

Trade Marks Act (2002)

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amended by the following Act:

21.11.2002 entered into force 01.01.2004 - RT I 2002, 99, 585.

Chapter 1. General Provisions ➔

§ 1. Scope of application of Act

This Act regulates the legal protection of well-known and registered trade marks and service marks (hereinafter trade mark) and rights and obligations related to trade marks.

§ 2. Equality of persons

The rights and obligations prescribed in this Act and other legislation concerning the protection of trade marks apply equally to persons of Estonia and persons of foreign states taking account of the restrictions provided for in this Act concerning persons with no residence, seat or commercial or industrial enterprise operating in Estonia.

§ 3. Trade marks

A trade mark is a sign used to distinguish the goods or services of a person from other similar types of goods or services of other persons.

Chapter 2. Legal Protection of Trade Marks ➔

§ 4. Content of legal protection of trade marks

(1) Legal protection of trade marks means the recognition of and protection of the rights of the person who holds an exclusive right to a trade mark (hereinafter proprietor of a trade mark) with legal means.

(2) An exclusive right to a registered trade mark may be exercised only by the person who is entered in the register of trade and service marks (hereinafter register) as the proprietor of the trade mark unless otherwise provided by this Act.

(3) An exclusive right to an international registration valid pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (RT II 1998, 36, 68) (hereinafter the Madrid Protocol) may be exercised in Estonia only by the person who is entered in the International Register of the International Bureau of the World Intellectual Property Organization (hereinafter Bureau) as the proprietor of the trade mark unless otherwise provided by this Act.

§ 5. Protectable trade marks

(1) Legal protection shall be granted to:

1) trade marks which are well known in Estonia within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property (RT II 1994, 4/5, 19) (hereinafter well-known trade marks);

2) trade marks which are registered in the register (hereinafter registered trade marks) or in the International Register of the Bureau.

(2) Legal protection is granted only to well-known trade marks, registered trade marks or trade marks valid in Estonia pursuant to the Madrid Protocol the legal protection of which is not precluded on the basis of the provisions of §§ 9 and 10 of this Act.

§ 6. Representability of protected trade marks

(1) Protected trade marks shall be capable of being represented graphically.

(2) Sound marks and olfactory marks are not protectable on the basis of this Act.

§ 7. Recognition of well-known trade marks

(1) A court shall recognise a trade mark as being well known at the request of the proprietor of the trade mark. A trade mark shall be recognised as being well known only in connection with an action or appeal concerning the legal protection of the trade mark.

(2) The Patent Office shall consider a trade mark to be well-known only in connection with the registration procedure of the trade mark or other trade marks. The Industrial Property Committee shall consider a trade mark to be well-known only in connection with the adjudication of an appeal against a decision of the Patent Office or an application concerning contestation of the legal protection of the trade mark.

(3) The following shall be taken into consideration upon recognising a trade mark as being well known:

1) the degree of knowledge of the trade mark in Estonia in the sector of actual and potential consumers of goods analogous to the goods or services to which the trade mark applies,

the sector of persons involved in channels of distribution of such goods or services or in business circles dealing with such goods or services;

2) the duration and extent of the use and promotion of the mark and geographical area of the use of the mark;

3) the registration, use and knowledge of the mark in other countries;

4) the value associated with the mark.

(4) A trade mark shall be recognised as being well known if the trade mark is known to the majority of persons in at least one of the sectors specified in clause (3) 1) of this section.

(5) The recognition of a trade mark as being well known shall not have any legal effect in later disputes.

§ 8. Legal protection on basis of registration

(1) A registration concerning a trade mark submitted for registration is made in the register under the conditions and pursuant to the procedure provided for in Chapter 4 of this Act, taking account of the provisions of the Act regulating the activities of the Industrial Property Committee and the maintenance of registers of industrial property.

(2) Legal protection of a registered trade mark is valid as of the filing date of an application for the registration of the trade mark (hereinafter application) until ten years as of the date of making the registration. The term of legal protection of a trade mark may be extended at the request of the proprietor of the trade mark for ten years at a time.

§ 9. Absolute circumstances which preclude legal protection

(1) Legal protection shall not be granted to the following signs:

1) signs which do not conform to the provisions of § 6 of this Act;

2) signs which are devoid of any distinctive character, including single letters in non-stylised form, single numbers in non-stylised form and single colours;

3) signs which consist exclusively of signs or indications which designate the kind, quality, quantity, intended purpose, value or 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 describe the goods or services in another manner, or which consist of the above-mentioned signs or indications which are not considerably altered;

4) signs which consist exclusively of signs or indications which have become customary in current language or in good faith business practice;

5) signs which consist 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) signs which are of such a nature as to deceive the consumer as to the kind, quality, quantity, intended purpose, value or 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;

7) signs which are contrary to public policy or accepted principles of morality;

8) signs the registration of which must be refused on the basis of Article 6 ter of the Paris Convention for the Protection of Industrial Property, unless the competent authorities or officials give written consent for the registration;

9) signs which include a flag, coat of arms or another symbol other than those covered by Article 6 ter of the Paris Convention for the Protection of Industrial Property the registration of which is contrary to public interest, unless the competent authorities or officials give written consent for the registration;

10) signs the application for the registration of which was submitted in bad faith by the person applying for registration (hereinafter applicant) or the use of which has commenced in bad faith;

11) signs which contain a registered geographical indication or are confusingly similar thereto if it may result in unlawful use of the geographical indication pursuant to the provisions of the Geographical Indications Protection Act (RT I 1999, 102, 907; 2000, 40, 252; 2001, 27; 151; 56, 332 and 335);

12) signs the use of which is prohibited pursuant to other Acts or an international agreement.

(2) If, following the use which has been made of it, a trade mark has acquired a distinctive character by the filing date of an application and in the case of well-known trade marks, the provisions of clauses (1) 2)-4) of this section do not apply.

(3) Upon the incorporation of a sign specified in clauses (1) 2), 3), 4) and 5) of this section within a trade mark, such sign constitutes an element of the trade mark which is not subject to protection.

§ 10. Relative circumstances which preclude legal protection

(1) Legal protection shall not be granted to the following trade marks:

1) trade marks which are identical with an earlier trade mark which has been granted legal protection with regard to identical goods or services designated by the trade mark;

2) trade marks which are identical or similar to an earlier trade mark which has been granted legal protection with regard to identical goods or services or goods or services of a similar kind designated by the trade mark, if there exists a likelihood of confusion on the part of the public, which includes association of the trade mark with the earlier trade mark;

3) trade marks which are identical or similar to an earlier registered trade mark or a trade mark which has been submitted for registration or to a trade mark which is known to the majority of the Estonian population and which has been granted legal protection for different kinds of goods or services, if the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

4) trade marks which are identical or confusingly similar to a business name entered in the

commercial register prior to the filing date of the registration application or the priority date if the area of activity in respect of which a notation has been made in the commercial register includes the goods and services which the trade mark are used to or are going to be used to designate;

5) which are identical or confusingly similar to the name of a proprietary medicinal product registered in Estonia if the goods which the trade mark is used to or is going to be used to designate belong to the field of medicine;

6) the use of which is detrimental to an earlier right to a name, a right of personal portrayal, a right to the name of an immovable, the name or image of an architectural site, an object of copyright or industrial property right or another earlier right;

7) which are identical or confusingly similar to a trade mark which has been granted legal protection in another country if the application is filed in bad faith.

(2) Circumstances specified in clauses (1) 2)-6) of this section which preclude legal protection are not taken into account if the proprietor of the earlier trade mark or another earlier right consents to the registration of the later trade mark in writing.

§ 11. Earlier trade mark and other earlier rights

(1) "Earlier trade mark" means the following:

1) a trade mark which became well known earlier;

2) a registered trade mark if the filing date of the application or the date of priority is earlier;

3) a trade mark submitted for registration if the filing date of the application or the date of priority is earlier. A trade mark submitted for registration shall be an earlier trade mark only if it is registered;

4) a trade mark which is valid in Estonia on the basis of the Madrid Protocol if the date of international registration or date of priority is earlier;

5) a trade mark submitted for registration on the basis of the Madrid Protocol if the date of international registration or date of priority is earlier. A trade mark submitted for registration is an earlier trade mark only if legal protection for the trade mark is not refused in Estonia.

(2) When determining other earlier rights, the date of acquisition of the corresponding right in Estonia shall be taken into consideration.

(3) If rights to a trade mark or other rights are created on the same date, such rights have no priority in relation to each other.

§ 12. Scope of legal protection of trade marks

(1) The scope of legal protection of a trade mark is based on the following:

1) for a well-known trade mark, the form of the trade mark in which it became well known;

2) the representation of the trade mark entered in the register.

(2) The scope of legal protection of a trade mark with regard to goods and services is determined:

1) for a well-known trade mark, by such goods and services which the trade mark was used to designate when it became well known;

2) by a list of goods and services entered in the register or the International Register of the Bureau.

(3) 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 (hereinafter the Nice classification) (RT II 1996, 4, 14).

(4) Goods or services may not be considered as being similar or dissimilar to each other on the ground that they appear in the same class or different classes of the Nice Classification.

(5) A trade mark may include elements which are not subject to protection unless this decreases the distinctive character of the trade mark or violates the rights of other persons.

(6) If, during subsequent use, an element of a trade mark which is not subject to protection acquires a distinctive character or becomes well known, new registration of the registered trade mark may be applied for to extend legal protection to the whole mark.

§ 13. Representative for performing acts related to legal protection of trade marks

(1) A person with no residence, seat or commercial or industrial enterprise operating in Estonia shall authorise a patent agent to perform acts related to the legal protection of a trade mark.

(2) If several persons act jointly upon the performance of acts related to the legal protection of a trade mark, they shall authorise a person from among themselves who has a residence or seat or a commercial or industrial enterprise operating in Estonia or a patent agent to act as a representative.

(3) Persons specified in subsections (1) and (2) of this section may file an application in person.

Chapter 3. Rights Conferred by Trade Mark ➔

§ 14. Exclusive right

(1) The proprietor of a trade mark has the right to prohibit third parties from using in the course of trade:

1) any sign which is identical with the trade mark which is granted legal protection in relation to goods or services which are identical with those for which the trade mark is protected;

2) any sign where, because of its identity with, or similarity to, the trade mark which is granted legal protection and the identity or similarity of the goods or services covered by the

trade mark and the sign, there exists the likelihood of confusion on the part of the public, including the likelihood of association between the sign and the earlier trade mark;

3) any sign which is identical with, or similar to a registered trade mark or a trade mark which is known to the majority of the Estonian population and which is granted legal protection, where such sign is used to designate goods or services which are not similar to those for which the trade mark is registered, if use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

(2) The following acts, inter alia, are prohibited based on the provisions of subsection (1) of this section:

- 1) affixing the sign to goods or to the packaging thereof;
- 2) offering goods for sale, putting them on the market or stocking them for the purposes of sale under the sign;
- 3) offering or supplying services under the sign;
- 4) importing or exporting the goods under the sign;
- 5) using the sign on business papers, in advertising or instruction manuals for the goods.

(3) The use of a trade mark on the Internet is considered to be use of the trade mark in Estonia only if such use has commercial consequence in Estonia. The following, inter alia, shall be taken into account upon the establishment of commercial consequence:

- 1) business activity in Estonia of the person who uses a trade mark on the Internet, such as actual business relations or relations motivated by business, the existence of customer services and non-Internet activity in Estonia;
- 2) the intention of the person who uses the trade mark on the Internet to offer goods or services to persons in Estonia via the Internet, taking into consideration the transportation of goods, the currency and information, the language and Internet links relating to communication with the provider of goods or services;
- 3) a condition indicated on the Internet stating that goods or services shall not be offered to persons in Estonia, and adherence to such condition;
- 4) taking unfair advantage of, or being detrimental to the distinctive character or the repute of a trade mark belonging to another person.

(4) Upon the publication of a registered trade mark in a reference book, manual, textbook, professional journal or other publication, including electronic publications, the author and publisher shall ensure that the trade mark has the registered trade mark symbol next to it if the proprietor of the trade mark so requests. If the publication is already published, the proprietor of a trade mark may request the use of the registered trade mark symbol in the next publication.

§ 15. Registered trade mark symbol

The proprietor of a trade mark may use the registered trade mark symbol or a warning

together with the trade mark.

§ 16. Limitation of exclusive right

(1) The proprietor of a trade mark has no right to prohibit other persons from using the following in the course of trade in accordance with good business practices:

- 1) the names and addresses of other persons;
- 2) any sign which consists of signs or indications which designate the kind, quality, quantity, intended purpose, value or 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 describe the goods or services in another manner, or which consists of the above-mentioned signs or indications which are not considerably altered;
- 3) signs or indications which have become customary in current language or in good faith business practice;
- 4) the trade mark if it is necessary to indicate the intended purpose of a product, in particular as accessories or spare parts, or a service;
- 5) elements of the trade mark which are not subject to protection.

(2) The proprietor of an earlier trade mark has no right to prohibit the use of a later trade mark or another later right if the proprietor of the earlier trade mark was aware or should have been aware of the later trade mark and has acquiesced, for a period of five consecutive years, in the use of the later trade mark. The limitation does not apply if the proprietor of the later trade mark commenced use of the trade mark or filed the application in bad faith or if another later right was acquired in bad faith. The proprietor of a later trade mark is not entitled to prohibit the use of an earlier trade mark or another earlier right.

(3) The proprietor of a trade mark is not entitled to prohibit further commercial exploitation of goods which have been put on the market in Estonia or in a State party to the Agreement of the European Economic Area under that trade mark by the proprietor or with the proprietor's consent unless the condition of the goods is changed after they have been put on the market.

§ 17. Obligation to use trade mark

(1) The proprietor of a trade mark is required to actually use a registered trade mark to designate goods and services in respect of which it is registered.

(2) The following shall also constitute use of a trade mark by the proprietor of the trade mark:

- 1) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;
- 2) affixing of the trade mark to goods or to the packaging thereof intended solely for export purposes;
- 3) use of the trade mark with the consent of the proprietor of the trade mark.

§ 18. Transfer of trade marks

- (1) A trade mark may be transferred in relation to all or some of the goods or services.
- (2) A trade mark shall transfer to the legal successor of the proprietor of the trade mark. A trade mark shall not be inherited by the state or a local government.
- (3) The transfer of a registered trade mark enters into force on the date of entry of the corresponding amendment in the register.

§ 19. Surrender of trade marks

- (1) The proprietor of a trade mark may surrender a trade mark with regard to all or some of the goods and services.
- (2) The surrender of a registered trade mark enters into force on the date of entry of the corresponding amendment in the register.
- (3) A trade mark cannot be surrendered if the trade mark is encumbered with a pledge, included in a bankruptcy estate or a licence has been issued or a prohibition on disposal has been made in relation to the trade mark.

§ 20. Division of registration

The proprietor of a trade mark may divide the registration into two or more registrations and divide the goods and services between these registrations. The division of a registration enters into force on the date of entry of the corresponding amendment in the register.

§ 21. Licence

- (1) A licensee may transfer the rights acquired from the proprietor of a trade mark by way of a licence to third persons only with the permission of the proprietor of the trade mark.
- (2) The transfer of a trade mark or a licence issued later shall not affect the validity of a licence issued earlier.
- (3) An entry shall be made in the register concerning a licence if a party to the licence agreement so requests.

§ 22. Prohibition

In order to secure an action, a prohibition on disposal may be made in relation to a trade mark in the register at the request of the plaintiff.

§ 23. Compulsory execution and bankruptcy

- (1) A trade mark may be the object of compulsory execution separately from an enterprise.
- (2) If a registered trade mark is included in a bankruptcy estate, a corresponding notation shall be made in the register at the request of the trustee in bankruptcy or a court.

§ 24. Pledging of trade marks

(1) A registered trade mark may be encumbered with a pledge such that the person for whose benefit the pledge is established (hereinafter pledgee) has the right to satisfaction of the claim secured by the pledge against the pledged trade mark.

(2) A pledge is created by making an entry concerning the pledge in the register on the basis of a notarised agreement for establishment of the pledge between the proprietor of the trade mark and the pledgee.

(3) A pledge shall transfer to the legal successor of the pledgee. An entry shall be made in the register concerning the transfer of a pledge.

§ 25. Satisfaction of claim secured by pledge

(1) A pledgee may demand the satisfaction of a claim secured by the pledge after it becomes collectable.

(2) If a claim secured by a pledge is not satisfied, the pledgee is entitled to satisfy the claim by way of selling the encumbered trade mark at a compulsory auction.

(3) An agreement whereby the pledgee acquires the encumbered trade mark for the satisfaction of a claim secured by the pledge is invalid.

§ 26. Extinguishment of pledge

A pledge extinguishes upon termination of the claim secured by the pledge or if the pledgee waives the pledge.

§ 27. Rights conferred by application

The provisions of §§ 18-23 of this Act apply to applications and rights conferred by applications taking into account the specifications arising from the legal status of applications.

Chapter 4. Registration of Trade Marks ➔

§ 28. Application

(1) Each trade mark shall have a separate application.

(2) An application shall set out:

1) a request for the registration of a trade mark;

2) an authorisation document or reference to an authorisation document submitted earlier if the applicant has a representative;

3) documents certifying priority if priority is claimed;

4) information concerning payment of the state fee.

(3) In addition, the provisions of Chapter 6 of this Act apply to applications for the registration of collective marks or guarantee marks.

§ 29. Priority

(1) Convention priority means the preferential right of the person who submits the first application to apply for legal protection to a trade mark. The filing date of the first application is deemed to be the date of priority.

(2) If a first application contains the goods or services indicated in an application filed with the Patent Office for the registration of the same trade mark and such application is filed with the Patent Office within six months as of the filing date of the first application, priority may be established:

1) on the basis of the filing date of the first application in any State party to the Paris Convention for the Protection of Industrial Property or in a contracting state of the World Trade Organisation;

2) on the basis of the filing date of the first application in a state which is not a State party to the Paris Convention for the Protection of Industrial Property or in a state which is not member of the World Trade Organisation if such state guarantees equivalent conditions for persons who file first applications in the Republic of Estonia.

(3) Exhibition priority means the preferential right of the person who publicly displays goods or services designated by a trade mark at an international or officially recognised international exhibition within the meaning of the Convention on International Exhibitions signed at Paris in 1928 which takes place in the territory of a state specified in clause (2) 1) or 2) of this section to apply for legal protection of the trade mark.

(4) If goods or services indicated in an application were displayed at an exhibition specified in subsection (3) of this section, designated by the same trade mark, and the application is filed with the Patent Office within six months after the date of display, priority may be established on the basis of the date of display at the exhibition.

(5) Priority may be established for a trade mark on the basis of several first applications. If several first applications have been submitted earlier, the six month term provided for in subsection (2) of this section shall be calculated from the earliest date of priority.

§ 30. Request for registration of trade mark

A request for the registration of a trade mark shall contain:

1) a request for the registration of a trade mark;

2) the name, address of the residence or seat of the applicant and, if the applicant so wishes, other details of the applicant;

3) the name of the representative of the applicant, if the applicant has a representative;

4) the address of a commercial or industrial enterprise operating in Estonia and belonging to a person of a foreign state, if such person has no representative;

5) a representation of the trade mark;

- 6) a list of goods and services classified according to the Nice Classification together with class numbers;
- 7) a declaration of priority if priority is claimed;
- 8) a list of colours, if the representation of the trade mark is in colour;
- 9) where the mark is a three-dimensional mark, a statement to that effect;
- 10) the signature of the applicant or the representative of the applicant.

§ 31. Representation of trade mark

- (1) A representation of a trade mark shall give a clear and complete depiction of the trade mark.
- (2) In the representation of a three-dimensional trade mark, one view or several views of the trade mark may be presented.
- (3) The Patent Office may request the transliteration and translation of the part of the trade mark consisting of words.

§ 32. Authorisation document

An authorisation document shall set out the following:

- 1) the name and address of the residence or seat of the person represented;
- 2) the name of the representative;
- 3) the scope of the authorisation;
- 4) right to delegate authorisation, if the person represented grants such right to the representative;
- 5) the term of validity of the authorisation, if the authorisation is granted for a specified term;
- 6) the signature of the person represented;
- 7) the place and date of issue of the authorisation document.

§ 33. Documents certifying priority

- (1) Convention priority is certified by a document which is issued to the applicant by the agency which received the first application and which sets out the information in the first application.
- (2) Exhibition priority is certified by a document concerning the display of goods or services designated by the trade mark at an exhibition specified in subsection 29 (3) of this Act issued by the organiser of the exhibition.

§ 34. Filing of application

- (1) Applications are filed with the Patent Office.
- (2) Information concerning payment of the state fee, a priority claim and an authorisation document issued to the representative of the applicant shall be filed within two months as of the date of receipt of an application.
- (3) Documents certifying a priority claim shall be filed within three months as of the date of receipt of the application. Documents certifying priority need not be submitted if priority is claimed on the basis of a first application filed in Estonia.
- (4) The formal requirements for applications and the procedure for filing thereof shall be established by the Minister of Economic Affairs.

§ 35. Filing date of application

The date on which at least the following information is submitted to the Patent Office shall be deemed to be the filing date of an application:

- 1) a request for the registration of a trade mark;
- 2) a representation of the trade mark;
- 3) a list of goods and services for which the registration application is filed;
- 4) information necessary for identification of the applicant, or address of the applicant or the representative of the applicant.

§ 36. Determination of filing date of application and acceptance for processing

- (1) If an application meets the requirements provided for in § 35 of this Act upon its receipt in the Patent Office, the date of receipt of the application in the Patent Office shall be deemed to be the filing date of the application.
- (2) If any information specified in § 35 of this Act is missing from an application, the applicant shall be notified thereof and a term of two months shall be set for elimination of deficiencies. The Patent Office is not required to give notice if the filed documents do not contain the name or address of an applicant or the name of the representative of the applicant.
- (3) If the name or address of an applicant or the name of the representative of the applicant are missing, the applicant may, on the initiative of the applicant, file all the application information specified in § 35 of this Act within two months as of the date of receipt of the initially filed documents in the Patent Office.
- (4) If an applicant files all the missing application information within a term set pursuant to subsection (2) of this section or, if subsection (3) applies, within the term provided for therein, the date on which all the application information specified in § 35 are submitted to the Patent Office shall be deemed to be the filing date of the application.
- (5) An application the filing date of which is determined pursuant to subsection (1) or (4) of

this section shall be accepted for processing. The Patent Office shall notify the applicant of the filing date of the application and the application number.

(6) The filing date of an application shall not be determined if the applicant fails to submit missing application information to the Patent Office within the term prescribed in the cases provided for in subsections (2) and (3) of this section. The Patent Office shall inform the applicant that the application is deemed to be not filed. The applicant is entitled to a refund of the state fee paid by the applicant.

§ 37. Examination of compliance of applications with formal and substantive requirements

(1) If it becomes evident in the course of examination of the compliance of an application with formal and substantive requirements that a document specified in § 28 of this Act is missing from the application or documents do not meet the requirements provided for in §§ 30-33 or requirements established on the basis of subsection 34 (4) of this Act, the Patent Office shall notify the applicant thereof in writing and set a term of at least two months for the elimination of deficiencies or provision of explanations.

(2) If an applicant fails to eliminate deficiencies in the applicant's response to the notice specified in subsection (1) of this section, a decision to reject the application shall be made.

(3) If an applicant fails to respond to the notice specified in subsection (1) of this section by the due date or fails to submit, within the term provided for in subsection 34 (2) of this Act, information concerning payment of the state fee in the prescribed amount or fails to file an authorisation document within the prescribed term, the application shall be deemed to be withdrawn.

(4) If an applicant does not submit a priority claim within the term provided for in subsection 34 (3) of this Act or fails to submit documents certifying priority by the due date or the priority claim does not comply with the provisions of § 29 or the documents submitted do not certify priority, the Patent Office shall not take the priority claim into consideration.

§ 38. Examination of trade marks

(1) The Patent Office shall examine a trade mark with regard to the provisions of subsection 9 (1) and § 10 of this Act.

(2) If an examination reveals circumstances which preclude the legal protection of a trade mark, the Patent Office shall notify the applicant thereof and set a term of at least two months for the elimination of the said circumstances or the provision of explanations. If the applicant fails to respond by the due date, the application shall be deemed to be withdrawn.

(3) If an examination reveals that a trade mark contains a sign which constitutes an element of the trade mark which is not subject to protection pursuant to subsection 9 (3) of this Act and such sign does not cause doubt as to the extent of the exclusive right, the Patent Office shall not indicate the element which is not subject to protection in the decision to register the trade mark.

(4) If an examination reveals that a trade mark contains a sign which constitutes an element of the trade mark which is not subject to protection pursuant to subsection 9 (3) of this Act and such sign may cause doubt as to the extent of the exclusive right, the Patent Office shall notify the applicant thereof and set a term of at least two months to agree to the element which is not subject to protection or to provide explanations. If notification of

agreement to the element which is not subject to protection is not given or a relevant explanation is not provided by the due date, the applicant shall be deemed to have agreed to the element which is not subject to protection.

§ 39. Decision to register trade mark and decision to refuse registration of trade mark

(1) The decision to register a trade mark shall be made if examination reveals none of the circumstances specified in subsection 9 (1) and § 10 of this Act which preclude legal protection or if the applicant eliminated circumstances which were revealed by the examination and which preclude legal protection.

(2) The decision to refuse to register a trade mark shall be made if circumstances specified in subsection 9 (1) or § 10 of this Act which were revealed by the examination and which preclude legal protection are not eliminated by the applicant.

(3) The provisions of subsections (1) and (2) of this section apply to some of the goods and services if the circumstance which precludes legal protection is not valid with regard to all goods or services for which the registration application is filed.

(4) If an applicant does not agree to consider part of the trade mark as an element which is not subject to protection but the Patent Office does not regard the opinion of the applicant as reasoned, the Patent Office shall make a decision to register the trade mark with a restriction, indicating the element which is not subject to protection.

§ 40. Publication of decision to register trade mark

A notice concerning a decision to register a trade mark shall be published in the official gazette of the Patent Office.

§ 41. Adjudication of appeals and revocation applications

(1) An applicant may file an appeal against a decision of the Patent Office specified in subsection 37 (2) and § 39 of this Act with the Industrial Property Committee within two months as of the date of making the decision.

(2) An interested person may contest an applicant's right to a trade mark in the Industrial Property Committee if circumstances specified in subsection 9 (1) or § 10 of this Act which preclude legal protection exist. The term for the filing of a revocation application is two months as of the publication of the notice of the decision to register a trade mark.

(3) Appeals and revocation applications are adjudicated and appealed against pursuant to the provisions of the Act regulating the activities of the Industrial Property Committee and the maintenance of registers of industrial property.

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

§ 42. Extension of terms

(1) The terms provided for in subsections 34 (2) and (3) of this Act shall not be extended.

(2) The Patent Office shall extend the terms specified in subsection 37 (1) and subsections 38 (2) and (4) of this Act at the request of the applicant for at least two months at a time but

not for longer than thirteen months altogether. The request together with information concerning payment of the state fee must be filed before the end of the set term.

§ 43. Suspension of processing

(1) If the examination of a trade mark depends on a decision to be made concerning an earlier trade mark, the Patent Office shall suspend the processing of the registration of the later trade mark until a final decision enters into force concerning the earlier trade mark and notify the applicant thereof.

(2) On the basis of a reasoned request from the applicant, the Patent Office may suspend processing for up to twelve months.

(3) Suspended processing shall be continued if grounds for suspending the processing cease to exist or, in the case specified in subsection (2) of this section, upon expiry of the term.

§ 44. Division and restriction of applications

(1) An applicant may, until a decision to register or refuse the registration of a trade mark is made or during proceedings concerning an appeal filed with regard to a decision to register a trade mark, divide the application into two or more applications by distributing among the latter the goods and services. A corresponding request shall be submitted together with information concerning payment of the state fee.

(2) Applications which are the result of a division shall preserve the filing date and priority of the initial application.

(3) An applicant may restrict the list of goods and services set out in an application. A restriction shall enter into force on the date of receipt of the request at the Patent Office.

§ 45. Correction and amendment of applications

An applicant may, until a decision to register or refuse the registration of a trade mark is made, make corrections and amendments to the application provided that such corrections and amendments do not alter the representation of the trade mark set out in the application on its filing date or extend the list of goods or services.

§ 46. Conditions for registration

(1) A registration shall be made if:

1) the decision to register a trade mark has not been appealed against or the applicant's right to the published trade mark has not been contested, and information concerning payment of the state fee for the registration has been submitted within four months as of the publication of the notice of registration of the trade mark, or

2) a decision to register a trade mark and the applicant's right to the trade mark remain in force regardless of appeal or contestation, and information concerning payment of the state fee for the registration is submitted within two months as of the date of entry into force of the final decision.

(2) If information concerning payment of the state fee for the registration is not submitted by

the due date, the application shall be deemed to be withdrawn.

§ 47. Withdrawal of applications, termination and resumption of processing

(1) An applicant may withdraw an application until the making of the registration by filing a corresponding written request. An application is deemed to be withdrawn on the date of receipt of the request at the Patent Office.

(2) If an application is withdrawn in the manner specified in subsection (1) of this section or deemed to be withdrawn in the cases specified in §§ 37, 38 or 46 of this Act, processing shall be terminated. If processing is terminated, the application documents shall not be returned and the state fee shall not be refunded.

(3) An applicant may request that processing be resumed if the Patent Office terminated processing having deemed the application to be withdrawn pursuant to §§ 37, 38 or 46 of this Act and if the applicant failed to perform the acts due to force majeure or some other impediment independent of the applicant or the representative of the applicant.

(4) The Patent Office shall resume processing if the applicant proves the existence of an impediment and performs the prescribed acts within two months after the impediment ceases to exist, and submits information concerning payment of the state fee.

(5) A request for the resumption of processing may be filed within six months after the due date for the act which was not performed.

(6) The provisions of subsections (3)–(5) of this section also apply upon the restoration of priority.

§ 48. Registration

(1) A registration shall be made on the basis of a decision to register a trade mark.

(2) Registration data are:

- 1) the registration number;
- 2) the date of making the registration;
- 3) a representation of the trade mark;
- 4) a list of goods and services classified according to the Nice Classification together with class numbers;
- 5) a list of colours, if the representation of the trade mark is in colour;
- 6) where the mark is a three-dimensional mark, a statement to that effect;
- 7) the element of the trade mark which is not subject to protection if such element is indicated in the registration decision;
- 8) the name and address of the residence or seat of the proprietor of the trade mark;

- 9) where the trade mark is a collective mark or a guarantee mark, a statement to that effect;
- 10) the name of the representative of the applicant, if the applicant has a representative;
- 11) the address of a commercial or industrial enterprise operating in Estonia and belonging to a person of a foreign state, if such person has no representative;
- 12) the date of expiry of the registration;
- 13) application number;
- 14) the filing date of the application;
- 15) priority data, if a priority claim is satisfied.

§ 49. Publication of registration data

Registration data and amendments or corrections to registration data shall be published in the official gazette of the Patent Office.

§ 50. Renewal of term of legal protection of trade marks

- (1) During one year prior to expiry of the term of legal protection of a trade mark, the proprietor of the trade mark may request the renewal of the term. A corresponding request shall be submitted together with information concerning payment of the state fee.
- (2) The proprietor of a trade mark may request restoration of the term for renewal of the legal protection of the trade mark within six months after expiry of the term of legal protection of the trade mark. A corresponding request shall be submitted together with information concerning payment of the state fee and additional state fee.
- (3) Renewal of the term of legal protection of a trade mark enters into force on the date of expiry of the term.

§ 51. Deletion of trade mark from register

- (1) A trade mark is deleted from the register six months after expiry of its term of validity unless renewal of the term of validity of the trade mark has been requested. The deletion enters into force retroactively on the date of expiry of the term of validity.
- (2) A trade mark shall be deleted from the register before the prescribed time if a corresponding court judgment which has entered into force is submitted to the Patent Office or if the proprietor of the trade mark surrenders the trade mark.

Chapter 5. Judicial Contestation of Rights and Civil Liability ➔

§ 52. Declaration of invalidity of exclusive right of proprietor of trade mark

- (1) An interested person may file an action against the proprietor of a trade mark for the exclusive right of the proprietor of the trade mark to be declared invalid if circumstances

specified in §§ 9 or 10 of this Act which preclude legal protection exist and grounds for the action also existed at the time of making the registration.

(2) An action provided for in subsection (1) of this section shall not be filed:

1) if the proprietor of the earlier trade mark or the proprietor of another earlier right filing the action has not contested the later trade mark within five years after becoming aware of the later trade mark. These grounds do not apply if the application of the later trade mark was filed in bad faith;

2) on the basis of clause 10 (1) 3) of this Act, if the earlier trade mark had not acquired a distinctive character by the filing date or priority date of the registration application of the later trade mark.

(3) If a trade mark which is identical or confusingly similar to a trade mark which has been granted legal protection in another country is registered to the name of the representative of the proprietor of the trade mark without the proprietor's consent, the proprietor of the trade mark used in the other country has the right to file an action in a claim requesting the transfer of the trade mark to the proprietor. These grounds do not apply if the representative proves the legality of the representative's activities.

(4) The proprietor of a trade mark does not have the right to request that the exclusive right of the proprietor of another trade mark be declared invalid if the proprietor of the trade mark has failed to use the registered trade mark within the meaning of § 17 of this Act during five consecutive years without good reason.

(5) Actions specified in subsection (1) of this section may be filed within five years as of the date of making the registration. This restriction does not apply if the contested application was filed in bad faith.

§ 53. Declaration of exclusive right of proprietor of trade mark extinguished

(1) An interested person may file an action against the proprietor of a trade mark for the exclusive right of the proprietor of the trade mark to be declared extinguished if:

1) the trade mark has, as a result of acts or failure to act on the part of the proprietor of the trade mark, become a customary sign in relation to the goods or services with regard to which it is registered;

2) the trade mark has, as a result of use, become such as to deceive the consumer as to the kind, quality, quantity, intended purpose, value or 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;

3) the registered trade mark has not been used within the meaning of § 17 of this Act during five consecutive years after the making of the registration, without good reason.

(2) An action specified in subsection (1) of this section cannot be filed on the basis of clause (1) 3) of this section if the registered trade mark is used within the meaning of § 17 of this Act after five years of non-use commences prior to filing of the action.

(3) The provisions of subsection (2) of this section do not apply if use of the trade mark within the meaning of § 17 of this Act commences after the end of the period of five years

and within three months prior to filing of the action and if the proprietor of the trade mark commenced preparations for the use of the trade mark only after the proprietor became aware of the intention of filing the action.

§ 54. Declaration of invalidity of exclusive right to trade mark containing geographical indication

(1) An interested person may file an action against the proprietor of a trade mark for the declaration of invalidity of exclusive right to the trade mark submitted for registration in bad faith if:

1) the trade mark contains a registered geographical indication or a sign confusingly similar thereto,

2) goods or services designated with the trade mark and a registered geographical indication are identical or of similar type, and

3) the trade mark is filed for registration after the geographical indication becomes subject of legal protection in its country of origin.

(2) If a trade mark specified in subsection (1) of this section contains the name of a geographical area in Estonia, the condition specified in clause (1) 3) of this section does not apply upon the declaration of invalidity of the exclusive right to use the trade mark.

(3) For the purposes of this Act, a trade mark is filed for registration in bad faith if the person who filed for registration knew or should have known that the sign indicates that goods or services originate from a certain geographical area and a certain characteristic, reputation or other characteristic feature of the goods or services can be related to the geographical origin to a considerable extent.

(4) An interested person may file an action against the proprietor of a trade mark for the declaration of invalidity of the exclusive right to a trade mark registered prior to 10 January 2000 to designate an alcoholic beverage if the trade mark contains a registered geographical indication or is confusingly similar thereto and the alcoholic beverage designated by the trade mark does not originate from the geographical area specified by the geographical indication.

(5) The provisions of this section also apply to the declaration of invalidity of exclusive right to trade marks containing geographical indications which were filed for registration or registered prior to 10 January 2000.

(6) If an action is satisfied, exclusive right to a trade mark shall be declared invalid as of 10 January 2000.

§ 55. Consequences of declaration of invalidity of exclusive right and declaration of exclusive right extinguished

(1) If an exclusive right is declared invalid, the registration shall be deemed to be null and void from inception.

(2) If an exclusive right is declared extinguished, the registration shall be deemed to be invalid as of the date of filing of the action. The plaintiff may request that an exclusive right be declared extinguished as of the date of creation of the grounds for the action.

(3) The declaration of invalidity of an exclusive right or declaration of an exclusive right extinguished is not the basis for the revocation of a court judgment concerning the protection of exclusive right which entered into force and was executed prior to the making of the court judgment declaring the exclusive right invalid or extinguished or for the revocation of an act performed earlier.

§ 56. Partial declaration of invalidity of exclusive right and partial declaration of exclusive right extinguished

If grounds for the declaration of invalidity of an exclusive right or declaration of an exclusive right extinguished apply only to some of the goods or services designated with the trade mark, the exclusive right shall be declared invalid or extinguished with regard to such goods or services.

§ 57. Protection of exclusive right

(1) The proprietor of a trade mark may file an action against a person infringing the exclusive right, including a licensee who violated the terms of the licence agreement:

- 1) for termination of the offence;
- 2) for compensation for patrimonial damage caused intentionally or due to negligence, including loss of profit and moral damage.

(2) If an exclusive right is infringed by an employee or representative of an undertaking, the action specified in subsection (1) of this section may be filed against the undertaking.

(3) A licensee has the right to file an action for the protection of an exclusive right only with the permission of the proprietor of the trade mark. A licensee may file an action without permission after sending a notice of an infringement of the exclusive right to the proprietor of the trade mark if the proprietor of the trade mark fails to file an action within a reasonable period of time.

(4) A licensee has the right to enter, as a third party, judicial proceedings in a claim for compensation for damage caused to the proprietor of a trade mark initiated on the basis of an action filed by the proprietor of the trade mark.

§ 58. Supplementary protection requirements

(1) If the proprietor of a trade mark files an action for the protection of an exclusive right specified in § 57 of this Act, the proprietor may request the destruction of unlawfully designated goods and objects solely or almost solely used or intended to commit the offence which are in the ownership or possession of the offender if it is not possible or expedient to eliminate the unlawful nature of the goods or objects in another manner.

(2) If the proprietor of a trade mark has filed an action for the protection of an exclusive right, the proprietor may request from the person infringing the exclusive right, through the court, information concerning the origin, the manner and channels of distribution and the amount of unlawfully designated goods, including the names and addresses of the manufacturer, supplier, previous proprietors and resellers of such goods.

§ 59. Counterclaims

A person against whom the proprietor of a well-known or registered trade mark has filed an action for the protection of the exclusive right may contest the exclusive right of the proprietor of the trade mark.

§ 60. Specifications of judicial proceedings in matters relating to trade marks

Appeals and actions related to the legal protection of trade marks fall within the jurisdiction of the court in the jurisdiction of which the Patent Office is located.

Chapter 6. Specifications of Legal Protection of Collective Marks and Guarantee Marks ➔

§ 61. Definition of collective mark and guarantee mark

(1) A collective mark is a trade mark which belongs to an association of persons with active legal capacity and which is used by members of the association to designate their goods and services under the conditions and pursuant to the procedure provided for in the regulations of the collective mark.

(2) A guarantee mark is a trade mark used to designate the goods and services of different persons in order to guarantee a common quality, common geographic origin or method of production or another common feature of such goods and services.

§ 62. Regulations of collective mark or guarantee mark

(1) An application for the registration of a collective mark or guarantee mark shall include the regulations of the collective mark or guarantee mark (hereinafter regulations).

(2) A collective mark or guarantee mark shall be registered if there are no circumstances which preclude legal protection and:

1) the regulations are not contrary to public policy or accepted principles of morality;

2) in the case of a guarantee mark, the regulations include a list of the required common features of goods and services designated with the guarantee mark which can be used as the basis for quality control;

3) in the case of a collective mark, the regulations have a list of members of the association whose goods and services are designated with the collective mark attached thereto and the regulations include the conditions of and procedure for becoming a member of the association.

(3) An amendment of regulations is effective as of the entry of the amendment in the register. An amendment shall be entered in the register only if the regulations do not conflict with the requirements provided for in subsection (2) of this section.

§ 63. Specifications of legal protection of collective marks and guarantee marks

(1) Circumstances specified in § 9 and 10 of this Act which preclude legal protection apply to collective marks and guarantee marks.

(2) The use of a collective mark or guarantee mark by a an unauthorised person is prohibited.

(3) A guarantee mark may be used by any person whose goods or services have features provided for in the regulations provided that such person pays a fee to the proprietor of the guarantee mark.

(4) A guarantee mark may indicate the geographical origin of the goods or services designated with the guarantee mark.

(5) The use of a collective mark by at least one member of the association which is the proprietor of the collective mark and the use of a guarantee mark, with the permission of the proprietor of the guarantee mark, by at least one person whose goods or services have features provided for in the regulations constitute use of a trade mark within the meaning of § 17 of this Act.

§ 64. Additional grounds for declaration of invalidity of exclusive right of proprietor of collective mark or guarantee mark or declaration of such exclusive right extinguished

(1) If regulations cannot be applied and the proprietor of the trade mark fails to eliminate deficiencies in the regulations during the term set by a court on the basis of an action filed by an interested person, the exclusive right of the proprietor of the collective mark or guarantee mark shall be declared invalid.

(2) If regulations cannot be applied due to amendments made thereto or changed circumstances and the proprietor of the trade mark fails to eliminate deficiencies in the regulations during the term set by a court on the basis of an action filed by an interested person, the exclusive right of the proprietor of the collective mark or guarantee mark shall be declared extinguished.

(3) If the proprietor of a collective mark or guarantee mark allows use of the collective mark or guarantee mark in conflict with law or the regulations and fails to eliminate deficiencies during the term set by a court, exclusive right of the proprietor of the collective mark or guarantee mark shall be declared extinguished based on the action of an interested person.

§ 65. Specifications of protection of exclusive right to collective marks and guarantee marks

(1) The user of a collective mark or guarantee mark may file an action for the protection of trade mark rights only with the permission of the proprietor of the trade mark. The user of a collective mark or a guarantee mark may file an action without the permission of the proprietor of the trade mark after giving notice of an infringement of the exclusive right to the proprietor of the trade mark if the proprietor of the trade mark fails to file an action within a reasonable period of time.

(2) The user of a collective mark or guarantee mark is entitled to enter a proceeding initiated on the basis of an action filed by the proprietor of the trade mark in order to claim compensation for damage suffered.

Chapter 7. International registration of trade marks ➡

§ 66. International registration of trade marks

(1) International registration of a trade mark means the registration of the trade mark in the International Register of the Bureau pursuant to the Madrid Protocol.

(2) The Patent Office is the Office of Origin and the Office of the Contracting Party within the meaning of the Protocol.

(3) Applications for licences to be entered in the International Register of the Bureau shall be filed directly with the Bureau.

§ 67. Application for international registration

(1) An Estonian citizen or a person whose residence or seat is located in Estonia or who has a commercial or industrial enterprise operating in Estonia may file an application for international registration (hereinafter international application) with regard to the same trade mark and same goods and services for which the person has filed an application or has registered a trade mark in Estonia.

(2) An international application shall comply with the form and content requirements established in the Madrid Protocol and its Common Regulations. The procedure for filing international applications with the Patent Office shall be established by the Minister of Economic Affairs.

(3) International application documents shall be submitted in English.

(4) An international application shall not be forwarded to the Bureau if the state fee for the filing of the international application is not paid.

(5) International fees pursuant to paragraphs 2-7 of Article 8 of the Madrid Protocol shall be paid directly to the Bureau.

§ 68. Processing of international applications

(1) The Patent Office shall verify the compliance of information in an international application with the information in the application or information concerning the registration which is the basis for the international application, confirm the correctness of information in the international application and forward the international application to the Bureau.

(2) The date and number of the international registration of an internationally registered trade mark (hereinafter international registration) shall be entered in the register if the international application is made on the basis of a registration, or a corresponding notation shall be made in the application which is being processed if the international application is made on the basis of such application.

§ 69. Effect of international registration

(1) Legal protection arising from an international registration valid in Estonia is equal to legal protection arising from a national registration and the rights and obligations arising from an internationally registered trade mark are equal to those arising from a nationally registered trade mark.

(2) An international registration shall not be valid in Estonia if the grant of legal protection is

refused as a result of processing the international registration.

(3) If a nationally registered trade mark is also registered internationally with regard to the same goods and services, a notation shall be made in the register concerning the replacement of the national registration at the request of the proprietor of the trade mark, unless the international application is filed on the basis of subsection 67 (1) of this Act.

§ 70. Processing of international registration

(1) The Patent Office shall perform an expert examination of international registrations in which Estonia is indicated to be a Contracting Party.

(2) The Patent Office shall perform expert examinations and process international registrations pursuant to the provisions of this Act, taking account of the specifications arising from the Madrid Protocol and its Common Regulations.

(3) The grant of legal protection shall be refused if circumstances which preclude legal protection exist.

(4) The Patent Office shall notify the Bureau of a refusal to grant legal protection within eighteen months as of the date of notice of the international registration of the trade mark.

(5) In the case and under the conditions provided for in Article 5 (2) (c) of the Madrid Protocol, the Patent Office may give notice of refusal to grant legal protection after the expiry of eighteen months as of the date of notice of the international registration of the trade mark.

(6) If there are no circumstances which preclude legal protection, a notice concerning the international registration shall be published in the official gazette of the Patent Office.

(7) Decisions on international registrations made by the Patent Office and the rights of applicants shall be contested pursuant to the provisions of this Act, taking account of the specifications arising from the Madrid Protocol and its Common Regulations. The Bureau shall be notified of a contestation and the decision made in the matter.

§ 71. Invalidity of international registration and alteration thereof to national application

(1) If an international registration becomes invalid, the international registration in Estonia becomes invalid on the same date.

(2) If the international registration of a trade mark is cancelled pursuant to Article 6 (4) of the Madrid Protocol, this trade mark may be registered as a national trade mark with regard to the goods and services included in the international registration if the proprietor of the trade mark files an application with the Patent Office within three months as of the date of cancellation of the international registration. The date of international registration of the trade mark shall be deemed to be the filing date of such application.

(3) An application specified in subsection (2) of this section must meet the requirements provided for in Chapter 4 of this Act.

Chapter 8. Implementing Provisions ➔

§ 72. Transitional provisions

(1) This Act applies to earlier rights and obligations relating to trade marks unless otherwise provided in this section.

(2) Reviewing decisions made by the Patent Office, the Industrial Property Committee or courts prior to 1 January 2003 shall be based on legislation in force at the time of making the decision.

(3) The Patent Office, the Industrial Property Committee and courts shall be guided by procedural provisions in force at the time of conducting proceedings in the matter.

(4) If, pursuant to the Act which was in force earlier, circumstances which preclude legal protection existed with regard to an application which is being processed by the Patent Office but such circumstances do not exist according to this Act, the trade mark shall be registered with the filing date of the application being 1 January 2003 if the applicant submits a corresponding request.

(5) More favourable provisions apply to persons who committed offences prior to 1 January 2003.

(6) If the limitation period valid before 1 January 2003 has not expired by the date of entry into force of this Act and a different limitation period is provided for in this Act, the longer limitation period applies.

§ 73. Repeal of Trade Marks Act

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) is repealed as of entry into force of this Act.

§ 74. Entry into force of Act

This Act enters into force on 1 January 2004.

(21.11.2002 entered into force 01.01.2004 - RT I 2002, 99, 585)

1 RT = Riigi Teataja = State Gazette