

**REVIEW UNDER ARTICLE 24.2 OF THE APPLICATION OF THE PROVISIONS
OF THE SECTION OF THE TRIPS AGREEMENT
ON GEOGRAPHICAL INDICATIONS**

Reponses to the Checklist of Questions¹

Addendum

SLOVENIA

This document contains the responses to the checklist of questions which the Secretariat has received from the Permanent Mission of the Republic of Slovenia in a communication dated 13 January 2003.

**RESPONSES TO THE CHECKLIST OF QUESTIONS ON
GEOGRAPHICAL INDICATIONS (IP/C/13)**

A. GENERAL

1. Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/ registration before protection is available; or through both? Does the recognition of a geographical indication require registration?

The Protection of Competition Act deals with "unfair competition", which includes fraudulent use of geographical indications as an illegal act by a person or a company.

There is a formal procedure for the registration of geographical indications on the basis of legal acts and supporting legislation.

2. Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.

There are three separate regimes, depending on the nature of the product:

Handicrafts and other goods are governed by the Industrial Property Act (Official Gazette RS No. 45/01) and supporting decrees.

¹ Documents IP/C/13 and IP/C/13/Add.1.

Wine and products from wine are governed by the Wine and other Grape and Wine Products Act (Official Gazette RS, No. 70/97, 16/01 as amended) with executive regulations under this Act.

Agricultural products and foodstuffs are governed by the Agriculture Act (Official Gazette RS, No. 54/00) and Rules on Procedures for Recognition of Special Agricultural Products and Foodstuffs (Official Gazette No. 44/02).

3. Do(es) the regime(s) of protection of geographical indications also extend to services?

No, services are not covered.

4. What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.

Article 13(3) of the Protection of Competition Act (Official Gazette RS, No. 13/93) provides that unfair competition includes in particular: sale of goods bearing designation or data which will or might lead to confusion concerning the origin, method of production, quantity, quality or the other properties of goods.

Article 58(2) of the Industrial Property Act provides that the use of a registered geographical indication by unauthorised persons is prohibited, and Article 58(3) that such use is 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.

The Agriculture Act provides in Article 49 that industrial property regulations shall be used for judicial protection in reference to the protected agricultural products or foodstuffs. Also Article 50 of the same act provides that labelling and other elements relating to the marketing of agricultural products or foodstuffs may not verbally, illustratively, or in any other way, mislead the consumer with regard to geographical denomination.

The Wine and other Grape and Wine Products Act defines in Article 29 how a right to use an indication of geographic origin is obtained by an applicant and how these indications can be used.

5. If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanisms through which the protection required is provided.

Not applicable.

6. Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.

Protected agricultural products and foodstuffs are various types of cheeses, specific type of ham products, olive oil, etc. These types of products have been registered in accordance with the Industrial Property Act 20, while other products are under procedure of registration on the basis of the Agriculture Act.

Other products under protection are wine and products from wine, handicrafts and other goods, such as, specific type of lace.

7. Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.

Yes, agricultural products and foodstuffs, which are protected under the Agriculture Act, enjoy the same type of protection as wine and spirits.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. How are geographical indications defined?

Definition according to Industrial Property Act:

Geographical indications: 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 (Article 55 of Industrial Property Act).

Definition of designations of the geographical origin of wine according to the Wine and other Grape and Wine Products Act:

Protected geographical origin: It may only be used for quality wines, provided that the grapes and wine are produced in a territory identical with or contained within a single viticulture district. The names and conditions for the protected geographical origin of wine shall be prescribed. The legal protection of rights is guaranteed by this Act and by regulations on industrial property (Article 4 of Wine and other Grape and Wine Products Act).

Recognised geographical indication: It applies to land wines made from grapes produced in a particular viticulture region or an area contained within it. The names and conditions for the recognised geographical indication are prescribed. The legal protection is guaranteed by this Act and by regulations on industrial property (Article 4 of the Wine and other Grape and Wine Products Act).

Recognised traditional denomination: The right to use it for wines must be supported by a study, prepared beforehand, which defines the geographical territory and characteristics of wine, and substantiates the use of traditional denominations. The study is to be prepared by the producers involved and shall be certified by the Minister of Agriculture. On entering a name of recognised traditional denomination into the register of the geographical designation of wine, the producers acquire the right to protection of the designation under this Act and under the regulations on industrial property (Article 4 of the Wine and other Grape and Wine Products Act).

Definitions according to the Agriculture Act:

Geographical indication; shall be the name of a geographical region, in exceptional cases, a country, used to describe an agricultural product or a foodstuff, and the production and/or processing and/or market preparation of which take place in the defined geographical area. The geographical indication may be used for an agricultural product or a foodstuff:- originating in a certain geographical region, and- which possesses a specific quality,

reputation or other characteristics attributable to a certain geographical region (Article 46 of the Agriculture Act).

Designation of origin: shall be the name of a geographical region, in exceptional cases, a country, used to describe an agricultural product or a foodstuff originating exclusively in a certain geographical region, where the raw materials of the products concerned come from the same geographical area.

The traditional geographical or non-geographical names designating an agricultural product or a foodstuff shall also be considered as designations of origin of agricultural products and foodstuffs if they fulfil the legal conditions for such designations.

The designation of origin may be used for agricultural products and foodstuffs the characteristics of which are, essentially or exclusively a result of natural and human factors, and the production, processing and market preparation of which takes place in the defined geographical area (Article 47 of the Agriculture Act).

9. Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?

No.

10. In determining whether recognition should be given a geographical indication, what criteria are considered?

The basis for the protection of geographical indications is long lasting producer tradition, good reputation and specific geographic conditions for the production of certain products.

11. Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?

The geographical environment referred to include natural factors and human factors such as traditional knowledge and the respect of traditional procedures.

12. Are they any other intellectual property rights involved, such as patents for example?

No.

13. What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?

The Ministry of Agriculture defines the geographical region or area on the basis of Article 4 of the Wine and other Grape and Wine Products Act and Articles 46(3) and 47(4) of the Agriculture Act.

14. Does your legislation contain criteria for homonymous geographical indications for wines?

Yes. In the case of homonymous geographical names, both geographical territories must be precisely defined so that it is impossible for consumers to be misled (Article 26(9) of the Wine and other Grape and Wine Products Act).

15. Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?

Yes. The Agriculture Act provides in Article 48 (3) that geographical denomination may be acknowledged for the benefit of a foreign person on the basis of the international treaty on mutual protection of geographical denominations.

Article 27 forbids any kind of misleading information. This article includes imported wines. Combined with other articles of the act including those, which refer to inspections, there is a basis for the protection of geographical indications of products of other countries.

16. Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.

As a general rule, the protection of geographical indications is based on the principle of recognition in the country of origin.

C. PROCEDURE FOR RECOGNITION

17. With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?

According to Article 104(1) of the Industrial Property Act, a request for the registration of a geographical indication may be filed by associations of legal or natural persons, chambers, larger local communities or State authorities.

The procedure for registering geographical denominations (conducted by The Office for Recognition of Geographical Denominations) shall start with the filing of an application by the producer, processor or their association including private entities.

A wine producer is entitled to designate the geographical origin of wine and other products upon evaluation of the wine, and when the following criteria are met, wine is produced in certain viticulture territorial region, specific characteristic are possessed by the wine (Article 26(1) of the Wine and other Grape and Wine Products Act). The protection is provided in an ex officio basis.

18. What are the competent authorities where the protection of a geographical indication can be obtained?

The following authorities are competent to provide the protection of the geographical indications:

- Ministry of Agriculture, Forestry and Food, for wine and wine products;
- Office for Recognition of denominations of Agricultural Products and Foodstuffs established within the Ministry of Agriculture, Forestry and Food, for agricultural products and foodstuffs;
- Slovenian Intellectual Property Office for handicrafts.

19. Do the procedures which lead to the recognition of geographical indication take place ex officio or must they be based on the initiative of an entity or person?

According to the Agriculture Act the procedures for the agricultural products or foodstuffs are prescribed by the minister, an initiative may come from the producers, processors or their associations while the protection of geographical indication is on an ex officio basis. According to the Rules on Conditions for the Use of Geographical Denominations for Agricultural Products and Foodstuffs (Official Gazette No. 7/01) a procedure is initiated upon an application of a producer, processor or their association.

20. What, if any, fees are involved in the application and maintenance of rights in a geographical indication?

For agricultural products and foodstuffs. Fees must be paid upon filing of an application for recognition of geographical denomination for agricultural products and foodstuffs (including wines) according to the Act on the administrative fees. There are no fees for maintenance of rights.

21. If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?

No. See reply to question 23 below.

The criteria are not purely geographical, but historical, traditional, etc.

22. What other criteria, if any, must be set out in an application for recognition of a geographical indication?

See reply to question 23 below.

23. What information must be supplied in an application for rights in a geographical indication?

The request for the registration of a geographical indication (under Article 104(2) of the Industrial Property Act) must 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.

The application for registration under the Agriculture Act must contain: identification data of the applicant (name and surname, or name of the company, address of the applicant or the company's headquarters, personal registry number of the applicant or the registry number of the company, tax number), the legal status of the company and in case of a farm, the KMG-MID number; a proposal for the denomination of the agricultural product or foodstuff, including the designation of origin or the geographical indication; a description of the agricultural product or foodstuff, including the raw materials and the principal physical, chemical, microbiological and/or organoleptic characteristics of the product or foodstuff; a definition of the geographic area of production and/or processing; documentation proving that the agricultural product or foodstuff originates from the geographical area, thus justifying direct connection with the geographical area or origin; a description of the method of production or processing of the agricultural product or foodstuff and/or preparation for the

market and a description of authentic and unvarying local methods of these exist; internal regulations for labelling; measures and instruments to ensure the prescribed quality; statute of the association.

24. Must the goods or services with respect to which a geographical indication is claimed be set out?

Yes.

25. What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?

No opposition procedure is provided under the Industrial Property Act or the Agriculture Act. There is a possibility of a litigation procedure before the Administrative Court.

26. Who can oppose the recognition of a geographical indication?

In general, any natural or legal person who has a legitimate economic interest can oppose the recognition of a geographical indication.

27. If your national legislation provides for recognition and protection of geographical indications or appellations of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?

The recognition and protection of geographical indications or appellations of foreign countries is possible only on the basis of an international agreement.

D. MAINTENANCE

28. How long does recognition for a geographical indication continue?

The term of protection of a registered geographical indication is unlimited (Article 60 of Industrial Property Act). In the case of agricultural products and foodstuffs (including wines), protection is unlimited as far as agricultural products and foodstuffs comply with regulations.

29. If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.

There is no renewal or reaffirmation procedure for a registered geographical indication.

30. Must geographical indication be used in order to maintain rights? If so, how is such use determined?

There is no provision of this kind.

31. Is there a specified limit for non-use before rights in a geographical indication case and, if so, what is that limit?

There is no provision of this kind.

32. Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?

The following authorities monitor the use of geographical indications:

- Association of producers (regarding handicrafts)
- Agricultural inspection services (regarding wine)
- Inspectorate for Quality Control of Agricultural Products and Foodstuffs

33. If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?

Aside from the authorizations given on the basis of general rules regulating the inspection, an inspector for the quality control of agricultural products or foodstuffs also has the following authorizations and competences: checking of documents of conformity of agricultural products or foodstuffs being traded in; control of the prescribed quality of agricultural products or foodstuffs; taking of samples of goods for analysis, for which a certificate must be issued; control of the fulfilment of conditions for labelling and marks of conformity of agricultural products or foodstuffs with the relevant criteria; access to databases needed for the exertion of control; proposing of the deletion from the databases pursuant to this Act; ascertaining whether the organizations for the assessment of conformity in the first and second indents of Article 65 of this Act fulfil the prescribed conditions.

In the case of wines agricultural inspectors have additional competence on the basis of the Wine and other Grape and Wine Products Act.

34. Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.

In case of non-use there are no provisions for terminations. In case of failure to maintain the criteria identified in application there are two possibilities. The procedure starts with the report to the inspectorate or the inspector during monitoring which establishes a breach of regulations.

The control over legal or natural persons who own a registered production of the agricultural product or food (hereinafter referred to as the producer), is carried out by the certification body.

The control of the producer's establishment is carried out at least once a year. It involves a complete physical control and if necessary, also unannounced routine controls. After each complete physical control, a report is written.

If the report expresses suspicion that the production is not carried out in accordance with the specification, or that the producer falsifies or even endangers consumers health, the certification body informs the competent inspector. The certification body also informs the controlled legal or physical person of the proceedings.

On the basis of the proposal by the certification body, the competent office deletes the producer from the register of producers if the producer is not in compliance with the prescribed conditions.

35. Do the procedures, which lead to forfeiture of a geographical indication, take place ex officio or must they be based on the initiative of an entity or person?

The procedures take place ex officio.

E. SCOPE OF RIGHTS AND USE

36. May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?

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 specifications, produce or market the goods protected by the geographical indication (Article 58(1) of the Industrial Property Act). The same applies to agricultural products and foodstuffs on the basis of the Agriculture Act.

37. Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?

The entity responsible for recognition.

38. Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?

There are no specific fees for an application or authorization to use a particular geographical indication. It is necessary to pay the costs of a required certification on a basis of a tariff.

In case of wines an applicant pays the costs of tests.

39. If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?

In all cases it is possible to initiate procedures before the Administrative Court.

40. Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?

There are no provisions for cancellation of authorizations to use geographical indications or any conditions that such use must be continuous.

41. If there is a dispute over continuity of use by a particular party, how is it resolved?

Refer to the reply to question 40.

42. Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?

There are no provisions for licencing.

43. How is "grandfathered use" of a geographical indication, under Article 24.4. of the TRIPS Agreement, applied in your country?

No "grandfathered use" of geographical indications exists.

F. RELATIONSHIP TO TRADEMARKS

44. What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?

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 (Article 59(1) of Industrial Property Act).

45. What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?

See reply to question above.

46. What procedures are foreseen in case of a conflict of a geographical indication with a trademark?

Article 44(1)(f) of Industrial Property Act provides that a sign shall not be eligible for registration as a mark if its use contradicts an earlier right to a geographical indication, unless the owner of the earlier right gives his express consent to the registration of such sign (relative ground for refusal).

Article 56(d) of Industrial Property Act provides that a geographical indication shall not be eligible for registration if, in the light of a mark's reputation and renown and length of time it has been used, registration is liable to mislead the consumer as to the true identify of the product.

A trademark for wines and other grape products which at the same time directly or indirectly indicates geographical origin can be used under the condition that the wine has been produced in a geographical area that is directly or indirectly indicated.

Labelling and other elements relating to the marketing of agricultural products or foodstuffs may not verbally, illustratively or in any other way, mislead the consumer with regard to geographical denomination.

With regard to geographical denomination, the following shall be deemed to be particularly misleading:

- use of the indication on the agricultural product or foodstuff which was not produced, processed or prepared for the market in compliance with the regulations enabling the use of the indication of geographical region, even though the true source, the origin of the agricultural product or foodstuff is indicated, and also in the case when the used indication is composed of the name of the geographical region;
- if the used indication is translated or accompanied by an expression such as "style", "type", "method", "imitation", or similar.

Industrial property regulations shall be used for judicial protection of rights in reference to the agricultural products or foodstuffs, which are granted geographical denomination pursuant to this act. In case of misleading inspection for quality control can prohibit the trading for agricultural products or foodstuffs, which are misleading or could mislead a consumer. A fine can also be imposed in such cases.

G. ENFORCEMENT

47. How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.

Any person who uses a registered geographical indication without authorization is liable for any damages in accordance with the general regulations governing compensation for damages (Article 121 of the Industrial Property Act).

48. Who has the right to enforce a geographical indication?

The owner of the geographical indication has the right to file an action for infringement (Article 121(1) of the Industrial Property Act).

49. What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?

The District Court Ljubljana is competent for all cases relating to infringements of intellectual property rights.

50. Must the public be notified of the existence of a geographical indication and, if so, how and how often?

The public is informed of the existence of a geographical indication through its publication in the Official Journal of the Slovenian Intellectual Property Office and in the Official Gazette of the Republic of Slovenia.

51. Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.

Yes. Article 238 of the Penal Code of Slovenia criminalizes fraud in the area of the intellectual property.

H. INTERNATIONAL AGREEMENTS

52. Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.

Yes, there is an agreement between the European Communities and the Republic of Slovenia on the Reciprocal Recognition, Protection and Control of Wine Names and Agreement between the European Communities and the Republic of Slovenia on the Reciprocal Recognition, Protection and Control of Designation for Spirit and Aromatised Drinks (Official Gazette RS - International Treaties No 31/01).

53. What other international agreements, if any, have been entered into? What do those agreements provide?

No other agreements have been entered into.

**RESPONSES TO THE CHECKLIST OF QUESTIONS ON
GEOGRAPHICAL INDICATIONS (IP/C/13/Add.1)**

1. Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like?

Yes, it does.

2. Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?

Yes, see reply to question 8.

3. Does your legislation contain criteria for homonymous geographical indications for wines and spirits?

Yes, see reply to question 14.

4. Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wine or spirit with respect to such wines or spirits not originating in the indicated territory?

Yes. A sign shall not be eligible for registration as a mark if it contains or consists of a geographical indication identifying wine or spirits, where the mark application relates to wines or spirits not having this origin (Article 43(1)(d) of the Industrial Property Act).
