

Issuer:	Riigikogu
Type:	act
In force from:	01.01.2012
In force until:	28.03.2019
Translation published:	18.11.2013

Trade Marks Act¹

Passed 22.05.2002
RT I 2002, 49, 308
Entry into force 01.05.2004

Amended by the following acts

Passed	Published	Entry into force
21.11.2002	RT I 2002, 99, 582	01.05.2004
16.12.2003	RT I 2003, 82, 555	01.05.2004
17.12.2003	RT I 2003, 88, 594	08.01.2004
10.03.2004	RT I 2004, 20, 141	01.05.2004
09.03.2005	RT I 2005, 18, 104	08.04.2005
15.06.2005	RT I 2005, 39, 308	01.01.2006
26.01.2006	RT I 2006, 7, 42	04.02.2006
06.12.2006	RT I 2006, 61, 456	01.01.2007
17.12.2008	RT I 2009, 4, 24	01.03.2009
07.12.2011	RT I, 28.12.2011, 1	01.01.2012

Chapter 1 GENERAL PROVISIONS

§ 1. Scope of application of Act

(1) This Act regulates the legal protection of well-known and registered trade marks and service marks (hereinafter trade mark), rights and obligations related to trade marks and, in the cases provided for in this Act, rights and obligations related to trade marks registered by the Office for Harmonization in the Internal Market (hereinafter Community trade mark) on the basis of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ L 11, 14/01/1994 pp. 1–36) (hereinafter Community Trade Mark Regulation).

(2) The Minister of Justice shall issue a regulation for the implementation of this Act in matters where the competence of a Member State for taking decisions arises from corresponding legal acts of the European Union or from this Act (hereinafter regulation on trade marks).
[RT I, 28.12.2011, 1 - entry into force 01.01.2012]

§ 2. Equality of persons

The rights and obligations prescribed in this Act and other legal acts 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 an operating commercial or industrial enterprise 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. Substance 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 is granted to:

- 1) trade marks which are well known in Estonia within the meaning of Article 6 *bis* 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);
- 3) trade marks with a registration, valid in Estonia, entered in the International Register of the Bureau pursuant to the Madrid Protocol.

(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.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 6. Representability of protected trade marks

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

(2) [Repealed – RT I 2004, 20, 141 – entry into force 01.05.2004]

§ 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 recognise a trade mark as being well known only in connection with the registration procedure of the trade mark or other trade marks. The Industrial Property Board of Appeal shall consider a trade mark as being well known only in connection with the adjudication of an appeal against a decision of the Patent Office or a revocation application concerning the legal protection of the trade mark.

(3) The following is taken into consideration while 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) It is sufficient for recognising a trade mark 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 filed 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 Principles of Legal Regulation of Industrial Property Act (RT I 2003, 18, 98; 82, 555).

(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 has passed since the date of making the registration. The term of legal protection of a trade mark may be renewed 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 is not 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 *bona fide* business practices;
 - 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 mislead 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 order 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, armorial bearings 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 filed 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 of a trade mark, it 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 is not 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 consumers, 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 filed 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 might take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark which has been acquired by the filing date of the application or by the date of priority of the later trade mark;
[RT I 2009, 4, 24 - entry into force 01.03.2009]
 - 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 application, the date of international registration or the date of priority, and the area of activity of the respective undertaking is in the same field as the goods and services which the trade mark is used to or is going to be used to designate;
[RT I 2006, 61, 456 - entry into force 01.01.2007]
 - 5) which are identical or confusingly similar to the name of a proprietary medicinal product registered in Estonia prior to the filing date of the application, the date of international registration or the date of priority if the goods which the trade mark is used to or is going to be used to designate belong to the field of medicine;
[RT I 2009, 4, 24 - entry into force 01.03.2009]
 - 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 is used in another country and was used in that country also on the date on which the application was filed, 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 grant of legal protection in writing.

§ 11. Earlier trade mark and other earlier rights

(1) An “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 filed for registration if the filing date of the application or the date of priority is earlier. A trade mark filed for registration is 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 filed for registration on the basis of the Madrid Protocol if the date of international registration or date of priority is earlier. A trade mark filed for registration is an earlier trade mark only if legal protection for the trade mark is not refused in Estonia;
- 6) a Community trade mark registered on the basis of the Community Trade Mark Regulation if the filing date of the application, date of priority or the seniority date granted on the basis of the Estonian registration is earlier;
- 7) a Community trade mark filed for registration on the basis of the Community Trade Mark Regulation if the filing date of the application, date of priority or the seniority date granted on the basis of the Estonian registration is earlier. A trade mark filed for registration is an earlier trade mark only if it is registered.

(2) While determining other earlier rights, the date of acquisition of the corresponding right in Estonia is 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.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 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 or in the International Register of the Bureau.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(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

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(1) Acts related to trade marks shall be performed at the Patent Office and at the Industrial Property Board of Appeal (hereinafter Board of Appeal) by interested persons or by patent attorneys who are expressly authorised by the interested persons and who have been awarded patent attorney qualifications for operation in the area of trade marks pursuant to the Patent Attorneys Act. An interested person or patent attorney may involve, at own expense, an interpreter or adviser without the right of representation in an oral procedure at the Patent Office or at the Board of Appeal.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(2) A person with no residence, seat or commercial or industrial enterprise operating in Estonia shall authorise a patent attorney as the person's representative to perform procedures related to trade marks at the Patent Office and at the Board of Appeal, except the filing of an application.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(3) If several persons jointly perform acts related to trade marks at the Patent Office and at the Board of Appeal, they may authorise a patent attorney as their representative or choose a representative from among themselves (hereinafter joint representative) whose residence, seat or an operating commercial or industrial enterprise is in Estonia. A joint representative has the right to perform all acts related to the processing of an application in the name of the applicants.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

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 which is identical with or similar to the trade mark which is granted legal protection in relation to goods or services which are identical with or similar to those for which the trade mark is protected if there is the likelihood of confusion on the part of the consumers, including the likelihood of association between the sign and the trade mark which is granted legal protection;

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 might take unfair advantage of, or be 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, distributing or storing 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 while establishing 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, 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 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.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 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 agreed, for a period of five consecutive years, with the use of the later trade mark. The limitation does not apply if the proprietor of the later trade mark commenced the 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 has no right to prohibit further commercial exploitation of goods which have been put on the market in Estonia or in a state which is a contracting party to the Agreement of the European Economic Area under that trade mark by the proprietor or with the proprietor's consent unless the proprietor has a legitimate interest in opposing further commercial exploitation of goods, especially if the characteristics of the goods have changed since they were put on the market.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

§ 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 from the representation of the mark in minor elements which do not alter the distinctive character of the mark;
- 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 transfers 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 as of 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 as of 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 distribute the goods and services among 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.

(4) A licence expires with the expiry of the term of the registration.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 22. Notation concerning prohibition

In order to secure an action, a notation concerning 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 is 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 in such manner that the person for whose benefit the pledge is established (hereinafter pledgee) has the right to satisfaction of the claim secured by the pledge out of 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 files 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 from the filing date of the first application, priority may be established:

- 1) on the basis of the filing date of the first application in a country which has acceded to the Paris Convention for the Protection of Industrial Property or in member state of the World Trade Organisation;
- 2) on the basis of the filing date of the first application in a country which has not acceded 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 in 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 filed 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 priority claim 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 impression 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 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) [Repealed – RT I 2009, 4, 24 – entry into force 01.03.2009]
 - 5) the term of the authorisation, if the authorisation is granted for a specified term;
 - 6) the signature of the person represented;
 - 7) the date of issue of the authorisation document.
- [RT I 2009, 4, 24 - entry into force 01.03.2009]

§ 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 from the filing date of an application.

(3) Documents certifying a priority claim shall be filed within three months from the filing date 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 requirements for the contents and form as well as the procedure for filing of the application and other documents to be submitted to the Patent Office shall be established by the regulation on trade marks.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 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 in Estonian;

[RT I 2004, 20, 141 - entry into force 01.05.2004]

2) a representation of the trade mark;

3) a list in Estonian of goods and services for which the registration application is filed;

[RT I 2004, 20, 141 - entry into force 01.05.2004]

4) the name of the applicant and information necessary for enabling the Patent Office to communicate with the applicant or a representative of the applicant.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

§ 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 by the Patent Office, the date of receipt of the application by 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.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(3) The Patent Office is not required to give notice as provided for in subsection (2) of this section if the filed documents do not contain the information set out in clause 35 4) of this Act. In such event the applicant may, on own initiative, file all the missing information as specified in § 35 of this Act within two months from the date of receipt of the initially filed documents by the Patent Office.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(4) If an applicant files all the missing 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 information specified in § 35 is submitted to the Patent Office is 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, is 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 is not 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. Verification of requirements for contents and form of applications

(1) If it becomes evident in the course of verification of the compliance of an application with the requirements for contents and form 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 is deemed to be withdrawn.

(4) If an applicant does not file a priority claim within the term provided for in subsection 34 (2) 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.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 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.

(1¹) While examining a trade mark with regard to clause 10 (1) 4), the Patent Office shall consider, as the areas of activity of an undertaking, those areas of activity of the year ended and the areas of activity intended for the new accounting year which were announced to the commercial register or recorded in the annual report before the filing date of the application, the date of international registration or date of priority.

[RT I 2006, 61, 456 - entry into force 01.01.2007]

(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 provision of explanations. If the applicant fails to respond by the due date, the application is 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 with the element which is not subject to protection or to provide explanations. If notification of agreement with the element which is not subject to protection is not given or a relevant explanation is not provided by the due date, the applicant is deemed to have agreed with 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 has eliminated the circumstances which were revealed by the examination and which precluded 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 precluded 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 a 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 notice of decision to register trade mark

(1) A notice concerning a decision to register a trade mark is published in the official gazette of the Patent Office «Eesti Kaubamärgileht» (hereinafter official gazette of the Patent Office).

(2) The structure and procedure for the publication of the official publication of the Patent Office shall be established by the regulation on trade marks.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 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 Board of Appeal within two months from the date of making the decision.

(2) An interested person may contest an applicant's right to a trade mark at the Industrial Property Board of Appeal if circumstances specified in subsection 9 (1) or § 10 of this Act which preclude legal protection exist.

The term for filing a revocation application is two months from the publication of the notice of the decision to register a trade mark.

(3) In case an appeal or revocation application is granted in whole or in part, the Board of Appeal shall annul the decision of the Patent Office and require the Patent Office to continue the processing taking into account the facts set out in the decision of the Board of Appeal.

(4) If an appeal is granted, the applicant has the right to a refund of the paid state fee.

(5) A participant in a processing concerning a revocation application who is not satisfied with a decision of the Board of Appeal regarding the legal protection of a trade mark, may file an action, within the term provided for in subsection 64 (1) of the Principles of Legal Regulation of Industrial Property Act, against another participant in the processing to establish the circumstances which preclude the legal protection of the trade mark or non-existence of such circumstances.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(6) After the entry into force of a court decision made as a result of the action, the Patent Office shall continue the processing of the application on the basis of the circumstances established by the court decision.

[RT I 2005, 18, 104 - entry into force 08.04.2005]

§ 42. Renewal of terms

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

(2) The Patent Office shall renew 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 shall 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 concerning the earlier trade mark enters into force and shall notify the applicant thereof. The examination of a trade mark depends on the decision to be made concerning an earlier trade mark if the registration of the earlier trade mark constitutes the circumstance precluding the legal protection provided for in § 10 of this Act with regard to the later trade mark.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

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

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(3) Suspended processing is 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 divide the application into two or more applications by distributing the goods and services among the applications. The application may be divided until a decision to register or refuse the registration of a trade mark is made or until the end of proceedings concerning an appeal filed with regard to or concerning a revocation application deriving from a decision to register or refuse the registration of a trade mark. To divide an application, a corresponding request shall be submitted together with information concerning payment of the state fee.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(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 by the Patent Office.

§ 45. Correction and supplementation of applications

An applicant may, until a decision to register or refuse the registration of a trade mark is made, make corrections and supplements to the application provided that such corrections and supplements 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 from 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 from 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 is 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 by 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 is terminated. If processing is terminated, the application documents are not returned and the state fee is not 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 the applicant failed to perform the acts due to *force majeure* or some other impediment beyond the control of the applicant or a representative of the applicant.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(4) The Patent Office shall resume the 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 the 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 is 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 proprietor of the trade mark, if the proprietor of the trade mark has a representative;

[RT I 2009, 4, 24 - entry into force 01.03.2009]

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 are published in the official gazette of the Patent Office.

§ 49¹. Certificate of registration

(1) After entry of a trade mark in the register, the Patent Office issues, within twenty working days, a certificate of registration to the proprietor of the trade mark.

(2) Only one certificate of registration is issued regardless of the number of proprietors of a trade mark.

(3) In case of transfer of a trade mark in relation to some of the goods or services or in case of division of a registration, a certificate of registration is issued to the proprietor of the new registration within twenty working days after entry of the new registration data in the register.

(4) A duplicate of a certificate of registration may be issued on the basis of a request of the proprietor of the trade mark. The duplicate is issued within twenty working days from the submission of the request and information certifying the payment of the state fee.

(5) The formal requirements for a certificate of registration and the procedure for the completion of the certificate form shall be established by the regulation on trade marks.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 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 supplementary state fee.

(3) Renewal of the term of legal protection of a trade mark enters into force as of the date of expiry of the term.

§ 50¹. Request for entry on transfer of trade mark in register

(1) A written request of the applicant, proprietor of the trade mark or another entitled person shall be the basis for making an entry on transfer of a trade mark in the register.

(2) Information concerning payment of the state fee shall be appended to the request.

(3) If the request is submitted by the new proprietor of the trade mark or the person to whom the rights conferred by the trade mark transfer, a document certifying the surrender or the transfer of the rights, or a transcript of the document officially certified by the Patent Office shall be appended to the request.

(4) In case of transfer of a trade mark encumbered with a registered security over movables, the written consent of the pledgee shall be appended to the request.

(5) In case of transfer of a trade mark in relation to some of the goods or services, a list of the goods and services to be transferred and a list of the goods and services which remain in the registration data shall be appended to the request.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 50². Request for entry on amendment of registration data in other cases

(1) A written request of the proprietor of the trade mark shall be the basis for making an entry on amendment of registration data.

(2) An entry on amendment of registration data shall not alter the trade mark or change the scope of legal protection thereof, except in the case specified in subsection 19 (1) of this Act.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 50³. Request for entry on surrender of trade mark in register

A written request of the proprietor of the trade mark shall be the basis for making an entry on surrender of the trade mark.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 50⁴. Request for entry on division of registration in register

(1) A written request of the proprietor of the trade mark shall be the basis for making an entry on division of the registration.

(2) Information concerning payment of the state fee shall be appended to the request.

§ 50⁵. Request for entry of licence in register

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(1) A written request of the licensor or the licensee shall be the basis for an entry concerning a licence in the register.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(2) An extract of the licence agreement, authenticated by the Patent Office, which contains information necessary for making an entry regarding the parties to the agreement, nature, scope and term of the licence, shall be appended to a request for entry concerning a licence in the register. Information on payment of the state fee shall also be appended to the request. The extract need not be submitted if the request for making an entry of licence in the register has been signed both by the licensor and the licensee and the request contains the information necessary for making the entry.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(3) An entry concerning a licence agreement shall be deleted upon expiry of the term of the licence or at the request of the person who filed the request for entry concerning the licence in the register.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 50⁶. Request for entry of pledge in register

(1) A written request of the proprietor of the trade mark or the pledgee shall be the basis for an entry concerning a pledge in the register.

(2) A notarised agreement for the establishment of the pledge and information concerning payment of the state fee shall be appended to the request.

(3) In order to have the conditions of an agreement for the establishment of the pledge amended, a request together with a notarised annex to the agreement for the establishment of the pledge, a court judgment or another document certifying the amendment and information concerning payment of the state fee shall be filed.

(4) In order to have the person of the pledgee changed, a request together with a notarised document certifying the change and information concerning payment of the state fee shall be filed.

(5) In order to have the ranking of a registered security over movables changed, a request together with the agreement between the persons the ranking of whose rights is changed and information concerning payment of the state fee shall be filed.

(6) An entry concerning a registered security over movables shall be deleted from the register upon termination of the claim secured by the pledge or waiver of the pledge.

(7) In case of waiver of the pledge, the pledgee shall file a request together with a notarised request for waiver of the pledge.

(8) Amendment or deletion of an entry concerning a registered security over movables at the request of the proprietor of the trade mark requires the notarised consent of the persons whose right, entered in the register, might be prejudiced by the amendment or deletion of the entry.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 50⁷. Processing of requests specified in §§ 50–50⁶

(1) If a request specified in §§ 50–50⁶ is filed by an authorised representative, an authorisation document shall be appended to the request. The authorisation document need not be appended if an authorisation document filed with the Patent Office earlier for the performance of the act is valid.

(2) The applicant shall be given notice of the making of an entry not later than on the twentieth working day after the date of receipt of a valid request and necessary documents.

(3) A notice concerning the making of an entry shall be published in the official gazette of the Patent Office.

(4) If some of the information or documents necessary for the making of an entry are missing, the applicant shall be notified thereof not later than on the fifteenth working day as of the receipt of a defective request by the Patent Office and a term of two months shall be set for the elimination of deficiencies. If it is not possible to make the entry by the specified due date on the basis of the documents submitted, the request is deemed to be not filed.

(5) If it is not possible to make an entry for any other reason provided by law, the applicant shall be notified thereof not later than on the fifteenth working day as of the receipt of the request by the Patent Office.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 51. Deletion of trade mark from register

(1) A trade mark is deleted from the register six months after expiry of its term unless renewal of the term of the trade mark has been requested. The deletion enters into force retroactively as of the date of expiry of the term.

(2) A trade mark is 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.

(3) A trade mark is deleted from the register at the request of an interested person, if during one year as of the deletion of the company from the commercial register no written request is filed for the making of an entry in the register on the transfer of the trade mark.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 51¹. Access to register

(1) Prior to the publication of the notice of the decision concerning registration of a trade mark, it is permitted to release the following information from the register: representations of trade marks, numbers of registration applications, filing dates of registration applications, information on priority, names of applicants, names of representatives of applicants, lists of goods and services, and class numbers of the international classification.

(2) Prior to the publication of the notice of the decision concerning registration of a trade mark, access to a registry file is granted to the applicant and a person who has written consent of the applicant, or a person who proves that the applicant, after the registration of the trade mark, intends to blame the person of infringement of the applicant's exclusive right of the proprietor of trade mark.

(3) After the publication of the notice of the decision concerning registration of a trade mark, the register is public. Everyone has the right to have access to the registry file and data entered in a record.

(4) In order to have access to a registry file or to receive copies or printouts from the register, a written request together with information concerning payment of the state fee for each file, copy or printout of a document is submitted. Applicants and proprietors of trade marks have access to the registry files concerning their trade marks free of charge.

(5) In order to receive a document certifying priority, which consists of the confirmation by the Patent Office and a copy of the application, the applicant or proprietor of the trade mark shall submit a written request together with information concerning payment of the state fee.

(6) The procedure for access to the register and release of information from the register shall be established by the regulation on trade marks.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

Chapter 5 CONTESTATION OF RIGHTS IN COURT AND CIVIL LIABILITY

§ 52. Declaration of nullity 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 null and void if circumstances specified in §§ 9 or 10 of this Act which preclude legal protection exist and existed also at the time when the decision to register the trade mark was made.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(2) An action provided for in subsection (1) of this section may be filed:

- 1) within five years after becoming aware of the use of the trade mark;
- 2) without a term if the application for registration of the trade mark was filed in bad faith.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(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, within five years after becoming aware of the registration of the trade mark to the name of the representative, 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 null and void 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) [Repealed - RT I 2009, 4, 24 – entry into force 01.03.2009]

§ 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 an act 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 an act or failure to act by the proprietor of the trade mark, become misleading for 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;
- 4) a trade mark, concerning which a registration valid in Estonia is entered in the International Register of the Bureau pursuant to the Madrid Protocol, has not been used within the meaning of § 17 of this Act during five consecutive years after grant of legal protection to the trade mark in Estonia.

(2) An action specified in subsection (1) of this section cannot be filed on the basis of clauses (1) 3) and 4) of this section if the use of a registered trade mark within the meaning of § 17 of this Act after five years of non-use commences prior to filing of the action.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(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.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 54. Declaration of nullity 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 nullity of his or her exclusive right to the trade mark filed 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 similar, 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 nullity of the exclusive right to use the trade mark.

(3) For the purposes of this section, a trade mark is filed for registration in bad faith if the person who filed the application knew or should have known that the sign indicates that goods or services originate from a certain geographical area and a certain characteristic, repute 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 nullity 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 nullity 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 null and void as of 10 January 2000.

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

(1) If an exclusive right is declared null and void, 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 nullity 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 nullity of exclusive right and partial declaration of exclusive right extinguished

If grounds for the declaration of nullity 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 null and void 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 consent of the proprietor of the trade mark. A licensee may file an action without consent 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 quantity of unlawfully designated goods, including the names and addresses of the manufacturer, supplier, previous proprietors and resellers of such goods.

§ 59. Counterclaims

(1) A person against whom the proprietor of a trade mark under legal protection in Estonia has filed an action for the protection of the exclusive right or against whom proceedings concerning an offence have been initiated, may contest the exclusive right of the proprietor of the trade mark.

(2) The proceedings concerning an offence shall be suspended for the period of the proceedings conducted concerning the counteraction specified in subsection (1) of this section.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

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

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

(2) Implementation of provisional measures referred to in Article 50 of the Agreement on Trade-Related Aspects of Intellectual Property Rights in Annex 1C to the WTO Agreement (RT II 1999, 22, 123) falls within the competence of the county court in the jurisdiction of which the offence occurred. A petition for the securing of an action shall be reviewed immediately.

(3) A court shall send a copy of the decision made in a dispute related to a trade mark to the Patent Office for its information.

[RT I 2005, 39, 308 - entry into force 01.01.2006]

§ 60¹. Representatives in court disputes concerning trade marks

(1) In resolution of a dispute related to a trade mark, a patent attorney may act as a representative in a county court and circuit court. In Supreme Court, a patent attorney may act as a representative only together with an attorney-at-law.

(2) In the protection of their rights, a proprietor of a trade mark may be represented by an organisation with passive legal capacity representing proprietors of trade marks while being a member of such an organisation.
[RT I 2006, 7, 42 - entry into force 04.02.2006]

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 is registered if there are no circumstances which preclude legal protection and:

- 1) the regulations are not contrary to public order 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 is 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) [Repealed – RT I 2004, 20, 141 – entry into force 01.05.2004]

(2) The use of a collective mark or guarantee mark by 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 the use of a trade mark within the meaning of § 17 of this Act.

§ 64. Additional grounds for declaration of nullity 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 within 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 null and void.

(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 within 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 within the term set by a court, the 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 rights conferred by a trade mark only with the consent of the proprietor of the trade mark. The user of a collective mark or a guarantee mark may file an action without the consent 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 requirements for contents and form established in the Madrid Protocol and its Common Regulations. The procedure for filing international applications with the Patent Office shall be established by the regulation on trade marks.

(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.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 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 in the registration data 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 is not 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 examination of international registrations in which Estonia is indicated to be a Contracting Party.

(2) The Patent Office shall perform 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 from 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 notify the Bureau of refusal to grant legal protection after the expiry of eighteen months from 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 can 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.

(8) The Patent Office shall establish and maintain the database of national processing of international registrations in which the Republic of Estonia is a Contracting Party.

(9) Information specified in subsection 51¹(1) of this Act shall be released from the database of national processing of international registrations.

(10) A state fee shall be paid for the release of information from the database of national processing of international registrations.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 71. Invalidity of international registration and conversion 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 from the date of cancellation of the international registration. The date of international registration of the trade mark is deemed to be the filing date of such application.

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

Chapter 7¹ COMMUNITY TRADE MARK

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 71¹. Registration of Community trade mark

(1) The registration of a Community trade mark means the registration of a trade mark with the Office for Harmonization in the Internal Market on the basis of the Community Trade Mark Regulation.

(2) The Patent Office is the central office in the field of legal protection of industrial property within the meaning of the Community Trade Mark Regulation.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 71². Application for Community trade mark

(1) An application for a Community trade mark may be filed with the Patent Office which shall forward the application to the Office for Harmonisation in the Internal Market within two weeks from the date of filing of the application, and shall issue a corresponding notice to the applicant. Upon filing an application for a Community trade mark with the Patent Office, a state fee for the forwarding of the application to the Office for Harmonisation in the Internal Market shall be paid.

(2) An application for a Community trade mark shall be in conformity with the requirements for the content and form as specified in the Community Trade Mark Regulation and in the Commission Regulation 2868/95/EC concerning the enforcement of the Council Regulation on the Community trade mark (OJ L 303, 15/12/1995 pp. 1–32). The application fee specified in Article 26 (2) of the Community Trade Mark Regulation shall be paid directly to the Office for Harmonisation in the Internal Market.

(3) The procedure for filing an application for a Community trade mark with the Patent Office shall be established by the Minister of Justice by the regulation on trade marks.

[RT I, 28.12.2011, 1 - entry into force 01.01.2012]

(4) The Patent Office does not accept or forward any other documents or letters to be submitted to the Office for Harmonisation in the Internal Market.

(5) Estonian citizens and legal persons whose seat is in the Republic of Estonia are deemed to be the persons specified in paragraph 1 (a) of Article 5 of the Community Trade Mark Regulation.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 71³. Conversion of Community trade mark application or Community trade mark into a national trade mark application

(1) Upon conversion of Community trade mark application or Community trade mark into a national trade mark application pursuant to the provisions of Section 3 of the Community Trade Mark Regulation, the date of filing of an application for a Community trade mark or the date of priority of that application or trade mark or the seniority date is deemed to be the date of national filing.

(2) The seniority date is the date of filing only where the basis for the seniority of a Community trade mark is a national trade mark registered in Estonia or a trade mark valid in Estonia pursuant to the Madrid Protocol.

(3) Upon conversion of Community trade mark application or Community trade mark into a national trade mark application pursuant to the provisions of Article 108 of Community Trade Mark Regulation, the person requesting conversion shall file the following documents within two months from the date on which a corresponding request from the Office for Harmonisation in the Internal Market is received by the Patent Office:

- 1) the request for conversion and the Estonian translation of the accompanying documents;
- 2) the address of a commercial or industrial enterprise operating in Estonia and belonging to the person of a foreign state or the authorisation document of an authorised patent attorney;
- 3) a representation of the trade mark;
- 4) information concerning payment of the state fee.

(4) The acts of the Patent Office in the processing of a request for conversion shall be established by the regulation on trade marks.

(5) The Patent Office shall perform examination and process requests for conversion pursuant to the provisions of Chapter 4 of this Act, taking into account the specific provisions arising from the Community Trade Mark Regulation.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 71⁴. Retroactive declaration of invalidity of trade mark deleted from register

If seniority of a trade mark valid in Estonia is claimed for a registered Community trade mark or a Community trade mark which has been filed for registration on the basis of an earlier registered trade mark or the Madrid Protocol pursuant to Articles 34 and 35 of the Community Trade Mark Regulation, an action may be filed for the exclusive right of the proprietor of the earlier trade mark to be declared null and void pursuant to § 52 of this Act or action against the proprietor of the earlier trade mark for the exclusive right of the proprietor of the trade mark to be declared extinguished pursuant to § 53 of this Act even if the earlier trade mark has been deleted from the register due to refusal to renew the term or is surrendered by the proprietor.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

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

(1) Matters relating to legal protection and validity of Community trade marks are heard by Harju County Court as the Community trade mark court of first instance.

(2) Appeals against the judgments of the Community trade mark court of first instance shall be reviewed by Tallinn Circuit Court as the Community trade mark court of second instance.
[RT I 2005, 39, 308 - entry into force 01.01.2006]

§ 71⁶. Prohibition on use of Community trade mark

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(1) A proprietor of an earlier trade mark or another earlier right may, under the conditions specified in Article 159a (5) of the Community Trade Mark Regulation, file an action against a proprietor of the Community trade mark for the protection of an exclusive right pursuant to subsection 57 (1) of this Act for the prohibition on the use of the Community trade mark in Estonia.
[RT I 2009, 4, 24 - entry into force 01.03.2009]

(2) If the proprietor of an earlier trade mark or another earlier right has filed an action for the protection of an exclusive right on the basis of subsection (1) of this section, the proprietor may request the application of supplementary protection requirements specified in § 58 of this Act only in respect of goods located in Estonia.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

Chapter 8 IMPLEMENTING PROVISIONS

§ 72. Transitional provisions

[RT I 2004, 20, 141 - entry into force 01.05.2004]

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

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(2) The exclusive right of proprietor of trade mark shall not be declared extinguished on the basis of clause 53 (1) 3) of this Act if the period of five years specified in the clause commenced before 1 May 2004 and the trade mark was used during the period between the commencement of the period of five years and 1 May 2004 pursuant to an Act regulating trade marks which was in force at the time of the trade mark was used.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

(3) This Act applies to applications processed by the Patent Office concerning which no decision was made before 1 May 2004 to register or refuse to register the trade marks.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(4) Clauses 11 (1) 6) and 7) do not apply to applications the filing date or the date of priority of which is earlier than May 1 2004.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(5) In appeal proceedings against a decision of the Patent Office made before 1 May 2004 and in making a new decision, the bases for refusal to register a trade mark valid at the time of the making of the decision and the procedural provisions in force at the time of the new proceedings in the matter apply.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(5¹) If the grounds for refusal to register a trade mark which were in force before 1 May 2004 were applicable while the Patent Office made a decision to register a trade mark, such grounds are applied also to the hearing of a action for declaration of nullity of the exclusive right of the proprietor of the trade mark.

[RT I 2009, 4, 24 - entry into force 01.03.2009]

(6) In appeal proceedings against a decision made by the Board of Appeal before 1 May 2004 and in making a new decision, the Act regulating trade marks which was force at the time of the making of the decision of the Board of Appeal applies.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(7) The terms specified in subsection 42 (2) and 43 (2) of this Act with respect to applications being processed by the Patent Office on 1 May 2004 shall be calculated as of the date of entry into force of this Act.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(8) More favourable provisions apply to persons who committed offences prior to 1 May 2004.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(9) If the limitation period valid before 1 May 2004 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.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(10) The provisions of this Act governing Community trade marks enter into force upon Estonia's accession to the European Union.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

(11) The legal acts established on the basis of the Trade Marks Act shall be valid after the entry into force of this Act in so far as they are not contrary to this Act, until either repeal thereof or until they are brought into conformity with this Act.

[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 73. Repeal of Trade Marks Act

[Omitted from this text.]

§ 74. Entry into force of Act

This Act enters into force on 1 May 2004.

[RT I 2003, 82, 555 - entry into force 01.05.2004]

¹First Council Directive 89/104/EEC to approximate the laws of the Member States relating to trade marks (OJ L 40, 11.02.1989, pp. 1–7); Council Regulation (EC) No. 40/94 on the Community trade mark (OJ L 011, 14.01.1994, pp. 1–36). [RT I 2009, 4, 24 – entry into force 01.03.2009]