

Submission from the Estonian Patent Office

This submission describe the absolute grounds of refusal of the Estonian Trade Mark Act and give examples from the trademark examination practice in Estonia, from the Estonian Patent Office and the Board of Appeals.

The absolute grounds of refusal are examined *ex officio* by the Office.

Abstract from the Estonian Trade Mark Act and comments.

§ 9. Absolute circumstances which preclude legal protection

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

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

§ 6 of the Trade Mark Act: Protected trade marks shall be capable of being represented graphically.

Words, combinations of words, figurative marks, three-dimensional marks, slogans etc (inter alia sound marks consisting of a musical notation on a staff) are registrable.

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

The devoid of distinctiveness is often connected with the descriptiveness of the trademark. The situation is often formulated: ... the trademark consists of signs or indications which designate the kind, quality, quantity or some other characteristics of the goods or services and for that reason the trademark is devoid of any distinctive character.

Examples

The trademark HAIRTRANSFER is descriptive and is devoid of any distinctive character in classes 3, 8, 10, 22, 26, 44. It was refused by the Office and by the Board of Appeals.

The trademark 5 MINUTES applied for goods in classes 29 and 30 was refused by the Office and by the Board of Appeal. The trademark describes the time for preparing the meals and is therefore devoid of distinctiveness.

The following trademark EUROVEOD (translation: Euro(pean) carriage) for the services in class 39 was refused by the Office. The text describes the transportation services and the figurative element of the mark was not sufficient for the registration

EUROVEOD

3) signs which consist exclusively of signs or indications which designate the kind, quality, quantity, intended purpose, value or geographical origin of the goods or

services, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services, or which describe the goods or services in another manner, or which consist of the above-mentioned signs or indications which are not considerably altered;

Examples

The trademark LASTE JUUST (translation: children's cheese) applied for goods in class 29 was refused by the Office and by the Board of Appeals. The combination of words describes the kind, characteristics and intended purpose.

The trademark UNIVERSAL MEDIA DISC applied for the goods in classes 9 and 28 was refused by the Office and by the Board of Appeals. This combination of words is descriptive for the goods and devoid of distinctiveness.

The trademark CAMELTS applied for the goods in class 30 was refused by the Office - the word designates the kind of sweets. The trademark was confirmed registrable by the Board of Appeals.

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

For example the words GROUP, WORLD in service classes.

5) signs which consist exclusively of the shape which results from the nature of the goods, is necessary to obtain a technical result or gives substantial value to the goods;

Example

The following three-dimensional trademark applied for goods in class 14 was refused by the Office and by the Board of Appeals as it consists exclusively of the shape which results from the nature of the goods (according to the previous Trade Mark Act § 7 (1)5).



6) signs which are of such a nature as to deceive the consumer as to the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services;

Example

The trademark SUISS applied for the goods in class 32 was refused by the Office as the word SUISS is not considerably altered version of the word SUISSE (translation: SWISS in French) and the mark is deceptive because the applicant is from Spain. The Board of Appeals found the word to be registrable because the public does not recognize the word as SWISS and therefore it is not deceptive.

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

Example

The following figurative trademark KOOL (Estonian word for school) applied for the goods in class 34 (tobacco products) was refused registration.



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

This provision applies in the case of identical or very similar words, abbreviations or combination of words or figurative elements.

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

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

The Estonian Patent Office examines for bad faith *ex officio*. This problem mainly concerns the deliverers of the goods of other producers.

11) signs which contain a registered geographical indication or are confusingly similar thereto if it may result in unlawful use of the geographical indication pursuant to the provisions of the Geographical Indications Protection Act

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

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

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

Since the year 2004 when the new Trade Mark Act entered into force the Estonian Patent Office does not inform the applicants of the disclaimed parts of the trademark by making the note to the document of the grant of protection.