

Trademark act

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Passed on 27 August 1992 (RT 1992, 35, 459), entered into force 1 October 1992, except the provisions of the Supreme Soviet of the Republic of Estonia decree of 27 August 1992 "Implementation of the Republic of Estonia Trade Marks Act"

(RT 1992, 35, 460; RT I 1993, 17, 275; 1998, 4, 63)

Amended by the following Acts (date the Act was passed, publication in the Riigi Teataja (State Gazette), date of entering into force):

| | | |
|------------|-------------------------|--------------------------------------------------|
| 15.02.1995 | (RT I 1995, 26-28, 355) | 01.09.1995 |
| 26.06.1996 | (RT I 1996, 49, 953) | 26.07.1996 |
| 17.12.1997 | (RT I 1998, 4, 63) | 13.01.1998, excluding implementing provisions |
| 24.11.1999 | (RT I 1999, 93, 834) | 25.12.1999 |
| 15.12.1999 | (RT I 1999, 102, 907) | 10.01.2000 |
| 21.02.2001 | (RT I 2001, 27, 151) | 20.04.2001 |

| | | |
|------------|----------------------|------------|
| 06.06.2001 | (RT I 2001, 56, 335) | 01.09.2001 |
| 05.06.2001 | (RT I 2001, 56, 332) | 01.10.2001 |

The amended section ends with a reference to the Act(s) (date the Act was passed) enforcing the current wording.

I. GENERAL PROVISIONS ➡

§ 1. Purpose of Act ➡

This Act regulates the relations which arise in the provision of legal protection of trademarks and service marks and in the use of protected trademarks and service marks in the Republic of Estonia.

§ 2. Legislation regulating legal protection of trademarks ➡

The legislation regulating the legal protection of trademarks comprises this Act, other Acts in this field and regulations issued by the Government of the Republic and ministers on the basis of such Acts. [26.06.1996]

§ 3. International Agreements ➡

If, in a bilateral or multilateral international agreement to which the Republic of Estonia is party, an issue relating to trademarks is regulated otherwise than in the Acts of the Republic of Estonia, the rules of the international agreement shall prevail.

II. LEGAL PROTECTION OF TRADEMARKS ➡

§ 4. Definition of trademark and service mark ➡

1. A trademark and a service mark (hereinafter trademark) is a sign which a natural or legal person uses or intends to use in economic and business activities in order to distinguish his goods or services from other goods or services of the same kind of other natural or legal persons.
2. Goods and services are classified in accordance with the international classification of goods and services established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (RT II 1996, 4, 14). [15.02.1995;17.12.1997]

§ 5. Legal regime of trademarks ➡

1. Natural and legal persons may acquire legal protection for their trademarks in the Republic of Estonia on the basis of and pursuant to the procedure prescribed in this Act.
2. The state protects the exclusive right of the owner of the protected trademark to the trademark.
3. No natural or legal person shall have the right, without the consent of the owner of the trademark, to use a trademark to designate the same or similar goods and services in economic and business activities if the trademark is identical with or confusingly

similar to the protected trademark. The following constitutes use of a trademark:

1. affixing the trademark to goods or to the packaging thereof;
 2. offering for sale, putting on the market or storage for the purpose of sale of goods designated by the trademark;
 3. offering or rendering services under the trademark;
 4. importing or exporting goods designated by the trademark;
 5. using the trademark on economic and business documents, advertising materials or user instructions of goods.
4. The owner of a trademark has the right to prohibit the use of the trademark in relation to the same or similar goods and services as well as other goods and services if the trademark is well-known in the Republic of Estonia and such use takes unfair advantage of or is detrimental to the distinctive character or reputation of the trademark.
5. The owner of a trademark has no right to prohibit any third party from making use in economic and business activities of:
1. the name or address of the third party;
 2. indications which designate the kind, quality, quantity, intended purpose, value or geographical origin of goods and services, time of production of goods or of rendering of services, as well as other characteristics of goods or services;
 3. the trademark if it is necessary to indicate the intended purpose of a good (e.g. as accessories or spare parts) or a service;
 4. elements of the trademark which are not subject to protection.
6. Upon publication of a registered trademark in reference books, manuals, textbooks, professional journals or other publications, the author and publisher shall ensure that the publication includes a warning notice at the request of the owner of the trademark pursuant to § 20 of this Act.
7. The owner of a trademark has no right to prohibit further distribution, sale or offer for sale of goods which are designated with the trademark by the owner or with the owner's consent and put on the market in the Republic of Estonia or in foreign states, or the storage, importation or exportation of goods for these purposes under the trademark, except if the quality of the goods has changed after they are put on the market.
8. The scope of legal protection of a registered trademark shall be based on a reproduction of the trademark.
9. The scope of legal protection of a registered trademark in relation to goods and services is determined by a list of goods and services. The list of goods and services indicated in the registration may be limited. Extension of the list of goods and services is prohibited. [15.02.1995; 17.12.1997]

§ 6. Registrable trademarks ➡

1. Any sign or combination of signs which is capable of being represented graphically and consists of letters, words, numerals or designs or is three-dimensional may be registered as a trademark provided that such signs distinguish the goods or services of one natural or legal person from those of others.
2. A trademark may be registered in black-and-white or colour. A trademark which is registered in black-and-white shall be protected in all colour combinations; a trademark which is registered in colour shall only be protected in the colour combination which is applied for.
3. Trademarks which consist of sound or smell are not registrable.
4. A registrable trademark may include elements which are not subject to protection unless this decreases the distinctive character of the trademark and infringes the

rights of other persons.

5. If, during subsequent use, an element of a registered trademark which is not subject to protection becomes well-known in the Republic of Estonia within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property (RT II 1994, 4/5, 19) and thereby acquires a distinctive character, a new application for registration of the registered trademark may be filed to extend legal protection to the entire mark. [17.12.1997]

§ 7. Absolute grounds for refusal of trademark registration ➡

1. The following shall not be registered as a trademark:
 1. signs which do not conform to the provisions of subsection 6(1) of this Act;
 2. trademarks which are devoid of any distinctive character;
 3. trademarks consisting exclusively of signs or indications which designate the kind, quality, quantity, intended purpose, value, geographical origin of the goods or services, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services, or which consist of the above-mentioned signs or indications which are not considerably altered;
 4. trademarks consisting exclusively of signs or indications which have become customary in the current language use in relation to such goods or services for which the registration of a trademark is applied for, or which have become customary in economic and business activities;
 5. signs consisting exclusively of the shape which results from the nature of the goods, is necessary to obtain a technical result or gives substantial value to the goods;
 6. trademarks which are of such nature as to deceive the consumer as to the kind, quality, quantity, intended purpose, value or geographical origin of the goods and services, the time of production of the goods or of the rendering of the services, or other characteristics of the goods or services;

6.1 trademarks which contain a registered geographical indication or are confusingly similar to it if it may result in an unlawful use of the geographical indication pursuant to the provisions of §§ 11 or 18 of the Geographical Indication Protection Act;

 7. trademarks which are contrary to public policy or accepted principles of morality;
 8. trademarks the registration of which must be refused on the basis of Article 6ter of the Paris Convention for the Protection of Industrial Property, unless the legally competent authority or official gives written consent for the registration;
 9. [repealed - 24.11.1999];
 10. trademarks which contain flags, armorial bearings or other symbols which are not covered by Article 6ter of the Paris Convention for the Protection of Industrial Property but the registration of which is contrary to public interest;
 11. signs which are prohibited to be used or registered as trademarks pursuant to other laws.
2. Clauses 2, 3 and 4 of subsection 1 of this section do not apply if it is certified that by the date of receipt of an application for registration of a trademark (hereinafter also registration application), the trademark has, as a result of its use, become well-known in the Republic of Estonia within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property.
3. Upon the incorporation of a sign specified in clauses 2, 3, 4 or 5 of subsection 1 of this section within a trademark, such sign is deemed to be an element of the trademark which is not subject to protection. [17.12.1997; 24.11.1999; 15.12.1999]

§ 8. Relative grounds for refusal of registration of trademarks ➡

1. The following shall not be registered as a trademark:
 1. trademarks which are identical with an earlier trademark which is registered or filed for registration in the name of another person to designate identical goods or services;
 2. trademarks which are identical with or confusingly similar to or associated with an earlier trademark which is registered or filed for registration in the name of another person to designate goods or services of the same kind, unless the other person gives written consent for the registration;
 3. trademarks which are identical with or confusingly similar to or associated with an earlier trademark registered or filed for registration in the name of another person to designate goods or services of a different kind, where they may mislead consumers and as a result take unfair advantage of the reputation or be detrimental to the distinctive character of another person's trademark, unless the other person gives written consent for the registration;
 4. trademarks or markings of goods which belong to another person and are well known in the Republic of Estonia on the date of receipt of the application for registration of a trademark or on the priority date within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property, regardless of whether or not they are registered, unless the other person gives written consent for the registration;
 5. trademarks which are identical with or confusingly similar to a trade name belonging to another person provided that the trade name has been entered in the commercial register prior to the date of receipt of the application for registration of a trademark or the priority date, and the other person's area of activity in respect of which a notation has been made in the commercial register includes the goods and services for which an application for registration is filed, unless the other person gives written consent for the registration;
 6. trademarks which include a portrait of a person, name of a well-known person, name of a registered immovable, name or representation of an architectural site if it is detrimental to the rights of the person depicted in the portrait, the well-known person or the owner of the immovable or architectural site, unless the entitled person gives written consent for the registration;
 7. trademarks including protected industrial designs;
 8. trademarks including works or titles thereof protected by copyright unless the entitled person gives written consent for the registration;
 9. trademarks including the name of a medicinal product belonging to another person and registered in the Republic of Estonia prior to the filing date of the registration application or the priority date or the name of an active ingredient of a medicinal product;
 10. trademarks which are identical with a trademark registered and in use in another country if the application for registration is filed in bad faith.
2. An earlier trademark within the meaning of subsection (1) of this section means:
 1. a trademark entered in the state register of trademarks and service marks with a filing date of the registration application or priority date which is earlier than the date of receipt or the priority date of the registration application of the trademark in question;
 2. a trademark filed for registration in the Republic of Estonia with a date of receipt of the registration application or priority date which is earlier than the date of receipt or priority date of the registration application of the trademark in question, if the trademark is entered in the state register of trademarks and service marks;

3. a trademark valid in the Republic of Estonia and registered pursuant to the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks, with the date of registration or priority date which is earlier than the filing date of the registration application or priority date of the trademark in question. [17.12.1997]

III. REGISTRATION OF TRADEMARK ➡

§ 9. Registration application of trademark ➡

1. A registration application shall be filed with the Patent Office by an applicant -natural or legal person - and accompanied by payment of the state fee.
2. An applicant may file a registration application of a trade mark and perform all procedures relating to the registration and maintaining of the trade mark independently or through a patent attorney. Natural and legal persons of foreign states shall perform procedures relating to the registration and maintaining of trade marks in the Republic of Estonia only through patent attorneys.
3. Each registration application shall cover one trademark only.

4. A registration application shall contain:

1. the request for registration of a sign as a trademark, specifying the name and seat or residence of the applicant (applicants);
2. the reproduction of the trademark;
3. the list of goods and services, classified in accordance with the international classification of goods and services, for which registration of the trademark is claimed, and the class numbers of the classification;
4. the document certifying payment of the state fee or a copy thereof;
5. the document certifying the authority of the patent attorney or a copy thereof, if the registration application is filed through a patent attorney;
6. the statutes of the collective mark, if the registration application concerns a collective mark.

4.1 The document certifying the authority of the patent attorney or a copy thereof may be filed within two months after the filing date of the registration application.

4.2 The statutes of the collective mark may be filed within two months after the filing date of the registration application.

5. The documents of the registration application shall be filed in the Estonian language.
6. The procedure for filing registration applications and the formal requirements for application documents are established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic. [15.02.1995; 17.12.1997; 21.02.2001]

§ 9.1. [repealed - 21.02.2001] ➡

§ 10. Priority of trademark ➡

1. The priority of a trademark is determined as of the date of receipt of the registration application by the Patent Office.
2. The priority of a trademark may be claimed on the basis of the filing date of the first registration application in any state party to the Paris Convention for the Protection of Industrial Property (convention priority) if the registration application is filed with the

Patent Office within six months after the filing date of the first application.

3. The priority date of a trademark in respect of an exhibit which is displayed at an international or officially recognised international exhibition in the territory of a state party to the Paris Convention for the Protection of Industrial Property (exhibition priority) is the date of public display of the exhibit at such exhibition if the registration application is filed with the Patent Office within six months after the date of display. The requirements for international exhibitions are specified in the Convention on International Exhibitions of 22 November 1928, and its later revisions.
4. An applicant wishing to claim convention or exhibition priority shall indicate such claim in the registration application and provide documents certifying the claim together with the application or within three months after the date of receipt of the registration application by the Patent Office. [17.12.1997]

§ 11. Filing registration application of trademark ➡

1. A registration application shall be filed with the Patent Office which, upon receipt of the application, shall check the compliance of the filed documents with the requirements of § 9 of this Act.
2. If a registration application complies with the requirements, the application shall undergo examination and the Patent Office shall notify the applicant of the date of receipt of the registration application.
3. If the Patent Office refuses to accept a registration application, the applicant may, after payment of the state fee, contest it at the Industrial Property Board of Appeal (hereinafter Board of Appeal) within two months after the date of refusal to accept the application.

The state fee shall be refunded if the Board of Appeal declares the refusal to accept the registration application unjustified.

§ 11.1. Database of registration applications and processing thereof, and access to and release of information from the database ➡

1. The database of registration applications and the processing thereof is a structured body of data concerning processed registration application documents and information on the processing thereof. Information on a registration application and the processing thereof is maintained until the end of processing.
2. Access to the database of registration applications and the processing thereof, and release of information from the database is generally prohibited. It is permitted to release the following information from the database: reproductions of trademarks, numbers of registration applications, filing dates of registration applications, information on priority, names of applicants, names of representatives of applicants, lists of goods and services, and class numbers of the international classification.
3. Access to a dossier on the processing of a registration application is granted to the applicant, persons who have the written consent of the applicant, persons whom the applicant has notified in writing of the filing of a registration application, competent officials of state agencies which have supervisory authority, and the courts.
4. Information from the database of registration applications and the processing thereof is available upon payment with the exception of the release of information to state agencies with supervisory authority or to a court. A state fee is charged for the release of information.
5. The database of registration applications and the processing thereof is established by the Government of the Republic or by the Minister of Economic Affairs as authorised by the Government of the Republic. [17.12.1997]

§ 12. Examination of trademarks ➡

1. If the examination of a registration application depends on the examination of another registration application which has earlier priority, the examination is suspended until a final decision is made concerning the registration application which has earlier priority.
2. The examination may also be suspended on the basis of a reasoned request from the applicant for a period determined by the Patent Office.
3. During the examination procedure, the Patent Office may require that the applicant specify or amend the registration application by a fixed term. The applicant has the right to extend the term upon payment of the prescribed supplementary state fee.
4. If the applicant fails to meet the term prescribed by the Patent Office, or to pay the state fee, or to respond to the decision made as a result of an examination, the Patent Office shall reject the registration application.
5. During the examination procedure the applicant may withdraw the registration application in which case the examination shall be terminated.

5.1 During the examination procedure the applicant may limit the list of goods and services specified in the registration application. Extension of the list of goods and services is prohibited.

6. A trademark shall be registered if no grounds for refusal of registration as specified in §§ 7 or 8 of this Act are revealed during the examination.

6.1 Registration of a trademark shall be refused if the examination reveals at least one of the grounds for refusal of registration specified in §§ 7 or 8 of this Act. A decision to refuse registration of a trademark shall be reasoned.

6.2 A trademark shall be registered for some of the goods or services specified in a registration application if the trademark cannot be registered pursuant to §§ 7 or 8 of this Act for the remaining goods or services specified in the registration application. Registration of the trademark for the remaining goods or services shall be refused.

6.3 The registration of a trademark shall include a limitation if the Patent Office determines that a particular element of the trademark is an element which is not subject to protection pursuant to subsection 7(3) of this Act.

7. The Patent Office may review a decision on registration of a trademark if it has received a registration application which has an earlier priority date pursuant to an international agreement of the Republic of Estonia.
8. In the decision on registration of the trademark the Patent Office shall indicate the element of the trademark which is not subject to protection. Upon making a decision on registration of the trademark, the trademark shall be published in the official gazette of the Patent Office.
9. The processing of a registration application shall cease with entering the trademark in the state register of trademarks and service marks or by refusal of registration or upon rejection of the registration application. [17.12.1997]

§ 13. Contesting decision on registration of trademark or decision on refusal of registration of trademark ➡

1. If an applicant disagrees with the decision of the Patent Office on refusal of registration of a trademark, the applicant may, after payment of the state fee, contest the decision at the Board of Appeal within two months after the date on which the decision is made.

The state fee shall be refunded if the Board of Appeal declares the refusal of

trademark registration to be unjustified.

2. The owner of another trademark or other interested persons may, after paying the state fee, contest a decision of the Patent Office on the registration of a trademark at the Board of Appeal within two months after publication of the trademark in the official gazette of the Patent Office. [17.12.1997]

§ 14. State register of trademarks and service marks ➡

1. Trademarks shall be entered in the state register of trademarks and service marks (hereinafter register) after payment of the appropriate state fee. The state fee shall be paid within three months after the expiration of the term for contest against the decision on trademark registration or, in case of contest, after termination of the contest proceeding. If the document certifying payment of the state fee has not been submitted to the Patent Office by the end of the term, the registration application shall be rejected.
2. The Patent Office is the chief and authorised processor of the register.
3. The registry secretary is responsible for the maintenance of the register at the Patent Office and for making the decisions on entries in the register.
4. The Register is maintained as an entry book on paper. The register may be maintained on computer, storing the entries as print-outs.
5. The register is maintained in Estonian. Documents in foreign languages shall be submitted to the authorised processor together with the translation into Estonian.
6. The expenditure for maintenance of the register is covered from the state budget through the budget of the Patent Office.
7. The statutes for maintenance of the register are approved by the Government of the Republic. [17.12.1997]

§ 15. Trademark certificate ➡

1. After the trademark has been entered in the register, the Patent Office shall issue a trademark certificate to the owner.
2. The formal requirements for and procedure for completion of the certificate form are established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic. [17.12.1997]

§ 16. Publication of registered trademark ➡

1. The Patent Office shall publish trademarks entered in the register in its official gazette.
2. The statutes of the official gazettes of the Patent Office are approved by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic. [17.12.1997]

§ 17. Validity of trademark ➡

1. The right to a trademark is valid from the filing date of the registration application until the expiry of 10 years from the date of entry of the trademark in the register.
2. The validity of the trademark may be renewed at the request of the owner for a further period of 10 years at a time if the owner files the request within one year before the expiry of the validity of the trademark and pays the state fee.
3. After the expiry of the validity of the trademark, the Patent Office may grant a period of six months to the owner of the trademark for filing the request specified in subsection 2 of this section. The owner of the trademark shall pay the state fees.
4. The Patent Office makes an entry in the register on the renewal of the validity of the trademark, publishes it in the official gazette of the Patent Office, and issues an annex

to the certificate certifying the renewal. [17.12.1997]

IV. USE OF TRADEMARK ➡

§ 18. Obligation to use trademark ➡

1. The owner of a trademark shall be obliged to use the trademark; transactions specified in subsection 5(3) of this Act shall be deemed to be the use of a trademark.
2. The procedure established in subsection 1 of this section shall be deemed to be complied with if the owner of a trademark grants a trademark licence to an interested person.
3. The trademark shall be deemed to have been used if the owner uses a trademark differing from a registered trademark in minor elements which do not alter the distinctive character of the registered trademark. [17.12.1997]

§ 19. Non-use of trademark ➡

1. If the owner of the trademark has failed, without justified reasons, to comply with the requirements of § 18 of this Act during a continuous five-year period from the date of entering the trademark in the register or later, every interested person shall have the right to contest the validity of the registration of the trademark. A state fee shall be paid upon filing a revocation application.
2. A revocation application based on the facts specified in subsection 1 of this section shall be filed with the Board of Appeal which shall notify the owner of the trademark thereof and invite him to present documentary proof of the use of the trademark. The Board of Appeal shall examine the revocation application and make a decision to reject the revocation application or to revoke the registration in full or in part. [17.12.1997]

§ 20. Warning notice ➡

The owner of trademark may use a warning notice together with the trademark to indicate that the trademark is registered in the Republic of Estonia. [17.12.1997]

V. TRANSFER OF TRADEMARK ➡

§ 21. License for trademark ➡

The owner of a trademark (licensor) may transfer the right to use the trademark to another person/other persons (licensee/licensees) pursuant to a licence agreement. An entry shall be made in the register concerning the licence agreement after payment of the state fee. [17.12.1997]

§ 22. Assignment of trademark ➡

1. The owner of a trademark may assign the registered trademark to a natural or legal person in respect of all or some of the goods or services.
2. An entry shall be made in the register concerning the assignment of the trademark after payment of the state fee. [15.02.1995; 17.12.1997]

§ 23.. Transfer of rights in trademark ➡

Upon the dissolution, merger, division or transformation of a legal person or upon the pledge of the trademark, the legal status of the trademark is altered, and a corresponding entry shall be made in the register after payment of the state fee. [15.02.1995]

§ 24. Invalidation of registration of trademark and deletion of trademark from register ➡

1. Upon the request of an interested person, the Board of Appeal may invalidate the registration of a trademark, if such registration infringes the requirements of §§ 7 and 8 of this Act.
2. The request for invalidation of trademark registration may be filed with the Board of Appeal after payment of the state fee within five years from the date of entry of the trademark in the register.
3. A trademark shall be deleted from the register by a decision of the Patent Office:
 1. if the owner of the trademark files a corresponding request;
 2. if the validity of registration of the trademark expires and the owner of the trademark has failed to comply with the provisions of § 18 of this Act;
 3. upon the dissolution of the owner of the trademark (legal person) or upon the death of the owner of trademark (natural person) or on other justified grounds unless the rights conferred by the trademark have transferred to a new owner;
 4. if the registration of the trademark is invalidated on the basis of subsection 1 of this section;
 5. pursuant to the provisions of § 17 of this Act. [15.02.1995; 17.12.1997]

§ 24.1. Invalidation and deletion from register of registration of trademark containing geographical indication ➡

1. Any interested person may request the invalidation of a trademark filed for registration or registered in bad faith in the following cases:
 1. the trademark contains a registered geographical indication or a confusingly similar indication, and
 2. the goods or services identified with the trademark and the geographical indication are identical or of the same kind;
 3. the trademark has been registered or filed for registration after the geographical indication has been granted legal protection in its country of origin.
2. If the trademark specified in subsection 1 of this section contains the name of Estonian geographical area, the condition specified in clause 3 of subsection 1 of this section shall not be applied upon the invalidation of such trademark.
3. The filing for registration or registration of a trademark is done in bad faith if the person who registers a trademark or files it for registration knew or should have known that the indication in question identifies the good or service as originating in a certain geographical area and a given quality, reputation or other characteristic of the good or service is essentially attributable to its geographical origin.
4. Any interested person may request the invalidation of a trademark registered for identifying alcoholic beverage before the date of entry into force of the Geographical Indication Protection Act if the trademark contains a registered geographical indication or is confusingly similar to it and the alcoholic beverage does not originate in the geographical area identified by the geographical indication.

5. A request for the invalidation of registration of trademarks specified in subsections 1 and 4 of this section shall be filed with the Board of Appeal.
6. Upon invalidation of registration of a trademark, the Patent Office deletes the trademark from the register.
7. The provisions of this section are also applied upon the invalidation of trademarks containing a geographical indication which were filed for registration or registered before the date of entry into force of the Geographical Indication Protection Act. [15.12.1999]

VI. COLLECTIVE MARKS ➡

§ 25. Definition of collective mark ➡

A collective mark is a trademark which an association of legal persons has an exclusive right to use for designation of the goods and services of the association and its members under the conditions prescribed in its statutes or in the statutes of the collective mark.

§ 26. Registration of collective marks ➡

A collective mark may be applied for in the name of an association and its registration shall be effected pursuant to the provisions of Chapter III of this Act.

§ 27. Use of collective marks ➡

A collective mark shall be used pursuant to the provisions of Chapter IV of this Act and the provisions of the statutes of the collective mark or the statutes of the association.

§ 28. Invalidation of collective mark ➡

A collective mark may be invalidated pursuant to the provisions of § 24 of this Act.

VII. STATE FEES ➡

§ 29. State fees ➡

In cases prescribed in this Act, state fees are charged for effecting transactions and issuing documents pursuant to the rates provided for in the State Fees Act (RT I 1997, 80, 1344; 86, 1461; 87, 1466 and 1467; 93, 1563; 1998, 2, 47; 4, 63). [17.12.1997]

§ 30. Procedure for payment of state fees ➡

1. The state fee shall be paid by an applicant, a trademark owner or a third party interested in effecting transactions or the issue of documents prescribed in this Act. If the state fee for registration of a trademark or for renewal of registration is paid by a third party, the written consent of the applicant or the owner of the trademark is required.
2. The state fee is deemed to be paid if the Patent Office receives a document which certifies payment of the state fee or, in the case of an appeal, if the Board of Appeal receives such document.
3. Paid state fees shall not be refunded, except in cases provided for in subsections

11(3) and 13(1) of this Act. [17.12.1997]

§ 31. [repealed - 17.12.1997] ➡

VIII. PROTECTION OF RIGHTS OF TRADEMARK OWNERS, DISPUTES AND LIABILITY ➡

§ 32. Protection of rights of trademark owners ➡

The rights of trademark owners are protected by way of administrative procedure and in court. [17.12.1997]

§ 33. Protection of exclusive right of trademark owners ➡

1. State supervisory agencies shall protect the exclusive right of the trademark owner as of entering the trademark in the register.
2. The exclusive right of the owner of a well-known trademark in the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property shall be protected by state supervisory agencies as of the certification of the trademark as well-known by a court or by the Patent Office. The Patent Office shall certify the trademark as well-known only in connection with the processing of the trademark.
3. The exclusive right of the trademark owner has been infringed if :
 1. for designating goods or services, a natural or legal person uses a sign identical with or confusingly similar to a sign designating the same or similar goods or services without the consent of the owner, or performs other acts infringing the exclusive right of the owner;
 2. the licensee fails to comply with the conditions of the licence agreement.
4. Goods which are designated with a sign identical with or confusingly similar to a legally protected trademark designating the same or similar goods without the consent of the owner of the trademark, are deemed to be counterfeit goods. [15.02.1995; 17.12.1997; 24.11.1999]

§ 34. Liability in case of infringement of exclusive right of trademark owners ➡

1. Performing of acts infringing the exclusive right of the trademark owner shall entail civil, criminal or administrative liability, whereby the different types of liability may be imposed together or separately. If a natural person has performed an act infringing the exclusive right of the owner of a trademark in the interest of a legal person, criminal liability may be imposed on a natural person and administrative liability may be imposed on a legal person at a time.
2. Calculation of the damages caused to the trademark owner or to the licensee shall be based on the profit that he would have received from the normal use of the trademark. [15.02.1995; 17.12.1997; 24.11.1999]

§ 35. Settlement of trademark disputes by Board of Appeal ➡

1. Industrial property disputes shall be settled by the Industrial Property Board of Appeal established in the area of government of the Ministry of Economic Affairs. The statutes of the Board of Appeal shall be approved by the Government of the Republic or the

Minister of Economic Affairs as authorised by the Government of the Republic.

2. The Board of Appeal shall examine contests filed against the decisions of the Patent Office pursuant to subsection 11(3) and §§ 13, 24 and 241 of this Act and it shall examine revocation applications made by interested persons pursuant to § 19 of this Act.
3. The Board of Appeal shall notify the contestant and, if necessary, the owner of another trademark, of the date and place of the examination of the contest. Their failure of such persons to attend the examination does not prevent the examination of the contest.

3.1 The Board of Appeal shall make a decision to reject or grant the appeal. Upon granting the appeal, the Board of Appeal shall revoke the decision of the Patent Office and propose that the Patent Office re-examine the application and make a new decision.

4. The Board of Appeal shall make a decision concerning the contest within three months from the date of receipt of the contest. The decision shall be notified to both the contestant and to the owner of the trademark. The Board of Appeal may postpone the examination of a contest on a corresponding reasoned request or if the Board of Appeal considers it necessary to request additional documents.
5. Interested persons may appeal the decision of the Board of Appeal to a court within three months from the date the decision was made. [17.12.1997; 15.12.1999]

§ 36. Civil liability ➡

1. The trademark owner whose rights have been infringed may file a civil action containing one or more of the following claims:
 1. to cease the transaction infringing the rights of the trademark owner or the licensee and restore the prior situation;
 2. to compensate for proprietary and moral damage caused to the trademark owner or the licensee, including unreceived profit;
 3. to take measures to prevent the further infringement of the rights of the trademark owner or the licensee, by removal from circulation all matter which causes infringement.
2. If the trademark owner refuses to file an action, the right to file an action shall transfer to the licensee unless the licence agreement provides otherwise. [17.12.1997]

§ 36.1. Administrative liability of legal persons ➡

1. For the designation by a legal person, without the consent of the owner of the trademark, of goods or package with a sign identical with or confusingly similar to a legally protected trademark used for the same or similar goods, a fine of 250 000 to 500 000 kroons shall be imposed.
2. For the use by a legal person, without the consent of the owner of the trademark, on the economic or business documents, advertising materials or user instruction of a sign identical with or confusingly similar to a legally protected trademark used for the same or similar goods or services, a fine of 25 000 to 50 000 kroons shall be imposed. [24.11.1999]

§ 36.2. Procedure of matters regarding administrative offences

involving legal persons ➡

1. Administrative court judges shall hear administrative offence matters involving legal persons.
2. Matters regarding administrative offences which involve legal persons shall be conducted pursuant to the procedure provided for in the Code of Administrative Offences (RT 1992, 29, 396; RT I 1999, 41, 496; 45, rectification; 58, 608; 60, 616). [24.11.1999]

§36.3. Seizure ➡

1. Upon hearing matters regarding administrative offence referred to in § 361 of this Act, the following shall be subject to seizure:
 1. the means of committing administrative offence;
 2. the property acquired by committing administrative offence;
 3. the goods, packages, economic or business documents, advertising materials or user instruction designated, without the consent of the owner of the trademark, with a sign identical with or similar to a legally protected trademark used for the same or similar goods or services.
2. Upon entering into force of a decision on seizure, the items with unauthorised designation referred to in clause 3 of subsection 1 of this section are subject to destruction pursuant to procedure provided for in § 340 of the Code of Administrative Offences.
3. Confiscated counterfeit clothes and shoes, from which unwarranted indications have been removed, may be transferred to a medical care or welfare institution belonging to the state or government agency. The order of transfer of confiscated counterfeit clothes and shoes to a medical care or welfare institution belonging to the state or government agency is established by the regulation of the Minister of Financial Affairs. [24.11.1999; 06.06.2001]

§ 36.4. Preparation of administrative offence report for legal person ➡

1. In administrative offence matters specified in § 361 of this Act, officials of the following agencies have the right to prepare administrative offence reports according to their competence:
 1. [repealed - 05.06.2001]
 2. police authorities;
 3. Consumer Protection Board;
 4. Customs Board.
2. An administrative offence report shall set out the following:
 1. the date and place of preparation thereof;
 2. the name and address of the agency in whose name the report is prepared;
 3. the given name, surname and official title of the person who prepared the report;
 4. the name and address of the administrative offender;
 5. the given name, surname and position of the representative of the administrative offender;
 6. the time, place and description of the administrative offence;
 7. a reference to the provision of law which prescribes liability for the administrative offence;

8. an explanation from the representative of the administrative offender;
 9. a notation that the representative of the administrative offender has been advised of the right to obtain legal assistance;
 10. other information necessary for a correct decision in the administrative offence matter.
3. The official who prepares the report and the representative of the administrative offender shall sign the administrative offence report.
 4. If the representative of the administrative offender refuses to sign the administrative offence report, the person who prepares the report shall make a corresponding entry therein. Written notations made by the representative of the administrative offender concerning the report and reasons for refusal to sign the report shall be annexed to the administrative offence report. [24.11.1999]

§ 36.5. Stipulations for imposing administrative punishment on legal persons ➡

1. Administrative punishment imposed on a legal person for the use of a trademark for the same or similar good or service in cases specified in clauses 2 and 3 of subsection 5(3) of this Act, if the exclusive right of the owner of the trademark is infringed, is provided for in Consumer Protection Act (RT I 1994, 2, 13; 1999, 35, 450).
2. Administrative punishment imposed on a legal person for the use of a trademark for the same or similar good in cases specified in clause 4 of subsection 5(3) of this Act, if the exclusive right of the owner of the trademark is infringed, is provided for in Customs Act (RT I 1998, 3, 54; 1999, 86, 782). [24.11.1999]

IX. SPECIAL PROVISIONS ➡

§ 37. Registration of trademarks in foreign states ➡

1. Natural or legal persons of the Republic of Estonia shall register their trademarks in foreign states independently.
2. Natural or legal persons of the Republic of Estonia may register their trademarks in foreign states regardless of the registration thereof in the Republic of Estonia.
3. Persons in whose name a trademark has been registered in the Republic of Estonia or who have filed a trademark registration application, may file with the Patent Office an application for international registration of the trademark in respect of the same goods or services. An application for the international registration of a trademark may be filed by a person who is a citizen of the Republic of Estonia, has permanent residence in the Republic of Estonia within the meaning of the term "residence" in § 21 of the General Part of the Civil Code Act (RT I 1994, 53, 889; 89, 1516; 1995, 26-28, 355; 49, 749; 87, 1540; 1996, 40, 773; 42, 811) or who owns an industrial or commercial enterprise operating in Estonia within the meaning of the term "enterprise" in § 5 of the Commercial Code (RT I 1995, 26-28, 355; 1996, 52-54, 993; 1997, 16, 258; 48, 774; 77, 1313; 1998, 2, 48). [15.02.1995; 17.12.1997]

§ 37.1. International registration of trademarks ➡

1. International registration of trademarks within the meaning of this Act is the registration of trademarks in the International Register of the International Bureau of the World Intellectual Property Organization (hereinafter International Bureau) pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter the Madrid Protocol), adopted at Madrid on 27 June 1989.

2. Within the state, the Patent Office performs the duties resulting from the Madrid Protocol and is the Office of Origin and the Office of the Designated Contracting Party within the meaning of the Protocol.
3. Persons who apply for the international registration of a trademark or renewal of the international registration shall pay international fees pursuant to Article 8 of the Madrid Protocol directly to the International Bureau. [17.12.1997]

§ 37.2. Applications for international registration of trademarks and national processing thereof ➡

1. An application for international registration of a trademark (hereinafter international application) which is filed pursuant to subsection 37(3) of this Act, shall comply with the form and content requirements established in the Madrid Protocol and its Common Regulations.
2. An international application shall be filed with the Patent Office. The documents of the international application shall be filed in English.
3. A state fee shall be paid for the filing of an international application.
4. The Patent Office shall check the compliance of information in an international application with the information in the registration application which is the basis for the international application, or with the information concerning the valid registration of a trademark which is entered in the state register of trademarks and service marks.
5. The Patent Office shall confirm the correctness of the information in an international application and forward the application to the International Bureau.
6. The date and number of the international registration of an internationally registered trademark shall be entered in the state register of trademarks and service marks if the international application is made on the basis of a trademark registered in that register, or a notice shall be made in the registration application which is being processed if the international application is made on the basis of such application.
7. The Patent Office shall maintain a database of the documents of international applications which are approved for processing nationally and on the processing thereof.
8. The procedure for filing applications for the international registration of trademarks with the Patent Office is established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.
9. The database of applications for the international registration of trademarks and the national processing thereof is established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.
10. Information from the database of applications for the international registration of trademarks and the national processing thereof is available upon payment, with the exception of the release of information to state agencies with supervisory authority or to a court. A state fee shall be paid for the release of information. [17.12.1997]

§ 38. Registration of foreign trademarks on basis of international applications ➡

1. Trademarks legally protected in the Republic of Estonia by way of international registration are subject to the same legal regime and enjoy the same benefits as trademarks registered in the Republic of Estonia.
2. If the owner of a trademark registered earlier in the Republic of Estonia registers the trademark internationally to distinguish the same goods and services, the earlier registration shall be replaced by the international registration. This provision does not apply to the persons specified in subsection 37(3) of this Act.
3. If an international registration becomes invalid, the international registration in the Republic of Estonia shall become invalid on the same date.
4. If the international registration of a trademark becomes invalid, the same trademark may be registered in respect of the same goods or services in the Republic of Estonia

pursuant to the procedure specified in Chapter III of this Act commencing on the date of international registration if the trademark owner files a registration application for registration with the Patent Office within three months from the date of expiration of the international registration.

5. The Patent Office shall examine, pursuant to the provisions of this Act, the international registrations where the Republic of Estonia is the designated party.
6. The Patent Office shall notify the International Bureau within 18 months after the date of notice of the international registration of a trademark if the international registration does not satisfy the conditions for registration of trademarks provided for in this Act.
7. The Patent Office may notify of the refusal to grant legal protection to an international registration pursuant to Article 5(2)c of the Madrid Protocol after the expiry of 18 months from the date of notice of the international registration.
8. If the examination confirms that the international registration satisfies the conditions specified in this Act, notice of the international registration of a trademark shall be published in the official gazette of the Patent Office.
9. Any person may file an opposition against the international registration of a trademark at the Board of Appeal within two months after the date of publication of the notice of international registration of the trademark in the official gazette of the Patent Office. The Patent Office shall notify the International Bureau of such opposition.
10. The Patent Office shall maintain a database of international registrations of trademarks in which the Republic of Estonia is a designated party, and the national processing thereof.
11. The database of international registrations of trademarks and the national processing thereof is established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.
12. Information from the database of international registrations of trademarks and the national processing thereof is available upon payment, with the exception of the release of information to state agencies with supervisory authority or to a court. A state fee is charged for the release of information. [17.12.1997]

Excerpt from the Act of 17 December 1997

ACT AMENDING THE REPUBLIC OF ESTONIA TRADEMARK ACT ➡

II. Implementation of Act ➡

§ 28. Implementing provisions ➡

1. Unless otherwise provided in this Section, the provisions of this Act shall be applied to trademarks whose registration application is pending on the day of entering into force of this Act, or to trademarks that have been entered in the register before the entering into force of this Act.
2. The provisions of this Act shall not be applied while examining contests and appeals submitted before the entering into force of this Act against the decision of the Patent Office, the Board of Appeal and the court, and while making a new decision.
3. If the term for contest of the decision on registration of the trademark has expired or, upon contest, the contest procedure has ceased and the fee for entering of the trademark in the register has not been paid by the date of entering into force of this Act, the term referred to in subsection 14(1) of the Trademark Act shall be calculated as of the date of entering into force of this Act.

§ 31. Entry into force of Act ➡

This Act enters into force as of the day following the day of publishing it in the Riigi Teataja, except §§ 24 to 26 of this Act that enter into force on the date of entering into force of the Madrid Protocol with respect to the Republic of Estonia.