

NEWSLETTER

No. 22, June 2017

Decisions of the Estonian Industrial Property Board of Appeal

I Oppositions

- Decision No. 1559-0

Earlier trademarks



Opposed trademark



The opposed trademark is not confusingly similar to or associated with the earlier trademark.

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The opposed trademarks are not visually, phonetically or semantically identical or similar. The Board took the view that the verbal elements JET and GAS should not be considered separately and that similarity cannot be based on simply the element JET. The consumer views element “jetgas” as a whole. The average Estonian consumer may be somewhat used to advertisements and elements of trademarks being presented in English; however, they would not confuse the commercial origin of the opposed trademarks in terms of the services under classes 35 and 39.

The opposition was dismissed.

• Decision No. 1627-0

Earlier trademark

HUMER

Opposed trademark

HUMAAR

The opposed trademark is not confusingly similar to or associated with the earlier trademark.

Considering the different length of the trademarks, the fact that the opposed trademark has several dominant differences apparent to consumers and that the similarities in the first parts of the marks are not considerable as a whole, the Board took the view that the marks are visually more different than similar.

The Board agreed that for the relevant Estonian consumer, both marks have no meaning; thus, the described associations are unlikely to arise and have not been proven to exist. The level of French of the relevant Estonian consumer is not at a sufficient level to presume the knowledge of a wide scale of French vocabulary.

The phonetic comparison of the opposed marks shows that the opposed trademark contains letters that do not appear in the earlier trademark, and these are apparent in pronunciation.

Since the differences in the opposed marks are sufficiently clear and apparent to the consumers, the partial identicalness and overlap in classes of goods is not relevant.

The opposition was dismissed.

• Decision No. 1360-0

Opposed trademark

Trahter Bogdan

T The owner of the opposed mark withdrew from further dispute.

The earlier right to the mark has to belong to the contesting party in order to consider it as a basis for revocation. The Board noted that the contesting party has been erased from the registry and, thus, cannot be the subject to the rights relating to the mark. Even if the legal existence of the contesting party continued, they would not own the earlier rights, as the mark “Trahter Bogdan” has been taken into use by a third party in 2007 and has thereafter been used by various individuals, including the Opponent themselves.

The arguments relating to bad faith are related to the past, namely the circumstances of the submission of application, and are not related to the future, where the owner of the opposed trademark’s exclusive right could affect the Opponent as an interested party. Thus, the Board reviewed the arguments relating to bad faith despite the Opponent not any longer being party to the proceedings. According to the Board, bad faith can be proven solely based on the fact that the Applicant did not withdraw their application, despite being fully aware of the fact that several other individuals had compelling interest and rights in relation to the opposed mark.

The Applicant did not respond to the reply to the statement of intent, expressing – according to the Board – the will to withdraw from participation in further dispute.

The opposition was sustained.

• Decision No. 1500-0

Earlier trademarks

Opposed trademark

CHILL OUT

CHILLER

CHILL OUT + shape

The opposed trademark is confusingly similar and can be associated with the Opponent's trademarks.

The opposed marks overlap visually in terms of 5 letters at the start of the marks. This is the dominant part in both marks, being the most memorable for the consumer. The consumer will not necessarily see the two marks next to each other and they will likely rely on their incomplete memories of the marks. The opposed trademarks overlap phonetically in relation to the four letters, the only difference being in the sound of pronunciation of the end of the word.

In comparing the opposed marks conceptually, one must bear in mind the Estonian consumer's comprehension as to the meaning of the marks. The Board agrees with the Opponent: the word "chill" should be viewed not in relation to a potential direct translation but rather in relation to general context and use.

Since the marks are visually, phonetically and conceptually similar and are used to signify identical goods, confusion and association of the marks by the consumer can be considered likely.

The opposition was sustained.

• Decision No. 1507-0

Earlier trademark

Opposed trademark

REVLON

REVONE

The opposed trademark is confusingly similar and can be associated with the Opponent's trademark.

The opposed marks have no meaning, thus the conceptual aspect does not affect the analysis of the similarity of the two marks.

Phonetically, the opposed marks are very similar. It is likely that due to the Estonian rules of pronunciation, the Estonian consumer will place the emphasis on the first syllable REV, identical in both marks.

The marks are also visually very similar. The Opponent's trademark and the opposed trademark are both composed of 6 letters, are written using the same font and have the same length visually. Even though the opposed trademark contains a design aspect, this is only a very small element – a fuchsia-coloured rectangle –, which will not be very memorable for the consumer.

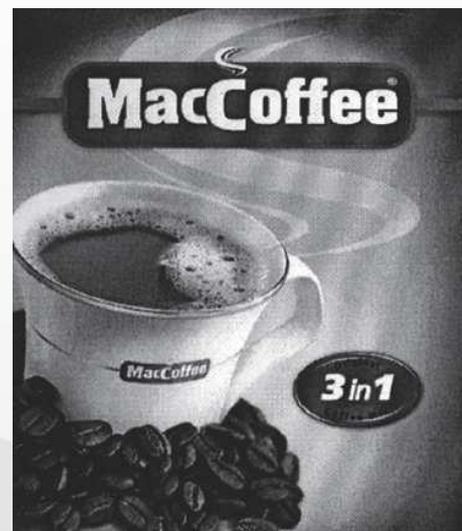
The opposition was sustained.

• Decision No. 1448-0

Earlier trademark

McCAFE

Opposed trademark



The opposed trademark is not confusingly similar and cannot be associated with the Opponent's trademark.

According to the Board, it is clear that the mark MacCoffee 3 in 1 + kuju should be viewed as a trademark as a whole. The combination 3 in 1 and the visual elements hold significant weight in distinguishing the opposed mark from the earlier mark. Thus, in the view of the Board the opposed mark as a whole is distinct from the earlier mark.

The Board found that there was no visual similarity between the two marks. The opposed mark is longer, has more distinct elements, has used a specific font and the use of double letters is apparent. These differences are also phonetically obvious.

The two marks are both related to coffee; however, the Board finds that conceptually their meanings are different. The earlier mark refers to a café, whereas the opposed mark directly refers to instant coffee powder used to make coffee, and the marketing of the product. The distinctiveness of the marks is further emphasised by the fact that the services and goods falling under the protection of the marks are different and their distribution channels vary.

The opposition was dismissed.

II Appeals

- **Decision No. 1679-0**

Appeal against the decision to refuse to register the trademark VIRU VALGE HÕBE.

The Patent Office refused to register the trademark VIRU VALGE HÕBE with regards to goods under class 33 (alcoholic drinks, except beer).

The Board found that the Opponent had presented enough evidence to prove the reputation of their earlier registered trademark. The Board came to the conclusion that adding an additional element to a well-known and distinct mark – even if the former is descriptive – does not make the mark as a whole descriptive and indistinctive.

The fact that the Estonian Dictionary under the word VALGE (white) gives a long explanation, and includes the pair of words “valge viin” (white vodka) does not provide for the presumption that the consumer considers the word “valge” (white) as a reference to vodka. The descriptive character of the word has to be clear and evidently perceptible; the word VALGE (white) does not correspond to this requirement. Considering the word HÕBE (silver) to be descriptive would require the consumer to be aware of the specifics of the filtration process of various alcoholic beverages, the likelihood of which is also questionable.

The appeal was sustained.

• Decision No. 1650-0

Appeal against the decision to refuse to register the trademark BROADLINE.

The Patent Office refused to register the trademark BROADLINE with regards to the following goods under class 5:

Preparation for broad spectrum parasite treatment for cats.

The Board agreed with the Patent Office insofar as considering words “broad” and “line” to not be very special of specific, and agreed that their basic meanings would be known to the Estonian consumer who speaks English above an average level.

At the same time, it is not evident that the words “line” or “broadline” normally translate into “product line” or “large product line”. The Board found that the two words are not widely spread in dictionaries available in Estonia and are fairly uncommon.

Considering the fact that the trademark is composed of the combination of two foreign words uncommon in Estonia and unusual for the Estonian consumer, it cannot be excluded that the consumer will view the mark as one word. In a situation where the relevant Estonian public does not grasp the meaning of “broadline” as defined by the Patent Office, the mark BROADLINE can be considered at least minimally distinctive and capable to act as a trademark.

The appeal was sustained.

Supreme Court

- **Case No. 3-2-1-168-16**

The application of Canon Kabushiki Kaisha for the restoration of the Estonian registration rights in relation to the European patent

The claimant is the owner of the European patent. Since the claimant failed to pay the annual state fee, they filed an application for a patent validity restoration. The Patent Office dismissed the application and did not restore the validity of the patent.

The petitioner and the courts disagree in front of which entity the decision can be challenged.

The County Court found, based on analogy, that the decision of the Patent Office should be contested in front of the Industrial Property Board of Appeal. In contrast, the Circuit Court concluded that the Patent Office's decision can be appealed before the Administrative Court. The Supreme Court agrees with the conclusion that the claimant can challenge the decision of the Patent Office in front of the Industrial Property Board of Appeal and then, if necessary, appeal the decision to the county court.

The courts have rightly refused the appeal. County Court rightly held that the court could not admit the application, since the applicant has not complied with the mandatory legal procedure of prior out-of-court settlement.

The appeal is to be dismissed and the decision of the Circuit Court unchanged, but alterations should be made to the reasoning.

- **Case No. 3-2-1-7-17**

The application of ZeroGroup Holding Ltd brought against Lenovo Technology BV for the termination of the violation of the trademark owner's exclusive right and for 10,000 EUR as compensation

The Court finds that the lower courts unjustifiably rejected the application in relation to the rights stemming from the Estonian trademark on the basis of lack of jurisdiction. Therefore, the County and Circuit Court decisions should be annulled and the case sent back to Harju County Court to be assessed for processing.

The Court notes that the request for a preliminary ruling from the European Court of Justice is not justified. The ECJ has submitted views in sufficiently similar disputes, which are also applicable in this case.

The Court found that the lower courts have in essence failed to hear the case in relation to the Estonian trademark due to the lack of legal outlook. However, the dismissal has not been adequately justified.

The Court finds that the lower courts had rightly refused the claim in relation to Community trademark rights violations. The Estonian courts would have jurisdiction in this respect if the defendant were alleged to have committed an act in violation of the claimant's rights in Estonia.

The Court finds that the lower courts had not infringed the applicant's procedural rights in refusing to set a date for the submission of an application for the initiation of the pre-trial taking of evidence, as per the request of the claimant. Since the initiation of the pre-trial taking of evidence is not limited to a particular timeline, there was no need for the County Court to grant the applicant an additional deadline.

The appeal was partially sustained.

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:

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