

Issuer: Riigikogu
Type: act
In force from: 01.04.2019
In force until: 15.01.2023
Translation published: 28.03.2019

Trade Marks Act¹

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

Amended by the following acts

| Passed | Published | Entry into force |
|------------|-----------------------|---|
| 21.11.2002 | RT I 2002, 99, 582 | 19.12.2002 |
| 16.12.2003 | RT I 2003, 82, 555 | 01.01.2004 |
| 17.12.2003 | RT I 2003, 88, 594 | 08.01.2004 |
| 10.03.2004 | RT I 2004, 20, 141 | 01.05.2004 |
| 09.03.2005 | RT I 2005, 18, 104 | 08.04.2005 |
| 15.06.2005 | RT I 2005, 39, 308 | 01.01.2006 |
| 26.01.2006 | RT I 2006, 7, 42 | 04.02.2006 |
| 06.12.2006 | RT I 2006, 61, 456 | 01.01.2007 |
| 17.12.2008 | RT I 2009, 4, 24 | 01.03.2009 |
| 07.12.2011 | RT I, 28.12.2011, 1 | 01.01.2012 |
| 19.06.2014 | RT I, 29.06.2014, 109 | 01.07.2014, titles of ministers are replaced, starting with the version in force from 1 July 2014, pursuant to subsection 107 ³ (4) of the Government of the Republic Act. |
| 20.02.2019 | RT I, 19.03.2019, 4 | 29.03.2019, partially 01.04.2019 |
| 20.02.2019 | RT I, 19.03.2019, 5 | 01.04.2019 |

Chapter 1 GENERAL PROVISIONS

§ 1. Scope of application of Act

(1) This Act regulates the legal protection of well-known and registered trade marks and service marks (hereinafter trade mark), rights and obligations related to trade marks and, in the cases provided for in this Act, rights and obligations related to trade marks registered by the European Union Intellectual Property Office (hereinafter EU trade mark) on the basis of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark (OJ L 154, 16.06.2017, pp. 1–99).
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(2) The minister responsible for the area shall issue a regulation for the implementation of this Act in matters where the competence of a Member State for taking decisions arises from corresponding legal acts of the European Union or where the right to issue the regulation arises from this Act (hereinafter regulation on trade marks).
[RT I, 28.12.2011, 1 - entry into force 01.01.2012]
[RT I, 29.06.2014, 109 – entry into force 01.07.2014, the “Minister of Justice” is replaced for the words “minister responsible for the area” as of 1 July 2014 under subsection 107³ (4) of the Government of the Republic Act.]

§ 2. Equality of persons

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

§ 3. Trade marks

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

Chapter 2 LEGAL PROTECTION OF TRADE MARKS

§ 4. Substance of legal protection of trade marks

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

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

(3) An exclusive right to an international registration valid pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (RT II 1998, 36, 68) (hereinafter the Madrid Protocol) may be exercised in Estonia only by the person who is entered in the International Register of the International Bureau of the World Intellectual Property Organisation (hereinafter Bureau) as the proprietor of the trade mark unless otherwise provided for in this Act.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 5. Protectable trade marks

(1) Legal protection is afforded to:

- 1) trade marks which are well known in Estonia within the meaning of Article 6 *bis* of the Paris Convention for the Protection of Industrial Property (RT II 1994, 4/5, 19) (hereinafter well-known trade marks);
- 2) trade marks which are registered in the register (hereinafter registered trade marks);
- 3) trade marks with a registration, valid in Estonia, entered in the International Register of the Bureau pursuant to the Madrid Protocol.

(2) Legal protection is afforded only to well-known trade marks, registered trade marks or trade marks valid in Estonia pursuant to the Madrid Protocol the legal protection of which is not precluded on the basis of the provisions of §§ 9 and 10 of this Act.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 6. Representability of protected trade marks

(1) A sign protected as a trade mark shall be capable of being represented in the register in a manner which enables the competent authorities and the public to determine the clear and precise scope of the legal protection afforded to the trade mark.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

§ 7. Recognition of well-known trade marks

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

(2) The Patent Office shall recognise a trade mark as being well known only in connection with the registration procedure of the given trade mark or other trade marks. The Industrial Property Board of Appeal shall consider a trade mark as being well known only in connection with the adjudication of an appeal against a decision of the Patent Office or a revocation application concerning the legal protection of the trade mark or a request for declaration of nullity of the exclusive right of the proprietor of the trade mark.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) The following is taken into consideration while recognising a trade mark as being well known:

- 1) the degree of knowledge of the trade mark in Estonia in the sector of actual and potential consumers of goods analogous to the goods or services to which the trade mark applies, the sector of persons involved in channels of distribution of such goods or services or in business circles dealing with such goods or services;
- 2) the duration and extent of the use and promotion of the mark and geographical area of the use of the mark;
- 3) the registration, use and knowledge of the mark in other countries;
- 4) the value associated with the mark.

(4) It is sufficient for recognising a trade mark as being well known if the trade mark is known to the majority of persons in at least one of the sectors specified in clause (3) 1) of this section.

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

§ 8. Legal protection on basis of registration

(1) A registration concerning a trade mark filed for registration is made in the register under the conditions and pursuant to the procedure provided for in Chapter 4 of this Act, taking account of the provisions of the Principles of Legal Regulation of Industrial Property Act (RT I 2003, 18, 98; 82, 555).

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) If a trade mark is not registered by the end date of the term of legal protection calculated in accordance with the first sentence of subsection (2) of this section, the term of legal protection of the trade mark is renewed until the mark is registered, for ten years at a time.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 9. Absolute circumstances which preclude legal protection

(1) Legal protection is not afforded to the following signs:

1) signs which do not conform to the provisions of § 3 or § 6 of this Act;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

2) signs which are devoid of any distinctive character;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

4) signs which consist exclusively of signs or indications which have become customary in current language or in *bona fide* business practices;

5) signs which consist exclusively of the shape or other characteristics which result from the nature of the goods, are necessary to obtain a technical result or give substantial value to the goods;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

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

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

9¹) signs which contain a sign with a high symbolic value;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

11) signs which contain a registered geographical indication or are confusingly similar thereto if it may result in unlawful use of the geographical indication pursuant to the provisions of the Geographical Indications Protection Act, or the registration whereof is precluded pursuant to legislation of the European Union or international agreements to which Estonia or the European Union is a party and which provide for the protection of the designations of origin and geographical indications;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

11¹) signs the registration whereof is precluded pursuant to legislation of the European Union or international agreements to which Estonia or the European Union is a party and which provide for the protection of traditional terms for wine or traditional specialties guaranteed;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

11²) signs which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with the Plant Propagation and Plant Variety Rights Act, legislation of the European Union or international agreements to which Estonia or the European Union is a party, providing for protection of plant variety rights, and which are related to plant varieties of the same or closely related species;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

(3) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019].

§ 10. Relative circumstances which preclude legal protection

(1) Legal protection is not afforded to the following trade marks:

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

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

3) trade marks which are identical or similar to an earlier registered trade mark, regardless of whether the earlier trade mark has been afforded legal protection for identical, similar types of or different types of goods or services, if the earlier Estonian trade mark has a reputation in Estonia or if the earlier EU trade mark has a reputation in the European Union and the use without due cause of the later trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

4) trade marks which are identical or confusingly similar to a business name entered in the commercial register prior to the filing date of the application, the date of international registration or the date of priority, and the area of activity of the respective undertaking is in the same field as the goods and services which the trade mark is used to or is going to be used to designate;
[RT I 2006, 61, 456 - entry into force 01.01.2007]

5) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

6) trade marks the use of which is detrimental to an earlier right to a name, a right of personal portrayal, an object of copyright or industrial property right or another earlier right;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

7) trade marks which are identical or confusingly similar to an earlier trade mark protected in another state if the application is filed in bad faith;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

8) trade marks the registration whereof in their own name is applied for by an agent or representative of the proprietor of the respective trade marks without the consent of the proprietor, where their activities are not justified;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

9) trade marks the use whereof may be prohibited by a person who, under the Geographical Indication Protection Act or under legislation of the European Union ensuring the protection of designations of origin and geographical indications, is entitled to exercise the rights deriving from an earlier registered designation of origin or geographical indication.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) The circumstances specified in clauses (1) 1)–8) of this section which preclude legal protection are not taken into account if the proprietor of the earlier trade mark or another earlier right consents to the grant of legal protection in writing.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 11. Earlier trade mark and other earlier rights

(1) An “earlier trade mark” means the following:

1) a trade mark which became well known earlier;

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

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

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

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

6) an EU trade mark registered on the basis of Regulation (EU) 2017/1001 of the European Parliament and of the Council if the filing date of the application, date of priority or the seniority date afforded on the basis of the Estonian registration is earlier;

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

7) a trade mark filed for registration on the basis of Regulation (EU) 2017/1001 of the European Parliament and of the Council if the filing date of the application, date of priority or the seniority date afforded on the basis of the Estonian registration is earlier. A trade mark filed for registration is an earlier trade mark only if it is registered.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(1¹) A registered designation of origin, geographical indication or plant variety denomination is an earlier right if the application for the registration of the designation of origin, geographical indication or plant variety was filed before the filing date of the application for registration of the trade mark or before the date of priority.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

§ 12. Scope of legal protection of trade marks

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

- 1) for a well-known trade mark, the form of the trade mark in which it became well known;
- 2) the representation of the trade mark entered in the register or in the International Register of the Bureau.

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

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

- 1) for a well-known trade mark, by such goods and services which the trade mark was used to designate when it became well known;
- 2) by a list of goods and services entered in the register or the International Register of the Bureau.

(3) Goods and services are classified in accordance with the international classification of goods and services established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter the Nice Classification) (RT II 1996, 4, 14).

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

(5) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(6) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

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

(3) If several persons jointly perform acts related to trade marks at the Patent Office and at the Board of Appeal, they may authorise a patent attorney as their representative or choose a representative from among themselves (hereinafter joint representative) whose residence, seat or an operating commercial or industrial enterprise is in a Member State of the European Economic Area.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) A patent attorney performing acts related to trade marks at the Patent Office and at the Board of Appeal as a representative is presumed to have the right of representation. In case of doubts about the existence of the right of representation, the Patent Office or the Board of Appeal will be entitled to request the patent attorney to submit a power of attorney. The power of attorney shall be submitted within two months after the request.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(5) Personal participation by the applicant or proprietor of the trade mark in the processing regarding acts related to trade marks shall not be deemed waiver of a representative, unless the principal has informed the Patent Office otherwise in writing.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 13¹. Notification by Patent Office

(1) The Patent Office shall submit notices regarding acts related to trade marks to the representative of the applicant, proprietor of the trade mark or other person applying for performance of acts, unless the principal has informed the Patent Office otherwise in writing, and in case there is no representative then to the person himself or herself.

(2) Within the meaning of subsection (1) of this section, a representative is deemed to be a person who has submitted an application or request as a representative of the applicant, proprietor of the trade mark or other person applying for performance of acts, or who has performed other acts in the processing of the Patent Office or who has been entered in the register as the representative of the applicant or proprietor of the trade mark, unless the principal has informed the Patent Office otherwise in writing.

(3) If a person has several representatives within the meaning of subsection (2) of this section, notices shall be submitted to the most recently reported representative; in case of several representatives reported on the same day, the representative who is a patent attorney shall be preferred. If persons jointly performing acts have different representatives, notices shall be submitted to all the representatives.

(4) In case of an applicant, proprietor of the trade mark or other person who has set out an e-mail address in an application or request, and in case of a patent attorney, their consent for submission of notices regarding acts related to trade marks by electronic means is presumed, unless they have informed the Patent Office otherwise in writing.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

Chapter 3 RIGHTS CONFERRED BY TRADE MARK

§ 14. Exclusive right

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

- 1) any sign which is identical with the trade mark which is afforded legal protection in relation to goods or services which are identical with those for which the trade mark is protected;
- 2) any sign which is identical with or similar to the trade mark which is afforded legal protection in relation to goods or services which are identical with or similar to those for which the trade mark is protected if there is the likelihood of confusion on the part of the consumers, including the likelihood of association between the sign and the trade mark which is afforded legal protection;
- 3) any sign which is identical or similar to a registered trade mark, designating identical, similar types of or different types of goods or services, if the trade mark has a reputation in Estonia and if unjustified use of that sign might take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

- 1) affixing the sign to goods or to the packaging thereof;
- 2) offering goods for sale, distributing or storing them for the purposes of sale under the sign;
- 3) offering or supplying services under the sign;
- 4) importing or exporting the goods under the sign;
- 5) using the sign on business papers, in advertising or instruction manuals for the goods;
- 6) using the sign as a business name or a part thereof;
- 7) using the sign in comparative advertising in any manner contrary to the Advertising Act.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2¹) The proprietor of a trade mark is entitled to prohibit third parties from bringing goods in the course of trade into Estonia without being released for free circulation here, where such goods or their packaging come from outside the states which are Member States of the European Economic Area and bear without the authorisation of the proprietor of the trade mark a mark which is identical with the trade mark protected in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. The respective entitlement of the proprietor of the trade mark shall lapse if, during the proceedings to determine whether the trade mark has been infringed, initiated in accordance with Regulation (EU) No 608/2013 of the European Parliament and of the Council concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 (OJ L 181, 29.06.2013, p. 15-34), evidence is provided by the declarant or the holder of the goods that the proprietor of the trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2²) If a trade mark has been registered in the name of an agent or representative of the proprietor of the respective trade mark without the latter's consent, the proprietor of the trade mark is entitled to prohibit the agent or representative to use the trade mark. These grounds do not apply if the activities of the agent or representative are justified.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

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

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

(5) Where the risk exists that the packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed could be used in relation to goods or services in a manner constituting an infringement of the exclusive rights of the proprietor of a trade mark, the proprietor of that trade mark is entitled to prohibit the following acts if carried out in the course of trade:

- 1) affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices or any other means;
- 2) offering or placing on the market, or stocking for those purposes, or importing or exporting any packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 15. Registered trade mark symbol

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

§ 16. Limitation of exclusive right

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

- 1) the names and addresses of natural persons;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]
- 2) signs which are devoid of any distinctive character or 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;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]
- 3) [repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019];

4) the trade mark for identification or indication of the goods or services of the proprietor of the trade mark, in particular if the use of the trade mark is necessary for indicating the intended purpose of the goods or services especially as accessories or spare parts;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

5) [repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019].

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2¹) The proprietor of an earlier trade mark is not entitled to prohibit the use of a later registered trade mark to the extent that the proprietor of the earlier trade mark is not entitled to claim declaration of nullity of the exclusive right with regard to the later trade mark pursuant to subsection 52 (4) or (6) of this Act, or in case or a later EU trade mark, declaration of invalidity of such trade mark pursuant to Article 60 (1), (3) or (4), Article 61 (1) or (2) or Article 64 (2) or (3) of Regulation (EU) 2017/1001 of the European Parliament and of the Council. An objection based on the non-use of an earlier registered trade mark shall be filed with the court in the first response to an action, and it is presumed to be justified.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019, is applied also to the processing of the Board of Appeal or judicial proceedings which commenced before 1 April 2019.]

(2²) The proprietor of a trade mark is not entitled to prohibit the use of the trade mark to the extent that during the filing of the action there are grounds for declaring the exclusive right of the proprietor of the trade mark extinguished pursuant to clause 53 (1) 3) or 4) of this Act. Said objection shall be filed with the court in the first response to an action, and it is presumed to be justified.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019, is applied also to the processing of the Board of Appeal or judicial proceedings which commenced before 1 April 2019.]

(2³) The proprietor of a later trade mark is not entitled to prohibit the use of an earlier trade mark or another earlier right.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) The proprietor of a trade mark has no right to prohibit further commercial exploitation of goods which have been put on the market in Estonia or in a Member State of the European Economic Area under that trade mark by the proprietor or with the proprietor's consent unless the proprietor has a legitimate interest in opposing further commercial exploitation of goods, especially if the characteristics of the goods have changed since they were put on the market.

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

§ 17. Obligation to use trade mark

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

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

1) use of the trade mark in a form differing from the representation of the mark in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether the trade mark in the form as used is also registered in the name of the proprietor of the trade mark;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

2) affixing of the trade mark to goods or to the packaging thereof intended solely for export purposes;

3) use of the trade mark with the consent of the proprietor of the trade mark.

(3) The provisions of subsections 16 (2²), 41 (2¹), 52 (4) and clauses 53 (1) 3) and 4) of this Act are not applied if less than five years have passed since the registration of the earlier trade mark.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) In case of a trade mark that has been registered pursuant to the Madrid Protocol and has been afforded legal protection in Estonia, the time period specified in subsection (3) of this section shall be calculated from the date when the decision on affording legal protection in Estonia can no longer be contested. If the trade mark has been contested or if notice of contestation on absolute or relative grounds has been given, the specified time period shall be calculated from the date when the decision on termination of the contestation procedure or the decision on the absolute or relative grounds for refusal became final or when contestation was waived.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 18. Transfer of trade marks

(1) A trade mark may be transferred in relation to all or some of the goods or services.

(2) A trade mark transfers to the legal successor of the proprietor of the trade mark. A trade mark shall not be inherited by the state or a local government.

(3) The transfer of a registered trade mark enters into force as of the date of entry of the corresponding amendment in the register.

§ 19. Surrender of trade marks

(1) The proprietor of a trade mark may surrender a trade mark with regard to all or some of the goods and services.

(2) The surrender of a registered trade mark enters into force as of the date of entry of the corresponding amendment in the register.

(3) A trade mark cannot be surrendered if the trade mark is encumbered with a pledge, included in a bankruptcy estate or a licence has been issued or a prohibition on disposal has been made in relation to the trade mark.

§ 20. Division of registration

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

§ 21. Licence

(1) A licensee may transfer the rights acquired from the proprietor of a trade mark by way of a licence to third persons only with the permission of the proprietor of the trade mark.

(2) The transfer of a trade mark or a licence issued later shall not affect the validity of a licence issued earlier.

(3) An entry shall be made in the register concerning a licence if a party to the licence agreement so requests.

(4) A licence expires with the expiry of the term of the registration.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 22. Notation concerning prohibition

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

§ 23. Compulsory execution and bankruptcy

(1) A trade mark may be the object of compulsory execution separately from an enterprise.

(2) If a registered trade mark is included in a bankruptcy estate, a corresponding notation is made in the register at the request of the trustee in bankruptcy or a court.

§ 24. Pledging of trade marks

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

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

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

§ 25. Satisfaction of claim secured by pledge

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

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

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

§ 26. Extinguishment of pledge

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

§ 27. Rights conferred by application

The provisions of §§ 18–26 of this Act apply to applications and rights conferred by applications, taking into account the specifications arising from the legal status of applications.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

Chapter 4 REGISTRATION OF TRADE MARKS

§ 28. Application

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

(2) An application shall set out:

- 1) a request for the registration of a trade mark;
- 2) a power of attorney if the applicants have a joint representative and all the applicants have not signed the application;

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

- 3) documents certifying priority if priority is claimed;
- 4) [repealed – RT I, 19.03.2019, 4 – entry into force 29.03.2019].

(3) The provisions of Chapter 6 of this Act additionally apply to applications for the registration of collective marks or certification marks.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 29. Priority

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

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

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

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

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

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

§ 30. Request for registration of trade mark

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

- 1) a request for the registration of a trade mark;
- 2) the name, address of the residence or seat of the applicant, and the e-mail address if the applicant wishes to receive notices from the Patent Office by electronic means;

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

- 3) the name of the representative of the applicant, if the applicant has a representative;
- 4) the address of a commercial or industrial enterprise operating in a Member State of the European Economic Area and belonging to a person of a foreign state, if such person has no representative;

[RT I, 19.03.2019, 4 – entry into force 01.04.2019]

- 5) a representation of the trade mark;
- 6) a list of goods and services classified according to the Nice Classification together with class numbers;

- 7) a priority claim if priority is claimed;
- 8) [repealed – RT I, 19.03.2019, 4 – entry into force 01.04.2019]
- 9) [repealed – RT I, 19.03.2019, 4 – entry into force 01.04.2019]
- 9¹) a notation regarding the type of the trade mark;
[RT I, 19.03.2019, 4 – entry into force 01.04.2019]
- 9²) a reference to generally recognised colour codes if the type of the trade mark is a colour mark;
[RT I, 19.03.2019, 4 – entry into force 01.04.2019]
- 10) the signature of the applicant or the representative of the applicant.

(2) A request for registration of a trade mark may set out the telephone number of the applicant, the personal identification code in case of an applicant who is a natural person, and the registry code in case of an applicant that is a legal person.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 31. Representation of trade mark

(1) A representation of a trade mark shall give a clear and complete impression of the trade mark.

(1¹) Types of trade marks and requirements for representation of trade marks shall be established by the regulation on trade marks.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 31¹. List of goods and services

(1) The goods and services for which the legal protection of a trade mark is requested shall be indicated with sufficient clarity and precision enabling the competent authorities and the public to determine the scope of the legal protection sought on the basis of the list of goods and services.

(2) The requirements for the list of goods and services shall be established by the regulation on trade marks.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 32. Power of attorney

A power of attorney shall set out the following:

- 1) the name and address of the residence or seat of the person represented;
- 2) the name of the representative;
- 3) the scope of the authorisation;
- 4) [Repealed – RT I 2009, 4, 24 – entry into force 01.03.2009]
- 5) the term of the authorisation, if the authorisation is granted for a specified term;
- 6) the signature of the person represented;
- 7) the date of issue of the power of attorney.

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

§ 33. Documents certifying priority

(1) Convention priority is certified by a document which is issued to the applicant by the agency which received the first application and which sets out the information in the first application.

(2) Exhibition priority is certified by a document concerning the display of goods or services designated by the trade mark at an exhibition specified in subsection 29 (3) of this Act, issued by the organiser of the exhibition.

(3) The Patent Office may accept also a document not specified in subsections (1) and (2) of this section as a document certifying priority, or accept a reference to a public database where all the data underlying a priority claim are reliably accessible to the Patent Office, instead of a document.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 34. Filing of application

(1) Applications are filed with the Patent Office.

(1¹) A state fee shall be paid for the examination of an application.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(2) The state fee for the examination of an application, and a priority claim and a power of attorney issued to the joint representative of the applicants shall be filed within two months from the filing date of an application.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3) Documents certifying a priority claim shall be filed within three months from the filing date of the application. Documents certifying priority need not be submitted if priority is claimed on the basis of a first application filed in Estonia or if the Patent Office accepts a reference to the data in a public database instead of a document certifying priority in the case specified in subsection 33 (3) of this Act.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(4) The requirements for the contents and form as well as the procedure for filing of the application and other documents to be submitted to the Patent Office shall be established by the regulation on trade marks.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 35. Filing date of application

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

- 1) a request for the registration of a trade mark in Estonian;
[RT I 2004, 20, 141 - entry into force 01.05.2004]
- 2) a representation of the trade mark conforming to the requirements provided for in § 6 of this Act;
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]
- 3) a list in Estonian of goods and services for which the registration application is filed;
[RT I 2004, 20, 141 - entry into force 01.05.2004]
- 4) the name of the applicant and information necessary for enabling the Patent Office to communicate with the applicant or a representative of the applicant.
[RT I 2009, 4, 24 - entry into force 01.03.2009]

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

(1) If an application meets the requirements provided for in § 35 of this Act upon its receipt by the Patent Office, the date of receipt of the application by the Patent Office shall be deemed to be the filing date of the application.

(2) If any information specified in § 35 of this Act is missing from an application, the applicant shall be notified thereof and a term of two months shall be set for elimination of deficiencies.
[RT I 2009, 4, 24 - entry into force 01.03.2009]

(3) The Patent Office is not required to give notice as provided for in subsection (2) of this section if the filed documents do not contain the information set out in clause 35 4) of this Act. In such event the applicant may, on own initiative, file all the missing information as specified in § 35 of this Act within two months from the date of receipt of the initially filed documents by the Patent Office.
[RT I 2009, 4, 24 - entry into force 01.03.2009]

(4) If an applicant files all the missing information within a term set pursuant to subsection (2) of this section or, if subsection (3) applies, within the term provided for therein, the date on which all the information specified in § 35 is submitted to the Patent Office is deemed to be the filing date of the application.

(5) An application, the filing date of which is determined pursuant to subsection (1) or (4) of this section, is accepted for processing. The Patent Office shall notify the applicant of the filing date of the application and the application number.

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

§ 37. Verification of requirements for contents and form of applications

(1) If it becomes evident in the course of verification of the compliance of an application with the requirements for contents and form that a document specified in § 28 of this Act is missing from the application or that the data of the application or documents do not meet the requirements provided for in §§ 30–33 or requirements established pursuant to subsection 31 (1¹), 31¹(2) or 34 (4) of this Act, the Patent Office shall notify the applicant thereof in writing and set a term of at least two months for eliminating of deficiencies or giving explanations.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) If an applicant fails to eliminate deficiencies in the applicant's response to the notice specified in subsection (1) of this section, a decision to reject the application partially or fully shall be made.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3) If an applicant fails to respond to the notice specified in subsection (1) of this section by the due date, fails to pay the state fee in the prescribed amount within the term specified in subsection 34 (2) of this Act, or fails to file a power of attorney within the prescribed term, the application is deemed to be partially or fully withdrawn.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3¹) If the state fee has been partially paid but it is not clear which classes of goods or services the paid amount is meant to cover, the Patent Office shall take the classes into consideration in the order they are set out in the application. The application is deemed to be withdrawn with regard to the classes for which the state fee has not been fully paid. The Patent Office shall notify the applicant about the classes regarding which the processing will continue.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3²) Subsections (1)–(3) of this section shall apply also in case the Patent Office requires the applicant to submit additional data regarding the application in cases prescribed by law or pursuant to law.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(4) If an applicant does not file a priority claim within the term provided for in subsection 34 (2) of this Act or fails to submit the required documents certifying priority by the due date or the priority claim does not comply with the provisions of § 29 or the documents submitted do not certify priority, the Patent Office shall not take the priority claim into consideration.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 38. Examination of trade marks

(1) The Patent Office shall examine a trade mark with regard to the provisions of subsection 9 (1) of this Act.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1¹) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) If an examination reveals circumstances which preclude the legal protection of a trade mark, the Patent Office shall notify the applicant thereof and set a term of at least two months for eliminating said circumstances or giving explanations. If the applicant fails to respond within the set term, the application is deemed to be partially or fully withdrawn.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

(1) The decision to register a trade mark shall be made if examination reveals none of the circumstances specified in subsection 9 (1) of this Act which preclude legal protection or if the applicant has eliminated such circumstances which were revealed by the examination and which precluded legal protection.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) The decision to refuse to register a trade mark shall be made if the circumstances specified in subsection 9 (1) of this Act which were revealed by the examination and which precluded legal protection are not eliminated by the applicant.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

(4) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 40. Publication of notice of decision to register trade mark

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

(2) The structure and procedure for the publication of the official publication of the Patent Office shall be established by the regulation on trade marks.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 41. Adjudication of appeals and revocation applications

(1) An applicant may file an appeal against a decision of the Patent Office specified in subsections 37 (2), § 39 (2) and 62¹(4) of this Act with the Board of Appeal within two months from the date the decision was made.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) An interested person may contest an applicant's right to a trade mark at the Board of Appeal if any circumstances specified in subsection § 10 of this Act which preclude legal protection exist. The term for filing a revocation application is two months from the publication of the notice of the decision to register a trade mark.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2¹) The proprietor of an earlier trade mark is not entitled to contest an applicant's right to a trade mark to the extent that the proprietor has not actually used the earlier registered trade mark during five years before the filing date of the application for the later trade mark or the date of priority without good reason within the meaning of § 17 of this Act or Article 18 of Regulation (EU) 2017/1001 of the European Parliament and of the Council. The respective objection shall be filed with the Board of Appeal in the first written position or with a court in the statement of claim or in the first response to an action, and it is presumed to be justified.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019, is applied also to the processing of the Board of Appeal or judicial proceedings which commenced before 1 April 2019.]

(3) In case a revocation application is granted in whole or in part, the Board of Appeal shall annul the decision of the Patent Office and make a new decision on the registration of the trade mark.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(5) A participant in a processing concerning a revocation application who is not satisfied with a decision of the Board of Appeal regarding the legal protection of a trade mark, may file an action, within the term provided for in subsection 64 (1) of the Principles of Legal Regulation of Industrial Property Act, against another participant in the processing to verify the circumstances specified in § 10 of this Act which preclude the legal protection of the trade mark or non-existence of such circumstances.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(6) In case the appeal, revocation application or action is satisfied in whole or in part, the Patent Office shall continue the processing of the application on the basis of the decision of the Board of Appeal or the court judgment which has entered into force.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 41¹. Observations by third parties

(1) Any person may submit to the Patent Office written observations to draw attention to the existence of any circumstances precluding legal protection of a trade mark as specified in subsection 9 (1) of this Act, or in case of a collective mark or certification mark, to the fact that the conditions for registration specified in subsection 62¹(1) are not satisfied.

(2) Observations can be submitted within two months after publication of the notice regarding the decision to register the trade mark.

(3) The Patent Office shall review the observations within one month.

(4) If the Patent Office finds an observation to be justified, the Patent Office shall make a decision to revoke the decision to register the trade mark and shall resume the examination of the trade mark. The Patent Office shall communicate said decision and resumption of the examination to the applicant and to the person who submitted the observation.

(5) If the Patent Office finds an observation not to be justified, the Patent Office shall communicate it to the person who submitted the observation. The Patent Office is not required to give reasons for its position.

(6) A person submitting observations is not a participant in a processing concerning the registration of the trade mark.

(7) If the Patent Office makes a decision to register a trade mark after the resumption of the examination of the trade mark, a new term for filing a revocation application does not start as of publication of a notice regarding such decision. The processing of the revocation application filed with regard to the first decision of the Patent Office shall be suspended until the Patent Office makes a new decision, and it shall be deemed as a revocation application filed with regard to the new decision.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 42. Renewal of terms

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

(2) The Patent Office shall renew the term specified in subsections 37 (1) and 38 (2) of this Act at the request of the applicant for at least two months at a time but not for longer than thirteen months altogether. The request for the renewal of the term shall be filed and the state fee shall be paid before the end of the term set for the performance of the act.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 43. Suspension of processing

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

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

§ 44. Division and restriction of applications

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

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

§ 45. Correction and supplementation of applications

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

§ 46. Conditions for registration

(1) A registration shall be made if:

- 1) the decision to register a trade mark has not been appealed against or the applicant's right to the published trade mark has not been contested, and information concerning payment of the state fee for the registration has been submitted within four months from the publication of the notice of registration of the trade mark, or
- 2) a decision to register a trade mark and the applicant's right to the published trade mark remain in force regardless of contestation or submission of observations.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) If information concerning payment of the state fee for the registration is not submitted by the due date, the application is deemed to be withdrawn.

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

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

(2) If an application is withdrawn in the manner specified in subsection (1) of this section or deemed to be partially or fully withdrawn in the cases specified in subsections 37 (3) and 38 (2) of this Act, processing of the respective part is terminated and the applicant is notified thereof. If processing is terminated, the application documents are not returned and the state fee is not refunded.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3) An applicant may request that processing be resumed if the Patent Office terminated processing having deemed the application to be partially or fully withdrawn pursuant to subsection 37 (3) or 38 (2) of this Act.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(4) The Patent Office shall resume the processing if the applicant submits a written request, pays the state fee prescribed for the resumption of the processing and performs the acts for the non-performance whereof the application was deemed to be partially or fully withdrawn pursuant to subsection 37 (3) or 38 (2) of this Act. The Patent Office shall notify the applicant of the resumption of the processing.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(5) A request for the resumption of processing shall be filed, the state fee shall be paid and the acts specified in subsection (4) of this Act shall be performed within two months after learning about the termination of processing, but not later than within six months after the due date for the act which was not performed.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

§ 48. Registration

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

(2) Registration data are:

- 1) the registration number;
- 2) the date of making the registration;
- 3) a representation of the trade mark;

3¹) a description of the trade mark if it has been submitted in cases prescribed pursuant to law;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

4) a list of goods and services classified according to the Nice Classification together with class numbers;

5) a list of colours if it has been submitted in cases prescribed pursuant to law;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

6) [repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

6¹) a notation regarding the type of the trade mark;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

6²) a reference to generally recognised colour codes if the type of the trade mark is a colour mark;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

7) [repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

8) the name and address of the residence or seat of the proprietor of the trade mark;

9) where the trade mark is a collective mark or certification mark, a notation to that effect;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

10) the name of the representative of the proprietor of the trade mark, if the proprietor of the trade mark has a representative;

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

11) the address of a commercial or industrial enterprise operating in a Member State of the European Economic Area and belonging to a person of a foreign state, if such person has no representative;

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

12) the date of expiry of the registration;

13) application number;

14) the filing date of the application;

15) priority data, if a priority claim is satisfied.

§ 49. Publication of registration data

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

§ 49¹. Certificate of registration

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

(1¹) On the basis of the request of a proprietor of a trade mark, a copy of an electronic certificate of registration shall be issued to the proprietor on paper. The copy shall be issued within twenty working days after submission of the request but not before the payment of the required state fee.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(2) [Repealed – RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

(4) A duplicate of a certificate of registration may be issued on the basis of a request of the proprietor of the trade mark. The duplicate is issued within twenty working days after the submission of the request but not before the payment of the required state fee.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(5) The list of data to be set out in a certificate of registration, the procedure for issue of the certificate of registration and, as necessary, the formal requirements shall be established by the regulation on trade marks.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

(1) During one year prior to expiry of the term of legal protection of a trade mark, the proprietor of the trade mark may request the renewal of the term. A corresponding request shall be submitted to the Patent Office and the state fee shall be paid.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(1¹) The Patent Office shall notify the proprietor of a trade mark about the expiry of the term of legal protection of the trade mark at least six months before the expiry of the term. The Patent Office shall not be liable for a violation of the notification obligation.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) The proprietor of a trade mark may request restoration of the term for renewal of the legal protection of the trade mark within six months after expiry of the term of legal protection of the trade mark. A corresponding request shall be submitted to the Patent Office and the state fee for renewal of the term of legal protection and supplementary state fee for restoration of the term for renewal of legal protection shall be paid.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(2¹) At the request of the proprietor of a trade mark, the Patent Office restores the term for submission of the request set out in subsection (1) or (2) of this section within six months after the expiry of the term for submission of the request if the state fee required for the submission of the request is paid on time.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) Renewal of the term of legal protection of a trade mark enters into force as of the next day following the date of expiry of the existing term of registration.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) If the renewal of the term of legal protection of a trade mark is requested only with regard to part of the goods or services for which the trade mark is registered, the term of legal protection of the trade mark shall be renewed only with regard to these goods or services.
[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

(2) A state fee shall be paid for making an entry on transfer of a trade mark.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3) If the request is submitted by the new proprietor of the trade mark or the person to whom the rights conferred by the trade mark transfer, a document certifying the surrender or the transfer of the rights shall be appended to the request.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

(5) In case of transfer of a trade mark in relation to some of the goods or services, a list of the goods and services to be transferred and a list of the goods and services which remain in the registration data shall be appended to the request.
[RT I 2004, 20, 14¹ - entry into force 01.05.2004]

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

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

(2) An entry on amendment of registration data shall not alter the trade mark or change the scope of legal protection thereof, except in the case specified in subsection 19 (1) of this Act.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

(3) If a request for performing an act related to trade mark is submitted on behalf of the proprietor of the trade mark by another person with the right of representation than the representative entered in the register, the person submitting the request shall be entered in the register as a representative replacing the former representative, unless explicitly indicated otherwise in the request or unless the new representative and the representative entered in the register act through the same company.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

A written request of the proprietor of the trade mark shall be the basis for making an entry on surrender of the trade mark.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

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

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

(2) A state fee shall be paid for making an entry on division of the registration.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 50⁵. Request for entry of licence in register

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

(1) A written request of the licensor or the licensee shall be the basis for an entry concerning a licence in the register.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

(2) An extract of the licence agreement which contains information necessary for making an entry regarding the parties to the agreement, nature, scope and term of the licence, shall be appended to a request for entry concerning a licence in the register. The extract need not be submitted if the request for making an entry concerning a licence in the register has been signed both by the licensor and the licensee and the request contains the information necessary for making the entry.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(2¹) A state fee shall be paid for making an entry concerning a licence in the register.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3) An entry concerning a licence agreement shall be deleted upon expiry of the term of the licence or at the request of the person who filed the request for entry concerning the licence in the register.
[RT I 2004, 20, 141 - entry into force 01.05.2004]

§ 50⁶. Request for entry of pledge in register

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

(2) A notarised agreement for the establishment of the pledge shall be appended to the request and the state fee shall be paid.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3) In order to have the conditions of an agreement for the establishment of the pledge amended, a request together with a notarised annex to the agreement for the establishment of the pledge, a court judgment or another document certifying the amendment shall be filed and the state fee shall be paid.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(4) In order to have the person of the pledgee changed, a request together with a notarised document certifying the change shall be filed and the state fee shall be paid.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(5) In order to have the ranking of a registered security over movables changed, a request together with the agreement between the persons the ranking of whose rights is changed shall be filed and the state fee shall be paid.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

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

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

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

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

(1) If a request specified in §§ 50–50⁶ is filed by a joint representative, a power of attorney shall be appended to the request. The power of attorney need not be appended if the request has been signed by all the principals or if a power of attorney filed with the Patent Office earlier for the performance of the same act is valid.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

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

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

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

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

§ 51. Deletion of trade mark from register

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

(2) A trade mark is deleted from the register before the prescribed time if a corresponding decision of the Board of Appeal or court judgment which has entered into force is submitted to the Patent Office or if the proprietor of the trade mark surrenders the trade mark.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

§ 51¹. Access to register

(1) Prior to the publication of a notice of the decision concerning registration of a trade mark, it is permitted to release the following information from the register: representation of the trade mark including, as appropriate, description and generally recognised colour codes, registration application number, filing date of the registration application, information on priority, name of the applicant, name of a representative of the applicant, list of goods and services, and class numbers of the international classification.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

(4) In order to have access to a registry file or to receive written information, copies or printouts from the register, a written request shall be submitted and the state fee shall be paid. Applicants and proprietors of trade marks have access to the registry files concerning their trade marks free of charge.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

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

Chapter 5

CONTESTATION OF RIGHTS AND LIABILITY

[RT I, 19.03.2019, 5 - entry into force 01.04.2019]

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

(1) Any person may file a request with the Board of Appeal against the proprietor of a trade mark for the exclusive right of the proprietor of the trade mark to be declared null and void if any circumstances specified in § 9 of this Act which preclude legal protection exist and existed also at the time when the decision to register the trade mark was made.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1¹) An interested person may file a request with the Board of Appeal against the proprietor of a trade mark for the exclusive right of the proprietor of the trade mark to be declared null and void if the circumstances specified in § 10 of this Act which preclude legal protection exist and existed also at the time when the decision to register the trade mark was made.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) A request provided for in subsection (1¹) of this section may be filed:

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

(3) If a trade mark is registered in the name of the agent or representative of the proprietor of the trade mark without the proprietor's consent, the proprietor of the trade mark has the right to file, within five years after becoming aware of the registration of the trade mark in the name of the agent or representative, a request with the Board of Appeal to claim the transfer of the trade mark to the proprietor. These grounds do not apply if the activities of the agent or representative are justified.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) The proprietor of an earlier trade mark is not entitled to claim declaration of nullity of the exclusive right of the proprietor of the trade mark to the extent that the proprietor of the earlier trade mark has not actually used the earlier registered trade mark during five years before the filing date of the application for the later trade mark or the date of priority or the filing date of a request for declaration of nullity of the exclusive right without good reason within the meaning of § 17 of this Act or, in case of an EU trade mark, within the meaning of Article 18 of Regulation (EU) 2017/1001 of the European Parliament and of the Council. The respective objection shall be filed with the Board of Appeal in the first written position or with a court in the statement of claim or in the first response to an action, and it is presumed to be justified.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019, is applied also to the processing of the Board of Appeal or judicial proceedings which commenced before 1 April 2019.]

(5) [Repealed - RT I 2009, 4, 24 – entry into force 01.03.2009]

(6) The proprietor of an earlier trade mark is not entitled to claim declaration of nullity of the exclusive right with regard to a later trade mark if, as of the filing date of the application for the later trade mark or as of the date of priority, the request for declaration of nullity of the exclusive right based on an earlier trade mark would not have been satisfied for any of the following reasons:

- 1) the earlier trade mark, regarding which any of the circumstances precluding legal protection under clause 9 (1) 2), 3) or 4) of this Act exist, or in case of an EU trade mark, any of the absolute grounds for refusal specified in points (b), (c) or (d) of Article 7 (1) of Regulation (EU) 2017/1001 of the European Parliament and of the Council exist, had not yet acquired its distinctive character pursuant to subsection 9 (2) of this Act or Article 7 (3) of Regulation (EU) 2017/1001 of the European Parliament and of the Council;

2) the earlier trade mark which is relied on as a circumstance precluding legal protection under clause 10 (1) 2) of this Act, had not yet acquired sufficiently distinctive character so that there would have been likelihood of confusion of the trade marks on the part of consumers;

3) the earlier trade mark which is relied on as a circumstance precluding legal protection under clause 10 (1) 3) of this Act, had not yet acquired reputation within the meaning of this provision.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019, is applied also to the processing of the Board of Appeal or judicial proceedings which commenced before 1 April 2019.]

(7) The grounds specified in clauses 9 (1) 2)–4) of this Act for declaration of nullity of the exclusive right of the proprietor of a trade mark do not apply with regard to trade marks that have acquired distinctive character as a result of use by the filing date of the request for declaration of nullity of the exclusive right.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(8) A participant in the processing concerning a request specified in subsection (1) or (1¹) of this section who is not satisfied with a decision of the Board of Appeal, may file an action, within the term provided for in subsection 64 (1) of the Principles of Legal Regulation of Industrial Property Act, against another participant in the processing to have the exclusive right of the proprietor of the trade mark to be declared null and void or to establish the lack of circumstances providing grounds therefor.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(9) A participant in the processing concerning a request specified in subsection (3) of this section who is not satisfied with a decision of the Board of Appeal, may file an action, within the term provided for in subsection 64 (1) of the Principles of Legal Regulation of Industrial Property Act, against another participant in the processing to claim transfer of the trade mark to themselves or to establish the lack of circumstances providing grounds therefor.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

(1) Any person may file a request with the Board of Appeal against the proprietor of a trade mark for the exclusive right of the proprietor of the trade mark to be declared extinguished if:

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

2) the trade mark has, as a result of an act or failure to act by the proprietor of the trade mark, become misleading for the consumer as to the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services;

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

4) a trade mark, concerning which a registration valid in Estonia is entered in the International Register of the Bureau pursuant to the Madrid Protocol, has not been used within the meaning of § 17 of this Act during five consecutive years after grant of legal protection to the trade mark in Estonia.

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) The provisions of subsection (2) of this section do not apply if the use of the trade mark within the meaning of § 17 of this Act commences after the end of the period of five years and within three months prior to filing of the request and if the proprietor of the trade mark commenced preparations for the use of the trade mark only after the proprietor became aware of the intention of filing the request.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) A participant in the processing concerning the request specified in subsection (1) of this section who is not satisfied with a decision of the Board of Appeal, may file an action, within the term provided for in subsection 64 (1) of the Principles of Legal Regulation of Industrial Property Act, against another participant in the processing for the exclusive right of the proprietor of the trade mark to be declared extinguished or to establish the lack of circumstances providing grounds therefor.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

[Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

(2) If an exclusive right is declared extinguished, the registration shall be deemed to be invalid as of the date of filing the request with the Board of Appeal or as of the date of filing the counterclaim with a court under subsection 59 (1) of this Act. The person filing the request or the plaintiff in the counterclaim may request that an exclusive right be declared extinguished as of the date of creation of the grounds for the request or counterclaim.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

§ 57. Protection of exclusive right

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

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

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

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) A licensee has the right to enter judicial proceedings initiated on the basis of an action for protection of the exclusive right of the proprietor of the trade mark, to be compensated for damage caused to the licensee.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 58. Supplementary protection requirements

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

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

§ 59. Contestation of exclusive right in counterclaims and offence proceedings

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1) A person against whom the proprietor of a trade mark under legal protection in Estonia has filed an action for the protection of the exclusive right, may contest the exclusive right of the proprietor of the trade mark in a counterclaim.

(2) A person against whom offence proceedings based on the infringement of the exclusive right of the proprietor of a trade mark have been initiated, may file a request with the Board of Appeal against the proprietor of the trade mark for declaration of nullity of the latter's exclusive right or for declaring the exclusive right extinguished on the grounds provided for in this Act. The offence proceedings shall be suspended for the period of the processing of the request.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

(1) Appeals and actions related to the legal protection, validity and unlawful use of trade marks, petitions for the securing of an action and petitions for provisional legal protection, as well as other appeals and actions specified in this Act shall be heard by Harju County Court.

[RT I, 19.03.2019, 4 – entry into force 01.04.2019]

(2) [Repealed – RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

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

§ 60¹. Representatives in court disputes concerning trade marks

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

(2) In the protection of their rights, a proprietor of a trade mark may be represented by an organisation with passive legal capacity representing proprietors of trade marks while being a member of such an organisation.

[RT I 2006, 7, 42 - entry into force 04.02.2006]

Chapter 6 SPECIFICATIONS OF LEGAL PROTECTION OF COLLECTIVE MARKS AND CERTIFICATION MARKS

[RT I, 19.03.2019, 5 - entry into force 01.04.2019]

§ 61. Collective mark and certification mark

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1) A collective mark is a trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings.

(2) A certification mark is a trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods and services which are not so certified.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 61¹. Persons entitled to apply for collective marks and certification marks

(1) Associations of manufacturers, producers, suppliers of services, or traders which have passive legal capacity, as well as legal persons in public law, may apply for collective marks.

(2) Any natural or legal person may apply for certification marks provided that such person does not carry on a business involving the supply of goods or services of the kind certified.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 62. Regulations of collective mark or certification mark

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1¹) The regulations of a collective mark shall specify a list of the members of the association whose goods or services are designated by the collective mark, the terms of and procedure for becoming a member of the association and the conditions of use of the mark, including sanctions. The regulations of a collective mark

which may designate the geographical origin of goods and services in the course of trade shall enable any person whose goods or services originate from the same geographical region to become a member of the association if they conform to other conditions set out in the regulations.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1²) The regulations of a certification mark shall specify the persons authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, as well as the conditions of use of the mark, including sanctions.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1³) The regulations shall not be contrary to public order or accepted principles of morality.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1⁴) Specified requirements for the regulations shall be established by the regulation on trade marks.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) [Repealed – RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) If the regulations are amended, the amended regulations shall be submitted to the Patent Office. Amendments to regulations are effective as of the entry of the amendments in the register. Amendments to the regulations are entered in the register only if the amended regulations conform to the requirements specified in subsection 62¹(1) of this Act.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 62¹. Registration of collective mark or certification mark

(1) A decision to register a collective mark or certification mark is made if:

1) the collective mark or certification mark applied for and the applicant conform to the requirements provided for in this Chapter;

2) there are no circumstances precluding legal protection specified in § 9 of this Act, taking into account the specifications arising from subsection 63 (4);

3) the regulations conform to the requirements specified in subsections 62 (1¹)–(1³) of this Act; and

4) there are no circumstances providing reason to believe that the public might be misled as regards the character or significance of the collective mark or certification mark, in particular if it is likely to be taken to be something other than a collective mark or certification mark.

(2) If the application for a collective mark or certification mark does not conform to the requirements specified in subsection (1) of this section, the Patent Office shall notify the applicant about it and shall set a term of at least two months for eliminating of deficiencies or giving explanations. The Patent Office shall renew this term pursuant to the provisions of subsection 42 (2) of this Act.

(3) If the applicant does not respond to the notification of the Patent Office specified in subsection (2) of this section, the application is deemed to be withdrawn. The applicant may request resumption of the procedure pursuant to the provisions of subsection 47 (3) of this Act.

(4) If the application does not conform to the requirements specified in subsection (1) of this section and the applicant does not eliminate the deficiencies within the term set by the Patent Office, the Patent Office shall make a decision to refuse to register the collective mark or certification mark.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) A collective mark or certification mark may be used by any person entitled to use it under the regulations.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(4) A collective mark or certification mark may indicate the geographical origin of the goods or services designated with the mark. The proprietor of such collective mark or certification mark is not entitled to prohibit a third party from using in the course of trade signs or indications of geographical origin, provided that they use them in accordance with good business practice.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(5) The use of a collective mark or certification mark by a person entitled to the use constitutes the use of a trade mark within the meaning of § 17 of this Act.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1) In addition to the grounds for declaration of nullity of the exclusive right of the proprietor of a trade mark as provided for in § 52 of this Act, taking into account the specifications deriving from subsection 63 (4), the exclusive right of the proprietor of a collective mark or certification mark shall be declared null and void if the collective mark or certification mark has not been registered in conformity with subsection 62¹(1), unless the proprietor of the mark eliminates the nonconformity by amending the regulations within a term set by the Board of Appeal or a court.

(2) In addition to the grounds for declaring the exclusive right of the proprietor of a trade mark extinguished as provided for in § 53 of this Act, the exclusive right of the proprietor of a collective mark or certification mark shall be declared extinguished if:

- 1) the proprietor of the collective mark or certification mark does not take reasonable measures to prevent the use of the mark in conflict with the regulations;
- 2) the persons entitled to use the collective mark or certification mark have used the mark in a manner which may mislead the public as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark or certification mark;
- 3) amendments to the regulations have been entered in the register in conflict with subsection 62 (3) of this Act, unless the proprietor of the mark amends the regulations within a term set by the Board of Appeal or a court in such manner that the amended regulations conform to the conditions for entry in the register;
- 4) the proprietor of a certification mark no longer conforms to the conditions provided for in subsection 61¹(2) of this Act.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

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

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(1) A person entitled to use a collective mark or certification mark is entitled to file an action for the protection of the exclusive right only with the consent of the proprietor of the mark.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(2) A person entitled to use a collective mark or certification mark is entitled to enter judicial proceedings initiated on the basis of an action for the protection of the exclusive right of the proprietor of the mark, to be compensated for damage caused to the such person.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(3) The proprietor of a collective mark or certification mark is entitled to claim compensation for damage on behalf of the persons entitled to use the mark who have suffered damage due to unlawful use of the mark.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

Chapter 7

INTERNATIONAL REGISTRATION OF TRADE MARKS

§ 66. International registration of trade marks

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

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

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

§ 67. Application for international registration

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

(2) An international application shall comply with the requirements for contents and form established in the Madrid Protocol and its Common Regulations. The procedure for filing international applications with the Patent Office shall be established by the regulation on trade marks.

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

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

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

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

§ 68. Processing of international applications

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

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

§ 69. Effect of international registration

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(2) An international registration is not valid in Estonia if the grant of legal protection is refused as a result of processing the international registration.

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 70. Processing of international registration

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

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

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

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

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

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

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

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(9) Information specified in subsection 51¹(1) of this Act shall be released from the database of national processing of international registrations of trade marks.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(10) A state fee shall be paid for the release of information from the database of national processing of international registrations.
[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 71. Invalidity and conversion of international registration

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

(4) Upon conversion of an international registration designating the European Union into an international registration where the Republic of Estonia is a designated Contracting Party, or into a national application pursuant to Article 202 of Regulation (EU) 2017/1001 of the European Parliament and of the Council, the provisions of § 71³ of this Act shall apply to the extent that is not regulated otherwise pursuant to Regulation (EU) 2017/1001 of the European Parliament and of the Council.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

Chapter 7¹ EU TRADE MARK

[RT I, 19.03.2019, 4 - entry into force 29.03.2019]

§ 71¹. Registration of EU trade mark

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(1) The registration of an EU trade mark means the registration of a trade mark with the European Union Intellectual Property Office on the basis of Regulation (EU) 2017/1001 of the European Parliament and of the Council.

(2) The Patent Office is the central industrial property office within the meaning of Regulation (EU) 2017/1001 of the European Parliament and of the Council.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 71². Application for Community trade mark

[Repealed – RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(1) Upon conversion of an EU trade mark application or EU trade mark into a national trade mark application pursuant to the provisions of Chapter XI Section 3 of Regulation (EU) 2017/1001 of the European Parliament and of the Council, the date of filing of an application for an EU trade mark or the date of priority of that application or trade mark or the seniority date is deemed to be the date of national filing.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(3) Upon conversion of an EU trade mark application or EU trade mark into a national trade mark application pursuant to the provisions of Article 139 of Regulation (EU) 2017/1001 of the European Parliament and of the Council, the person requesting conversion shall pay the state fee and file the following documents within two months from the date on which a corresponding request from the European Union Intellectual Property Office is received by the Patent Office:

1) the Estonian translation of the list of goods and services grouped according to the classes of the Nice Classification;

2) in case of a person of a foreign state, the address of a commercial or industrial enterprise operating in a Member State of the European Economic Area and belonging to the person or the data of an authorised patent attorney.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

(5) The Patent Office shall perform examination and process requests for conversion pursuant to the provisions of Chapter 4 of this Act, taking into account the specific provisions arising from Regulation (EU) 2017/1001 of the European Parliament and of the Council.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(6) The provisions of this Chapter apply also to the conversion of an EU collective mark application or collective mark into a national collective mark application.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

If seniority of a trade mark valid in Estonia is claimed for a registered EU trade mark or an EU trade mark which has been filed for registration on the basis of an earlier registered trade mark or the Madrid Protocol pursuant to Article 39 or 40 of Regulation (EU) 2017/1001 of the European Parliament and of the Council, an action may be filed for the exclusive right of the proprietor of the earlier trade mark to be declared null and void or to be declared extinguished pursuant to this Act even if the earlier trade mark has been deleted from the register due to refusal to renew the term or is surrendered by the proprietor.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

(2) Appeals against the judgments of the EU trade mark court of first instance shall be reviewed by Tallinn Circuit Court as the EU trade mark court of second instance.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

§ 71⁶. Prohibition on use of EU trade mark

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(1) A proprietor of an earlier trade mark or another earlier right may, under the conditions specified in Article 137 or 138 or Article 209 (5) of Regulation (EU) 2017/1001 of the European Parliament and of the Council, file an action against a proprietor of the EU trade mark for the protection of an exclusive right pursuant to subsection 57 (1) of this Act for the prohibition on the use of the EU trade mark in Estonia.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

(2) If the proprietor of an earlier trade mark or another earlier right has filed an action for the protection of an exclusive right on the basis of subsection (1) of this section, the proprietor may request the application of supplementary protection requirements specified in § 58 of this Act only in respect of goods located in Estonia.

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

Chapter 71² STATE FEE

[RT I, 19.03.2019, 4 - entry into force 29.03.2019]

§ 71⁷. State fee

(1) A state fee shall be paid in the amount provided by the State Fees Act for examination of an application, issue of information and performance of other acts in the cases specified in this Act.

(2) The procedure for the payment of a state fee and verification thereof shall be established by the regulation on trade marks.

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

Chapter 8 IMPLEMENTING PROVISIONS

§ 72. Transitional provisions

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(9) If the limitation period valid before 1 May 2004 has not expired by the date of entry into force of this Act and a different limitation period is provided for in this Act, the longer limitation period applies.

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

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

[RT I, 19.03.2019, 4 – entry into force 29.03.2019]

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

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

(12) A decision concerning an application processed by the Patent Office which was submitted after 1 May 2004 and regarding which no decision to register or refuse to register a trade mark was made before 1 April 2019, shall be subject to the grounds for refusal to register a trade mark which were in force at the time of filing the application, and the processing thereof shall be carried out pursuant to the procedural provisions valid as at the time of performing the procedural act.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(13) If the decision to register a trade mark was made before 1 April 2019, an interested person may contest the applicant's right to the trade mark pursuant to subsection 41 (2) of this Act even if circumstances which preclude legal protection under subsection 9 (1) exist.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(14) Adjudication of an appeal or revocation application filed against a decision of the Patent Office and, in case a decision is annulled, making of a new decision regarding an application which was filed before 1 April 2019 and for which a decision was made after 1 May 2004, shall be subject to the grounds for refusal to register a trade mark which were in force at the time of filing the application, and the processing thereof shall be carried out pursuant to the procedural provisions valid as at the time of performing the procedural act.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(15) If the grounds for refusal to register a trade mark which were in force from 1 May 2004 to 31 March 2019 were applied to the making of a decision to register a trade mark, these grounds shall apply also to the review of a request for declaration of nullity of the exclusive right with regard to the respective trade mark and to the hearing of the action.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(16) Clause 10 (1) 9) of this Act shall apply also to the declaration of nullity of the exclusive right with regard to a trade mark containing a geographical indication which was filed for registration or which was registered before 10 January 2000. If the request is satisfied, the exclusive right with regard to the trade mark shall be declared null and void from 10 January 2000.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(17) The provisions of subsections 16 (2¹) and (2²), 41 (2¹) and 52 (4) and (6) of this Act shall apply also to the processing of the Board of Appeal or judicial proceedings which commenced before 1 April 2019.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(18) The starting date of the term of legal protection of a registered trade mark shall be determined pursuant to the law valid at the time of filing an application for the registration of the trade mark.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(19) Guarantee marks shall be registered on the basis of applications filed before 1 April 2019 and these marks shall be subject to the law valid at the time of filing an application.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(20) In case of a decision to register a trade mark made before 1 April 2019, the state fee for the registration shall be paid pursuant to the law valid at the time of making the decision to register the trade mark.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(21) Proceedings concerning an action filed pursuant to this Act before 1 April 2019 shall be conducted by a court even in case mandatory pre-trial procedure in the Board of Appeal is prescribed for the settlement of the respective dispute starting from said date.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

(22) Proceedings concerning an appeal, petition or action filed with a court pursuant to this Act before 1 April 2019 shall be conducted by a county court other than Harju County Court even in case Harju County Court has exclusive jurisdiction over adjudication of the respective appeal, petition or action starting from said date.

[RT I, 19.03.2019, 5 – entry into force 01.04.2019]

§ 73. Repeal of Trade Marks Act

[Omitted from this text.]

§ 74. Entry into force of Act

This Act enters into force on 1 May 2004.

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

¹Directive (EU) 2015/2436 of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (OJ L 336, 23.12.2015, p. 1–26).
[RT I, 19.03.2019, 5 - entry into force 01.04.2019]