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Company name blocks trademark registration for the first time Examination/opposition
Slovenia - ITEM doo National procedures
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The Slovenian Intellectual Property Office (SIPO) has partly refused a trademark application for EURO CITY due to the existence of the earlier company name Eurocity doo (Case 670-1736/03-AČ-7, December 13 2005). This is the first time that the SIPO has refused a trademark application on the grounds that it is similar to an earlier company name since the Industrial Property Act came into force on December 7 2001.

Slovenian company **Spar Slovenija doo** applied to register the word mark EURO CITY covering various services in Classes 35, 36 and 41 of the **Nice Classification**. Eurocity podjetje za transport in proizvodnjo doo, which uses the shortened version of its name Eurocity doo, filed an opposition, arguing that its company name was registered (i) in the court register of companies before Spar applied to register the contested trademark, and (ii) for similar types of services to those covered by the application.

Spar countered that the opposition should be refused because (i) the SIPO should take into consideration the long version of the company name rather than the shortened version, which would mean that the name and mark were not similar, and (ii) the fact that the company name was registered in respect of similar services was irrelevant since services can be registered on the court register of companies without any restrictions, regardless of whether a company in fact has an intent to render these services on the market. Spar stated that only those services that are actually provided by the company should be regarded as relevant in an opposition. Because Eurocity doo had failed to prove the use of any relevant services on the market, the opposition should be refused.

The SIPO partly upheld the opposition and refused the trademark for the following services: "business management" in Class 35; "financial affairs, real estate affairs" in Class 36 and "education and providing of training" in Class 41. The SIPO held that Spar's trademark application was confusingly similar to the company name Eurocity doo in respect of those services. However, it allowed registration for the other types of services.

Article 44(1)(f) of the Industrial Property Act provides that "[a] sign shall not be eligible for registration as a mark if: ... (f) its use would contradict an earlier right to a name". The SIPO held that a company name constitutes "an earlier right to a name" because the law does not

restrict the notion of a 'name' merely to a name of a natural person. Furthermore, the similarity analysis typically applied to conflicting trademarks and the respective goods and services can be applied by analogy to cases where the prior right is a company name. Where an earlier right is not a trademark but a company name, the goods and services to be considered are those registered in the court register of companies, not, as Spar had argued, those in use on the market.

Gregor Maček, ITEM doo, Ljubljana

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