

NEWSLETTER

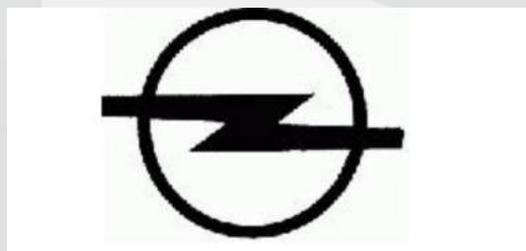
No. 20, December 2016

Decisions of the Estonian Industrial Property Board of Appeal

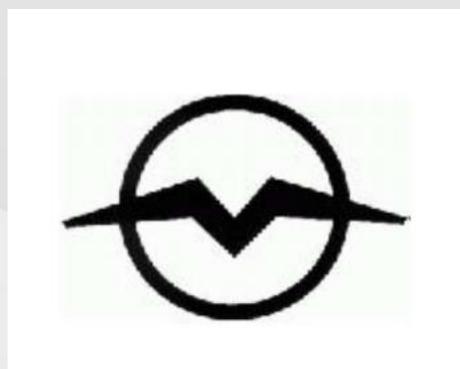
I Oppositions

- **Decision No. 1659-0**

Earlier trademarks



Opposed trademark





Wir leben Autos.

The goods and services covered by the opposed trademarks are identical or similar and there is a likelihood of confusion between the marks.

The Board agreed that the goods and services in classes 12, 16 and 25 covered by the opposed trademarks are identical or similar and the marks are similar enough, based on an overall impression, for there to be a likelihood of confusion for the consumer. The Board also found that there could be exploitation of and harm to the earlier mark's reputation and distinctive character. The Board further agreed that the reputation of the earlier trademarks is well-established. The Board took the view that the registration of the opposed trademark would present a risk of exploitation of and harm to the earlier trademarks reputation and distinctive character.

The opposition was sustained.

• Decision No. 1596-0

Earlier trademarks

CELESTINS VICHY ETAT

VICHY
Célestins

Opposed trademark

VICHY
Fresh

The opposed trademark is sufficiently distinctive.

The Opponent had brought three earlier trademarks, with the element VICHY, as examples; incidentally the elements “VICHY” and “VICHY ETAT” do not fall under the scope of protection. The Board found that the opposed trademarks with the element VICHY have co-existed in Estonia since 1995. The Applicant’s variety of bottled waters, marked with the element VICHY or Fresh or both elements together, are well-known in Estonia. Saku Õlletehas (the Applicant manufacturer) is well-known in Estonia. There is very little likelihood of confusion for the Estonian consumer. The Board agreed that the element VICHY on its own does not warrant protection and is available for use to the general public.

The opposition was not sustained.

• Decision No. 1604-0

The Opponent's trademark



Opposed trademark



The reputation of the trade mark as the Opponent's trade mark is not established; The Opponent does not own proprietary rights of the earlier mark.

The Opponent did not present any evidence to the Board, i.e. proof of employment or any other contract, concerning the ownership of the intellectual property rights of the name/logo Check-In. What is more, the Board did not consider the claims that the creation of the name was a result of a brainstorm between the Opponent's employee and the Applicant. The Board added that, even if this claim were true, it would not diminish the Applicant's rights to the mark since, based on the evidence presented, the Applicant had not relinquished any rights to the Opponent, nor had such rights transferred to the Opponent based on law.

Based on the evidence presented by the Opponent, the name Marko Söönurm (Applicant), the name Sky Plus and the visual elements of the mark presented for registration have been used together on all advertisements at least until the year 2014. Even though the Opponent claimed that they, not Marko Söönurm, had the right to use the verbal element Check-In, the Board did not agree.

The Opponent did not prove bad faith on behalf of the Applicant. The fact alone that the Applicant was a DJ and a co-author of the programs, his name has been in adverts, etc., did not give rise to bad faith. The Opponent has confirmed that the Applicant designed the visual elements of the opposed mark; such a visual element can give rise to copyright. The submission of an application for registration of the trademark can be considered one of the ways of protecting the copyright of the Applicant.

The Board took the view that the reputation of the mark had not been proven. The fact that the programme has been presented on the radio channel Sky Plus alone does not mean the mark is well-known. The Board also noted that even if the mark was well-known, this reputation would be attached to the Applicant's trademark, not to the Opponent's mark.

The opposition was not sustained.

• Decision No. 1651-0

Earlier trademarks

Opposed trademark

RV reg. nr. 0782228

FERRE'

RV reg. nr. 1043677

GF FERRE'

CTM nr. 000270223

GIANFRANCO
FERRE

Ferrede

Trademarks are identical and there is a likelihood of confusion.

The dominant element of the earlier trademarks is the word FERRE. The opposed mark differentiates from the earlier marks by the additional element -de; the dominant element of the earlier marks is fully present in the opposed mark, making part of the marks identical. The Board, therefore, found that the opposed marks are visually similar enough for there to be a likelihood of confusion and for the consumer to believe they might come from the same company.

The Board noted that even though the earlier marks have the element “” added to the end, the average Estonian consumer does not understand the meaning of that element, and therefore does not affect the pronunciation of the marks in comparison with the opposed mark. The Board concluded the marks were phonetically similar enough for there to be a likelihood of confusion. Conceptually, the opposed marks are composed of artificial words with no meaning, therefore it is not possible to distinguish between them conceptually.

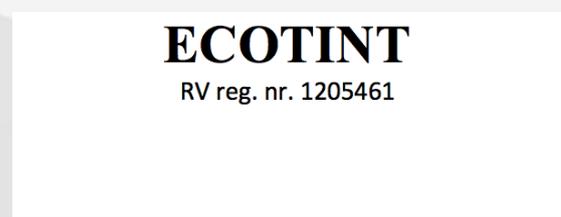
The opposition was sustained.

• Decision No. 1612-0

Earlier trademarks



Opposed trademark



The opposed trademark is not conceptually distinctive from the earlier trademarks and there is a likelihood of confusion.

The Board agreed that the opposed trademark is visually and phonetically similar to the earlier trademark. The earlier trademark differs from the opposed trademark only based on the design element “Tint” and the capital letter “D”. The Board agreed that the opposed trademark ECOTINT does not have a meaning for the average Estonian consumer. The opposed trademark is also not conceptually different from the earlier marks. The overlapping element “tint” in both marks means liquid ink used for writing in Estonian.

The Board agreed that the applicant had applied for protection of the mark for identical goods as the earlier marks. The opposed marks are visually, phonetically and semantically so similar that there is therefore a likelihood of confusion.

The opposition was sustained.

II Decisions of the Domain Disputes Committee

- **Case No.16-1a-309**

Opposed domain name: nike.ee

The Committee decided to transfer the domain name nike.ee to the Opponent.

The Opponent found that the domain name nike.ee is identical to the Opponent's trademark, the Registrar did not have a right or justified interest to the domain name at hand and it was registered in bad faith.

The Board agreed with the Opponent that the domain name is identical with the Opponent's earlier trademarks. The Registrar did not prove justified interest to the domain. The Registrar is not known by the domain name; the domain is not used for legal economic activity, nor is it used for non-profit purposes. The individuals entering the website www.nike.ee are redirected to www.sportsdirect.com, where goods with trademarks other than "NIKE" are also being sold. The Registrar does not have a license to use the trademark "NIKE" and does not have a legal connection with the Opponent that would give rise to the right to use the mark.

The opposition was sustained.

County and Circuit Courts

Tallinn Circuit Court

- **Civil Case No. 2-16-7455**

Civil Action for the termination of the infringement of the exclusive right of the owner of a European Union trademark, domain handover and damages. The judgment in default proceedings.

The Circuit Court agreed with the first claim of the Respondent stating that, in the case at hand, it was not necessary to present a compelling reason in order to present an application to restore the application procedure. It was not evident from the file that the writ could be considered to have been delivered to the Respondent or the Respondent's representative. Since only an individual, who was not the legal or contractual representative of the Respondent, received the application materials via post, the writ had not been delivered to the Respondent personally in exchange for a signature. Therefore, the Respondent was allowed to submit the application regardless of the existence of a compelling reason.

As a response to the second claim, the Circuit Court noted that the County Court unduly associated the rejection of the application with the alleged procedural rights abuse of the Respondent. The Circuit Court drew attention to the fact that in a ruling to reject an application, the County Court should have included descriptions of the facts of the case decided in absentia and present the reasoning behind the decision rendered in absentia. Upon restoration of the application, the decision rendered in absentia will not come into force and the proceedings will continue according to the application to restore the application procedure. It is no longer necessary to address the Respondent's application to stop the enforcement proceedings.

The Court concluded that the application is founded and the decision of the County Court should be annulled.



Patent Agency

The material provided in this newsletter is for informational purpose only and does not contain legal advice. For additional information please contact our patent agency:

Patendibüroo TURVAJA OÜ

Liivalaia 22

Tallinn 10118

Estonia

turvaja@turvaja.ee

Phone: +372 6 403 109

Fax: +372 6 403 105

© Patendibüroo TURVAJA OÜ, 2016