

### Earlier CTM loses priority date after being converted into national trademark Slovenia - ITEM d.o.o

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In Decision No 31207-1387/2012-12 (October 1 2014), the [Slovenian Intellectual Property Office](#) (SIPO) has held that the opposition against the registration of the trademark DIPLOMAT - a Community trademark (CTM) converted into a Slovenian trademark - was deemed not to have been filed, because the trademark on which the opposition was based - DIPLOMATICO, also a CTM converted into a Slovenian trademark - was not an earlier trademark within the meaning of Article 44(2)(a) of the [Slovenian Industrial Property Act](#). As both converted trademarks had the same application date of May 1 2004 (the day on which Slovenia joined the European Union and the CTM system), neither of them was deemed to predate the other.

In October 2012 [Aldi GmbH & Co KG](#) partially converted its CTM DIPLOMAT (No 003421096) into, among others, Slovenian trademark application No Z-201271387. Although Aldi's CTM was filed with OHIM on October 21 2003, the Slovenian trademark had a later application date, namely May 1 2004, because CTMs could not be effective in Slovenia before the country joined the CTM system.

In March 2013 [Barberton Consultores e Serviços LDA](#) opposed the registration of the converted DIPLOMAT mark based on its allegedly earlier Slovenian trademark DIPLOMATICO (No 201070370), which was converted from a Community trademark (No 003197084) filed with OHIM on May 23 2003. The converted Slovenian trademark application DIPLOMATICO also had a later application date, namely May 1 2004.

[Barberton](#) argued that the Slovenian trademark DIPLOMATICO should be considered to predate the opposed trademark DIPLOMAT, despite the identical converted filing dates (May 1 2004), because the filing date of the original CTM DIPLOMATICO (May 23 2003) predated the filing date of Aldi's original CTM DIPLOMAT (October 21 2003). [Barberton](#) invoked Article 112(3) of the [Community Trademark Regulation](#) (207/2009), which states that "the national trademark application resulting from the conversion of a Community trademark application or a Community trademark shall enjoy in respect of the member state concerned the date of filing... of that application or trademark". It argued that, if the filing dates of two national trademarks converted from CTMs were identical, the filing dates of the respective CTMs determined which of the national trademarks predated the other.

In its response, Aldi argued that [Barberton's](#) Slovenian trademark DIPLOMATICO could not enjoy the status of an earlier trademark in relation to the opposed trademark under Article 44(2)(a) of the Industrial Property Act, which defines an earlier trademark as, among other things, a "trademark which was applied for or registered in Slovenia on the basis of a national application prior to the filing date of the later trademark or its priority date, if applicable". Namely, neither the Slovenian application date of DIPLOMATICO nor its registration date was prior to the Slovenian application date of DIPLOMAT. Both trademarks had the same application date (May 1 2004), regardless of the original application dates before OHIM.

Aldi also argued that Article 112(3) of the regulation referred to the procedure of conversion of CTMs into national trademarks in general. In this particular case, the provisions relating to the EU enlargement and appropriate national legislation also had to be taken into consideration. Aldi claimed that the opposition should be deemed not to have been filed, since it did not fulfil the necessary requirements under Article 44 of the Industrial Property Act.

SIPO adopted Aldi's arguments and found that [Barberton's](#) opposition was deemed not to have been filed.

This case clearly shows that those CTMs which were applied for before May 1 2004 and then converted into Slovenian trademarks (and thus have identical application dates) will have to coexist in Slovenia despite being similar or even identical. The situation will be different for converted CTMs which were filed with OHIM after May 1 2004; those converted marks will keep their original application dates.

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