

## ***Principles of Legal Regulation of Industrial Property Act***

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(RT I 2003, 18, 98),

entered into force 1 January 2004.

### **Chapter 1. General Part ➔**

#### **§ 1. Scope of application of Act**

(1) This Act regulates the status of industrial property registers (hereinafter register) established pursuant to industrial property protection Acts (hereinafter industrial property Act), the registrar of such registers, the status and financing of the registrar, the status and financing of the Industrial Property Board of Appeal (hereinafter Board of Appeal) and regulates the maintenance of registers and the extra-judicial contestation of the decisions of the registrar and legal protection of objects of industrial property rights before the Board of Appeal.

(2) For the purposes of this Act, the following are objects of industrial property rights:

1) inventions registered pursuant to the Patents Act (RT I 1994, 25, 406; 1998, 74, 1227; 107, 1768; 1999, 84, 764; 2001, 27, 151; 93, 565; 2002, 53, 336), the Utility Models Act (RT I 1994, 25, 407; 2000, 60, 388; 2001, 27, 151; 2002, 53, 336; 63, 387) or the Implementation of the Convention of the Grant of European Patents Act (RT I 2002, 38, 233);

2) layout-designs of integrated circuits registered pursuant to the Layout-Designs of Integrated Circuits Protection Act (RT I 1998, 108/109, 1783; 2001, 27, 151; 93, 565; 2002, 53, 336);

3) trade marks and service marks (hereinafter trade mark) registered pursuant to the Trade Marks Act (RT 1992, 35, 459; RT I 1998, 15, 231; 1999, 93, 834; 102, 907; 2001, 27, 151);

56, 332 and 335; 2002, 49, 308; 63, 387);

4) industrial designs registered pursuant to the Industrial Designs Protection Act (RT I 1997, 87, 1466; 2002, 9, 45; 53, 336; 63, 387).

(3) The industrial property Acts referred to in subsection (2) of this section are specific Acts with regard to this Act.

## **§ 2. Nature of legal protection of industrial property**

(1) The objects of industrial property rights specified in subsection 1 (2) of this Act acquire legal protection as a result of registration pursuant to the appropriate industrial property Act or, in the case provided for in an industrial property Act, as a result of the recognition of exclusive rights created on another basis.

(2) Exclusive right to a registered object of industrial property rights belongs to the person who is entered in the register as the owner.

(3) Legal protection of industrial property consists of the recognition and protection of the exclusive rights of the owner of an object of industrial property rights with legal means. No person has the right to commence misdemeanour or criminal proceedings against another person for the protection of the exclusive right of an owner or file a claim for compensation for damage caused as a result of an infringement of the exclusive right without a claim from the owner or without the owner's knowledge and permission.

## **§ 3. Definitions**

For the purposes of this Act:

1) "application" means a registration application filed pursuant to an industrial property protection Act in order to have legal protection granted to an object of industrial property rights. Where patent protection is applied for, "application" shall mean a patent application;

2) "applicant" means a person or the legal successor of a person who has filed an application to have legal protection granted to an object of industrial property rights;

3) "owner" means a person in respect of whom the last entry as the owner of an object of industrial property rights which is subject to legal protection has been made in a register;

4) "industrial property Act" means a specific Act which provides for the legal protection of objects of industrial property rights;

5) "international agreements" means industrial property conventions and other international agreements which apply to Estonia;

6) "Board of Appeal" means the Industrial Property Board of Appeal in accordance with Chapter 4 of this Act.

## **[Chapter 2. Registers](#) ➔**

## **Division 1. General Provisions →**

### **§ 4. Purpose of registers**

(1) The main purpose of the registers is the registration and disclosure, in the public interest, of objects of industrial property rights and owners thereof.

(2) The purpose of the registers is also to inform the public about application for legal protection to objects of industrial property rights, the grant and validity of legal protection, the transfer of rights and other acts related to objects of industrial property rights.

### **§ 5. Status and official names of registers**

(1) By this Act, state registers established pursuant to industrial property Acts are granted the status of general national registers within the meaning of the Databases Act (RT I 1997, 28, 423; 1998, 36/37, 552; 1999, 10, 155; 2000, 50, 317; 57, 373; 92, 597; 2001, 7, 17; 17, 77; 2002, 61, 375; 63, 387).

(2) Official names of the registers are as follows:

- 1) register of patents;
- 2) register of utility models;
- 3) register of European patents valid in Estonia;
- 4) register of layout-designs of integrated circuits;
- 5) register of trade and service marks;
- 6) register of industrial designs.

### **§ 6. Basis of maintenance of registers**

(1) Registers shall be maintained pursuant to this Act, the appropriate industrial property Acts and other Acts. Where an issue relating to the legal protection of industrial property is not regulated by law or international agreements, guidance shall be taken from the practice of implementation of European law or national law in European countries.

(2) The provisions of the Databases Act or other Acts do not apply to registers and maintenance thereof if this Act or an industrial property Act provides otherwise.

### **§ 7. Registrar**

The registers are maintained by the Patent Office.

### **§ 8. Composition of registers**

(1) Each register comprises a database and registry files.

(2) A database consists of records. A record contains information pertaining to all register

acts related to an application and the object of industrial property rights which is granted legal protection on the basis of the application from the opening of the record upon acceptance of the application for processing until closing of the record upon the termination or revocation of legal protection. Records are identified by application numbers.

(3) Each record includes a registry file. All documents referred to in a record are kept in the registry file. Temporarily, documents which are related to the processing of an application and are intended for internal use by the Patent Office and any business secrets related to an object of industrial property rights which have been separated from an application at the request of the applicant and, in the cases provided by law, documents containing personal data not subject to disclosure may also be kept in the registry file as long as is necessary, provided that confidentiality thereof is guaranteed.

### **§ 9. Working language**

(1) The language of the registers is Estonian. Documents in foreign languages shall be submitted to the Patent Office together with a translation into Estonian.

(2) The Patent Office has the right to postpone performance of the obligation to submit translations of documents or not to request the submission of a translation if the due date for the submission of a translation of this document is not specified in the appropriate industrial property Act.

(3) Where subsection (2) of this section applies, the person who submitted a document in a foreign language shall submit the translation at the request of the Patent Office, the Industrial Property Board of Appeal, a court or an interested party within two months as of the date of submission of the request. Upon failure to submit a translation, the document shall be deemed not to have been submitted.

### **§ 10. Access to registers**

(1) As of the date on which the Patent Office makes an application public, records contained in the database and the registry files belonging thereto shall be available to the public, taking into consideration the restrictions provided for in the industrial property Act. The date on which the Patent Office makes an application public shall be the publication date of the application, publication date of the notice of the decision concerning registration or publication date of the notice concerning registration, depending on the industrial property Act.

(2) Information in the database pertaining to or documents in a registry file concerning an application which has not been made public by the Patent Office shall not be used as the basis for commencing misdemeanour or criminal proceedings or used as evidence when conducting proceedings in a misdemeanour or criminal matter or used to stop a presumed offence and file a claim for compensation for damage caused as a result of an infringement of a presumed exclusive right.

### **§ 11. Inviolability of registers**

(1) It is prohibited to remove register records, including original paper documents in registry files and technical equipment used in the maintenance of registers, from the premises of the Patent Office. Original paper documents in registry files may only be seized in the course of criminal proceedings in order to verify the authenticity of a document or signature. The document which is being verified shall be replaced with a copy for the duration of the seizure.

(2) The processing of data in the database or documents in registry files for commercial purposes, including making copies thereof, without the permission of the registrar is prohibited.

## ***Division 2. Maintenance of Registers →***

### **§ 12. Register acts**

(1) Register acts are acts related to the maintenance of a register.

(2) The following are types of register acts:

- 1) opening of a record and entry of application data in a register;
- 2) entry of data pertaining to procedural acts in a register;
- 3) entry of data pertaining to the grant of legal protection to an object of industrial property rights (registration data) in a register;
- 4) entry of amendments to registration data in a register;
- 5) entry of new registration data as a result of the division of a registration in a register;
- 6) entry of data pertaining to the continued validity or renewal of a registration in a register;
- 7) entry of data pertaining to a licence or pledge in a register;
- 8) disclosure of information entered in a register and issue of protection documents;
- 9) release of data from a register;
- 10) closing of a record (deletion of the registration from the register).

(3) Register acts are prescribed by this Act, industrial property Acts and regulations of the Government of the Republic and ministers established on the basis thereof.

### **§ 13. Procedural acts**

(1) Procedural acts are acts performed with an application received by the Patent Office after acceptance of the application for processing until a decision concerning the grant of legal protection is made, the application is rejected, the application is withdrawn or deemed to be withdrawn.

(2) Procedural acts are prescribed by the corresponding industrial property Act and international agreements and legislation established on the basis thereof.

### **§ 14. Data entered in register and types thereof**

(1) Data to be entered in a register are prescribed by industrial property Acts, international agreements and this Act and other legislation established on the basis thereof.

(2) Data shall be entered in a database in the form of entries and notations.

### **§ 15. Entries**

(1) Data, as determined by an industrial property Act, international agreements or legislation established on the basis thereof, pertaining to the creation, changing and extinguishment of rights in respect of an object of industrial property rights, procedural and register acts related thereto and documents which reflect such acts have the legal effect of an entry.

(2) Types of entries related to procedural and register acts are:

1) entries of application data;

2) entries to amend application data;

3) entries of registration data;

4) entries to amend registration data;

5) entries of data pertaining to licences and pledges;

6) entries concerning the renewal of registrations, the validity or term of validity of the legal protection of objects of industrial property rights;

7) entries to delete registrations;

8) entries concerning the publication of notices of procedural and register acts related to the creation, changing and extinguishment of rights in respect of objects of industrial property rights in the official gazette of the Patent Office.

(3) Documents which reflect procedural and register acts and concerning which entries shall be made in a register are:

1) written notices, inquiries and decisions concerning the setting of terms which are issued to applicants by the Patent Office;

2) written notices, explanations and applications received in response to letters from the Patent Office as specified in clause 1) of this subsection;

3) written applications pertaining to the progress of the processing of an application which are filed on the initiative of an applicant;

4) applications pertaining to the amendment of registration data, registration of a licence or pledge, renewal of a registration or termination of legal protection.

### **§ 16. Notations**

(1) Facts, as determined by an industrial property Act, international agreements or legislation established on the basis thereof, which must be taken into consideration in the processing of an application or performance of register acts or which the registrar deems necessary to disclose in the public interest have the legal effect of a notation.

(2) Notations are a preliminary notation, objection, prohibition and comment.

(3) A preliminary notation shall be entered in a database on the basis of a notice or application of an applicant, owner or another person in order to secure the making of an entry concerning a right provided for in an industrial property Act or another Act in the future. A preliminary notation shall be made, among other things, concerning the receipt of an application or a request for the division of a registration.

(4) A notice concerning the filing of an appeal, revocation application, challenge or an action received from an applicant, owner, the Board of Appeal or a court shall be entered in a database as an objection in order to inform the Patent Office and the general public about possible amendments to the entry in the register.

(5) A prohibition shall be entered in a database on the basis of a notice, application, decision, judgment or ruling of an applicant, owner, another person or a court in order to secure a right provided for in an industrial property Act or another Act or prevent an offence. A prohibition shall be made, among other things, in the cases provided for in an industrial property Act if disclosure of the name of the author is prohibited, in order to restrict or prohibit disposal of an object of industrial property rights in connection with the registration of a licence or pledge or in connection with the bankruptcy of the owner if the object of industrial property rights is included in the bankruptcy estate.

(6) The Patent Office shall enter a prohibition in a database on its own initiative if facts relating to a procedural act or an entry affect the course of subsequent procedural acts or if legal basis which precludes the making of certain entries has arisen.

(7) A comment shall be entered in a database on the basis of an application of an applicant, owner or another person or on the Patent Office's own initiative if disclosure thereof is in the public interest. The transfer of the processing of an application and performance of register acts from a competent official to another and information regarding the identification of the official shall also be entered in the database as a comment.

#### **§ 17. Persons who submit data to register**

(1) Data shall be submitted to a register by applicants, owners, other persons, the Board of Appeal and courts within the competence provided by an industrial property Act.

(2) Data submitted by an unentitled person shall be forwarded to an applicant or owner for an opinion if such data are significant for the processing of an application or validity of the legal protection of an object of industrial property rights. A comment shall be entered in the database concerning the submission and forwarding of the data.

#### **§ 18. Liability for correctness of data**

A person who submits data shall be responsible for the correctness thereof. Persons who submit false information shall be liable for damage wrongfully caused.

#### **§ 19. Submission of confidential information**

(1) In the cases provided by an industrial property Act, a person who submits data may specify submitted information as confidential.

(2) Confidential information must be clearly specified by the person who submits the

information.

(3) Information subject to public disclosure, such as the following, shall not be specified as confidential information:

1) information needed to define the nature of an object of industrial property rights, the scope of legal protection and bases for the grant thereof;

2) information pertaining to an applicant, as of the making of the application public pursuant to an industrial property Act;

3) information pertaining to an owner;

4) information pertaining to a licensee and the extent of rights granted to the licensee and the term of validity thereof;

5) information pertaining to a pledgee and the nature, amount of and term for performance of a claim secured by the pledge.

(4) Confidential information shall not be preserved in a register, except information pertaining to authors in the cases provided by law. Such information shall be disclosed with the permission of the person who submitted the information, destroyed once it is no longer needed in connection with processing or returned to the person who submitted the information.

## **§ 20. Liability of Patent Office upon disclosure of confidential information**

(1) The Patent Office is required to ensure the protection of confidential information specified pursuant to subsection 19 (2) of this Act until the person who submitted the information grants permission for disclosure thereof, the information is destroyed once it is no longer needed in connection with processing or returned to the person who submitted the information.

(2) The Patent Office shall bear liability in the event of disclosure of confidential information or allowing any person to examine confidential information without the permission of the person who submitted the information. An official shall be liable for damage wrongfully caused by the official.

## **§ 21. Data protection requirements**

(1) The Patent Office shall ensure the integrity and authenticity of register data and the processing, protection, preservation and archival processing of the database using organisational and technical measures. A back-up copy of the database must be made periodically.

(2) The Patent Office is required to:

1) prevent the unauthorised recording of register data and unauthorised alteration or erasure of recorded register data;

2) prevent unauthorised transmission of register data by means of data communication equipment and access to confidential information;



3) ensure that it be subsequently possible to determine when, by whom and which register data were input or altered.

### ***Division 3. General Procedure for Performance of Register Acts ➡***

#### **§ 22. Competent person**

(1) Register acts are performed by an authorised official of the Patent Office. Authorisation shall be granted by the job description in accordance with the statutes of the Patent Office and the statutes of the structural unit.

(2) If the performance of a register act is transferred from an official to another, a comment shall be entered in the register pursuant to subsection 16 (7) of this Act.

#### **§ 23. Receipt of documents**

(1) An inscription shall be made on each document received and the inscription shall contain the actual date of receipt of the document by the Patent Office. An inscription may contain additional information concerning the record which the document belongs to.

(2) If a document is submitted on paper and is not bound, an inscription shall be made on each page; if a document is bound, an inscription may be made only on the first page.

#### **§ 24. Verification of documents**

(1) The verification of a document shall begin with the identification of the person who submitted the document and the purpose of submission thereof. If it is impossible to identify the person who submitted a document, the document shall be disregarded. If it is impossible to identify the purpose of submission of a document, an inquiry shall be sent to the person who submitted the document for clarification to be given and verification of the document shall be suspended.

(2) After identification of the person who submitted a document and the purpose of submission thereof, it shall be verified whether the person has the right to submit such a document, except the right of a person who filed an application to apply for legal protection to an object of industrial property rights. In the case of documents filed through a representative, the scope and validity of the representative's authorisation to perform an act pursuant to the provisions of an industrial property Act shall be verified. If the person who submitted a document has no right to submit such documents, the person shall be notified thereof and verification of the document shall be suspended. In the specified case, the provisions of subsection 17 (2) of this Act apply.

(3) If the right to submit a document exists, compliance with the formal requirements established for the document shall be verified. The person who submitted a document shall be notified of any formal deficiencies in the document and processing of the document shall be suspended. If a digital document is submitted in a format allowing the alteration of data set out therein, the document shall be converted to a format where such alteration of data is precluded.

(4) The date of receipt of a document and relevant information pertaining thereto shall be entered in the database in the form of an entry or notation in accordance with the provisions of §§ 15 and 16 of this Act.

(5) A document shall be processed with regard to its content pursuant to the corresponding industrial property Act and the statutes of the register established on the basis thereof.

#### **§ 25. Opening of record and entry of application data in register**

(1) A record shall be opened upon acceptance of an application for processing.

(2) Upon the opening of a record, the following entries shall be made in the database:

- 1) entry of the application number;
- 2) entry of the filing date of the application;
- 3) entry of data set out in the application for legal protection;
- 4) entry concerning documents submitted.

(3) A registry file shall be opened upon the opening of a record.

#### **§ 26. Entry of data pertaining to procedural acts in register**

(1) The following entries or notations pertaining to procedural acts shall be made in a database:

- 1) concerning procedural acts performed;
- 2) concerning documents received and issued;
- 3) concerning terms set by the Patent Office.

(2) Register entries specified in subsection (1) of this section shall be made pursuant to the provisions of the corresponding industrial property Act.

#### **§ 27. Entry of data pertaining to grant of legal protection to objects of industrial property rights in register**

(1) An entry concerning the grant of legal protection to an object of industrial property rights (registration entry) shall be made in a register on the basis of a decision of a competent official of the Patent Office.

(2) Upon the grant of legal protection, an object of industrial property rights shall be assigned a unique number (registration number) and the term of legal protection together with other information prescribed by an industrial property Act shall be entered in the register.

#### **§ 28. Entry of amendments to registration data in register**

(1) As a result of changes in registration data, the following shall be entered in a database:

- 1) data of a petition for an entry;

2) new data or data pertaining to a new document;

3) data of the notice concerning changes made which is issued to the person who submitted a petition for an entry and the publication date of the notice concerning changes if so prescribed by an industrial property Act;

4) data of the notice concerning refusal to make an entry which is issued to the person who submitted a petition for an entry if the making of an entry is refused.

(2) In the case of changes arising from the division of a registration, a corresponding comment and the number of the new registration made on the basis of the separated part shall be entered in the database.

### **§ 29. Entry of new registration data as result of division of registration in register**

(1) Each registration created as a result of a division shall be assigned a new registration number and a new record shall be opened in the register concerning such registration.

(2) The data of a new registration shall be submitted on the basis of the earlier registration. The new registration shall contain a reference to the earlier registration.

(3) If the division of a registration is accompanied by the transfer of the object of industrial property rights, the provisions of the industrial property Act concerning the transfer of objects of industrial property rights apply.

### **§ 30. Entry of data pertaining to continued validity or renewal of registration in register**

(1) An entry concerning the continued validity or renewal of a registration shall be made in the register provided that all conditions prescribed by an industrial property Act are met.

(2) Data of the petition for an entry, the amount of state fee paid and the date of payment thereof shall be entered in the database.

### **§ 31. Registration of licence or pledge in respect of object of industrial property rights**

(1) If an object of industrial property rights is encumbered with a pledge, data on the pledgee, the nature, amount of and term for performance of a claim secured by the pledge shall be entered in the register.

(2) A pledge shall be deleted from the register upon termination of the claim secured by the pledge or waiver of the pledge. If a pledge is waived, the provisions concerning the pledging of industrial property apply taking into consideration the specifications arising from the nature of the entry.

(3) If a licence is issued in respect of an object of industrial property rights, data pertaining to the licensee and the nature, scope and term of the licence shall be entered in the register accompanied by other conditions entry of which in the register is deemed necessary.

### **§ 32. Disclosure of information entered in register**

Information entered in a register shall be published in the official gazette of the Patent Office pursuant to the procedure prescribed by an industrial property Act.

### **§ 33. Closing of record**

(1) A record and the registry file belonging thereto shall be closed if:

- 1) an application is withdrawn, deemed to be withdrawn or rejected;
- 2) the registration expires due to expiry of the term of legal protection or the owner waiving legal protection;
- 3) the registration is revoked.

(2) Closed records shall be preserved permanently.

(3) Closed records shall be public unless a record was closed before the application was made public pursuant to an industrial property Act.

## **Chapter 3. Patent Office** ➔

### **§ 34. Status of Patent Office**

(1) The Patent Office is the government agency which exercises executive power and implements the policies of the Government of the Republic in the field of legal protection of industrial property and which is the central office in the field of legal protection of industrial property within the meaning of paragraph (1) of Article 12 of the Paris Convention for the Protection of Industrial Property (RT II 1994, 4/5, 19), taking into consideration the provisions of paragraph (1) of Article 2 of the Agreement on Trade-Related Aspects of Intellectual Property Rights in Annex 1C to the WTO Agreement (RT II 1999, 22, 123).

(2) In the performance of its functions, the Patent Office represents the state.

### **§ 35. Functions of Patent Office**

(1) The functions of the Patent Office are as follows:

1) the acceptance and processing of applications pursuant to industrial property Acts or international agreements, including the conduct of expert assessments in the cases prescribed by industrial property Acts or international agreements, the making of decisions concerning the grant of legal protection to objects of industrial property rights, the maintenance of industrial property registers, the issue of official publications and protection documents;

2) the performance of other functions in the field of legal protection of industrial property assigned by law or international agreements.

(2) Pursuant to international agreements, the Patent Office shall:

- 1) organise international co-operation in the field of legal protection of industrial property;

2) participate in the work of the World Intellectual Property Organization and the European Patent Organization;

3) co-operate with the institutions of the legal protection of industrial property of other countries.

### **§ 36. Independence of Patent Office**

(1) The Patent Office shall be independent in the performance of the functions specified in § 35 of this Act, including the making of decisions concerning the grant of legal protection to objects of industrial property rights and the use of decision-making methodology. The Patent Office shall comply with court judgments and the decisions of the Board of Appeal.

(2) Supervisory control shall not restrict the independence of the Patent Office in the performance of functions imposed on the Patent Office by law or an international agreement.

### **§ 37. Budget and financing of Patent Office**

(1) The Patent Office is financed from the state budget and funds of the World Intellectual Property Organization and the European Patent Organization intended for specific purposes.

(2) The Patent Office has bank accounts within the group account of the State Treasury and special accounts for the use of funds intended for specific purposes referred to subsection (1) of this section.

## **Chapter 4. Board of Appeal** ➔

### ***Division 1. General Provisions*** ➔

#### **§ 38. Status of Board of Appeal**

(1) The Board of Appeal is an extra-judicial independent body.

(2) The possibilities of filing appeals against decisions of the Patent Office with a court are not limited.

#### **§ 39. Competence of Board of Appeal**

(1) In the cases prescribed by industrial property Acts, the Board of Appeal shall:

1) resolve appeals filed by applicants in order to contest decisions of the Patent Office;

2) settle disputes between an interested party and an applicant or owner on the basis of an application of the interested party (hereinafter revocation application).

(2) The Board of Appeal acts in accordance with this Act, industrial property Acts, international agreements and regulations of the Government of the Republic and ministers. Where an issue relating to the legal protection of industrial property is not regulated by law or international agreements, guidance shall be taken from the practice of implementation of

European law or national law in European countries.

(3) Damage caused by the unlawful action of the Board of Appeal shall be compensated for by the state.

#### **§ 40. Formation and membership of Board of Appeal**

(1) The Board of Appeal shall be formed at the Ministry of Economic Affairs and Communications.

(2) The Minister of Economic Affairs and Communications shall establish the statutes of the Board of Appeal which prescribe the following:

- 1) the procedure for filing an appeal or revocation application;
- 2) rules of procedure of the Board of Appeal, and
- 3) the procedure for remuneration of the members of the Board of Appeal.

(3) The Board of Appeal shall consist of at least eight members. The members must have completed an academic higher education and they must be experts in the field of industrial property. Half of the members must have an academic degree in law. Members of the Board of Appeal, including the chairman and deputy chairman, shall be appointed by the Minister of Economic Affairs and Communications.

(4) In the absence of the chairman of the Board of Appeal, the deputy chairman shall substitute for the chairman of the Board of Appeal.

#### **§ 41. Working language**

The working language of the Board of Appeal is Estonian. Documents which are not in Estonian shall be submitted to the Board of Appeal together with an Estonian translation pursuant to subsection 9 (3) of this Act.

#### **§ 42. Working conditions of Board of Appeal**

(1) The working conditions of the Board of Appeal, including working premises and clerical support, shall be provided by the Ministry of Economic Affairs and Communications.

(2) The administrative expenditure of the Board of Appeal and expenses related to the resolution of appeals and revocation applications shall be covered from the state budget out of the funds allocated to the Ministry of Economic Affairs and Communications for these purposes.

(3) Documents of the Board of Appeal shall be permanently preserved in the archives of the Ministry of Economic Affairs and Communications.

### ***Division 2. Appeal and Revocation Application ➡***

#### **§ 43. Filing of appeal or revocation application**

(1) A written appeal or revocation application together with documents appended thereto

shall be addressed to the Board of Appeal and filed taking into account the terms provided for in the relevant industrial property Act.

(2) If a written appeal or revocation application is filed after expiry of the term, the chairman of the Board of Appeal may restore the term provided that an application for the restoration of the term and explanations concerning the good reason which caused the term to expire have been submitted.

(3) An application or another document submitted to the Board of Appeal shall be disregarded if it contains improper or insulting expressions towards the Board of Appeal, the Patent Office or a third party.

#### **§ 44. Requirements for appeals and revocation applications**

(1) An appeal shall set out:

- 1) the name and address of the person who filed the appeal (hereinafter appellant) and, if the appellant so wishes, other details;
- 2) the name of the representative of the appellant if the appellant has a representative;
- 3) information pertaining to the contested decision of the Patent Office;
- 4) the appellant's grounds for considering the decision of the Patent Office to be unlawful;
- 5) the claim of the appellant;
- 6) a list of annexes to the appeal;
- 7) the signature of the appellant or the representative of the appellant.

(2) A revocation application shall set out:

- 1) the name and address of the person who filed the revocation application and, if the person so wishes, other details;
- 2) the name of the representative of the person who filed the revocation application if the person has a representative;
- 3) information pertaining to the contested object of industrial property rights;
- 4) the grounds based on which the person who filed the revocation application claims that an offence has taken place;
- 5) the claim of the person who filed the revocation application;
- 6) a list of annexes to the revocation application;
- 7) the signature of the person who filed the revocation application or of the person's representative.

(3) The following shall be appended to an appeal or revocation application:

- 1) information concerning payment of the state fee;
- 2) an authorisation if the appeal or revocation application is filed by a representative;
- 3) evidence which proves the facts on which the appeal or revocation application is based.

#### **§ 45. Registration of appeals and revocation applications**

(1) An inscription shall be made on an appeal, revocation application and documents received by the Board of Appeal later and the inscription shall contain the date of receipt and the serial number of the appeal or revocation application.

(2) Within fifteen days, the chairman of the Board of Appeal shall verify, based on the information set out in an appeal or revocation application, whether the appeal or revocation application falls within the competence of the Board of Appeal, whether the term for filing an appeal or revocation application is complied with and whether the appeal or revocation application meets the form and content requirements.

(3) If the chairman of the Board of Appeal finds that an appeal or revocation application contains deficiencies which can be eliminated, the appellant or the person who filed the revocation application shall be notified thereof immediately in writing and a term of fifteen days shall be set for the elimination of deficiencies. The Board of Appeal may request the original documents of an appeal or revocation application submitted by fax.

(4) The Board of Appeal may extend the term for the elimination of deficiencies of an appeal at the reasoned written request of the appellant or the person who filed the revocation application.

#### **§ 46. Correction and amendment of appeal or revocation application**

(1) An appellant or the person who filed a revocation application may, until the beginning of final processing, make corrections or amendments to the appeal or revocation application on the basis of a reasoned written request provided that such corrections or amendments do not extend the basis or content of the claim as set out in the appeal or revocation application on the filing date thereof.

(2) In the cases prescribed by industrial property Acts, an applicant or owner may restrict the scope of legal protection and request that an appeal or revocation application be processed based on the new scope of legal protection.

#### **§ 47. Withdrawal and rejection of appeal or revocation application**

(1) An appellant or the person who filed a revocation application may withdraw the appeal or revocation application before the beginning of final processing by submitting a corresponding written application. An appeal or revocation application shall be withdrawn as of the date of receipt of the corresponding application by the Board of Appeal.

(2) An appeal or revocation application shall be deemed to be withdrawn if the appellant or the person who filed the revocation application fails to respond within the term specified in subsection 45 (3) or (4) of this Act.



(3) An appeal or revocation application shall be rejected by a decision made by the chairman of the Board of Appeal alone if the appeal or revocation application does not fall within the competence of the Board of Appeal, is not filed within the term or if the appellant or the person who filed the revocation application fails to eliminate the deficiencies in the appeal or revocation application within the term specified in subsection 45 (3) or (4) of this Act. A copy of the decision shall be immediately sent to the appellant or the person who filed the revocation application.

(4) A decision of the Board of Appeal made by a person sitting alone shall set out:

- 1) the name of the Board of Appeal and the type of decision;
- 2) a reference to the appeal or revocation application and the person who filed it;
- 3) a reference to the Acts applied in making the decision;
- 4) the grounds for the decision;
- 5) the conclusion;
- 6) information on the procedure and term for appeal against the decision;
- 7) the date and place the decision is made;
- 8) the name and signature of the person making the decision.

(5) In the case specified in subsection (1) of this section, if an application for the withdrawal of an appeal or revocation application is received by the Board of Appeal before the appeal or revocation application is accepted for processing, the appellant or the person who filed the revocation application is entitled to a refund of the paid state fee.

(6) The state fee shall not be refunded in the cases specified in subsections (2) and (3) of this section. In the case specified in subsection (1), the state fee shall not be refunded if the application for the withdrawal of an appeal or revocation application was received by the Board of Appeal after the appeal or revocation application was accepted for processing.

### ***Division 3. Proceedings before Board of Appeal ➡***

#### **§ 48. Acceptance of appeal or revocation application for processing**

(1) If the chairman of the Board of Appeal finds that an appeal or revocation application falls within the competence of the Board of Appeal, is filed within the term and meets the form and content requirements, the chairman shall decide to accept the appeal or revocation application for processing.

(2) The acceptance of an appeal or revocation application for processing shall be prepared as a conclusion. A conclusion shall be dated and signed by the chairman of the Board of Appeals.

(3) An appellant or the person who filed a revocation application shall be notified immediately of the acceptance of the appeal or revocation application for processing. A notice concerning the acceptance of an appeal or revocation application for processing

shall be published on the website of the Board of Appeal.

#### **§ 49. Preliminary processing**

(1) Within five days as of the acceptance of an appeal or revocation application for processing, the chairman of the Board of Appeal shall appoint a competent member of the Board of Appeal to conduct preliminary processing (hereinafter person conducting preliminary processing) whose task is to provide the Board of Appeal with an overview of the factual information and legal facts pertaining to the appeal or revocation application and opinions of the participants in the proceedings.

(2) In the course of preliminary processing of an appeal, the person conducting preliminary processing shall examine any information in the register pertaining to the contested decision. In the course of preliminary processing of a revocation application, the person conducting preliminary processing shall examine any information in the register pertaining to the contested object of industrial property rights.

(3) The person conducting preliminary processing shall prepare an overview in writing within three months as of the acceptance of an appeal or revocation application for processing and submit the dated and signed overview to the chairman of the Board of Appeal. The person conducting preliminary processing has the right to amend and supplement the overview.

(4) In the course of preliminary processing, the chairman of the Board of Appeal shall make decisions of the Board of Appeal sitting alone, pursuant to the provisions of subsection 47 (4) of this Act. A copy of a decision shall immediately be sent to the participants in proceedings.

#### **§ 50. Participants in proceedings before Board of Appeal**

(1) The appellant and the Patent Office are the participants in proceedings in the processing of an appeal by the Board of Appeal.

(2) The person who filed a revocation application and an applicant or owner are the participants in proceedings in the processing of a revocation application by the Board of Appeal.

(3) Participants in proceedings have the right to perform the following acts either in person or, pursuant to the provisions of an industrial property Act, through a representative:

- 1) submit a written opinion on an appeal or revocation application;
- 2) submit additional documents and applications and provide explanations;
- 3) pose questions to other participants in the proceedings;
- 4) request removal of a member of the Board of Appeal.

#### **§ 51. Written opinions of participants in proceedings**

(1) Upon the acceptance of an appeal or revocation application for processing, the Board of Appeal shall send a copy of the appeal or revocation application to the other participant in the proceedings and make a proposal to the other participant in the proceedings to submit a

written opinion within three months as of the date of acceptance of the appeal or revocation application for processing.

(2) Written opinions shall be addressed to the Board of Appeal and shall contain the name and address of the person who submitted the opinion, a reference to the appeal or revocation application and shall be reasoned.

(3) A written opinion submitted by a participant in a proceeding shall be immediately forwarded to the other participant in the proceeding who has the right to respond to the opinion in writing within three months.

(4) The fact that a participant in a proceeding has failed to submit a written opinion or respond to a question shall not hinder the making of a decision.

#### **§ 52. Submission of additional documents**

(1) The Board of Appeal may request additional documents on its own initiative or on the basis of the application of a participant in a proceeding.

(2) Participants in proceedings shall submit any additional documents requested within three months as of the date on which the request for additional documents is made.

(3) Additional documents shall be immediately forwarded to the other participant in the proceeding who has the right to submit an opinion within three months.

(4) If participants in proceedings fail to submit the requested additional documents, a decision shall be made on the basis of the facts which have been revealed.

#### **§ 53. Combining of separate claims which are related**

(1) The chairman of the Board of Appeal has the right to combine several separate claims which are related.

(2) If several separate, related claims are combined in one proceeding, a separate decision may be made on each claim if this expedites the review of the matter.

(3) In a joined proceeding of several claims against one respondent a partial decision shall not be made if the respondent contests this with good reason.

#### **§ 54. Suspension, resumption and termination of processing**

(1) The Board of Appeal may suspend the processing of an appeal or revocation application in the cases of suspension of proceedings prescribed by the Code of Administrative Court Procedure (RT I 1999, 31, 425; 33, correction notice; 40, correction notice; 96, 846; 2000, 51, 321; 2001, 53, 313; 58, 355; 2002, 29, 174; 50, 313; 53, 336; 62, 376) or on the basis of a corresponding request from a participant in the proceeding.

(2) The Board of Appeal shall decide on the resumption of processing if the circumstances which caused the suspension cease to exist.

(3) The Board of Appeal may make a decision to terminate the processing of an appeal or revocation application if it becomes evident that the information is not sufficient to make a

decision or if the person who filed the appeal or revocation application gives notice of the person's wish to discontinue the appeal or revocation application.

(4) In the case of a decision specified in subsection (3) of this section, the appellant has the right to appeal against the decision of the Patent Office to an administrative court pursuant to the procedure provided for in the Code of Administrative Court Procedure within thirty days after the decision to terminate the processing by the Board of Appeal is made. The court shall decide on the refund of the state fee.

### **§ 55. Final processing**

(1) The person conducting preliminary processing may make a proposal to commence final processing after the person has examined the written opinions of the participants in the proceeding and granted the participants in the proceeding a term of one month for the submission of final opinions.

(2) Participants in proceedings have the right to submit a proposal for oral proceedings (hereinafter meeting) to be conducted in respect of an appeal or revocation application; in such case they shall justify the need for a meeting.

(3) On the basis of the proposal of the person conducting preliminary processing, the chairman of the Board of Appeal shall make a decision to commence final processing and, if necessary, decide on the holding of a meeting, the membership of the Board of Appeal conducting proceedings concerning an appeal or revocation application and appoint the presiding member of the Board. If it is necessary to hold a meeting, the time and place of the meeting shall be set out in the decision to commence final processing. A notice concerning final processing shall be published on the website of the Board of Appeal.

(4) In final processing, proceedings in respect of an appeal or revocation application shall be conducted by a panel of three members of the Board of Appeal. The person who conducted preliminary processing shall be one of the members of the panel.

(5) Participants in a proceeding shall be immediately notified of the commencement of final processing and the membership of the panel conducting proceedings in respect of an appeal or revocation application and the time and place of the meeting.

(6) If the holding of a meeting is not deemed necessary, the Board of Appeal shall make a decision not earlier than fifteen days and not later than thirty days after the commencement of final processing.

### **§ 56. Time of meeting and postponement of meeting**

(1) A meeting shall be held not earlier than fifteen days and not later than thirty days after the date on which the time and place of the meeting were determined.

(2) The Board of Appeal may postpone a meeting if a participant in a proceeding submits a reasoned request to that effect or if additional documents need to be requested from a participant in a proceeding.

(3) If a meeting is postponed, participants in the proceeding shall be notified of the new time and place of the meeting and a notice containing that information shall be published on the website of the Board of Appeal.

(4) If a meeting is postponed, it shall be held not earlier than ten days but not later than forty-five days after the date of receipt of the additional documents by the Board of Appeal.

### **§ 57. Meeting**

(1) A meeting of the Board of Appeal shall be chaired by the presiding member of the panel. Minutes shall be taken of the meetings.

(2) A meeting shall include the following:

- 1) identification of the persons present and verification of their authorisation;
- 2) submission and resolution of requests for removal and any other requests of participants in the proceeding;
- 3) a summary of the final overview presented by the person who conducted preliminary processing;
- 4) opinions of and discussion between participants in the proceeding;
- 5) posing of questions by participants in the proceeding and the Board of Appeal and responses thereto.

(3) The failure of a participant in a proceeding or a representative of such participant to appear at a meeting does not constitute an impediment to the processing of an appeal or revocation application if the participant in the proceeding has been notified of the time and place of the meeting and the membership of the panel of the Board of Appeal and the participant has not given notice of any significant circumstances which may prevent the participant's presence at the proceedings.

(4) If a participant in a proceeding introduces supplementary evidence at a meeting and explains why earlier submission of such evidence was impossible and the Board of Appeal considers that such evidence must be taken into consideration, the Board of Appeal shall adjourn the meeting and set a new time and place for the meeting.

(5) If the participants in a proceeding have given their statements to the Board of Appeal and answered all questions, and continuation of the discussion is not requested by any participants in the proceeding, the hearing of the appeal or revocation application shall be terminated and the Board of Appeal shall make a decision.

### **§ 58. Removal of member of Board of Appeal**

(1) A member of the Board of Appeal who is personally interested in the outcome of an appeal or revocation application shall be removed on the basis of a reasoned request for removal presented by a participant in the proceeding. Unless otherwise provided by this Act, the provisions of § 10 of the Administrative Procedure Act (RT I 2001, 58, 354; 2002, 53, 336; 61, 375) apply to removal.

(2) Requests for removal may be submitted within ten days as of the date on which the membership of the panel of the Board of Appeal is announced. A request for removal may also be submitted during a meeting before the commencement of the hearing of the appeal or revocation application.

(3) A request for removal shall be reviewed by the panel of the Board of Appeal which is processing the appeal or revocation application. If a request for removal is satisfied, the specified member of the panel of the Board of Appeal shall be removed from the panel of the Board of Appeal which is processing the appeal or revocation application and replaced with another member of the Board of Appeal. If the replacement of a member is impossible at a meeting, the meeting shall be adjourned and a new time and place shall be set for the meeting.

(4) If all members of a panel of the Board of Appeal are removed, the chairman of the Board of Appeal shall appoint a new panel to process the appeal or revocation application.

(5) If the resolution of an appeal or revocation application with a quorum is impossible, the Board of Appeal shall make a decision to terminate the processing of the appeal or revocation application. The appellant has the right to appeal against the decision of the Patent Office to an administrative court pursuant to the procedure provided for in the Code of Administrative Court Procedure within thirty days after the decision to terminate the processing by the Board of Appeal is made. The court shall decide on the refund of the state fee.

#### **§ 59. Making of decisions of Board of Appeal**

(1) The participants in a proceeding are not present during the making of the decision of the Board of Appeal.

(2) Decisions of the Board of Appeal are made by majority vote. It is prohibited to abstain from voting. If a member of the Board of Appeal maintains a dissenting opinion, he or she has the right to request that the dissenting opinion be recorded in the minutes.

(3) A decision of the Board of Appeal shall be prepared in writing and signed by all members of the panel of the Board of Appeal which processed an appeal or revocation application. A decision shall be reasoned and based on the facts established in the course of processing.

(4) A decision of the Board of Appeal shall set out:

- 1) the name of the Board of Appeal and the type of decision;
- 2) a summary of the appeal or revocation application;
- 3) a summary of the presented evidence and justifications;
- 4) the claim of the appellant or the person who filed the revocation application;
- 5) a reference to the Acts applied in making the decision;
- 6) the grounds for the decision;
- 7) the conclusion;
- 8) information on the procedure and term for appeal against the decision;
- 9) the date and place the decision is made.

## **§ 60. Evidence presented to Board of Appeal**

The provisions of § 38 of the Administrative Procedure Act apply to evidence to be presented to the Board of Appeal.

## **§ 61. Content of decision of Board of Appeal**

(1) The Board of Appeal shall dismiss an appeal or revocation application or grant an appeal or revocation application in full or in part.

(2) The Board of Appeal shall make decisions pursuant to the provisions of industrial property Acts.

(3) If an appeal or revocation application is granted in full or in part, the Board of Appeal shall require the Patent Office to annul its decision in full or in part and to make a new decision.

## **§ 62. Communication of decisions of Board of Appeal**

(1) Decisions of the Board of Appeal shall be communicated to the participants in the proceeding orally immediately after the decision is made on the day of the meeting.

(2) Copies of a decision shall be delivered to the participants in a proceeding within five working days after the date the decision is communicated or shall be delivered to the participants by post within the same term.

(3) Decisions of the Board of Appeal together with information pertaining to entry into force thereof shall be published on the website of the Board of Appeal within five working days after the date the decision is communicated.

## **§ 63. Entry into force of decision of Board of Appeal in case of appeal**

(1) An appellant has the right to appeal against the decision of the Board of Appeal to an administrative court pursuant to the procedure provided for in the Code of Administrative Court Procedure within three months after publication of the decision of the Board of Appeal.

(2) If no appeal specified in subsection (1) of this section is filed within three months, the decision of the Board of Appeal shall be deemed to have entered into force and shall be executed.

## **§ 64. Entry into force of decision of Board of Appeal in case of revocation application**

(1) A participant in proceedings in respect of a revocation application who wishes to appeal against a decision of the Board of Appeal due to violation of procedural provisions has the right to appeal against the decision of the Board of Appeal to an administrative court pursuant to the procedure provided for in the Code of Administrative Court Procedure within three months after publication of the decision of the Board of Appeal.

(2) A participant in proceedings in respect of a revocation application who disagrees with a decision of the Board of Appeal in the matter of protectability of a trade mark and who wishes to continue the dispute by way of an action has the right to file an action within three months after publication of the decision of the Board of Appeal.

(3) If no appeal specified in subsection (1) of this section or action specified in subsection (2) of this section is filed within three months, the decision of the Board of Appeal shall be deemed to have entered into force and shall be executed.

## ***Chapter 5. Implementing Provisions*** ➔

### **§ 65. Transitional provisions**

(1) The Acts in force prior to entry into force of this Act apply to the review of applications and other documents filed with the Patent Office prior to entry into force of this Act.

(2) The Board of Appeal formed pursuant to this Act shall apply Acts in force prior to entry into force of this Act upon the resolution of appeals and revocation applications filed with the Board of Appeal formed pursuant to the Trade Marks Act prior to entry into force of this Act.

### **§ 66. Entry into force of Act**

This Act enters into force on 1 January 2004.

1 RT = Riigi Teataja = State Gazette