

Trademark Act

(Passed on 27 August 1992 (RT 1992, 35, 459),
entered into force 1 October 1992)

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

15.02.1995 (RT I 1995, 26-28, 355)	01.09.1995
26.06.1996 (RT I 1996, 49, 953)	26.07.1996
17.12.1997 (RT I 1998, 4, 63)	13.01.1998

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

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I. General Provisions

Purpose of the Act

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

[26.06.1996]

Legislation Regulating Legal Protection of Trademarks

2. Legislation regulating the legal protection of trademarks comprises this Act, other acts in this field and regulations based on the acts and issued by the Government of the Republic and the Ministers.

International Agreements

3. If, in certain provisions of a bi- or multilateral international agreement to which the Republic of Estonia is party, certain issues relating to trademarks are regulated differently from those of the legislation of the Republic of Estonia, the former shall prevail.

II. Legal Protection of Trademarks

Definition of the Trademark and the Service Mark

4.—(1) A trademark or a service mark (hereinafter *trademark*) is a sign which a natural or legal person uses or intends to use in economic and commercial activities in order to distinguish his goods or services from the goods and services of the same kind to those of the other natural or legal person.

(2) Goods and services are classified in accordance with the international classification of goods and services adopted under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

[15.02.1995; 17.12.1997]

Legal Protection of Trademarks

5.—(1) Natural and legal person may acquire legal protection for their trademarks in the Republic of Estonia on the basis of and pursuant to the procedure prescribed in this Act.

(2) The State protects the exclusive right of the owner of the trademark to use the trademark that has been granted legal protection.

(3) No natural person or legal entity shall have the right, without the consent of the owner of the trademark, to use a trademark in economic and commercial activities if it is identical with or confusingly similar to the protected trademark used for designation of the same or similar goods and services. The following constitute use of a trademark:

1. affixation of the trademark to goods or packaging;
2. offering goods for sale, putting them on the market or storage for the purpose of sale of goods under the trademark;
3. offering or rendering services under the trademark;
4. importation and exportation of goods under the trademark;
5. use of the trademark in economic and commercial documents, advertising materials or operating manuals relating to the goods.

(4) The owner of a trademark has the right to prohibit the use of the trademark in relation to identical or similar goods or services and other goods or services if the trademark is well-known in the Republic of Estonia and such use takes unfair advantage of or is detrimental to the distinctive character or reputation of the trademark.

(5) The owner of a trademark has no right to prohibit any third party from making use in economic and commercial activities of:

1. the name or address of the third party;
2. indications which designate the kind, quality, quantity, intended purpose, value or geographical origin of goods and services, time of production of goods or of rendering of services, as well as other indications characterising the services or properties of the goods;
3. the trademark if it is necessary to indicate the intended purpose of a good (e.g. as accessories or spare parts) or a service;
4. elements of the trademark which are not subject to protection.

(6) Upon publication of a registered trademark in reference books, manuals, textbooks, professional journals or other publications, the author and publisher shall ensure that the publication includes a warning notice, at the request of the owner of the trademark, pursuant to Section 20 of this Act.

(7) The owner of a trademark has no right to prohibit further distribution, sale or offer for sale of goods which are affixed with the trademark by the owner or with the owner's consent and put on the market in the Republic of Estonia or in foreign states, or the storage, importation or exportation of goods for these purposes under the trademark, except if the quality of the goods has changed after they are put on the market.

(8) The scope of legal protection of a registered trademark shall be based on a reproduction of the trademark.

(9) The scope of legal protection of a registered trademark in relation to goods and services is determined by a list of goods and services. The list of goods and services indicated in the registration may be limited. Extension of the list of goods and services is prohibited.

[15.02.1995; 17.12.1997]

Registrable Trademarks

6.—(1) Any sign or combination of signs which is capable of being represented graphically and consists of letters, words, numerals or designs or is three-dimensional may be registered as a trademark provided that such signs distinguish the goods or services of one natural or legal person from those of others.

(2) A trademark may be registered in black-and-white or colour. A trademark which is registered in black-and-white sign shall be protected in all colour combinations; a trademark which is registered in colour shall only be protected in the colour combination claimed.

(3) Trademarks which consist of sound or smell are not registrable.

(4) A registrable trademark may include elements which are not subject to protection unless this diminishes the distinctiveness of the trademark and does not infringe the rights of other persons.

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

[17.12.1997]

Absolute Grounds for Refusal of Trademark Registration

7.—(1) The following shall not be registered as a trademark:

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

7. trademarks which are contrary to public policy or accepted principles of morality;
8. trademarks the registration of which must be refused on the basis of Article 6ter of the Paris Convention for the Protection of Industrial Property, unless the legally competent official gives written consent for the registration;
9. trademarks which are not covered by Article 6ter of the Paris Convention for the Protection of Industrial Property but which contain the names or their abbreviations, flags, armorial bearings, emblems, seals, honorary distinctions, hallmarks indicating control and warranty, symbols, important elements of symbols or imitations of these signs of the Republic of Estonia or of undertakings or foundations of the Republic of Estonia which are registered in the Republic of Estonia, unless the legally competent official gives written consent for the registration;
10. trademarks which contain the names or their abbreviations, flags, armorial bearings, emblems, seals, honorary distinctions, hallmarks indicating control and warranty, important elements of symbol or imitations of these signs, which are of public interest, of other states or international organisations which are not specified in Article 6ter of the Paris Convention for the Protection of Industrial Property, unless the legally competent official gives written consent for the registration.

(2) Subparagraphs 2, 3 and 4 of paragraph 1 of this Section do not apply if it is certified that by the date of receipt of an application for registration of a trademark (hereinafter also *registration application*), the trademark has, as a result of its use, become well-known in the Republic of Estonia within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property.

(3) Where the sign mentioned in subparagraphs 2, 3, 4 or 5 of paragraph 1 of this Section is used in the composition of the trademark, the said sign shall be deemed as the unprotectable part of the trademark.

[17.12.1997]

Relative Grounds for Refusal of Trademark Registration

8.—(1) The following signs shall not be registered as trademarks:

1. trademarks which are identical with earlier trademarks which are registered or filed for registration in the name of another person to designate identical goods or services;
2. trademarks which are identical with or confusingly similar to or associated with an earlier trademark which is registered or filed for registration in the name of another person to designate goods or services of the same kind, unless the other person gives written consent for the registration;
3. trademarks which are identical with or confusingly similar to or associated with earlier trademarks registered or applied for registration in the name of another person to designate goods or services of a different kind, where they may deceive consumers and as a result take unfair advantage of the repute or be detrimental to the distinctive character of another person's trademark, unless the other person gives written consent for the registration;
4. trademarks or markings of goods which belong to another person and are well known in the Republic of Estonia on the date of receipt of the application for registration of a trademark or on the priority date within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property, regardless of whether or not it is registered, unless the other person gives written consent for the registration;

5. trademarks which are identical with or confusingly similar to a trade name belonging to another person provided that the trade name has been entered in the commercial register prior to the date of receipt of the application for registration of a trademark or the priority date, and the other person's area of activity in respect of which a notation has been made in the commercial register includes the goods and services for which an application for registration is filed, unless the other person gives written consent for the registration;

6. trademarks which include a portrait of a person, the name of a well-known person, the name of a real estate, the name or representation of an architectural object where it infringes the rights of the person depicted in the portrait, the well-known person or the person being the owner of the real estate or of the architectural object, and where the written consent of the entitled person for registration is missing;

7. trademarks including protected industrial designs;

8. trademarks including creative works protected by copyright or their titles where the written consent of the entitled person for registration is missing;

9. trademarks which include the active agent of a medicament or the name of a medicament belonging to another person and registered in the Republic of Estonia prior to the filing date of the application for registration or the priority date;

10. trademarks which are identical with a trademark registered and in use in another country if the application for registration is filed in bad faith.

(2) An earlier trademark within the meaning of subsection (1) of this Section means:

1. a trademark entered in the State Register of Trademarks and Service Marks with a filing date of the application for registration or priority date which is earlier than the date of receipt or the priority date of the application for registration of the trademark in question;

2. a trademark filed for registration in the Republic of Estonia with a date of receipt of the application for registration or priority date which is earlier than the date of receipt or priority date of the application for registration of the trademark in question, if the trademark is entered in the State Register of Trademarks and Service Marks;

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

[17.12.1997]

III. Registration of Trademark

Registration Application of a Trademark

9.—(1) A registration application shall be filed with the Patent Office by an applicant (natural or legal person) and accompanied by payment of the state fee.

(2) A registration application may be filed, and all proceedings for the maintenance of the trademark may be effected, through the patent attorneys of the Republic of Estonia. Foreign natural or legal persons shall perform matters connected with the registration and maintaining of trademarks in the Republic of Estonia through the Estonian patent attorneys.

(3) A registration application shall relate to one trademark only.

(4) A registration application shall contain:

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

(4¹) The document certifying the authority of the patent attorney or the copy of it may be filed within two months after the filing date of the application for registration .

(4²) The statutes of the collective mark may be filed within two months after the filing date of the application for registration .

(5) The documents of the application for registration shall be filed in the Estonian language.

(6) The procedure for filing a registration application and the formal requirements for application documents are established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.

[15.02.1995; 17.12.1997]

Estonian Patent Attorney

9¹.—(1) An Estonian patent attorney is a professional and independent representative, providing legal advice on the legal protection of industrial property and acting on the basis of authorization from such person.

(2) An Estonian patent attorney may be a natural person resident and citizen of the Republic of Estonia who is a resident within the meaning of the Income Tax Act (RT I 1993, 79, 1184; 1998, 9, 111), who complies with the requirements established in the statute of Estonian patent attorneys, has been evaluated pursuant to procedure provided for in the statutes and has been entered in the State Register of Estonian Patent Attorneys.

(3) The statutes of Estonian patent attorneys shall be ratified by the Government of the Republic.

(4) The statutes for maintaining the State Register of Estonian Patent Attorneys shall be ratified by the Government of the Republic.

(5) The chief and authorised processor of the State Register of Estonian Patent Attorneys is the Estonian Patent Office.

[17.12.1997]

Priority of a Trademark

10.—(1) The priority of a trademark is determined as of the date of receipt of the application for registration with the Patent Office.

(2) The priority of a trademark may be claimed on the basis of the filing date of the first application for registration in any state party to the Paris Convention for the Protection of Industrial Property (Convention priority) if the application for registration is filed with the Patent Office within six months after the filing date of the first application.

(3) The priority date of a trademark incorporated on exhibits which is displayed at an international or officially recognised international exhibition in the territory of a state party to the Paris Convention for the Protection of Industrial Property (exhibition priority) is claimed on the basis of the first date of public display of the exhibit at such exhibition if the registration application is filed with the Patent Office within six months after the date of display. The requirements for international exhibitions are specified in the Convention on International Exhibitions of 22 November 1928, and in the subsequent amendments to it.

(4) An applicant wishing to claim either Convention or exhibition priority shall indicate such claim in the registration application and provide documents certifying the claim together with the claim or within three months after the date of receipt of the registration application by the Patent Office.

[17.12.1997]

Filing a Registration Application of a Trademark

11.—(1) A registration application shall be filed with the Patent Office, which upon receipt of the application shall check the compliance of the filed documents with the requirements of Section 9 of this Act.

(2) If a registration application complies with the requirements, the application shall undergo examination and the Patent Office shall notify the applicant of the date of receipt of the application for registration .

(3) If the Patent Office refuses to accept the registration application , the applicant may, after payment of the state fee, contest the refusal at the Board of Appeal for Industrial Property (hereinafter *Board of Appeal*) within two months after the date of refusal to receive the application.

The state fee shall be refunded if the Board of Appeal finds the decision to reject the application for registration unjustified.

Files of Registration Applications, Access to and Release of Information Therefrom

11¹.—(1) The files of applications for registration and their processing is a structured body of data concerning documents of processed applications for registration and information on the processing thereof. The files shall contain information on a registration application and the processing thereof is maintained until the cessation of processing.

(2) Access to the files of applications for registration and their processing as well as the release of information from the files shall generally be prohibited. The following information from the files: reproductions of trademarks, numbers of applications for registration, filing dates of applications for registration , information on priority, names of applicants, names of representatives of applicants, lists of goods and services, and class numbers of the international classification.

(3) Access to the files file containing information on the processing of a registration application is granted to the applicant, persons who have the written consent of the applicant, persons whom the applicant has notified in writing of the filing of a registration application, competent officials of state agencies which have supervisory authority, and the courts.

(4) Information from the files of registration applications and their processing is available upon payment, except with the release of information to state agencies with supervisory authority or to a court. A state fee is charged for the release of information.

(5) The files of registration applications and their processing is established by the Government of the Republic or by the Minister of Economic Affairs as authorised by the Government of the Republic.

[17.12.1997]

Examination of Trademarks

12.—(1) If the examination of a registration application depends on the examination of another application for registration which has earlier priority, the examination is suspended until a final decision is made concerning the application for registration which has earlier priority.

(2) The examination may also be suspended, on the basis of a reasoned request of the applicant, for a period determined by the Patent Office.

(3) During the examination procedure, the Patent Office may require the applicant to make amendments and corrections by a fixed term. The applicant has the right to extend the term upon payment of the prescribed supplementary state fee.

(4) If an applicant fails to respect the term prescribed by the Patent Office, or to pay the state fee, or to respond to the decision made as a result of an examination, the Patent Office shall reject the application for registration .

(5) During the examination procedure the applicant may withdraw the application for registration, in which case the examination shall be terminated.

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

(6) A trademark shall be registered where the examination reveals no issues being the ground for refusal of registration specified in Sections 7 or 8 of this Act.

(6¹) Registration of a trademark shall be refused if the examination reveals at least one issue being the ground for refusal of registration specified in Sections 7 or 8 of this Act. A decision on the refusal of trademark registration shall be reasoned.

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

(6³) A trademark shall be registered with a limitation if the Patent Office determines that a particular element is an element which is not subject to protection pursuant to subsection 7(3) of this Act.

(7) The Patent Office may reconsider its decision on registration of a trademark if there is a registration application which has an earlier priority in conformity with an international agreement to which the Republic of Estonia is party.

(8) In the decision on registration of the trademark the Patent Office shall indicate the unprotectable part of the trademark which is not subject to protection. Upon making a

decision on registration of the trademark, the trademark shall be published in the Official Gazette of the Patent Office.

(9) The processing of a registration application shall cease upon entering the trademark in the State Register of Trademarks and Service Marks or upon refusing of registration of the trademark or upon rejection of the application for registration.

[17.12.1997]

Contesting the Decision on Trademark Registration or Refusal of Trademark

13.—(1) Where the applicant disagrees with the decision of the Patent Office on refusal of registration of a trademark, the applicant may, after payment of the state fee, contest the decision at the Board of Appeal within two months following the date on which the decision was made.

The state fee shall be refunded if the Board of Appeal adjudicates the refusal of trademark registration as unjustified.

(2) The owner of another trademark or other interested persons may contest the decision of the Patent Office on registration of a trademark at the Board of Appeal, after paying the state fee, within two months from publication of the trademark in the Official Gazette of the Patent Office.

[17.12.1997]

State Register of Trademarks and Service Marks

14.—(1) Trademarks shall be entered in the State Register of Trademarks and Service Marks (hereinafter *Register*) after payment of the corresponding state fee. The state fee shall be paid within three months after the expiration of the term for contesting the decision on the registration of a trademark or, upon contesting the decision, after cessation of the contesting procedure. If the document proving payment of the state fee has not been submitted to the Patent Office by the end of the term, the application for registration shall be rejected.

(2) The Patent Office is the chief and authorised processor of the Register.

(3) The registry secretary is responsible for the maintenance of the Register at the Patent Office and for making the decisions on entries in the Register.

(4) The Register is maintained as an entry book on paper carrier. The Register may be maintained on computer storing the entries as print-outs.

(5) The Register is maintained in Estonian. Documents in foreign languages shall be submitted to the authorised processor together with the translation into Estonian.

(6) The expenses for maintenance of the Register is covered from the State Budget via the budget of the Patent Office.

(7) The statutes for maintenance of the Register shall be ratified by the Government of the Republic.

[17.12.1997]

Trademark Certificate

15.—(1) After the trademark has been entered in the Register, the Patent Office shall issue a trademark certificate to the owner.

(2) The formal requirements for the certificate and the procedure for filling in the certificate form are established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.

[17.12.1997]

Publication of Registered Trademark

16.—(1) The Patent Office shall publish trademarks entered in the Register in its Official Gazette.

(2) The statutes on the official publications of the Patent Office shall be ratified by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.

[17.12.1997]

Term of Validity of Trademark

17.—(1) The right to the trademark shall commence on the date of the filing of the application for registration until the expiration of 10 years from the date of entry in the Register.

(2) The validity of the trademark may be renewed at the corresponding request of the owner for a further period of 10 years each time if the owner files the request within one year before the expiration of the preceding period, against payment of the state fee.

(3) After expiration of validity of the trademark, the Patent Office may grant a period of six months to the owner of the trademark for the filing of the request specified in subsection 2 of this Section. The owner of the trademark shall pay the state fees.

(4) The Patent Office makes an entry on the renewal of the trademark in the Register, publishes it in the Official Gazette of the Patent Office, and issues an annex to the certificate certifying the renewal.

[17.12.1997]

IV. Use of Trademark

Requirement of Trademark Use

18.—(1) The owner of a trademark shall be required to use the trademark; transactions specified in subsection 5(3) of this Act shall be construed as use of the trademark.

(2) The requirements set forth in subsection 1 of this Section shall be deemed to be complied with where the owner of a trademark gives a trademark licence to an interested person.

(3) The trademark shall be deemed to be used if the owner uses a trademark different from the registered trademark in minor details without changing the distinctive character of the registered trademark.

[17.12.1997]

Failure to Use a Trademark

19.—(1) Where the owner of the trademark has failed, without a substantiated reason, to comply with the requirements set forth in Section 18 of this Act within the course of a continuous five-year period from the date of entering the trademark in the Register or later, every interested person shall have the right to contest the validity of the registration of the trademark. A state fee shall be paid upon filing of a revocation application.

(2) Revocation application based on the facts specified in subsection 1 of this Section shall be filed with the Board of Appeal who will notify the owner of the trademark and shall invite him to furnish documentary proof of the use of the trademark. The Board of Appeal shall consider the revocation application and make a decision to reject the revocation application or invalidate the registration in full or in part.

[17.12.1997]

Warning Notice

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

[17.12.1997]

V. Transfer of Trademark

License for a Trademark

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

[17.12.1997]

Assignment of Trademark

22.—(1) The owner of a trademark may assign the registered trademark to a natural person or legal entity for all or some of the goods or services.

(2) An entry shall be made in the Register concerning the assignment of the trademark after payment of the state fee.

[15.02.1995; 17.12.1997]

Transfer of Trademark Rights

23. Upon the dissolution, merger, division or transformation of legal persons or upon pledging of the trademark, the legal status of the trademark will change; the change shall be entered in the Register after payment of the state fee.

[15.02.1995]

Invalidation of Registration of a Trademark and Deletion from the Register

24.—(1) Upon the request of an interested person the Board of Appeal may invalidate the registration of a trademark, where such registration was made in a manner contrary to the requirements of Sections 7 and 8 of this Act.

(2) The request for invalidation of trademark registration may be filed with the Board of Appeal after payment of the state fee within five years from the date of entering the trademark in the Register.

(3) A trademark shall be deleted from the Register by a decision of the Patent Office:

1. if the owner of the trademark files a corresponding request;
2. if the period of validity of trademark expires and the owner of trademark has failed to comply with the provisions of Section 18 of this Act;
3. upon the dissolution of the owner of the trademark legal entity or upon the death of the owner of trademark (natural person) or on other legitimated reasons where the rights conferred by the trademark have not been transferred to the new owner;
4. if the registration of the trademark is invalidated on the basis of subsection 1 of this Section;
5. on the basis of the provisions of Section 17 of this Act.

[15.02.1995; 17.12.1997]

VI. Collective Marks

Definition of a Collective Mark

25. A collective mark is a trademark to which an association of legal persons has been granted an exclusive right to use for designation of its goods and services of the association and those of its members in conformity with conditions prescribed in the statute of the association or in the rules of the trademark.

Registration of Collective Marks

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

Use of Collective Marks

27. A collective mark shall be used in conformity with the provisions of Chapter IV of this Act and the provisions of the statute of the association or of the rules of the trademark.

Invalidation of the Registration of a Collective Mark

28. A collective mark may be invalidated in conformity with the provisions of Section 24 of this Act.

VII. State Fee

State Fee

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

[17.12.1997]

Payment of State Fees

30.—(1) The state fee shall be paid by the applicant, the trademark owner or a third party interested in effecting transactions or the issue of documents prescribed in this Act. If the state fee for registration of a trademark or for renewal of the period of the registration is paid by a third party, the written consent of the applicant or the owner of the trademark is required.

(2) The state fee is deemed to be paid if the Patent Office receives a document which certifies payment of the state fee or, in the case of an appeal, if the Board of Appeal receives such document.

(3) The paid state fee shall not be refunded, except in the cases provided for in subsections 11(3) and 13(1) of this Act.

[17.12.1997]

31. [repealed—17.12.1997]

VIII. Protection of the Rights of Trademark Owners, Settlement of Disputes, Liability

Protection of the Rights of Trademark Owners

32. The rights of the trademark owner are protected in administrative procedure and in court.

[17.12.1997]

Protection of Exclusive Right of Trademark Owners

33. The exclusive right of the trademark owner has been infringed if:

1. for designating goods or services, a natural person or legal entity uses a sign confusingly similar to a sign designating goods or services of the same kind without the consent of the owner, or performs other acts liable to infringe the exclusive right of the owner;
2. the licensee fails to comply with the conditions of the licence agreement.

[15.02.1995; 17.12.1997]

Liability in the Case of Infringement of the Exclusive Right of the Trademark Owners

34.—(1) The acts of a natural or legal person that intentionally or through negligence, effected transactions infringing the exclusive right of the trademark owner, shall entail civil or criminal liability, or both.

(2) Calculation of the damages caused to the trademark owner or to the licensee shall be based on the profit that he would have received from the normal use of the trademark.

[15.02.1995; 17.12.1997]

Settlement of Trademark-Related Disputes at the Board of Appeal

35.—(1) Industrial property disputes shall be settled at the Board of Appeal established within the area of government of the Ministry of Economic Affairs. The statute of the Board of Appeal shall be ratified by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.

(2) The Board of Appeal shall consider appeals against the decisions of the Patent Office lodged in compliance with subsections 11(3), 13 and 24 of this Act and shall consider revocation applications made by interested persons lodged in compliance with Section 19 of this Act.

(3) The Board of Appeal shall notify the appellant, and if necessary, also the owner of another trademark, the date and place of reviewing the appeal. Their failure to attend does not prevent the reviewing of the appeal.

(3¹) The Board of Appeal shall make a decision on rejection of the appeal or on satisfying it. Upon satisfying the appeal, the Board of Appeal shall revoke the decision of the Patent Office and proposes the Patent Office to reconsider the application for registration and to make a new decision.

(4) The Board of Appeal shall make a decision concerning the appeal within three months from the date of receipt of the appeal. The decision shall be notified to both the appellant and to the owner of a trademark. The Board of Appeal may postpone the hearing of the appeal on a corresponding reasoned request or where the Board of Appeal considers it necessary to request additional documents.

(5) Interested persons may appeal against the decision of the Board of Appeal in court within three months from the date the decision was made.

[17.12.1997]

Civil Liability

36.—(1) The trademark owner whose rights have been infringed may bring civil action containing one or more of the following requirements:

1. to terminate the transaction infringing the rights of the trademark owner or the licensee and that the situation obtaining prior to the infringement be restored;

2. to compensate for the proprietary and moral damage caused to the trademark owner or the licensee, including reimbursement for any shortfall in profits;

3. to take measures to prevent the further infringement of the rights of the trademark owner or the licensee, by removal from circulation all infringing matter.

(2) Where the trademark owner refuses to bring action, the right to sue shall pass on to the licensee except as otherwise provided in the licence agreement.

[17.12.1997]

IX. Special Provisions

Registration of Trademarks in Foreign States

37.—(1) Natural or legal persons of the Republic of Estonia shall register their trademarks in foreign states independently.

(2) Natural or legal persons of the Republic of Estonia may register their trademarks in foreign states regardless of their registration in the Republic of Estonia.

(3) Persons in whose name a trademark has been registered in the Republic of Estonia or who have filed a registration application of a trademark, may file with the Patent Office an application for international registration of the trademark for the same goods or services. An application for the international registration of a trademark may be filed by a person who is a

citizen of the Republic of Estonia, has permanent residence in the Republic of Estonia within the meaning of the term “residence” referred to in 21 of the General Part of the Civil Code Act (RT I 1994, 53, 889; 89, 1516; 1995, 26-28, 355; 49, 749; 87, 1540; 1996, 40, 773; 42, 811) or who owns an operating industrial or commercial enterprise in the Republic of Estonia within the meaning of the term “enterprise” referred to in 5 of the Commercial Code (RT I 1995, 26-28, 355; 1996, 52-54, 993; 1997, 16, 258; 48, 774; 77, 1313; 1998, 2, 48).

[15.02.1995; 17.12.1997]

International Registration of Trademarks

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

(2) The Patent Office performs the duties proceeding from the Madrid Protocol in the Republic of Estonia and it is the Office of Origin and the Office of the Designated Contracting Party within the meaning of the Protocol.

(3) Persons, who apply for the international registration of a trademark or renewal of the international registration, shall pay international fees pursuant to Article 8 of the Madrid Protocol directly to the International Bureau.

[17.12.1997]

Applications for International Registration of Trademarks and their National Processing

37².—(1) An application for international registration of a trademark (hereinafter *international application*) which is filed pursuant to subsection 37(3) of this Act, shall comply with the form and content requirements established in the Madrid Protocol and its Regulations.

(2) An international application shall be filed with the Patent Office. The documents of the international application shall be filed in English.

(3) A state fee shall be paid for the filing of an international application.

(4) The Patent Office shall check the compliance of the particulars appearing in the international application with the particulars of the registration application which is the basis for the international application, or with the particulars appearing in the valid registration of the trademark which is entered in the State Register of Trademarks and Service Marks.

(5) The Patent Office shall certify the authenticity of the particulars appearing in an international application and forward the application to the International Bureau.

(6) The date and number of the international registration of the internationally registered trademark shall be entered in the State Register of Trademarks and Service Marks if the international application is made on the basis of a trademark registered in that Register, or a notice shall be made in the registration application which is being processed if the international application is made on the basis of such application.

(7) The Patent Office shall maintain a files of the documents of international applications which are approved for processing nationally and on the processing thereof.

(8) The procedure for filing applications for the international registration of trademarks with the Patent Office is established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.

(9) The files of applications for the international registration of trademarks and the national processing thereof is established by the Government of the Republic or the Minister of Economic Affairs as authorised by the Government of the Republic.

(10) Information from the files of applications for the international registration of trademarks and the national processing thereof is available upon payment, with the exception of the release of information to state agencies with supervisory rights or to a court. A state fee shall be paid for the release of information.

[17.12.1997]

Registration of Foreign Trademarks on Basis of International Applications

38.—(1) A trademark legally protected in the Republic of Estonia by virtue of international registration shall have the same legal regime and enjoy benefits as trademarks registered in the Republic of Estonia.

(2) If the owner of a trademark registered earlier in the Republic of Estonia effects international registration for the trademark for the same goods and services on a later date, the earlier registration shall be replaced by the international registration. This provision does not apply to the persons specified in subsection 37(3) of this Act.

(3) If an international registration becomes invalid, the international registration in the Republic of Estonia shall become invalid on the same date.

(4) If the international registration of a trademark becomes invalid, the same trademark may be registered in respect of the same goods and services in the Republic of Estonia in compliance with the procedure specified in Chapter III of this Act on the date of international registration if the trademark owner files a conversion application for registration with the Patent Office within three months from the date of expiration of the international registration.

(5) The Patent Office shall examine, pursuant to the provisions of this Act, the international registrations where the Republic of Estonia is the designated party.

(6) The Patent Office shall notify the International Bureau within 18 months after the date of notice of the international registration of a trademark, if the international registration does not satisfy the conditions for registration of trademarks provided for in this Act.

(7) The Patent Office may notify of the refusal of granting legal protection to an international registration pursuant to Article 5(2)c of the Madrid Protocol after the expiry of 18 months after the date of notice of the international registration.

(8) If, as a result of the examination, it appears that the international registration satisfies the conditions specified in this Act, notice of the international registration of a trademark shall be published in the official gazette of the Patent Office.

(9) Any person may lodge an opposition against the international registration of a trademark at the Board of Appeal within two months after the date of publication of the notice of international registration of the trademark in the official gazette of the Patent Office. The Patent Office shall notify the International Bureau of such opposition.

(10) The Patent Office shall maintain a files of international registration of trademarks in which the Republic of Estonia is a designated party, and the national processing thereof.

(11) The files of international registration of trademarks and the national processing thereof is established by the Government of the Republic or the Minister of Economic Affairs authorised by the Government of the Republic.

(12) The release of information from the files of international registration of trademarks and the national processing thereof shall be available upon payment, with the exception of the release of information to state agencies with supervisory authority or to a court. A state fee shall be charged for the release of information.

[17.12.1997]

Excerpt from the Act of 17 December 1997

Act Amending the Republic of Estonia Trademark Act

II. Implementation of Act

Implementing Provisions

28.—(1) Unless otherwise provided in this Section, the provisions of this Act shall be applied to trademarks whose registration application is pending on the day of entering into force of this Act, or to trademarks that have been entered in the Register before the entering into force of this Act.

(2) The provisions of this Act shall not be applied while reviewing appeals lodged before the entering into force of this Act against the decision of the Patent Office, the Board of Appeal and the court, and while making a new decision.

(3) Where *the term for contest* of the decision on registration of the trademark has expired or, upon contest, the contest procedure has ceased and the fee for entering of the trademark in the Register has not been paid by the date of entering into force of this Act, the term referred to in Section 14(1) of the Trademark Act shall be calculated as of the date of entering into force of this Act.

Entry into Force of Act

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