirements of Articles 10, 12, 14 and 15 only in part, and thereby correspondingly amending the claims of a patent granted; or

(c) a declaratory decision stating that the invention failed to meet the requirements of Articles 10, 12, 14 and 15 on the date of the filing of the application, and thereby declaring the patent to be void.

(2) A decision under paragraph (1)(b) or (c) may not be issued by the Office if it has not previously notified the owner of a patent of the intended amendments of claims or the nullity of a patent, and if the owner of a patent has not been invited to comment, within three months from the receipt of the invitation, on the decision, or amend the claims. If the owner of a patent comments on the decision, or amends the claims in due time, the Office shall, before issuing the decision under paragraph (1)(b) or (c), verify if the reasons for the issuance thereof still exist. If the owner of a patent fails to comment on the decision in due time, it shall be deemed that he shares the opinion of the Office.

(3) Patent claims which are amended pursuant a decision under paragraph (1)(b) shall
not confer protection which is broader than that conferred by claims of a patent granted by a decision under Article 90.

(4) Where the Office establishes, on the basis of the submitted evidence under

Article 92, that the patent granted does not meet the requirement of Article 87(6), it shall divide the patent into several patents preserving the date of filing of the initial application and, if priority is claimed, the date of priority.

Section III **Special provisions for industrial designs**

Article 94 **Requirements of an industrial design application**

- (1) An application for an industrial design shall contain:
- (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 of the products in case of a multiple application, in the number of copies prescribed by an executive regulation.
- (2) The applicant may request, when filing the application, that the essential data of the application shall not be published before the expiry of twelve months from the date of filing of the application or, if a priority is claimed, the date of priority. The multiple application can not contain a request for deferment of publication for only some products.
- (3) Where the industrial design is two-dimensional, including a textile design or hologram, and a request for deferment of publication is made in accordance with paragraph (2), the application may, instead of containing a photograph or graphical representation of the appearance of the whole or a part of the product, be accompanied by a specimen of that product or the part thereof. The photograph or graphical representation of the product, in the number of copies prescribed by an executive regulation, shall be submitted no later than two months before the expiry of the time limit for requested deferment of publication under paragraph (2). In the opposite case, the application shall be deemed to be withdrawn.

Article 95 **Substance of requirements of an industrial design application**

(1) The request for the registration of an industrial design shall contain data concerning the applicant (surname, forename and address, or firm and seat), an indication of the product to which the subject-matter of the application relates, a suggestion for the classification according to the international classification established by Locarno Agreement on International Classification for Industrial Designs of 8 October 1968 (Official Gazette SFRJ-MP, No 51/74, Official Gazette RS-MP, No 9/92), hereinafter referred as "the Locarno Classification", and other data relating to the application which are prescribed by an executive regulation.

(2) An industrial design application may cover several products, provided that they belong to a single class of the Locarno Classification.

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

Article 96

Examination of requirements for the registration of industrial designs

(1) The Office shall examine whether the design to which the application relates may be protected by an industrial design, subject to provisions of Article 36, but excluding item (b).

(2) Where the Office establishes that the design to which the application relates meets the requirements of paragraph (1), it shall issue a decision on the registration of the industrial design, enter the industrial design in the register and publish the mention of the registration.

(3) Where the Office establishes that the design to which the application relates does not meet the requirements of paragraph (1), it shall refuse the application wholly or in part.

Section IV

Special provisions for marks

Article 97

Requirements of a mark application

(1) A mark application shall contain:

(a) a request for the registration of a mark;

(b) a list of the goods or services for which the protection is sought;

(c) a representation of the sign, in the number of copies prescribed by an executive regulation.

(2) A collective mark application shall contain, besides items listed in paragraph (1), also the regulations referred to in Article 46.

(3) A separate application shall be filed for each sign, however, the registration of the same mark may be requested, in the same application, for several kinds of goods or services. The applicant may also request, on the basis of several applications, the registration of several different or similar marks for the same kind of goods or services.

(4) Any application listing goods or services belonging to two or more classes of the Nice Classification may, during the registration procedure, including administrative litigation, be divided, upon the request of the applicant, into several applications. Each application shall preserve the date of filing of the initial application and, if priority is claimed, the date of priority.

Article 98

Substance of requirements of a mark application

(1) The request for the registration of a mark shall contain data concerning the applicant (surname, forename and address, or firm and seat), where the sign is in colours, an indication of colours, where the mark is a three-dimensional mark or a collective mark, a statement to that effect, and other data relating to the application which are prescribed by an executive regulation.

(2) Goods and services shall be classified in the list of goods or services in accordance with the Nice Classification.

Article 99

Examination of absolute requirements for the refusal of a mark

(1) In the examination preceding the publication of a mark application, the

Office shall examine whether the sign to which the application relates may be registered as a mark, subject to provisions of Articles 42 and 43. Where the application relates to a collective mark, the Office shall also examine whether the application meets the requirements of Articles 45 and 46.

(2) Where the Office establishes that the sign to which the application relates meets the requirements of paragraph (1), it shall publish the application.

(3) Where the Office establishes that the sign to which the application relates does not meet the requirements of paragraph (1), it shall refuse the application wholly or in part.

Article 100

Opposing observations by third parties

(1) Following the publication of a mark application, any person may present to the Office observations concerning the registration of a sign, subject to Articles 42 and 43, and shall state the reasons.

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

(3) The Office shall communicate the observations by third parties referred to in paragraph (1) to the applicant who may comment on them.

Article 101

Opposition against registration of a mark

(1) Within three months following the publication of a mark application, a written notice of opposition to registration of the mark may be filed with the Office by the owner of an earlier mark.

(2) The notice of opposition may only be given on the grounds referred to in Article 44 and shall contain supporting evidence.

(3) The opposition under paragraph (1) may also be filed by the owner of a mark which has been registered in any Member State of the Paris Union or WTO and has been applied for in the Republic of Slovenia by his agent or representative without the owner's consent.

(4) Where the ground for opposition is Article 44(1)(t), a notice of opposition

under this Article may also be filed by an owner of the earlier right referred to in Article 44(1)(t).

(5) When filing the opposition, or no later than three months from the receipt of the invitation, the opposition fee shall be paid, and a power of attorney shall be submitted, if the opposition has been filed by a representative.

(6) If the opponent withdraws the opposition, the withdrawal may not be cancelled later on.

(7) If the opposition does not meet requirements under this Article, it shall be deemed not to have been filed.

Article 102

Examination of the application following the opposition

(1) The Office shall notify the applicant for a mark of an opposition filed. The applicant may, within three months from the receipt of the notification, comment on the opposition.

(2) On the basis of the opposition and any observations from the applicant for a mark, the Office shall examine the grounds for the opposition.

(3) Where the examination of the opposition reveals that the opposition is not grounded and that the mark may be registered in respect of the goods or services for which the application has been made, the Office shall refuse the opposition.

(4) Where the examination of the opposition reveals that the opposition is grounded and that the mark may not be registered in respect of all or some of the goods or services for which the application has been made, the Office shall refuse the application wholly or in part.

Article 103

Registration of marks

(1) Where no notice of opposition to registration of the mark has been filed or where opposition has been refused or has been deemed not to have been filed, the Office shall invite the applicant to pay, within three months from the receipt of the invitation, the registration fee which includes the maintenance fee for the first ten years.

(2) Following the payment of the fee referred to in paragraph (1), the Office shall issue a decision on registration of the mark, enter the mark in the register and publish the mention of the registration.

(3) If the applicant fails to pay the fee referred to in paragraph (1) in due time, the application shall be deemed to be withdrawn.

Section V

Special provisions for geographical indications

Article 104

Registration of geographical indications

(1) A request for the registration of a geographical indication may be filed by associations of legal or natural persons, chambers, communes, larger local communities or State authorities.

(2) The request under paragraph (1) shall be accompanied by a specification including in particular:

- (a) indication to be registered as a geographical indication;
- (b) indication of the good to which that 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) indication of 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) details bearing out the link between the good and the location or region;
- (g) details of inspection structures;
- (h) labelling details.

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

(4) Provisions of this Article shall not apply to geographical indications which have been protected by virtue of Article 55(3).

Chapter VIII

REGISTERS AND MAINTENANCE OF RIGHTS

Article 105

Registers

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

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

(3) The Office shall deliver extracts from registers on request and against payment of a fee prescribed by the Act regulating administrative fees.

(4) An executive regulation issued by the Minister competent for the field of industrial property shall define, in greater detail, the contents of registers, the contents of requests for entry of alterations in registers, the procedure for entry of such alterations, the contents of extracts from registers and the procedure for deliverance of such extracts.

Article 106

Contents of registers

(1) The register of patents shall contain primarily the following entries: registration number, date of filing and number of the application, requested right of priority, date of publication, date of entry in the register, number and date of issuance of the declaratory decision under Article 93, data concerning the owner

(name and address), type of the patent, data concerning the inventor (name and address), title of the invention, data concerning the maintenance of the patent, date of lapse of the patent.

(2) The register of supplementary protection certificates shall contain primarily the following entries: registration number, date of filing and number of the application, date of publication of the application and the grant, date of entry in the register, data concerning the applicant and the holder (name and address), title of the product, registration number of the patent on the basis of which the supplementary protection certificate has been granted, number and date of the authorization to place the product on the market in the Republic of Slovenia or on the Community market as a medicinal product or plant protection product, indication of the state, where the authorization has not been issued by a competent Community authority under a centralised procedure, date until which the certificate is effective, data concerning the maintenance of the certificate, date of lapse of the certificate.

(3) The register of industrial designs shall contain primarily the following entries: registration number, date of filing of the application, requested right of priority, date of publication, date of entry in the register, data concerning the owner (surname, forename and address, or firm and seat), data concerning the designer (surname, forename and address), if the designer so wishes, indication of the product, number of products, classification code according to the Locarno Classification, data concerning the renewal of the industrial design, date of lapse of the industrial design.

(4) The register of marks shall contain primarily the following entries: registration number, date of filing of the application, requested right of priority, date of publication of the application and the registration, data on opposing observations by third parties, data concerning any opposition and opponent, date of entry in the register, data concerning the owner or holder (surname, forename and address, or firm and seat), appearance of the mark, list of goods or services and classification code according to the Nice Agreement, data concerning the international registration, data concerning renewal of the mark, data concerning the cancellation of the mark, date of lapse of the mark.

(5) The register of geographical indications shall contain primarily the following entries: registration number, date of filing of the request, date of publication, date of entry in the register, geographical indication, the kind of the good and the location to which the indication relates.

(6) Information on litigations of which the Office has been notified and final judgements shall be entered ex officio in the registers referred to in Article 105(1).

(7) Provisions of this Article shall apply mutatis mutandis to registers of applications.

Article 107

Entry of alterations in the registers

(1) Upon request, all subsequent alterations regarding a right or the owner of a right shall be entered in the register referred to in Article 105(1). The provisions of this paragraph shall apply mutatis mutandis to applications and applicants.

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

(3) The person who has been entered in the register as the owner of a right prior to the alteration may, by submitting relevant evidence, contest any alteration which has been unduly entered without his consent, instituting an action in the administrative litigation filed with the Administrative Court of the Republic of Slovenia in Ljubljana, which has exclusive territorial jurisdiction.

Article 108

Procedure for entry of alterations

(1) A single request may relate to more than one alteration in the register. A single request shall also be sufficient where the alteration or alterations relate to more than one application and/or right of the same person, provided that the alteration or alterations are the same for all applications and rights concerned, and the numbers of all applications and rights concerned are indicated in the request.

(2) When filing the request or within three months from the receipt of the invitation, a fee for the entry of each alteration in the register for each application or right shall be paid. If the fee is not paid in due time, the request shall be deemed to be withdrawn.

(3) Where the request for the alteration is filed by the person who has been entered in the register as the owner of a right, the Office shall immediately issue a decision on the entry of alteration and enter such alteration in the register.

(4) Where the request for the alteration is filed by the person who has not been entered in the register as the owner of a right, that person shall submit, when filing the request or within three months from the receipt of the invitation, the consent of the owner of the right for the entry of the requested alteration in the

register or, of his own choosing, other documents evidencing the legal basis for the entry of the alteration. Where the Office doubts the veracity of any indication contained in the request for the alteration or if the submitted documents are in a foreign language, it may require that, within three months from the receipt of the invitation, additional documents or a Slovene translation of the submitted documents be furnished.

(5) If the requesting party fails to submit additional documents or their translation requested under paragraph (4) in due time, the request for entry of alterations shall be deemed to be withdrawn.

(6) The Office shall decide on the entry of an alteration by a decision.

Article 109 **Renewal fees**

(1) The renewal of rights shall be subject to the payment of fees which shall be due, calculated from the date of filing of the application:

(a) in respect of patents, each year for one subsequent year;

(b) in respect of industrial designs, each five years for subsequent five years;

(c) in respect of marks, each ten years for subsequent ten years.

(2) The fees under paragraph (1) shall be paid within twelve months preceding the due date.

(3) The application fee for patents includes the renewal fee for the first three years. The application fee for industrial designs includes the renewal fee for the first five years.

(4) Where the procedure for the grant of a patent lasts more than three years from the date of the filing of the application, or the procedure for the registration of an industrial design more than five years from such date, the provisions of paragraphs (1) and (2) shall apply mutatis mutandis to patent and industrial design applications.

Article 110 **Payment of renewal fees in a subsequent time limit**

(1) Where a renewal fee has not been paid in accordance with Article 109 on or before the due date, it may still be paid within six months following the due date, provided that the additional fee, amounting to 50 % of the fee which has not been paid in due time, is paid.

(2) The Office shall remind the owner of a right of the failure of due payment of the renewal fee under Article 109(1), of the possibility of payment under paragraph (1) of this Article, and of the consequences of non-payment.

(3) The non-payment of renewal fees in due time or, following the reminder of the Office, within the subsequent time limit referred to in paragraph (1), together with the additional fee, shall entail lapse of the right on the day following the due date referred to in Article 109(1).

(4) Paragraphs(1) and (2) shall apply mutatis mutandis in the cases referred to in Article 109(4). If in such cases the renewal fee and the additional fee have not been paid in the subsequent time limit, the application shall be deemed to be withdrawn.

Chapter IX

JUDICIAL PROTECTION AND ENFORCEMENT OF RIGHTS

Section I

Judicial protection

Subsection I

Nullity of rights

Article III

Actions for a declaration of nullity

Any interested party may bring an action in the court of competent jurisdiction to declare nullity of a patent, short-term patent, industrial design or mark.

Actions for a declaration of nullity of a patent

(1) Actions to declare nullity of a patent may be filed on one or more of the following grounds:

(a) on the date of the filing of the application the invention did not meet all requirements under Articles 10, 11, 12, 14 and 15 or, in the case of a short-term patent, requirements under Article 16;

(b) the invention does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art to which the invention relates;

(c) the content of the protection extends beyond the content of the first received application or, if the patent was granted on a divisional application, beyond the content of the initial application.

(2) Actions to declare nullity of a patent may also be filed in instances where a declaratory decision under Article 93(1)(a) or (b) has already been issued, or where the patent has lapsed.

(3) Where an action to declare nullity of a European patent valid in the Republic of Slovenia pursuant to an international treaty, and which has been the subject of an opposition at the EPO, has been filed during the opposition procedure at the EPO, the court shall interrupt the proceedings until the decision of the EPO on the opposition has become final,

Article 113

Actions for a declaration of nullity of an industrial design

Actions to declare nullity of an industrial design may be filed, subject to the date of the filing of the application, on one of the following grounds:

(a) the industrial design has been registered contrary to Article 36;

(b) the applicant for or the owner of the industrial design has not been entitled to an industrial design protection.

Article 114

Actions for a declaration of nullity of a mark

(1) Actions to declare nullity of a mark may be filed where the mark has been registered, subject to the date of the filing of the application, contrary to Article

42 or 43.

(2) Actions to declare nullity of a collective mark may be filed where the collective mark has been registered, subject to the date of filing of the application, contrary to Article 42, 43, 45 or 46.

(3) Where the ground for the action under paragraph (2) is a collective mark which

has been registered contrary to Article 46, the court shall reject the action if the holder of the collective mark, prior to the issuance of the court's decision, amends the regulations referred to in Article 46.

Subsection II

Contesting of rights

Article 115

Contesting the right to a patent or industrial design

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

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

(3) The action referred in paragraphs (1) or (2) may also be filed by a person who is entitled to the rights conferred by a patent or industrial design if the patent was granted or industrial design was registered in the name of the inventor or designer or a third person, which the inventor or the designer unjustifiably authorised that the patent be granted or industrial design be registered in his name.

Article 116

Contesting the right to a mark

(1) Legal or natural persons may file an action with a court of competent jurisdiction requesting the court to decide that a sign which they use in trade for marking their goods or services is identical or similar to a mark used by a third person in marking his goods or services of the same or similar kind and that the sign was generally known as the sign for designation of the goods or services of the legal or natural person before the defendant filed his mark application, and requesting the court to issue a decision declaring the plaintiff to be the owner of the mark.

(2) The court shall rule against the request referred to paragraph (1) if the defendant owner of the mark proves that he had used the contested sign for the same or similar goods or services for as long as or longer than the plaintiff before filing his application.

(3) The action referred to in paragraph (1) may not be filed after the expiry of five-year period following the date of entry of the mark in the register.

Article 117

Entry in the register of the new owner

(1) Within three months from the receipt of a final judgement that rules favourably on the actions referred to in Articles 115 or 116, the plaintiff may request to be entered in the register as the owner of the patent, industrial design or mark and to be issued a certificate to that effect.

(2) If the successful plaintiff does not submit a request to be entered in the register as the owner of the right within the time limit laid down in paragraph (1), the right shall be ex officio removed from the register.

(3) Any rights a third person has acquired from the person who has been entered in the register as the owner of the right before the judgement referred to in paragraph (1) shall be binding on the new owner if entered in the corresponding register or if correctly applied for the entry before the action was filed.

Subsection III

Right of the inventor or designer to be named

Article 118

Actions for recognition of the right to be named

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

(a) that he be named in the application and in all documents;

(b) that a final judgement be published at the defendant's expense.

(2) The action referred in paragraph (1) may be filed at any time during the validity of the patent or industrial design.

Subsection IV **Removal and cancellation of marks**

Article 119 **Actions for removal of marks from the register**

(1) Actions to remove marks from the register and to prohibit the use of signs may be filed with the court of competent jurisdiction on one of the following grounds:

(a) the applicant was acting in bad faith when filing the application;

(b) the mark has been registered, subject to the date of the filing of the application, contrary to Article 44, except in the cases referred to in Article 139;

(c) in consequence of acts or inactivity of the owner, the mark has become the common name in the trade for goods or services in respect of which it is registered;

(d) in consequence of the use made of it by the owner of the mark or with his consent in respect of the goods or services for which it is registered, the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) Save the grounds referred to in paragraph (1), actions to remove collective marks from the register and to prohibit the use of signs may be filed on one or more of the following grounds:

- (a) the holder of the collective mark ceased to exist;
 - (b) the collective mark is used contrary to the regulations under Article 46;
 - (c) the regulations governing use of the collective mark have been amended in such a manner as to contradict Article 46.
- (3) The court shall rule against the action filed under paragraph (1)(b) if the defendant proves that the reasons under Article 120 for cancellation of an earlier mark referred to in Article 44 exist.
- (4) Where the ground for an action under paragraph (1) or (2) is Article 44(1)(c), (d) or (e), the plaintiff may, instead of the removal of the mark from the register, requests the transfer thereof on his name.
- (5) In the case provided for in paragraph (2)(c), Article 114(3) shall apply *mutatis mutandis*.
- (6) The action under paragraph (1)(b) shall not be admissible after the expiry of five-year period following the entry of a right in the register, unless the applicant was acting in bad faith when filing the mark application.
- (7) The mark shall be removed from the register as of the date on which the judgement on the removal has become final.

Article 120

Actions for cancellation of marks on account of non-use

(1) Any interested party may file an action with a court of competent jurisdiction requesting cancellation of a mark if, within a continuous period of five years from the date of entry of the right in the register, or the day on which the mark has been seriously and effectively used in the Republic of Slovenia for the last time, the owner

without proper reasons fails to use the mark in connection with the goods or services in respect of which it is registered.

(2) Cancellation of a mark may not be requested where, during the interval between the expiry of the five-year period referred to in paragraph (1) and filing of the action for cancellation, the owner has started or resumed to seriously and effectively use the mark. The commencement or resumption of use within a

period of three months preceding the filing of the action which began at the earliest on expiry of the time limit referred to in paragraph (1) shall, however, be disregarded where preparations for the commencement or resumption occur only after the owner becomes aware that the action for cancellation of his mark may be filed.

(3) The owner of the mark shall prove the use of the mark in the cancellation procedure.

(4) Use of the mark with the consent of the owner or by any person who has authority to use it shall be deemed to constitute use by the owner.

(5) A collective mark shall be deemed to be used by the holder where it is used by at least one person who has authority to use it.

(6) The following shall also constitute use of the mark:

(a) use of the mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

(b) affixing of the mark to goods or to the packaging thereof in the Republic of Slovenia solely for export purposes.

(7) The Office shall cancel the mark as of the day on which the judgement on cancellation has become final for those goods or services for which it is established that the mark has not been used in the territory of the Republic of Slovenia.

Section II **Enforcement of rights**

Article 120a **Capacity to enforce rights**

(1) The rights to enforce judicial protection belong, in addition to owners of the right referred to in Articles 18, 37, 47 and 58, *mutatis mutandis* also to:

(a) persons entitled to use a collective mark;

(b) persons entitled to use a geographical indication;

(c) owners of exclusive licence to the extent to which the owner's rights are assigned to them by law or through a legal transaction; and

(d) professional associations established for the protection of industrial property rights to the extent to which the owner's rights are assigned to them by law or through a legal transaction.

Article 121

Actions for infringement of rights

(1) Against a person who encroaches a right listed in Articles 18,37,47 or 58 without the owner's consent, the owner of the right may file an action with a court of competent jurisdiction requesting that:

(a) the infringement already commenced and future infringements be prohibited;

(b) the objects of infringement be recalled from the channels of commerce, taking account of the interests of bona fide third parties;

(c) the situation caused by the infringement be rectified;

(c) the objects of infringement be irrevocably removed from the channels of commerce;

(d). the objects of infringement be destroyed;

(e) the means of infringement that are owned by the infringer and intended or used exclusively or principally for infringement be destroyed;

(t) the objects of infringement be surrendered to the plaintiff against the reimbursement of the costs of their production;

(g) the judgment be published.

(2) In deciding on the claims referred to in paragraph (1)(b) to (f.), the court shall take account of the circumstances of the case, in particular proportionality between the seriousness of the infringement and the claim, as well as the interest of the owner of the right to ensure an effective protection of rights.

(3) In proceedings against a person whose services have been used to infringe

the right, and the existence of such infringement has already been finally established in proceedings against the third party, the infringement shall be presumed to exist.

Article 121a
Compensation for damage

(1) For infringements under this Act, general rules governing causation of damage shall be applicable, unless otherwise provided by this Act.

(2) The infringer shall pay to the owner of the right damages in the amount to be defined under general rules on compensation for damage, or in the amount which is equal to agreed or customary license fee.

Article 122
Additional provisions governing infringement of patent rights

(1) In the case of infringement of a patent conferring protection on a process for obtaining a new substance, such substance shall be deemed, in the absence of proof to the contrary, to be of an identical composition or identical and made under the protected process. The burden of proof shall be borne by the defendant or alleged infringer whose legitimate interests in protecting his business secrets shall be taken into account.

(2) Where the action under Article 121 refers to infringement of patent rights or a published European patent application requesting protection in the Republic of Slovenia, the court shall interrupt proceedings until the Office issues a declaratory decision under Article 93(1)(a) or (b), or until the European patent is entered in the Office's patent register.

(3) In the case of infringement of a patent in respect of which a declaratory decision under Article 93(1)(a) or (b) has not yet been issued, the court shall, for the use of invention during the interval between the granting of the patent and the issuance of the declaratory decision, impose on the infringer the payment of compensation reduced with respect to the given circumstances.

(4) Paragraph (3) shall apply mutatis mutandis to a published patent application filed abroad under Article 3(2), for the use of invention during the interval between the publication of the application and the granting of the patent or, where the European patent has been entered in the Office's register, the date on which the EPO published its decision on the grant of the European patent.

Article 122a

Presentation of evidence

(1) If the court decides to take the proposed evidence and that evidence is in the possession of the opposite party, that party shall present such evidence at the request of the court.

(2) Paragraph (1) shall also be applicable for banking, financial and commercial documents under the control of the opposite party if the infringement was committed on a commercial scale. An act shall be deemed to be performed on a commercial scale if it has been performed for direct or indirect economic advantage.

(3) The provisions of the Act regulating civil procedure shall apply to the proceedings for the presentation of evidence, unless otherwise provided by this Act.

(4) After the taking of evidence referred to in paragraph (1), the court shall ensure that confidential information from the parties to the proceedings be protected and that judicial proceedings not be used in bad faith with the sole purpose to obtain confidential information from the opposite party.

Article 123

Provisional measures

(1) The court shall order provisional measures to secure non-monetary claims under this Act if the claimant shows probable grounds for belief that:

(a) he/she is the owner of the right according to Articles 18, 37, 47 and 58; and

(b) his/her right has been infringed or there exists an actual danger to be infringed.

(2) The claimant shall also show probable grounds for belief that:

(a) a danger exists that the enforcement of claims will be made impossible or rather difficult;

(b) the adoption of a provisional measure is necessary to avoid damage difficult to repair; or

(c) a provisional measure, which may prove unfounded in the course of the proceedings, does not have more detrimental consequences for the alleged infringer than would have the non-adoption of such measure for the owner of the

right.

(3) The claimant who proposes the order of a provisional measure without prior notification and hearing of the opposite party shall show probable grounds for belief, in addition to the requirements of paragraphs (1) and (2), that any delay of the order is likely to cause the owner of the right a damage difficult to repair. In that event, the opposite party shall be given notice after the execution of the order at the latest.

(4) The owner of the right shall not be obliged to prove the existence of a danger that the enforcement of claims will be made impossible or rather difficult if he/she shows probable grounds for belief that the proposed provisional measure would cause the infringer only insignificant damage. The danger shall be deemed to exist when the claims are to be enforced abroad, with the exception of Member States of the European Union.

(5) The court may order any provisional measure to secure non-monetary claims referred to in paragraph (1), with which the purpose of security can be achieved, in particular:

(a) to interdict to the alleged infringer the continuation of infringement already commenced and future infringements;

(b) to seize, exclude from circulation and take into custody the objects of infringement and the means of infringement that are intended or used exclusively or principally for infringement.

(6) The court shall decide on the opposition against a decision on the adoption of a provisional measure within 30 days following the filing of the answer to the opposition, or by the end of the time limit set for the filing of the answer to the opposition.

(7) The provisions of the Act regulating execution of judgements and insurance of claims shall apply to the proceedings for the adoption of provisional measures, unless otherwise provided by this Act. Proceedings shall be expeditious.

Article 123a **Order for provisional measures in patent infringements**

Where the proposal for order of a provisional measure referred to in Article 123 relates to a patent infringement, the court shall order the provisional measure if also the following two conditions are fulfilled:

(a) that the owner of the right submits a declaratory decision under Article 93(1)(a) or (b); and

(b) that the owner of the right proposes the order of provisional measure within three months after he has learned of the alleged infringement.

Article 124 **Preservation of evidence**

(1) The court shall issue an order to preserve evidence if the owner of the right presents reasonably available evidence that:

(a) he/she is the owner of the right according to Articles 18, 37, 47 and 58;

(b) his/her right has been infringed or there exists an actual danger to be infringed;

and

(c) evidence of infringement will be destroyed or that it will be impossible to take such evidence at a later time.

(2) The owner of the right who requests the order to preserve evidence without prior

notification and hearing of the opposite party shall show probable grounds for belief, in addition to the requirements of paragraph (1), that there is a danger of evidence of infringement being destroyed as the result of conduct of the opposite party or that it will be impossible to take such evidence at a later time. In that event, the opposite party shall be given notice after the execution of the order at the latest.

(3) The court may issue the order referred to in paragraph (1) to take any evidence, and in particular:

(a) to inspect places, business records, inventory, databases, computer memory units or other things;

(b) to seize samples of the objects of infringement;

(c) to examine and seize documents;

(d) to appoint and examine experts; and

(e) to examine witnesses.

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

(5) The provisions concerning provisional measures of the Act regulating execution of judgements and insurance of claims shall apply *mutatis mutandis* to the proceedings for preservation of evidence under this Article, unless otherwise provided by this Act. Proceedings shall be expeditious.

(6) Where it is subsequently found that the request for preservation of evidence has been unfounded or that the owner of the right has not justified it, the opposite party shall have the right to claim:

(a) the return of the seized objects;

(b) the prohibition of the use of information obtained; and

(c) the compensation for damage.

(7) In the proceedings for preservation of evidence in accordance with this Article, the court shall ensure that confidential information from the parties be protected and that judicial proceedings not be used in bad faith with the sole purpose to obtain confidential information from the opposite party.

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

Where the proposal for order to preserve evidence referred to in Article 124 relates to a patent infringement, the court shall issue the order if also the following two conditions are fulfilled:

(a) that the owner of the right submits a declaratory decision under Article 93(l)(a) or (b); and

(b) that the owner of the right proposes the order of provisional measure within three months after he has learned of the alleged infringement.

Article 124b **Duty to provide information**

(1) In the proceedings concerning the infringement of rights the court may, upon a justified request of the party, order that information on the origin and distribution networks of the goods or services which infringe a right under this Act be provided by the alleged infringer.

(2) The court may order that information referred to in paragraph (1) be provided also by persons who:

- (a) possess the infringing goods on a commercial scale;
- (b) use the infringing services on a commercial scale; or
- (c) provide on a commercial scale services used in an infringing activity.

(3) The court may order that information referred to in paragraph (1) be provided also by the person who was indicated by any person referred to in paragraph (2) as being involved in the production, manufacture or distribution of the infringing goods or the provision of the infringing services.

(4) The information referred to in paragraph (1) may comprise:

- (a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services, as well as the intended wholesalers and retailers; and
- (b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.

Article 124c

Protection of other industrial property rights

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

Article 125

Compulsory licences

(1) The court may decide that a third party or the Government of the Republic of Slovenia exploit the invention without the authorisation of the owner of the patent:

(a) where the public interest concerning, in particular, national security, nutrition, health or the development of other vital sectors of the national economy so requires, or

(b) where the court has determined that the owner of the patent or his licensee abuses the patent rights, in particular where the manner of exploitation, contrary to the adopted regulations, restrains competition.

(2) The court shall grant compulsory licences under paragraph (1) with regard to given circumstances and after hearing the owner of the patent.

(3) Compulsory licences under paragraph (1) shall be granted provided that the person filing the request proves that he has made efforts to conclude a licence contract with

the owner of the patent on reasonable commercial terms and that such efforts failed to succeed within a reasonable period of time.

(4) Paragraph (3) shall not apply if a state of war or similar state of emergency has been declared. Nevertheless, the owner of the patent shall be notified of the decision of the court as soon as reasonably practicable.

Article 126

Conditions for granting compulsory licences

(1) Compulsory licences under Article 125 shall be granted under the following conditions:

(a) scope and duration shall be limited with regard to their purpose;

(b) they shall be non-exclusive;

(c) they shall be non-transferable, with the exception of the part of the enterprise or business of the licence owner to which the licence refers;

(d) they shall be granted primarily for the supply of the market of the Republic of Slovenia.

(2) Where a patent, hereinafter referred to as "the second patent", cannot be exploited without infringing another patent, hereinafter referred to as "the first patent", the following conditions, in addition to those of Article 125 and paragraph (1) above, for the grant of compulsory licence in respect of the first patent shall be met:

(a) the invention claimed in the second patent shall involve a technical advance of considerable economic significance compared to the invention claimed in the first patent;

(b) the owner of the first patent shall under reasonable conditions be entitled to a cross-l licence to use the invention claimed in the second patent;

(c) the use authorised in respect of the first patent shall not be transferable except with the simultaneous transfer of the second patent.

(3) The court shall decide that a compulsory licence expire if the circumstances which led to it being granted have ceased to exist and are unlikely to recur.

Article 127

Remuneration for compulsory licences

(1) Owners of patents under a compulsory licence shall be entitled to remuneration.

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

Chapter XI REPRESENTATION

Article 128

Representation before the Office

(1) Only representatives whose names have been entered in the corresponding register of representatives maintained by the Office shall be authorised to act before the Office. The representative shall be appointed in a power of attorney which shall be in writing.

(2) The party making the appointment may appoint one or several representatives for all or only for certain acts in the proceedings before the Office. If several representatives are appointed and the party does not name one to whom the Office should address notifications, they shall be addressed to the representative who is named first.

(3) The party making the appointment may, in a general power of attorney, authorise a representative for acts in respect of all applications, rights and requests filed with the Office. If the general power of attorney has been deposited with the Office, its reference number shall be indicated, and its copy attached, when filing any request with the Office.

(4) The power of attorney shall be submitted when filing the request or within three months from the receipt of the invitation. If the power of attorney is not submitted in due time, the representative is deemed not to have been appointed and his acts not to have been carried out. The request filed by the alleged representative shall be rejected by an order of the Office. The order on rejection shall be served on the alleged representative.

Article 129

Representation of foreign persons

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

(2) Notwithstanding paragraph (1) and subject to paragraph (3), a foreign person may file applications, perform acts relating to the establishment of the filing date, pay fees in the proceedings before the Office, file copies of first applications when claiming the right of priority under Article 61, and receive notifications by the Office relating to those proceedings, without a representative.

(3) If a foreign person, in cases referred to in paragraph (2), does not have a representative in the proceedings before the Office, he shall communicate to the

Office an address for correspondence which shall be in the territory of the Republic of

Slovenia. Any notification referred to in paragraph (2) which the Office sends to the address for correspondence shall be deemed to be a sufficient notification.

(4) Notwithstanding paragraph (1), a renewal fee may be paid by any person.

(5) If a foreign person, contrary to this Article, does not appoint a representative in the proceedings before the Office, or does not communicate an address for correspondence which is in the territory of the Republic of Slovenia, the Office shall exceptionally invite him directly by post to appoint, within three months from the receipt of the invitation, a representative and submit a power of attorney or, in accordance with paragraph (3), communicate an address for correspondence. If a foreign person does not appoint a representative and does not submit a power of attorney or, in accordance with paragraph (3), communicate an address for correspondence in due time, the Office shall reject any request by order, unless otherwise provided by this Act. The order shall be announced on the notice board of the Office.

Article 130

Revocation and renunciation of a power of attorney

(1) The party making the appointment may, at any time, revoke the power of attorney, and the representative may, at any time, renounce his appointment.

(2) The revocation or renunciation shall be communicated to the Office and shall be effective as from the date of receipt by the Office. If the representative has renounced his appointment, he shall continue, for three months, to perform acts for the party who has appointed him, unless the party has another representative.

(3) If due to the revocation or renunciation a foreign person remains without a representative, Article 129(5) shall apply mutatis mutandis.

Article 131

Representatives

(1) Parties may be represented in proceedings before the Office by patent agents and by industrial design and mark agents. Patent agents 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 mark agents shall only represent parties to proceedings relating to the acquisition and

maintenance of industrial designs, marks and geographical indications and other requests concerning those rights.

(2) Patent agents may be:

(a) persons, resident in the Republic of Slovenia, who have completed university studies in technology or science and have passed the qualifying examination for a patent agent at the Office;

(b) lawyers or law firms, employing on a regular or contractual basis a person who fulfils the conditions laid down in sub-paragraph (a);

(c) legal persons, having their seat in the Republic of Slovenia, employing at least one person who fulfils the conditions laid down in sub-paragraph (a).

(3) Industrial design and mark agents may be:

(a) persons, resident in the Republic of Slovenia, who have completed university studies and have passed the qualifying examination for industrial design and mark agents at the Office;

(b) lawyers or law firms;

(c) legal persons, having their seat in the Republic of Slovenia, who employ at least one person who fulfils the conditions laid down in sub-paragraph (a).

(4) Parties to proceedings relating to rights under this Act may be represented by patent agents and industrial design and mark agents also before courts and other State authorities, provided that they fulfil the conditions laid down in regulations governing representation before courts and other State authorities, and by an authorised person employed by such agents, provided that he is a national of the Republic of Slovenia, that he has graduated in law at the university in the Republic of Slovenia or has acquired a foreign law degree recognized by the Republic of Slovenia, that he has passed the lawyer's state examination, that he has a professional experience of at least five years and a good command of the Slovene language. In such cases, the agent is entitled to be paid for his work in the amount fixed by the agent's price list, and to have his costs refunded by the opposing party. The agent's price list shall be adopted by agent or association of agents with the consent of the Minister competent for justice.

Article 132 **Entry of agents in the register**

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

(2) A fee prescribed by the Act regulating administrative fees shall be paid for entry in the register. Following the payment of the fee, the Office shall issue the decision on the entry.

(3) A patent agent may request that he be removed from the register of patent agents and entered in the register of industrial design and mark agents. An industrial design and mark agent may request that he be removed from the register of industrial design and mark agents and entered in the register of patent agents only if he fulfils the requirements of Article 131(2).

(4) Agents shall be removed from the register if:

(a) they file a request for removal;

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

(5) The following data in particular shall be entered in the register: registration number of the representative, data on the representative (surname, forename and address, or firm and seat), date of entry in the register and data on persons who fulfil the conditions under Article 131(2)(a) or (3)(a) and are employed by the agent on a regular or contractual basis (surname, forename, address and education).

(6) An executive regulation issued by the Minister competent for the field of industrial property shall define, in greater detail, the contents of the requests for entry in the register of agents, proceedings relating to such entries, data to be entered in the register and proceedings relating to entries of alterations.

Article 133 **Qualifying examinations**

(1) The Office shall conduct qualifying examinations under Article 131(2) and (3). A fee prescribed by the Act regulating administrative fees shall be paid before the examination.

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

(3) An executive regulation issued by the Minister competent for the field of industrial property shall define, in greater detail, the manner of conducting qualifying examinations under Article 131(2) and (3).

ChapterXn PENALPROVISIONS

Article 134 Offences

(1) By a fine of SIT 100,000 to 10,000,000 shall be punishable for an offence any legal person who:

(a) uses, in the course of trade, the signs referred to in Article 43(3) without the consent of the Government of the Republic of Slovenia;

(b) submits to the Office a false or untrue evidence referred to in Article 92, or request an interruption of the proceeding referred to in Article 92(3) by a false or untrue communication;

(c) represents a third person in the proceedings before the Office without being entered in the register referred to in Article 132.

(2) By a fine of SIT 10,000 to 500,000 shall be punishable the person responsible within the legal person for any offence referred to in paragraph (1).

(3) By a fine of not more than SIT 150,000 shall be punishable natural persons for any offence referred to in paragraph (1).

ChapterXIII TRANSITIONAL AND FINAL PROVISIONS

Article 135 The use of substances as medicine

(1) The use of substances as medicine for humans and animals shall not be deemed to constitute infringement of a patent for invention of such substances if the corresponding patent application was filed on or before December 31, 1992, or if a right of priority was claimed for the application on or before December

31, 1992.

(2) By the use of substance as a medicine within the meaning of paragraph (1) is meant its production and processing into the medicine under a process which is not the subject-matter of a relevant patent protection, and marketing of this substance or medicine.

(3) Following the accession of the Republic of Slovenia to the European Union, Article 21(2) shall apply to substance or medicine referred to in paragraph (1) only if the consent of the owner of the patent under which such substance or medicine is protected has been obtained.

Article 136

Treatment of applications and validity of rights

(1) Procedures concerning the registration and grant of industrial property rights with respect to applications filed before the date of entry into force of this Act shall be carried out in accordance with the provisions of this Act, unless otherwise provided by this Act.

(2) The industrial property rights which are valid on the date of entry into force of this Act shall continue to be valid according to 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 Law on Industrial Property (Official Gazette RS No 13/92, 27/93, 34/97 - Decision by Constitutional Court, 75/97) shall continue to apply to patents applied for or granted prior to entry into force of this Act.

(2) The provisions of Article 22(2) and (3) of this Act shall apply to patents applied for after 1 January 1993.

(3) From the date of accession of the Republic of Slovenia to the European Union, Article 22(3) of this Act shall apply in accordance with the regulations of the European Union.

(4) Within six months following the accession of the Republic of Slovenia to the European Union, a supplementary protection certificate may be requested for

patents applied for after 1 January 1993, and for which the time limit referred to in Article 7 of the EU Regulation No 1768/92 of 18 June 1992, or Article 7 of the 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 for the Republic of Slovenia.

(6) The provision of Article 32(6) of this Act shall not apply to applications under the PCT which have been filed prior to entry into force of this Act.

Article 138

Industrial design applications and industrial designs

(1) Article 58 of the Law on Industrial Property shall continue to apply to industrial designs published prior to entry into force of this Act, and for which opposition against the issuance of the decision on the registration has been filed.

(2) Where an industrial design application has been published prior to entry into force of this Act, and opposition against the issuance of the decision on the registration under Article 58 of the Law on Industrial Property has not been filed, the Office shall issue the decision on the registration of the industrial design, enter it in the register and publish the mention of the registration.

(3) Industrial designs valid on the date of entry into force of this Act shall be dealt with in accordance with the provisions of this Act.

Article 139

Opposition on the basis of a mark applied for or registered with the Office for Harmonisation in the Internal Market (trade marks and designs)

(1) Prior to the accession of the Republic of Slovenia to the European Union, a mark which was applied for or registered with the Office for Harmonisation in the Internal Market (trade marks and designs) before the date of application for or registration of the later mark in the Republic of Slovenia shall also be deemed to be an earlier mark under Article 44(1).

(2) The owner of the earlier mark referred to in paragraph (1) may file an opposition under Article 101, provided that he files, within the time limit provided for the opposition, a correct application for his mark in the Republic of Slovenia.

(3) If the owner of the earlier mark referred to in paragraph (1), when filing an

opposition under Article 101, does not file in due time also a correct application for his mark in the Republic of Slovenia, the opposition shall be deemed not to have been filed.

Article 140 **Appellations of origin**

Appellations of origin valid on the date of entry into force of this Act shall be dealt with as geographical indications under this Act, unless otherwise provided for by another act.

Article 141 **Qualifying examinations and agents**

(1) Qualifying examinations passed or recognised up to the date of entry into force of this Act shall be treated as qualifying examinations for patent agents and qualifying examinations for industrial design and mark agents.

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

Article 142 **Executive regulations**

(1) Executive regulations under this Act and order on the tariff referred to in Article 7(3) shall be issued within six months following the entry into force of this Act, with the exception of the regulation referred to in Article 80(2) which shall be issued after the Office will have had the necessary technical facilities.

(2) Prior to the issuance of new regulations, the following regulations issued under the Law on Industrial Property shall apply mutatis mutandis:

- (a) Regulations governing grant of patents (Official Gazette RS No 49/93);
- (b) Regulations governing registration of industrial designs (Official Gazette RS No 49/93, 37/95 - Decision by Constitutional Court);
- (c) Regulations governing registration of marks (Official Gazette RS No 49/93);

(d) Regulations governing international registration of marks (Official Gazette RS No 15/93);

(e) Regulations governing qualifying examinations and entry in the register of representatives (Official Gazette RS No 20/92);

(f) Regulation governing fees for acquisition and protection of industrial property rights prescribed by the Slovene Intellectual Property Office (Official Gazette RS No 14/95);

(g) Regulation governing fees for information and other services provided by the Slovene Intellectual Property Office (Official Gazette RS No 57/96).

Article 143 **Termination of validity**

(1) On the date of entry into force of this Act,

(a) Law on Industrial Property, and

(b) Regulations governing transfer of industrial property rights applied for at the Federal Patent Office in Belgrade to the Slovene Intellectual Property Office (Official Gazette RS No 49/93)

shall cease to apply.

(2) Notwithstanding paragraph (1)(a) and subject to Articles 137(1) and 138(1) of this Act, the provisions of Articles 10, 58, 77, 78 and 112 of the Law on Industrial Property shall continue to apply.

Article 144 **Entry into force**

This Act shall enter into force after the expiry of six-month period following its publication in the Official Gazette of the Republic of Slovenia.

**TRANSITIONAL AND FINAL PROVISIONS
of the Act of 6 February 2006 Amending the Industrial Property Act**

**Article 23
Pending proceedings**

Proceedings which are pending pursuant to Chapter IX at the time when this Act becomes effective shall be terminated according to the provisions of this Act applicable hitherto.

Article 24

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

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| <p>http://www.wipo.int/portal/en/index.html</p> |
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