

National Group: ESTONIA

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Packaging Questionnaire

Questions

Please answer the following questions. For each of questions 1) – 10) below, please answer in relation to your country's national laws including any constitutional law.

1) If the general conditions of registrability are met, does the product or service in relation to which a trade mark is used or proposed to be used have any affect on the ability to:

- (a) register the trademark; and**
- (b) use it once so registered?**

- There is nothing explicitly said neither in Estonian legislation nor in the Constitution about whether or how the particular product or service would affect the ability to register particular trademark. The principle comes to Estonian legislation from article 7 of the Paris Convention and from article 15(4) TRIPS, which provide that the nature of the goods or services to which a trademark is to be applied “shall in no case form an obstacle to the registration of the trademark”.

2) What rights are derived from trademark registration?

- The proprietor of a trade mark has the right to prohibit third parties from using in the course of trade:
 - o any sign which is identical with the trade mark which is granted legal protection in relation to goods or services which are identical with those for which the trade mark is protected;
 - o any sign which is identical with or similar to the trade mark which is granted legal protection in relation to goods or services which are identical with or

similar to those for which the trade mark is protected if there is the likelihood of confusion on the part of the consumers, including the likelihood of association between the sign and the trade mark which is granted legal protection;

- any sign which is identical with, or similar to a registered trade mark or a trade mark which is known to the majority of the Estonian population and which is granted legal protection, where such sign is used to designate goods or services which are not similar to those for which the trade mark is registered, if use of that sign might take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark.

Among others following acts are prohibited:

- affixing the sign to goods or to the packaging thereof;
- offering goods for sale, distributing or storing them for the purposes of sale under the sign;
- offering or supplying services under the sign;
- importing or exporting the goods under the sign;
- using the sign on business papers, in advertising or instruction manuals for the goods.

A trade mark may be transferred in relation to all or some of the goods or services.

A trade mark transfers to the legal successor of the proprietor of the trade mark.

The proprietor of a trade mark may surrender a trade mark with regard to all or some of the goods and services.

The proprietor of a trade mark may divide the registration into two or more registrations and distribute the goods and services among these registrations.

The proprietor of a trade mark may conclude a licence agreement with a licensee. A licensee may transfer the rights acquired from the proprietor of a trade mark by way of a licence to third persons only with the permission of the proprietor of the trade mark.

A trade mark may be the object of compulsory execution separately from an enterprise.

A registered trade mark may be encumbered with a pledge in such manner that the person for whose benefit the pledge is established (hereinafter pledgee) has the right to satisfaction of the claim secured by the pledge out of the pledged trade mark.

During one year prior to expiry of the term of legal protection of a trade mark, the proprietor of the trade mark may request the renewal of the term.

The proprietor of a trade mark may file an action against a person infringing the exclusive right, including a licensee who violated the terms of the licence agreement:

- for termination of the offence;

- for compensation for patrimonial damage caused intentionally or due to negligence, including loss of profit and moral damage.

If the proprietor of a trade mark files an action for the protection of an exclusive right, the proprietor may request the destruction of unlawfully designated goods and objects solely or almost solely used or intended to commit the offence which are in the ownership or possession of the offender if it is not possible or expedient to eliminate the unlawful nature of the goods or objects in another manner.

If the proprietor of a trade mark has filed an action for the protection of an exclusive right, the proprietor may request from the person infringing the exclusive right, through the court, information concerning the origin, the manner and channels of distribution and the quantity of unlawfully designated goods, including the names and addresses of the manufacturer, supplier, previous proprietors and resellers of such goods.

3) What rights exist in relation to a sign used as a trademark but not registered? What is the basis of any such right?

- Estonian law does not grant any rights in respect of a sign used as a trademark but not registered. Legal protection is granted only to:
 - 1) trade marks which are well known in Estonia within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property;
 - 2) trade marks which are registered in the register;
 - 3) trade marks with a registration, valid in Estonia, entered in the International Register of the Bureau pursuant to the Madrid Protocol.

An owner of a sign used as a trademark but not registered can only in case of bad faith application of a trademark contest the registration of such trademark.

4) Is it possible to:

- (a) obtain; or**
- (b) maintain;**

registration for a trademark that is not:

- (i) used; or**
- (ii) intended to be used?**

- It is possible to obtain registration for a trademark that is not used or intended to be used. The trademark applicant does not have to file declaration of intent to use or evidence of present use. However, after registration the owner of a trademark is required to actually use a registered trade mark to designate goods and services in respect of which it is registered.

n interested person may file an action against the proprietor of a trade mark for the exclusive right of the proprietor of the trade mark to be declared extinguished if:

- o the registered trade mark has not been used during five consecutive years after the making of the registration, without good reason;
- o a trade mark, concerning which a registration valid in Estonia is entered in the International Register of the Bureau pursuant to the Madrid Protocol, has not been used during five consecutive years after grant of legal protection to the trade mark in Estonia.

5) If yes to 4) above, are the rights derived from such trademark registration the same or different to registered trademarks that are used?

- The rights are the same to proprietors of trademarks that are used /intended to be used and to the proprietors of the trademarks that are not used / intended to be used.

6) Are rights in unregistered trademarks dependent on use? Whether yes or no, please explain the basis for your answer.

- Estonian law does not recognize rights in unregistered trademarks (that are not well-known).

7) Is there any basis to restrict the use of:

- (a) a registered trademark; or
- (b) a sign used as a trademark?

If yes, please explain any relevant laws or precedents.

- There are no laws under which it would be possible to restrict the use of a registered trademark completely on certain goods or services without declaring nullity of the exclusive right of the proprietor or declaring exclusive right of the trademark proprietor extinguished. We are not aware of any precedents concerning restricting the use of a registered trademark.

n principle all restrictions on use of (intellectual) property have to be prescribed by the law and have to be in public interest.

he use of a trademark on certain goods (tobacco, medicines, alcoholic beverage) has been restricted in case of advertisement under the Advertising Act and respective other acts.

8) Is there any basis for the state or any state-controlled body to expropriate

- (a) a registered trademark;
- (b) a sign used as a trademark; or

(c) the rights deriving from either (a) or (b)?

If yes, please explain any relevant laws or precedents.

- According to Article 32 of the Constitution the property of every person is inviolable and equally protected. Property may be taken from the owner without his or her consent only in the public interest, in the cases and pursuant to a procedure provided by law, and for fair and immediate compensation. Everyone whose property has been taken from him or her without his or her consent has the right to bring an action in the courts to contest the taking of the property, the compensation, or the amount of the compensation. The term "property" also includes intellectual property.

herefore, the state could expropriate a registered trademark (or rights deriving from registered trademark) only in public interest, if there is a law providing a relevant procedure and for fair and immediate compensation. At the moment there is no law in Estonia that would serve as legal bases for expropriating trademarks and there are no precedents.

9) If yes to 7) or 8) above, do public interest considerations provide any basis for such restriction or expropriation ("Restriction/Expropriation")? If yes, please explain any applicable public interest f, and any relevant laws or precedents.

- Yes, in principle public interest considerations would provide a basis for such restriction or expropriation, but still relevant regulation by law is needed.

10) If yes to 7) or 8) above, are trademarks different from other intellectual property rights in this regard?

- No.

11) If yes to 7) or 8) above, are any treaty or other international obligations relied on to provide a basis for such Restriction/Expropriation (as applicable)? If yes, please explain the international obligations, and how those obligations are reflected in or received into your country's law.

- No.

12) Is your country a signatory to the WHO Framework Convention on Tobacco Control ("FCTC")? If yes, has your country ratified the FCTC?

- Yes, Estonia is a signatory to the FCTC. Estonia ratified the FCTC in 2005.¹

¹ http://www.who.int/fctc/signatories_parties/en/index.html

13) If yes to 12) above, has the FCTC been implemented in your country? If yes, please explain its legal impact, if any, including by reference to the Guidelines for Implementation of Articles 11 and 13 of the FCTC.

- Yes, it has been implemented in Estonia. The Guidelines for Implementation of articles 11 and 13 of the FCTC are covered by national legislation – they are included in Tobacco Act.

14) Is the FCTC received directly into your country's domestic law or is domestic legislation required to give it effect in your country's law?

- Domestic legislation is required to give FCTC effect in your Estonian's law.

15) If there is presently a legal basis in your country for permitting any Restriction/Expropriation, please answer the following questions in relation to both registered trademarks and unregistered trademarks (if your country recognizes/protects the latter).

(a) What are the parameters for such Restriction/Expropriation? For example, the nature of any stated public interest considerations, the proportionality of the proposed measure to the Restriction/Expropriation.

- According to the commented edition of the Estonian Constitution any aim that is not contradictory to the constitution and disproportionate is acceptable in case of restricting the use. However, if the use is restricted in a manner that the owner will not be able to use it all, it will be considered expropriation. However, each restriction has to be prescribed by the law.

(b) Is it relevant that such Restriction/Expropriation only applies in relation to a particular class of products, eg tobacco products, foods deemed to be unhealthy or alcohol?

- Most likely yes, when considering whether the restriction is proportionate.

(c) What are the financial consequences for the state and the trademark rights holder respectively? For example, is a rights holder entitled to or eligible for any compensation in respect of the Restriction/Expropriation? If yes, what type of rights holders are so entitled or eligible? If not, why is no compensation available?

- According to Art 14 Sec 1 of the State Liability Act a person may claim compensation for damage caused by legislation of general application only if the damage was caused by a significant violation of the obligations of a public authority, the legal provision forming the basis for the violated obligation is directly applicable, and the person belongs to a group of persons who have been specially injured due to the legislation of general application or by failure to issue legislation of general application.

- (d) If compensation is available, how is it calculated?**
- (e) Does a trademark rights holder affected by Restriction/Expropriation have any other claims or remedies against the state? If yes, please explain the basis and nature of any claims or remedies.**
- According Art 15 of the constitution everyone is entitled to petition the court that hears his or her case to declare unconstitutional any law, other legislative instrument or measure which is relevant in the case.
- (f) In the event of Restriction/Expropriation, could a trademark remain registered?**
- In principle yes.
- (g) If yes, what is the consequence of any Restriction/Expropriation on a well known trademark that was registered prior to the Restriction/Expropriation?**
- Most likely the same as in case of other registered trademarks.
- 16) If there is presently no legal framework in your country permitting Restriction/Expropriation, please answer the following questions in relation to both registered trademarks and unregistered trademarks (if your country recognizes/protects the latter).**
- (a) What legislative changes would be necessary in your country to implement a plain packaging regime for a specific class or classes of products such as those previously mentioned? For example, amendments to existing domestic trademark legislation, changes to your country's constitution, multilateral or supranational treaty obligations.**
- Amendments to existing domestic (trademark) legislation as well as TRIPS agreement are needed.
- (b) Could a plain packaging regime be implemented in your country without providing compensation to affected trademark rights holders? If no, what type of rights holders would be entitled to or eligible for compensation? If yes, why would no compensation be payable?**
- It depends whether in the course of implementing plain packaging regime the use of trademark will be only restricted (partly) or the trademarks will be expropriated. In case of expropriation plain packaging regime could not be implemented in Estonia without providing compensation to affected trademark rights holders. All owners of registered trademarks would be entitled to or eligible for compensation.
- (c) Would a trademark rights holder affected by Restriction/Expropriation have any**

other claims or remedies against the state? If yes, please explain the basis and nature of any claims or remedies.

- According to the Estonian Constitution everyone whose property has been taken from him or her without his or her consent has the right to bring an action in the courts to contest the taking of the property, the compensation, or the amount of the compensation.