

Slovenia

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Legal framework

Slovenia is subject to the following international rules:

- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the World Intellectual Property Organisation Convention;
- the Madrid Agreement Concerning the International Registration of Marks;
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;
- the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement;
- the Trademark Law Treaty and Regulations; and
- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the

Registration of Marks.

It is also subject to the following EU legislation:

- the IP Rights Enforcement Directive (2004/48/EC);
- EU Regulation 1383/2003 concerning customs action against goods suspected of infringing certain IP rights and the measures to be taken against goods found to have infringed such rights;
- EU Regulation 1891/2004 laying down provisions for the implementation of EU Regulation 1383/2003;
- EU Regulation 1172/2007 amending EU Regulation 1891/2004;
- the EU First Trademarks Directive (89/104/EEC); and
- all EU legislation related to the Community trademark.

Finally, Slovenia has implemented the following pieces of national legislation:

- the Industrial Property Act;
- the Act Implementing the Customs Regulations of the European Community;

- the Rules on the Procedure for Requests Concerning International Registration of Trademarks; and
- the Rules on the Method of Payment of Security, the Criteria for Determining Its Amount and the Method of Its Release or Exercise in the Event of Application of Customs Measures for Violation of IP Rights.

Border measures

The Customs Administration of the Republic of Slovenia carries out special actions and adopts measures to combat trademark infringement and counterfeiting at the point of entry of goods into Slovenia. Further action against trademark infringement and counterfeiting of goods is also adopted via Customs' special mobile unit, which monitors road transport.

Customs may implement such anti-counterfeiting measures *ex officio* or at the request of the rights holder. The rights holder may lodge a request with the General Customs Directorate. All customs offices, along with the rights holder itself, are notified

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of Customs' decision approving the lodged request. Such decision is valid for one year.

Customs is generally authorised to detain temporarily goods that are suspected of trademark infringement during the routine examination of goods. Upon the detention of goods, both the owner of the goods and the rights holder shall be notified of the seizure and asked to file a statement within 10 working days from receipt of the notice (three working days in the case of perishable goods). During this period, the rights holder must declare whether the detained goods constitute trademark infringement, thus deciding whether it will file legal action pertaining to the infringement of the aforementioned right. On the other hand, the owner of the goods must decide whether it will follow through on its statement confirming that the goods do not infringe the trademark right.

Should the owner of the goods fail to respond to the notification issued by Customs, or if the owner and the rights holder expressly agree to the destruction of the goods through the expedited procedure, the detained goods shall be destroyed under customs supervision. This is an exception to the general rule stipulating that goods may be destroyed only by court order.

In the event that the declarant, owner or holder of the goods does not explicitly oppose the destruction of goods, it shall be assumed that it has consented to the destruction and, at the request of the rights holder, the goods may be destroyed under customs supervision. Samples of the destroyed goods are saved for the purposes of future legal proceedings.

Should the declarant, owner or holder of the goods submit a statement declaring that the detained goods do not constitute trademark infringement and that it expressly opposes the destruction of the

goods, the goods shall not be destroyed. In such cases the rights holder may pursue civil proceedings, within the scope of which trademark infringement can be established. In order to prevent the release of the detained goods until the civil court renders a final decision, Customs must be notified of the initiation of court proceedings within 10 working days of the date of notification of temporary detention (three days in the case of perishable goods). Should the court hold that an infringement has occurred, the goods are generally destroyed once the decision is final. In the event that the rights holder fails to establish trademark infringement within the scope of court proceedings, the goods shall be released.

As mentioned above, Customs may temporarily detain goods *ex officio* where it has sufficient grounds to suspect that goods infringe a trademark right. The period of such temporary detention is limited to three working days. Customs may notify the rights holder and the declarant, owner or holder of the goods, if known, in order to enable the trademark owner to submit a request for action. The procedure is then as described above.

Through the available customs actions and temporary detention measures, plus the timely response of both parties and the initiation of legal procedures, it should be possible to determine whether a trademark right has been infringed. According to the Slovenian legislation, it is not possible to release temporarily detained goods by paying security in case such goods violate trademark rights.

Criminal prosecution

In accordance with the Constitution, the protection of copyright and other rights deriving from artistic, scientific, research and invention activities (collectively known

as IP rights) is guaranteed. However, only the most serious infringements of IP rights are deemed to be criminal offences by the Criminal Code.

The criminal offence of trademark infringement is determined by Article 233 of the Criminal Code under the title “Unauthorised use of another's mark or model”. In accordance with this provision, any party which, while engaged in economic activities, uses another party's trade name, brand, geographical indication or particular goods or services mark, or which uses essential components of another party's mark in its own trade name, brand or other goods or services mark, shall be sentenced to imprisonment of up to three years. Only trademark infringements committed while engaging in economic activities constitute a criminal offence. Article 233 of the Criminal Code stipulates the mandatory seizure of infringing items.

Unauthorised trademark use is prosecuted *ex officio*. In practice, however, state prosecutors greatly rely on information volunteered to the police or state prosecution office (eg, in the form of a criminal complaint) to initiate prosecution. The state authorities competent to commence and conduct criminal proceedings are generally not in a position to detect trademark infringement; therefore, they are largely dependent on parties reporting that their IP rights have been violated. All state agencies and organisations in which public authority is vested (eg, inspectorates and Customs) are obligated by law to report all criminal offences subject to public prosecution of which they are aware.

The protection of trademark rights through the application of criminal law is considered a supplementary legal instrument, through which IP rights infringements are remedied. Generally, the rights holder's prime

goals – banning future infringements and obtaining restitution in the form of compensation for damages suffered – are achieved through civil proceedings.

The Criminal Procedure Act offers minimal leeway through which claims for indemnification regarding damages pertaining to criminal offences may be filed within the ambit of criminal proceedings. However, pursuant to the act, such claims may be referred to the civil courts in the event that the criminal courts should estimate that adjudication of such a claim would significantly prolong the procedure. A claim for indemnification may consist of a claim for compensation for damages, the recovery of property or the cancellation of a legal transaction.

In practice, the criminal courts often refuse to adjudicate an indemnification claim and instruct the injured party to seek satisfaction through civil proceedings. The grounds for such a court decision generally lie in the fact that the data collected within the criminal procedure does not provide a reliable basis on which to award either full or partial indemnification.

Civil enforcement

Cases of counterfeiting, actions and other civil procedures are submitted before the Ljubljana District Court. This court has exclusive jurisdiction to render decisions on disputes arising from IP issues.

The Industrial Property Act regulates basic questions related to the enforcement of IP rights, such as trademarks.

The owner of an infringed trademark may file an action against an infringer. According to Article 121 of the act, the owner can request that:

- if infringement has already begun, future infringement be prohibited;
- infringing items be recalled from channels of commerce, taking account of the interests of good-faith third parties;
- the situation caused by the infringement be rectified;
- infringing items be irrevocably removed from channels of commerce;
- infringing items be destroyed;
- the means of infringement owned by the infringer and intended or used exclusively or principally for infringement be destroyed;
- infringing items be surrendered to the plaintiff against reimbursement of the costs of their production; and
- the judgment be published.

In addition, the owner of an infringed trademark may, according to Article 121a of

the act, request compensation for the damages incurred. The Code of Obligations applies in such cases. Payment of compensation under the Code of Obligations is generally imposed on the infringer or, in certain cases, payment of the usual or agreed licence fee is imposed.

An appeal can be filed with the Ljubljana Higher Court against the judgment of the Ljubljana District Court. The higher court's decision may be challenged by application of extraordinary judicial remedies, which are to be adjudicated by the Supreme Court. This rule is not applicable to decisions on provisional measures.

Provisional measures can be proposed under Article 123 of the act. The court shall issue provisional measures to secure non-monetary claims (as specified above) if the rights holder proves that:

- it owns the infringed trademark; and
- its right has been infringed or there exists actual danger of its right being infringed.

Both elements must be proven. In addition, one of the following circumstances must be proven by the owner of the infringed trademark:

- A danger exists that the enforcement of claims will be made impossible or very difficult;
- The adoption of a provisional measure is necessary to avoid damage that would be difficult to repair; or
- A provisional measure, which may prove unfounded in the course of the proceeding, will not have more detrimental consequences for the alleged infringer.

The court will issue such proposals by decision (and not necessarily in the main judgment). If the court issues a proposed provisional measure, the opposing party can file an opposition against such measure. The court must rule on such opposition within 30 days. If the court rejects the request for provisional measures or if it rejects the opposition filed against the provisional measure, an appeal against such decision can be filed with the Ljubljana Higher Court.

Anti-counterfeiting online

In general, internet service providers (ISPs) are not liable for actions/infringements. However, if a court order so rules, an ISP is obligated to remove all materials that could potentially infringe IP rights. The Market Inspectorate of the Republic of Slovenia deals with such actions, specifically in regard to unauthorised internet commerce

which could constitute or lead to infringement.

The police are generally authorised to order the removal of materials from websites that could constitute infringements of IP rights.

Preventive measurements/strategies

In most cases law firms provide consulting services to rights holders. Within the scope of proceedings before the Slovenian Intellectual Property Office (SIPO), rights holders may also be represented by trademark representatives (or, in case of patents, by patent attorneys). In some cases trademark representatives are not lawyers or attorneys at law.

SIPO does not rule on cases of infringement. However, it does cooperate with the police, the Market Inspectorate of the Republic of Slovenia and Customs.

Slovenian Customs has taken part in several international customs operations, organised by the European Commission, individual EU member states and international organisations. In some international customs operations, Slovenian Customs has cooperated with the police and various inspection services. [WTR](#)

Biographies

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