

World Trademark Review Daily

**SIPO adopts opposing opinion's arguments for the first time
Slovenia - ITEM d.o.o**

**Examination/opposition
National procedures**

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The [Slovenian Intellectual Property Office](#) (SIPO) has refused to register the international trademark BAVARIA for beer based on absolute grounds (31212-130/2010-9, September 2 2011). Importantly, the decision was not issued *ex officio*, but following an opposing opinion filed by a third party. The latter argued that:

- the trademark should not be registered due to the existence of the earlier geographical indication '*Bayerisches Bier*'; and
- use of the mark could confuse consumers as to the origin of the beer.

On September 10 2010 the [World Intellectual Property Organisation](#) (WIPO) registered the trademark BAVARIA (International Registration 1051133) for "beer and alcohol-free beer" in the name of Dutch brewer [Bavaria NV](#). The mark, which designated Slovenia, among other countries, was published in the *WIPO Gazette* on October 21 2010.

On January 20 2011 the association of Bavarian brewers, [Bayerischer Brauerbund eV](#), filed an opposition with SIPO based on the following earlier trademarks, which all covered goods in Class 32 of the [Nice Classification](#):

- the Community trademark (CTM) BAVARIAN BEER (Registration 009103367);
- the international trademark designating the European Community GENUINE BAVARIAN BEER (International Registration 021405);
- the CTM BAYRISCHES BIER REINHEITSGEBOT SEIT 1516 (Registration 000226589);
- the CTM BAYERISCHES BIER (Registration 000226621); and
- the CTM BAYERISCHES BIER – EINZIG IN DER WELT (Registration 002914729).

Bayerischer Brauerbund simultaneously filed an opposing opinion based on absolute grounds, arguing that there was a high degree of similarity between the contested trademark and the earlier geographical indication '*Bayerisches Bier*', registered on June 28 2001 under [Council Regulation 1347/2001](#). Furthermore, Bayerischer Brauerbund argued that the word 'Bavaria' was the dominant element of the opposed trademark. Therefore, Slovenian consumers could be misled into believing that beer sold under the BAVARIA mark originated from the German federal state of Bavaria, as consumers are aware that many popular beers of good quality originate from Bavaria.

On September 2 2011 the SIPO refused to register the BAVARIA mark based on the arguments set forth in the opposing opinion. The SIPO also decided to stay the opposition proceedings until the decision based on the opposing opinion became final.

According to the Slovenian Industrial Property Act, an opposition may be filed by the holder of an earlier trademark based on relative grounds within three months of the publication of the contested trademark (Article 44). An opposing opinion may be filed by any interested natural or legal person based on absolute grounds (Article 43). The main procedural difference between these two remedies is that, in opposition proceedings, the opponent is party to the administrative procedure, which means that it may contest the SIPO's decision before the Administrative Court. In contrast, a party that has filed an opposing opinion is not considered to be party to the procedure; therefore, it cannot contest the SIPO's decision before the Administrative Court.

In practice, the SIPO has generally ignored opposing opinions - it has informed applicants about their existence, but has never decided on the merits of an opposing opinion.

This decision is thus important because, since the introduction of opposing opinions in 2001, it is the first case in which the SIPO has refused to register a trademark by adopting the arguments set forth in an opposing opinion. It is expected that, in the future, the SIPO will take opposing opinions into consideration on a more regular basis.

Eva Plut Pekolj, ITEM doo, Ljubljana

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