

# Principles of Legal Regulation of Industrial Property Act

Passed 28 January 2003

(RT<sup>1</sup> I 2003, 18, 98),

entered into force 1 May 2004,

amended by the following Acts:

17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24;

10.12.2008 entered into force 01.01.2009 - RT I 2008, 59, 330;

24.01.2007 entered into force 01.01.2008 - RT I 2007, 12, 66;

15.06.2005 entered into force 01.01.2006 - RT I 2005, 39, 308;

09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104;

10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141;

16.12.2003 entered into force 01.01.2004 - RT I 2003, 82, 555.

## Chapter 1

### General Part

#### § 1. Scope of application of Act

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

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

1) inventions registered pursuant to the Patents Act, the Utility Models Act or the Implementation of the Convention of the Grant of European Patents Act (RT I 2002, 38, 233; 2003);

- 2) layout-designs of integrated circuits registered pursuant to the Layout-Designs of Integrated Circuits Protection Act;
- 3) trade marks and service marks (hereinafter trade mark) registered pursuant to the Trade Marks Act;

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

- 4) industrial designs registered pursuant to the Industrial Designs Protection Act.
- (3) The industrial property Acts referred to in subsection (2) of this section are specific Acts with regard to this Act.

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

- (1) The objects of industrial property rights specified in subsection 1 (2) of this Act acquire legal protection as a result of registration pursuant to a corresponding industrial property Act or, in the case provided for in an industrial property Act, as a result of the recognition of exclusive rights created on another basis.
- (2) Exclusive right to a registered object of industrial property rights belongs to the person who is entered in the register as the owner.
- (3) Legal protection of industrial property consists of the recognition and protection of the exclusive rights of the owner of an object of industrial property rights with legal means. No person has the right to commence misdemeanour or criminal proceedings against another person for the protection of the exclusive right of an owner or file a claim for compensation for damage caused as a result of an infringement of the exclusive right without a claim from the owner or without the owner's knowledge and permission.

## § 3. Definitions

For the purposes of this Act:

- 1) "application" means a registration application filed pursuant to an industrial property protection Act in order to have legal protection granted to an object of industrial property rights. Where patent protection is applied for, "application" shall mean a patent application;
- 2) "applicant" means a person or the legal successor of a person who has filed an application to have legal protection granted to an object of industrial property rights;

- 3) “owner” means a person in respect of whom the last entry as the owner of an object of industrial property rights which is subject to legal protection has been made in a register;
- 4) “industrial property Act” means a specific Act which provides for the legal protection of objects of industrial property rights;
- 5) “international agreements” means industrial property conventions and other international agreements which apply to Estonia;
- 6) “Board of Appeal” means the Industrial Property Board of Appeal in accordance with Chapter 4 of this Act.

## Chapter 2

### Registers

#### Division 1

#### General Provisions

##### § 4. Purpose of registers

- (1) The main purpose of the registers is the registration and disclosure, in the public interest, of objects of industrial property rights and owners thereof.
- (2) The purpose of the registers is also to inform the public about application for legal protection to objects of industrial property rights, the grant and validity of legal protection, the transfer of rights and other acts related to objects of industrial property rights.

##### § 5. Registers

Official names of the registers are as follows:

- 1) register of patents;
- 2) register of utility models;
- 3) register of European patents valid in Estonia;
- 4) register of layout-designs of integrated circuits;

- 5) register of trade and service marks;
- 6) register of industrial designs.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

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

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

(2) The provisions of the Public Information Act regarding databases apply to the registers and maintenance thereof together with the specifications provided for in this Act or the industrial property Act.

(24.01.2007 entered into force 01.01.2008 - RT I 2007, 12, 66)

#### § 7. Registrar

The registers are maintained by the Patent Office.

#### § 8. Composition of registers

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

(2) A database consists of records. A record contains information pertaining to all register acts related to an application and the object of industrial property rights which is granted legal protection on the basis of the application from the opening of the record upon acceptance of the application for processing until closing of the record upon the termination or revocation of legal protection. Records are identified by application numbers.

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

subject to disclosure may also be kept in the registry file as long as is necessary, provided that confidentiality thereof is guaranteed.

#### § 9. Working language

- (1) The language of the registers is Estonian. Documents in foreign languages shall be submitted to the Patent Office together with a translation into Estonian.
- (2) The Patent Office has the right to postpone performance of the obligation to submit translations of documents or not to request the submission of a translation if the due date for the submission of a translation of this document is not specified in the corresponding industrial property Act.
- (3) Where subsection (2) of this section applies, the person who submitted a document in a foreign language shall submit the translation at the request of the Patent Office, the Industrial Property Board of Appeal, a court or an interested party within two months as of the date of submission of the request. Upon failure to submit a translation, the document shall be deemed not to have been submitted.

#### § 10. Access to registers

- (1) As of the date on which the Patent Office makes an application public, the records contained in the database and the registry file shall be available to the public, taking into account the restrictions provided for in an industrial property Act. Depending on an industrial property Act, the date on which the Patent Office makes an application public shall be the publication date of the application, publication date of the notice of the decision concerning registration of a trade mark or publication date of the notice of entry of registration data of an industrial design, a utility model or a layout-design of an integrated circuit in the official gazette of the Patent Office,
- (2) Information in the database pertaining to or documents in a registry file concerning an application which has not been made public by the Patent Office shall not be used as the basis for commencing misdemeanour or criminal proceedings or used as evidence when conducting proceedings in a misdemeanour or criminal matter or used to stop a presumed offence or to file a claim for compensation for damage caused as a result of a presumed infringement of an exclusive right.

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

(3) Access to applications withdrawn or deemed to be withdrawn or rejected before they have been made public by the Patent Office, to classified patent applications and to information in the database pertaining to or documents in a registry file concerning a classified patent application is prohibited to all the persons, with the exception of the applicant, the holder of a classified patent and an authorised employee of the Patent Office.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

#### § 11. Inviolability of registers

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

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

### Division 2

#### Maintenance of Registers

#### § 12. Register acts

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

(2) The following are types of register acts:

- 1) opening of a record and entry of application data in a register;
- 2) entry of data pertaining to procedural acts in a register;
- 3) entry of data pertaining to the grant of legal protection to an object of industrial property rights (registration data) in a register;
- 4) entry of amendments to registration data in a register;

- 5) entry of new registration data as a result of the division of a registration in a register;
- 6) entry of data pertaining to the continued validity or renewal of a registration in a register;
- 7) entry of data pertaining to a licence or pledge in a register;
- 8) disclosure of information entered in a register and issue of protection documents;
- 9) release of data from a register;
- 10) closing of a record (deletion of the registration from the register).

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

#### § 13. Procedural acts

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

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

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

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

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

#### § 15. Entries

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

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

- 1) entries of application data;
- 2) entries to amend application data;
- 3) entries of registration data;
- 4) entries to amend registration data;
- 5) entries of data pertaining to licences and pledges;
- 6) entries concerning the renewal of registrations, the validity or term of validity of the legal protection of objects of industrial property rights;
- 7) entries to delete registrations;
- 8) entries concerning the publication of notices of procedural and register acts related to the creation, changing and extinguishment of rights in respect of objects of industrial property rights in the official gazette of the Patent Office.

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

- 1) written notices, inquiries and decisions concerning the setting of terms which are issued to applicants by the Patent Office;
- 2) written notices, explanations and applications received in response to letters from the Patent Office as specified in clause 1) of this subsection;
- 3) written applications pertaining to the progress of the processing of an application which are filed on the initiative of an applicant;
- 4) applications pertaining to the amendment of registration data, registration of a licence or pledge, renewal of a registration or termination of legal protection.

#### § 16. Notations

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



- (2) Notations are a preliminary notation, objection, prohibition and comment.
- (3) A preliminary notation shall be entered in a database on the basis of a notice or application of an applicant, owner or another person in order to secure the making of an entry concerning a right provided for in an industrial property Act or another Act in the future. A preliminary notation shall be made, among other things, concerning the receipt of an application or a request for the division of a registration.
- (4) A notice concerning the filing of an appeal, revocation application, challenge or an action received from an applicant, owner, the Board of Appeal or a court shall be entered in a database as an objection in order to inform the Patent Office and the general public about possible amendments to the entry in the register.
- (5) A prohibition shall be entered in a database on the basis of a notice, application, decision, judgment or ruling of an applicant, owner, another person or a court in order to secure a right provided for in an industrial property Act or another Act or to prevent an offence. A prohibition shall be made, among other things, in the cases provided for in an industrial property Act if disclosure of the name of the author is prohibited, in order to restrict or prohibit disposal of an object of industrial property rights in connection with the registration of a licence or pledge or in connection with the bankruptcy of the owner if the object of industrial property rights is included in the bankruptcy estate.
- (6) The Patent Office shall enter a prohibition in a database on its own initiative if facts relating to a procedural act or an entry affect the course of subsequent procedural acts or if legal basis which precludes the making of certain entries has arisen.
- (7) A comment shall be entered in a database on the basis of an application of an applicant, owner or another person or on the Patent Office's own initiative if disclosure thereof is in the public interest. The transfer of the processing of an application and performance of register acts from a competent official to another and information regarding the identification of the official shall also be entered in the database as a comment.

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

- (1) Data shall be submitted to a register by applicants, owners, other persons, the Board of Appeal and courts within the competence provided by an industrial property Act.
- (2) Data submitted by an unentitled person shall be forwarded to an applicant or owner for an opinion if such data are significant for the processing of an application or validity of the

legal protection of an object of industrial property rights. A comment shall be entered in the database concerning the submission and forwarding of the data.

§ 18. Liability for correctness of data

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

§ 19. Submission of confidential information

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

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

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

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

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

3) information pertaining to an owner;

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

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

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

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

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

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

## § 21. Data protection requirements

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

(2) The Patent Office is required to:

- 1) prevent the unauthorised recording of register data and unauthorised alteration or erasure of recorded register data;
- 2) prevent unauthorised transmission of register data by means of data communication equipment and access to confidential information;
- 3) ensure that it be subsequently possible to determine when, by whom and which register data were input or altered.

## Division 3

### General Procedure for Performance of Register Acts

## § 22. Competent person

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

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

## § 23. Receipt of documents

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

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

## § 24. Verification of documents

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

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

(3) If the right to submit a document exists, compliance with the formal requirements established for the document shall be verified. The person who submitted a document shall be

notified of any formal deficiencies in the document and processing of the document shall be suspended. If a digital document is submitted in a format allowing the alteration of data set out therein, the document shall be converted to a format where such alteration of data is precluded.

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

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

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

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

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

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

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

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

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

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

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

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

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

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

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

§ 28. Entry of amendments to registration data in register

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

1) data of a request for an entry;

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

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

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

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

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

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

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

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

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

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

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

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

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

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

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

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

§ 32. Disclosure of information entered in register

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

§ 33. Closing of record

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

1) an application is withdrawn, deemed to be withdrawn or rejected or registration of the object of industrial property rights is refused;

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

2) the term of legal protection of the object of industrial property rights expires or the registration is deleted from the register pursuant to an industrial property Act;

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

(2) Closed records shall be preserved permanently.

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

## Chapter 3

### Patent Office

#### § 34. Status of Patent Office

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

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

#### § 35. Functions of Patent Office

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

1) the acceptance and processing of applications pursuant to industrial property Acts or international agreements, including the conduct of expert assessments in the cases prescribed by industrial property Acts or international agreements, the making of decisions concerning



the grant of legal protection to objects of industrial property rights, the maintenance of industrial property registers, the issue of official publications and protection documents;

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

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

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

2) participate in the work of the World Intellectual Property Organization, the Office for Harmonization in the Internal Market and the European Patent Organization;

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

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

#### § 36. Independence of Patent Office

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

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

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

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

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

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

## Chapter 4

### Board of Appeal

#### Division 1

#### General Provisions

##### § 38. Status of Board of Appeal

- (1) The Board of Appeal is an extra-judicial independent body.
- (2) Proceedings before the Board of Appeal for hearing an appeal against a decision of the Patent Office are mandatory pre-trial proceedings.

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141; 10.12.2008 entered into force 01.01.2009 - RT I 2008, 59, 330)

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

- (1) In the cases prescribed by industrial property Acts, the Board of Appeal shall:
  - 1) resolve appeals filed by applicants in order to contest decisions of the Patent Office;
  - 2) settle disputes between an interested party and an applicant or owner on the basis of an application of the interested party (hereinafter revocation application).
- (2) The Board of Appeal acts in accordance with this Act, industrial property Acts, international agreements and regulations of the Government of the Republic and ministers. Where an issue relating to the legal protection of industrial property is not regulated by law or international agreements, guidance shall be taken from the practice of implementation of European law or national law in European countries.
- (3) Damage caused by the unlawful action of the Board of Appeal shall be compensated for by the state.

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

- (1) The Board of Appeal shall be formed at the Ministry of Economic Affairs and Communications.
- (2) The Minister of Economic Affairs and Communications shall establish the statutes of the Board of Appeal which prescribe the following:
  - 1) the procedure for filing an appeal or revocation application;
  - 2) rules of procedure of the Board of Appeal, and
  - 3) the procedure for remuneration of the members of the Board of Appeal.
- (3) The Board of Appeal shall consist of at least eight members. The members must have completed an academic higher education and they must be experts in the field of industrial property. Half of the members must have an academic degree in law. Members of the Board of Appeal, including the chairman and deputy chairman, shall be appointed by the Minister of Economic Affairs and Communications.
- (4) In the absence of the chairman of the Board of Appeal, the deputy chairman shall substitute for the chairman of the Board of Appeal.

#### § 41. Working language

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

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

- (1) The working conditions of the Board of Appeal, including working premises and clerical support, shall be provided by the Ministry of Economic Affairs and Communications.
- (2) The administrative expenditure of the Board of Appeal and expenses related to the resolution of appeals and revocation applications shall be covered from the state budget out of the funds allocated to the Ministry of Economic Affairs and Communications for these purposes.
- (3) Documents of the Board of Appeal shall be permanently preserved in the archives of the Ministry of Economic Affairs and Communications.

## Division 2

### Appeal and Revocation Application

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

(1) A written appeal or revocation application together with documents appended thereto shall be addressed to the Board of Appeal and filed taking into account the terms provided for in the corresponding industrial property Act.

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

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

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

(1) An appeal shall set out:

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

(2) A revocation application shall set out:

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

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

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

#### § 45. Registration of appeals and revocation applications and notification thereof

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

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

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

(3) If the chairman of the Board of Appeal finds that an appeal or revocation application contains deficiencies which can be eliminated, the appellant or the person who filed the

revocation application shall be notified thereof immediately in writing and a term of fifteen days shall be set for the elimination of deficiencies.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

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

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

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

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

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

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

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

(3) An appeal or revocation application shall be rejected by a decision made by the chairman of the Board of Appeal alone and a copy of the decision shall be sent immediately to the appellant or the person who filed the revocation application and to the Patent Office if:

1) the appeal or revocation application does not fall within the competence of the Board of Appeal;

- 2) the appeal or revocation application is not filed within the prescribed term;
- 3) the appeal or revocation application does not comply with the requirements or the appellant or the person who filed the revocation application fails to eliminate the deficiencies within a specified term;
- 4) the state fee for filing an appeal or revocation application has not been paid;
- 5) a decision of the Board of Appeal which is in force has been made in a matter between the same parties concerning the same object of action on the same basis.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

(3<sup>1</sup>) An appeal against the decision referred to in subsection (3) of this section may be filed with Harju County Court within 30 days as of the date of receipt of a copy of the decision. The court shall hear an appeal in proceedings on petition. The Board of Appeal shall notify the Patent Office immediately of the filing of an appeal and of a court decision in force made as a result of court proceedings.

(15.06.2005 entered into force 01.01.2006 - RT I 2005, 39, 308)

- (4) A decision made by the chairman of the Board of Appeal alone shall set out:
  - 1) the name of the Board of Appeal and the type of decision;
  - 2) a reference to the appeal or revocation application and the person who filed it;
  - 3) a reference to the Acts applied in making the decision;
  - 4) the grounds for the decision;
  - 5) the conclusion;
  - 6) information on the procedure and term for appeal against the decision;
  - 7) the date and place the decision is made;
  - 8) the name and signature of the person making the decision.
- (5) The appellant or the person who filed the revocation application is entitled to a refund of the paid state fee:
  - 1) in the case specified in subsection (1) of this section, if an application for the withdrawal of an appeal or revocation application is received by the Board of Appeal before the appeal or revocation application is accepted for processing;

2) if the appeal or revocation application does not fall within the competence of the Board of Appeal, is not filed within the term and the chairman of the Board of Appeal rejects the appeal or revocation application pursuant to subsection (3) of this section.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

(6) (Repealed - 17.12.2008 entered into force 01.03.2009 – RT I 2009, 4, 24)

### Division 3

#### Proceedings before Board of Appeal

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

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

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

(3) The appellant or the person who filed a revocation application and the Patent Office shall be notified immediately of the acceptance of the appeal or revocation application for processing. A notice concerning the acceptance of an appeal or revocation application for processing shall be published on the website of the Board of Appeal.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

##### § 49. Preliminary processing

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



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

(3) (Repealed - 09.03.2005 entered into force 08.04.2005 – RT I 2005, 18, 104)

(4) In the course of preliminary processing, the chairman of the Board of Appeal shall make decisions of the Board of Appeal sitting alone, pursuant to the provisions of subsection 47 (4) of this Act. A copy of a decision shall immediately be sent to the participants in proceedings. An appeal against the decision may be filed with Harju County Court within 30 days as of the date of receipt of a copy of the decision. The court shall hear an appeal in proceedings on petition.

(15.06.2005 entered into force 01.01.2006 - RT I 2005, 39, 308)

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

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

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

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

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

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

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

proceedings and shall make a proposal to the other participant in the proceedings to submit a written opinion within three months as of the date of making the proposal.

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

(3) A written opinion submitted by a participant in the proceedings shall be immediately forwarded to the other participant in the proceedings.

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

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

#### § 52. Submission of additional documents

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

(2) Participants in proceedings shall submit any additional documents requested by the due date specified by the Board of Appeal. The Board of Appeal may extend the term for the submission of additional documents at the reasoned written request of a participant in proceedings.

(3) Additional documents shall be immediately forwarded to the other participant in the proceedings.

(4) The fact that a participant in proceedings has failed to submit additional documents shall not hinder continuation of the proceedings.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

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

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

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

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

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

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

(1) The chairman of the Board of Appeal has the right to make a decision alone to suspend the processing of an appeal or revocation application on the basis of the provisions of the Code of Civil Procedure concerning suspension of proceedings or on the basis of a reasoned request from a participant in the proceedings or a joint request from the participants in the proceedings.

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141; 15.06.2005 entered into force 01.01.2006 - RT I 2005, 39, 308)

(2) If the circumstances which caused the suspension cease to exist, the chairman of the Board of Appeal shall decide alone on the resumption of processing.

(3) If the person who filed an appeal or revocation application withdraws the appeal or revocation application, the processing shall be terminated by a decision made by the chairman of the Board of Appeal alone. A copy of a decision to terminate the processing shall be sent to the Patent Office even if the Patent Office has not participated in the processing.

(10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

(4) (Repealed - 10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

#### § 54<sup>1</sup>. Final opinions of participants in proceedings

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

(1) One month after the receipt of the opinions of the participants in the proceedings the Board of Appeal shall make a proposal to the participants in the proceedings to submit their final opinions. Participants in the proceedings shall submit their final opinions within one month as of making of the proposal.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

(2) A proposal for the submission of final opinions shall be made first to the appellant or the person who filed the revocation application. The Board of Appeal shall forward the final opinions of the appellant or the person who filed the revocation application immediately to the other participant in the proceedings together with a proposal to submit his or her final opinions. A participant in the proceedings who has not submitted his or her written opinions to the Board of Appeal shall not be allowed to present his or her final opinions.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

(3) Upon the submission of final opinions, the participants in the proceedings have the right to submit a proposal to the Board of Appeal for oral proceedings (hereinafter meeting) to be conducted in respect of an appeal or revocation application; in such case they shall justify the need for a meeting.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

(4) Final opinions may only refer to the facts which have been presented in written opinions and to the evidence which were submitted to the Board of Appeal before the proposal to submit final opinions was made.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

(5) The fact that a participant in the proceedings has failed to submit final opinions shall not hinder commencement of final processing and the making of a decision.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

#### § 55. Final processing

(1) The chairman of the Board of Appeal shall commence final processing on the proposal of the person conducting preliminary processing and shall determine the membership of the panel of the Board of Appeal conducting proceedings concerning an appeal or revocation application and appoint the presiding member of the Board. If it is necessary to hold a meeting, the chairman of the Board of Appeal shall determine the time and place of the meeting.

(2) Commencement of final processing shall be prepared as a conclusion which need not be substantiated. A conclusion shall be dated and signed by the chairman of the Board of Appeal.

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

(4) Participants in the proceedings shall be immediately notified of the commencement of final processing and the membership of the panel of the Board of Appeal conducting proceedings in respect of an appeal or revocation application and, in the case a meeting is held, the time and place of the meeting. A notice concerning final processing shall be published on the website of the Board of Appeal.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

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

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

(2) The Board of Appeal may postpone a meeting if a participant in proceedings submits a reasoned request for postponement of the meeting.

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

(4) (Repealed - 09.03.2005 entered into force 08.04.2005 – RT I 2005, 18, 104)

#### § 57. Meeting

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

(2) A meeting shall include the following:

1) identification of the persons present and verification of their authorisation;

2) submission and resolution of requests for removal and any other requests of participants in the proceeding;

3) a summary of the final overview presented by the person who conducted preliminary processing;

- 4) opinions of and discussion between participants in the proceeding;
- 5) posing of questions by participants in the proceeding and the Board of Appeal and responses thereto.

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

(4) (Repealed - 09.03.2005 entered into force 08.04.2005 – RT I 2005, 18, 104)

(5) If the participants in proceedings have given their statements to the Board of Appeal and answered all questions, the hearing of the appeal or revocation application shall be terminated and the participants in the proceeding shall be notified of the due date by which the Board of Appeal shall make a decision.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

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

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

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

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

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

(5) If the resolution of an appeal or revocation application with a quorum is impossible, the Board of Appeal shall make a decision to terminate the processing of the appeal or revocation application. The appellant has the right to appeal against the decision of the Patent Office to Harju County Court within thirty days after the decision to terminate the processing is made by the Board of Appeal. The court shall hear an appeal in proceedings on petition and decide, inter alia, on the refund of the state fee.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

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

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

(2) Decisions of the Board of Appeal are made by majority vote. It is prohibited to abstain from voting.

(3) A decision of the Board of Appeal shall be prepared in writing and signed by all members of the panel of the Board of Appeal which processed an appeal or revocation application. A decision shall be reasoned and be based on the facts established in the course of processing. If a member of the Board of Appeal maintains a dissenting opinion, he or she has the right to present a brief summary of the dissenting opinion after the signatures.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

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

- 1) the name of the Board of Appeal and the type of decision;
- 2) a summary of the appeal or revocation application;
- 3) a summary of the presented evidence and justifications;
- 4) the claim of the appellant or the person who filed the revocation application;
- 5) a reference to the Acts applied in making the decision;
- 6) the grounds for the decision;
- 7) the conclusion;

- 8) information on the procedure and term for appeal against the decision;
- 9) the date and place the decision is made.

§ 60. Evidence presented to Board of Appeal

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

§ 61. Content of decision of Board of Appeal

- (1) The Board of Appeal shall dismiss an appeal or revocation application or grant an appeal or revocation application in full or in part.
- (2) The Board of Appeal shall make decisions pursuant to the provisions of industrial property Acts.
- (3) (Repealed - 10.03.2004 entered into force 01.05.2004 - RT I 2004, 20, 141)

§ 62. Communication of decisions of Board of Appeal

- (1) A decision of the Board of Appeal shall be communicated by publishing the decision on the website of the Board of Appeal. The date of publication of the decision on the website shall be deemed to be the date of communication of the decision.
- (2) Copies of a decision of the Board of Appeal shall be delivered immediately to the participants in proceedings by post. A copy of a decision shall be sent to the Patent Office even if the Patent Office was not a participant in the proceeding.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

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

- (1) An appellant has the right to appeal against the decision of the Board of Appeal with Harju County Court within three months after publication of the decision of the Board of Appeal. The court shall hear an appeal in proceedings on petition. An appellant shall notify the Board of Appeal immediately of the filing of an appeal.



(2) If an appeal specified in subsection (1) of this section is not filed, the decision of the Board of Appeal shall enter into force after three months as of its publication and shall be executed.

(3) If an appeal specified in subsection (1) of this section is filed, but the court does not accept it for processing, refuses to hear the appeal or terminates a proceeding without a decision, the decision of the Board of Appeal enters into force at the time of entry into force of the corresponding court ruling unless otherwise provided by the court ruling.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

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

(1) A participant in proceedings in respect of a revocation application who disagrees with a decision of the Board of Appeal and who wishes to continue the dispute between the participants in the proceeding by way of an action has the right to file an action within three months after publication of the decision of the Board of Appeal. A plaintiff shall notify the Board of Appeal immediately of the filing of an action.

(2) If an action specified in subsection (1) of this section is not filed, the decision of the Board of Appeal shall enter into force after three months as of its publication and shall be executed.

(3) If an action specified in subsection (1) of this section is filed, but the court does not accept it for processing, refuses to hear the action or terminates a proceeding without a decision, the decision of the Board of Appeal enters into force at the time of entry into force of the corresponding court ruling unless otherwise provided by the court ruling.

(17.12.2008 entered into force 01.03.2009 - RT I 2009, 4, 24)

## Chapter 5

### Implementing Provisions

#### § 65. Transitional provisions

(1) On the basis of this Act, information contained in state registers established on the basis of industrial property Acts is deemed to be information entered in general national registers.

(2) This Act applies to further processing of appeals and revocation applications filed with the Board of Appeal before 1 May 2004, unless otherwise provided for in this Act.

(3) - (4) (Repealed 09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

(4<sup>1</sup>) The chairman of the Board of Appeal shall, by 1 May 2005, appoint a person conducting preliminary processing of applications for declaration of invalidity of the registration of a trade mark filed with the Board of Appeal on the basis of §§ 24 and 24<sup>1</sup> of the Trade Marks Act in force until 1 May 2004.

(5) Subsection 52 (2) of this Act does not apply if the Board of Appeal has, before 1 May 2004, established a term for the filing of additional documents.

(6) The Trade Marks Act in force until 1 May 2004 and the provisions regulating hearing of revocation applications apply to revocation applications filed with the Board of Appeal before 1 May 2004 on the basis of § 19 of the Trade Marks Act in force until 1 May 2004 and to applications for declaration of invalidity of the registration of a trade mark filed with the Board of Appeal on the basis of §§ 24 and 24<sup>1</sup> of the Trade Marks Act in force until 1 May 2004.

(09.03.2005 entered into force 08.04.2005 - RT I 2005, 18, 104)

§ 66. Entry into force of Act

This Act enters into force on 1 May 2004.

(16.12.2003 entered into force 01.01.2004 - RT I 2003, 82, 555)

<sup>1</sup> RT = *Riigi Teataja* = *State Gazette*