

fore, it is advisable to make sure no-one else already owns a similar trade mark or business name. Earlier trade marks can be checked from the databases on the website of the Estonian Patent Office (database of the Patent Office, EUTM database eSearch, TMview), business names can be checked from the Commercial Register.

Before filing the application it is important to thoroughly think through the **representation of the trade mark** and the **list of goods and services** as after the application has been received it is not possible to change the trade mark or add any goods or services.

If you find it difficult to determine whether or not your trade mark can be registered, you may use the **opportunity to get free consultations** from the Estonian Patent Office or ask advice from a patent attorney. In case of refusal of the trade mark registration, the state fees which have been paid will not be refunded.

When a trade mark has been registered

At first the trade mark will be granted legal **protection for 10 years**. The term of legal protection can be renewed by 10 years upon payment of a state fee. It is important to monitor the expiry of the term of legal protection as it can be renewed only within a certain period of time.

A trade mark must be **used**. If a trade mark has not been used for designating goods or services within five years, an interested person may demand for the exclusive right of the trade mark owner to be declared extinguished.

Guard your assets – it is important to observe what is happening with the registered trade mark on the market. It is the task of a trade mark owner. The owner should not let others use the trade mark or let it be registered in someone else's name. If similar trade marks appear on the market, it decreases the distinctive character of the trade mark and may violate or take advantage of the reputation of the earlier trade mark.



REPUBLIC OF ESTONIA
PATENT OFFICE

ESTONIAN PATENT OFFICE

Toompuiestee 7
15041 Tallinn

Reception

Phone +372 627 7911, Fax +372 627 7912
Electronic filing of applications
<https://teenused.epa.ee/>

Free of charge consultations

From Monday to Friday 09.00–13.00
Phone +372 627 7937
e-mail: kaubamark@epa.ee

Consultation in the Office on Thursday 14.30–16.30
NB! Book your time for consultation in the Office
by phone +372 627 7937
or by e-mail: kaubamark@epa.ee



EUIPO

European Union Intellectual Property Office

Avenida de Europa 4
E-03008 Alicante, SPAIN

Free of charge consultations

e-post: information@euipo.europa.eu
Phone +34 96 513 9100
Fax +34 96 513 1344

TRADE MARK



How to protect
a trade mark

What is a trade mark?

A **trade mark** is a sign by which a consumer distinguishes the goods or services of one person from the goods or services of other persons. A trade mark may consist of a single word, a combination of words, phrases, figurative elements, combinations of letters and numerals, three-dimensional signs, combinations of the above etc.

Registration of a trade mark **does not provide protection** to the content of the goods or services, the way the goods are produced or services are rendered, the ingredients of products etc.

Which signs cannot be registered as trade marks?

The following signs **cannot** be registered as trade marks:

- signs which **describe** the characteristics of the goods or services;
- signs which have become **customary** in the particular field of activity;
- signs which are of such nature as to **mislead** the consumer;
- **genuine and ordinary** images of products or packages;
- signs which are contrary to **public order or accepted principles of morality**;
- signs which are **devoid of any distinctive character**.

What are the goods and services?

The scope of legal protection of a trade mark does not cover all the areas of activity, it depends on the **goods and services** listed in the registration application. The goods and services are divided into 45 classes based on the international Nice Classification. According to this the goods and services have to be classified in the application. The application fee depends on the number of classes listed in the application.

Does a trade mark have to be registered?

Registering a trade mark **is not an obligation**, it is a right. The owner of a registered trade mark has the right to prohibit other persons from using the trade mark and a sign similar to it for designating certain goods and services in the country or territory where the trade mark is protected. User of an unregistered trade mark does not have such right. However, an unregistered mark may be used if the earlier rights of the other person are not violated. If the term of legal protection is renewed, the rights of a trade mark owner can be valid for an unlimited period of time. A trade mark may be sold, licensed, pledged and bequeathed like any other asset.

How to protect a trade mark in Estonia?

In order to obtain legal protection in Estonia, an applicant has to file an application for the registration of a trade mark with the **Estonian Patent Office** and pay the state fees. Any natural or legal person may file a trade mark application, the state fees are the same. The application can be submitted electronically through the website of the Patent Office www.epa.ee, sent by post or brought to the Patent Office (the mailbox is open around the clock). If a trade mark passes the examination and period of appeal with a positive result, a registration fee has to be paid and the trade mark owner will receive a trade mark certificate. Legal protection will enter into force retroactively from the date of submitting the application with the Patent Office.



owner of a trade-
mark EAS



owner of a trademark
AS BESTNET



owner
of a trademark
Alis Co Estonia OÜ

How to protect a trade mark abroad?

There are three options.

1. Submitting an application for registration of a trade mark with the **trade mark office of a relevant country**. In case of registration, the trade mark will be protected on the territory of the relevant country or union of countries.

2. Applying for a **European Union trade mark** (EUTM) by filing an application with the European Union Intellectual Property Office (EUIPO). The application may be filed either electronically through the website of EUIPO (<https://euipo.europa.eu/ohimportal/en>) or on paper. It is advisable to use electronic application as it is cheaper and more convenient. In case of registration, legal protection will be valid throughout the entire European Union and it will extend to the new member states. Unitary protection of the EUTM throughout the EU means that if the ground for refusal of the trade mark becomes apparent in any member state, the trade mark will not be registered. In that case, the EUTM application can be converted into a national application in those countries where the grounds for refusal do not apply.

3. Applying for an **international trade mark** on the basis of the Madrid Protocol by filing an application with the World Intellectual Property Organization (WIPO) (www.wipo.int) via the Estonian Patent Office or EUIPO. In order to do that it is necessary to have an application or a registration of the same trade mark in the Estonian Patent Office or EUIPO. In case of registration, legal protection will be valid in the countries chosen by the applicant where the grounds for refusal do not apply. If needed, the scope of legal protection of a trade mark can later be expanded by applying for protection in new countries on the basis of the same registration.

What to do before filing an application?

A trade mark filed for registration should not be contradictory to **earlier rights** (earlier trade marks, business names, objects of copyright etc.). There-