



Study Question

Submission date: April 17, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General
Registrability of 3D trademarks

Responsible Reporter(s): Anne Marie VERSCHUUR

| | |
|-------------------------|-------------------|
| National/Regional Group | Estonia |
| Contributors name(s) | Viive KAUR |
| e-Mail contact | kauler@turvaja.ee |

I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

1 Are 3D Shapes* registrable as a trademark? Please answer YES or NO.

If you have answered NO, please skip Questions 2 to 9 and proceed to Question 10.

**This Study Question focuses on signs consisting of 3D shapes comprising solely the three-dimensional shape of goods or packaging without any addition (3D Shapes). (see further para. 12 of the Study Guidelines).*

Yes

(Explanation is Optional)

2 Can a 3D Shape be inherently distinctive? If YES, what test is applied in order to establish if it is inherently distinctive?

Yes

What test is applied in order to establish if it is inherently distinctive?

There is no specific test stipulated in Estonian laws in order to establish inherent distinctiveness. The Estonian Patent Office shall examine in expert analysis whether the 3D Shape is inherently distinctive.

3 Can a 3D Shape acquire distinctiveness? If YES, what test is applied in order to establish if it has acquired distinctiveness?

Yes

What test is applied in order to establish if it has acquired distinctiveness?

There is no specific test stipulated in Estonian laws in order to establish acquired distinctiveness. If any disputes arise from this, it will be assessed and resolved in the Estonian Industrial Property Board of Appeal or in court. The Estonian Patent Office shall examine in expert analysis if the 3D Shape has acquired distinctiveness.

4 Will a 3D Shape be refused registration, or is a 3D Trademark* liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test is applied.

**3D Shapes registered as trademarks (see also para. 14 of the Study Guidelines)*

Yes

Please describe what test is applied.

Pursuant to Estonian law, legal protection is not granted to signs which consist exclusively of the shape which results from the nature of the goods. The Estonian Patent Office shall examine in expert analysis whether the shape, or another characteristic results in from the nature of the goods themselves.

5 Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test is applied.

Yes

Please describe what test is applied.

Pursuant to Estonian law, legal protection is not granted to signs which consist exclusively of the shape which is necessary to obtain a technical result. The Estonian Patent Office shall examine in expert analysis whether the shape is necessary to obtain a technical result.

6 Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test is applied.

Yes

Please describe what test is applied.

Pursuant to Estonian law legal protection is not granted to signs which consist exclusively of the shape which gives substantial value to the goods. The Estonian Patent Office shall examine in expert analysis whether the shape gives substantial value to the goods.

7 Is there any other ground of absolute refusal or invalidity specific to 3D Shapes or 3D Trademarks available under your Group's current law?

No

(Explanation is Optional)

All the absolute grounds that preclude legal protection of signs stipulated in Estonian Trade Marks Act applies to 3D Shapes and 3D Trademarks. There are no specific grounds of absolute refusal or invalidity regarding 3D Shapers or 3D Trademarks.

If you have answered NO to each of Questions 4, 5, 6 and 7 proceed to Question 10.

If you have answered YES to any one of Questions 4, 5, 6, or 7, please answer Questions 8 and 9 in

relation to the relevant refusal / invalidity ground(s).

8 Do the refusal / invalidity grounds referred to in Questions 4, 5, 6 and/or 7, to the extent available in your Group's jurisdiction, operate independently from one another or may they also apply in combination? For example, do they apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

The refusal grounds referred to in answers to the Questions 4, 5, 6, and 7 can be applied in combination, but even if one of them is applicable, it is enough to refuse from giving legal protection to the sign.

9 Which, if any, of the refusal / invalidity grounds referred to in Questions 4, 5, 6 and 7, to the extent available in your Group's jurisdiction, can be overcome by acquired distinctiveness?

Each the refusal / invalidity ground can be overcome by acquired distinctiveness.

II. Policy considerations and proposals for improvements of your current law

10 Could any of the following aspects of your Group's current law be improved? If YES, please explain.

10.a Registrability (or lack thereof) of 3D Shapes

No

(Explanation is Optional)

3D Shapes can be registered under Estonian laws.

10.b The test applied, if any, in relation to the registrability (based on inherent and/or acquired distinctiveness) referred to in Question 10(a)

No

(Explanation is Optional)

Currently, there is no specific tests stipulated in Estonian laws in order to assess whether the criteria to give legal protection to submitted trade mark is fulfilled. Pursuant to Estonian law the Estonian Patent Office examines in expert analysis whether the submitted trade mark is eligible for protection. We are of opinion that stipulating a specific test is not necessary.

10.c The refusal / invalidity grounds, if any, referred to in Questions 4 to 7 (and potential combination thereof)

No

(Explanation is Optional)

10.d The possibility or lack thereof to overcome these refusal / invalidity grounds by acquired distinctiveness.

No

(Explanation is Optional)

11 Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

No

(Explanation is Optional)

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

12 Does your Group consider that harmonisation in any or all areas described in the response to Question 10 or 11 above is desirable? Please answer YES or NO.

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

13 Does your Group consider that 3D Shapes should be registrable as a trademark? Please answer YES or NO.

14 Should it be possible for a 3D Shape to be inherently distinctive? If YES, what test should be applied in order to establish if it is inherently distinctive?

15 Should it be possible for a 3D Shape to acquire distinctiveness? If YES, what test should be applied in order to establish if it has acquired distinctiveness?

16 Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test should be applied.

17 Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test should be applied.

18 Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test should be applied.

19 Should there be any other absolute refusal or invalidity ground specific to 3D Shapes or 3D Trademarks? If YES, please explain briefly.

If you have answered NO to each of Questions 16, 17, 18 and 19, please skip Questions 20 and 21 and proceed to Question 22.

If you have answered YES to any one of Questions 16, 17, 18 or 19, please answer Questions 20 and 21 in relation to the relevant refusal / invalidity ground(s).

20 Should the refusal / invalidity grounds referred to in Questions 16, 17, 18 and/or 19 operate independently from one another or should it also be possible to apply them in combination? For example, should they also apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

21 Which, if any, of the refusal / invalidity grounds referred to in Questions 16, 17, 18 and 19 should (and thus may) be overcome by acquired distinctiveness?

22 Please comment on any additional issues concerning the registrability of 3D Trademarks and the refusal / invalidity grounds mentioned above that are within the scope of this Study Question (as described in paragraphs 11 to 13 of the Study Guidelines), and that you consider relevant to this Study Question

23 Please indicate which industry sector views are included in your Group's answers to Part III.