

NEWSLETTER

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Decisions of the Estonian Industrial Property Board of Appeal

I Oppositions

• Decision No. 1629-0

Earlier trademarks

SIDERAL

SIDERAL Liposomial Iron
SIDERAL Ferro Liposomiale

Opposed trademark

VIDERAL

First, the Board compared the symbols SIDERAL and VIDERAL.

The Board found that the opposing mark SIDERAL and the applicant's trade mark VIDERAL, were visually and phonetically similar to the extent that they could be confused, but the protected goods were not identical or similar, and thus there is no conflict between the marks in question.

Both marks are single-length words consisting of 7 letters and their only difference is the first letter. The one-letter difference is not sufficient to achieve a different overall impression, and the signs are therefore visually similar. Phonetically, the only difference is the first letter. The Board considers that the aforementioned difference is not sufficient and that the overall phonetical impression and sound is similar enough to create confusion. The marks are not semantically comparable because they do not have a known meaning in Estonian. The protected goods are not identical or similar.

Subsequently, the Board compared the symbols SIDERAL Liposomal Iron, SIDERAL Ferro Liposomiale and VIDERAL and **found that although the goods protected were identical and of the similar kind with the goods applied by the applicant under the sign VIDERAL, the signs were not themselves, identical or similar to the extent that they would be confused, and therefore there is no conflict here.**

Upon visual comparison, the significantly different length of the marks is evident. Although the Opponent has declared that SIDERAL is the dominant element of his mark, the Board disagrees with it and considers that the signs are visually different. The phonetic comparison reveals a significant difference in the length of the signs and in the number of syllables. From the semantic point of view, the words "Iron" and "Ferro" raise interest. Most of the consumers understand the meaning of the words as "iron" in Estonian ("raud"). As the other words of the marks lack meaning in Estonian, it can be regarded as an important semantic difference. Whilst the goods protected by the marks are identical, the marks themselves are not identical or similar to the extent that they can be confused.

The opposition was dismissed.

• Decision No. 1647-0

Earlier trademarks

Opposed trademark

PIK-NIK



The opposed trademark is not confusingly similar to the earlier trademark.

The Board considers that the marks are not identical and clearly differ in terms of the different content, length and placement of the word elements 'Pik-Nik' and „HIIRTE JUUSTU PIKNIKUPULGAD cheese strings estover PIIMATÖÖSTUS“ in the marks, creating a completely different overall visual impression of the opposed marks. The design elements are also completely different in the marks.

In comparing the word elements, the Board found that Pik-Nik is an artificial word that does not have a direct meaning in Estonian. The overlapping letters P, I, K, N, I exist also in the element “PIKNIKUPULGAD“, but they form the word "PIKNIK" (picnic) in Estonian.

Similarly, the pronunciation of the words "Pik-Nik" and "PIKNIKUPULGAD" is entirely different, without taking into account the pronunciation of the whole word element of the Applicant's trademark.

The opposition was dismissed.

• Decision No. 1637-0

Earlier trademarks

Opposed trademark

CHAMPION



CHAMPION



CHAMPION®

CHEMPIOIL

The opposed trademarks are confusingly similar.

The Board considers that the word mark CHEMPIOIL is visually similar to the earlier CHAMPION marks. The Board agrees with the Opponent that both marks begin with the letters CH-, followed by the vowels A/E, and -MPIO. The elements CHAMPIO-/CHEMPIO- are visually very similar and easily memorable to the consumer.

Semantically, the marks have no meaning in Estonian. At the same time, it is very likely that the Estonian consumer will associate the word "CHAMPION" with the Estonian word "tšempion". The Opponent considers that the applicant's trademark CHEMPIOIL refers to the concept CHAMPION OIL, the Estonian equivalent of which is "champion oil" (tšempion-õli).

The Board notes that, even in the light of the meaning given by the Applicant associating CHEM with chemistry and ending with OIL with oil, the meaning of the element "PI" is unclear. Although this element is not in the focal point of the mark, it changes pronunciation and increases visual similarity between the opposed marks. Alternatively, if the meaning given by the applicant were to not be taken into account, the opposed mark would be considered imitative of the earlier mark.

The opposition was sustained.

• Decision No. 1646-o

Earlier trademark

Opposed trademark

KORA

EKORA

The opposed trademark is not confusingly similar to the earlier trademark.

From the visual point of view, the only difference between the opposed marks is the letter "E" in the beginning of the Applicant's mark, which is clearly visible to the consumer but not sufficient to make the signs visually distinct as a whole. Phonetically, the vowel "E" is evident in pronunciation; it changes the length of the word and, as a result, affects the pronunciation of the whole word. The marks are, thus, phonetically different.

According to the Board, the word EKORA refers to decor and decoration, which is generally known to the average Estonian consumer. In addition, the beginning of the trademark "EKO" can be perceived as close to the Estonian word ÖKO ("eco").

The Applicant claims that KORA is the name of an ancient African folk music sculpture, also called the African harp. Considering the difference in cultural space, the Board does not share the conviction that the average Estonian consumer would be well aware of ancient African folk music instruments. Consequently, the element KORA carries no meaning for the public.

Goods covered by the trademarks overlap partially, some are partially similar, and some rather different. The relevant public is made up of end users, painters, and those working with paint, being are well-informed and attentive. Consequently, the Board found that, despite the similarities between the signs, there are sufficient differences between the trademarks, which will not go unnoticed by the average consumer and relevant expert.

The opposition was dismissed.

• Decision No. 1680-0

Earlier trademarks

ERA



Opposed trademark



The opposed trademark is not confusingly similar to the earlier trademark.

The dominant combinations of letters and symbols of the trademark are composed of three non-overlapping symbols, with the exception of the first letter E. The symbol used in the opposed mark is a combination of the letter 'E', and the Old Slavic alphabet symbol 'Э', which is in the centre of the square-shaped red coloured element. The Board found that the difference in the combination of symbols and in their placement produced a different overall visual impression upon the visual comparison of those marks.

The verbal element of the earlier marks is to be pronounced as an ERA, which carries meaning in Estonian, in contrast to the applicant's trademark, which the Opponent considers to be read as ERE, in disagreement with the Board. The Board concludes that the pronunciation of the opposed marks is not necessarily similar.

Even when the verbal element in the opposed mark is pronounced as 'ERE', it would carry a different meaning than the word 'ERA' in Estonian. Thus, the semantics of the opposed marks is different in all cases.

The Board also considers that the Estonian consumer is sufficiently aware, attentive and well informed in order not to get confused about a potential commercial or economic connection between the Opponent and the Applicant.

The opposition was dismissed.

II Appeals

• Decision No. 1686-o

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

The Patent Office refused to register the trademark JUSTFAB with regards to goods under classes 14, 18, 25 and 35.

The Board considers that, although the consumer is likely to understand the meaning of the word "fab" used in the slang, the fact that the word "just" is used in Estonian cannot be ignored. JUSTFAB is an artificial word; its meaning may be unambiguous to the average consumer, which can make the understanding of the word more complex and unclear.

The Board considers that if a mark consisting of English words in Estonia is under observation and the same mark has received legal protection in an English-speaking country, there is reason to doubt whether the conclusions on the distinctive inefficiency and descriptiveness of the sign in question are still justified. In this case, the Patent Office has failed to explain the linguistic, cultural, social or economic differences which make the trademark distinctive for native English speakers, but do not do so for Estonians.

The appeal was sustained.

Decisions of the Domain Disputes Committee

- **Case No. 17-1a-312**

Opposed domain name: kerstikaljulaid.ee

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

The Opponent found that the domain name kerstikaljulaid.ee is identical to the Opponent's name. The element ".ee" and the compilation of the first and last names are not important in determining identicalness. The Registrar had no right or legitimate interest for the domain.

The basis for sustaining the application was the registration or use of the domain name in bad faith. In the Board's view, the Registrar had a desire to make a profit from the sale of the domain name in question, based on bidding and correspondence. This is confirmed by the fact that the registration of the domain took place immediately after the election of the Kersti Kaljulaid as president.

The opposition was 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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