



ESTONIAN PATENT OFFICE
TRADEMARK DEPARTMENT

THE PROTOCOL RELATING TO THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

NOTIFICATION OF *EX OFFICIO* PROVISIONAL REFUSAL

notified to the International Bureau of the World Intellectual Property Organization (WIPO)
according to Article 5 of the Madrid Protocol

I. Name and address of the office refusing protection: 1 (3)

The Estonian Patent Office
Trademark Department
Toompuiestee 7
15041 Tallinn
ESTONIA
Telephone: + 372 62 77 931
Telefax: + 372 62 77 912

II. Number of the international registration which is the subject of the provisional refusal:

788486

III. Other information concerning the international registration which is the subject of the provisional refusal:
verbal elements of the mark: **SGS (fig.)**

IV. The grounds for this provisional refusal are the following:

1. It is indicated in the notification of registration that the mark in question is a collective, certification or guarantee mark. In order to protect the mark in Estonia **it has to be specified whether it is a collective or a guarantee mark.** There are no regulations for certification mark in Estonian Trademark Act.

The applicant must also submit **the regulations of the collective mark or guarantee mark.**

In the case of a guarantee mark, the regulations must include a list of the required common features of services designated with the guarantee mark which can be used as the basis for quality control.

In the case of a collective mark, the regulations must have a list of members of the association whose services are designated with the collective mark and include the conditions of and procedure for becoming a member of the association.

If the applicant does not provide specifications and regulations listed above, IR 788486 can not be registered in Estonia.

2. The trademark is similar with the following trademark, which is registered for similar kind of services in class 42 (copy of the registration enclosed):

SGS (fig.), registered 08.11.2000, EUTM filing number 000189381. The name and the address of the owner of the mark are:

Owner: SGS SOCIETE GENERALE DE SURVEILLANCE S.A.

Address: 1, Place des Alpes

1201 Geneve

Country: CH

The written consent from the owner of the above-mentioned trademark is required for protection in Estonia for services indicated in item VI.2.

3. The trademark is confusingly similar to a trade name **SGS Eesti Aktsiaselts** belonging to another person which has been entered in the Estonian commercial register on 12.05.1997 (registration number 10144527) and the other person's area of activity in respect of which a notation has been made in the commercial register includes services in class 42 for which an international registration is filed.

Address of the trade name owner: Vana-Narva mnt 27a

Maardu linn, Harju maakond 74114

Estonia

The written consent from the above-mentioned owner of the trade name is required for protection in Estonia for services indicated in item VI.3.

V. Provision of the Estonian Trademark Act applicable on the subject (enclosed):
Sections 61 and 62 (see IV.1).

Section 10 subsection 1(2) and subsection 2.

Section 11 subsection 1(6). (see IV.2)

Section 10 subsection 1(4) and subsection 2. (see IV.3)

VI. 1. The ground referred to in item IV.1 affects **all services**.
2. The ground referred to in item IV.2 affects **all services**.
3. The ground referred to in item IV.3 affects **all services**.

VII. The owner of the registration may request a review of the provisional refusal. The request shall be received by Estonian Patent Office no later than within 4 months from the date of the provisional refusal.

The time limit expires **21/01/2019** (dd/mm/yyyy).

The request has to be filed through the authorized patent attorney of the Republic of Estonia (section 13 subsection 2 of the Estonian Trademark Act). List of patent attorneys is available at <http://www.epa.ee/>

Please note that if the owner of the registration fails to respond by the due date, the registration shall be deemed to be withdrawn for goods and services mentioned in item VI (section 38 subsection 2 of the Estonian Trademark Act). The owner may request that processing be resumed if the owner failed to perform the acts due to force majeure or some other impediment independent of the owner or the representative of the owner (section 47 subsection 3 of the Estonian Trademark Act).

Please note that if the mark is protected subsequent to reviewal of the provisional refusal an interested person may contest the owners right to a trade mark within two months as of the publication of the trade mark (section 41 subsection 2 of the Estonian Trademark Act).

VIII. Date on which the provisional refusal was pronounced: 20/09/2018 (dd/mm/yyyy).

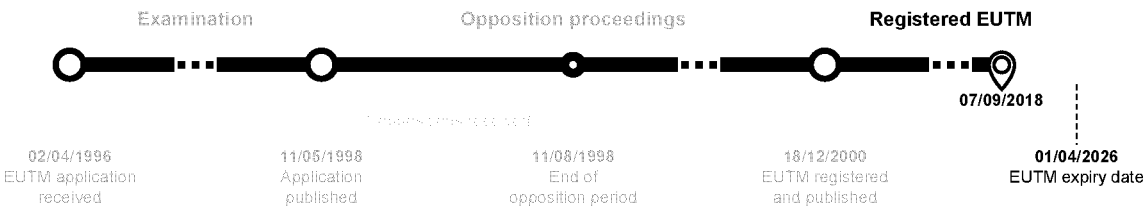
IX. Signature of the Office:

Ekke-Kristian Erilaid
Senior Examiner

EUTM file information

SGS
000189381

Timeline



Trade mark information

Name	SGS	Filing date	01/04/1996
Filing number	000189381	Registration date	08/11/2000
Basis	EUTM	Expiry date	01/04/2026
Date of receipt	02/04/1996	Designation date	
Type	Figurative	Filing language	French
Nature	Individual	Second language	English
Nice classes	35, 36, 39, 41, 42 (Nice Classification)	Application reference	1.S839.22EU.4
Vienna Classification	01.05.02, 26.11.06, 26.11.12 (Vienna Classification)	Trade mark status	Registered
		Acquired distinctiveness	No

Graphic representation



Goods and services

English (en)



- 35** Price comparison and evaluation of various goods; employment search for technical personnel; product optimization studies.
- 36** Risk assessment and prevention services; damage valuation and loss adjusting services; valuation and other appraisals of real estate, equipment, contracts and industrial property; evaluation and follow-up of foreign investment projects; assistance to customs, audit of customs codes and establishment of dutiable values prior to shipment of goods.
- 39** Storage, warehousing, handling and transportation of goods; vehicle inspection; container inspection; supervision of maritime transport.
- 41** Various training courses, particularly in the field of quality assurance.
- 42** Inspection, control, supervision, verification and certification of the quality and quantity of raw materials, commodities, manufactured, semi-manufactured and transformed goods or goods of any other nature as well as their conformity with national and international norms, laws, rules, practice and standards and with clients' contractual requirements related to the import and export of the above mentioned goods; control and certification of the planning, building, construction works and maintenance of machines, industrial equipments and plants; inspection, control, supervision, verification and certification of production or processing methods and of the manufacturing processes of equipment, devices and appliances, as well as qualification of personnel, including certification of product quality control procedures, control of measuring appliances and methods of measurement, sampling and analyses; engineering services for the modernization of devices, equipment, systems, sampling methods and technology; quality assurance services and certification, including establishment and certification of quality assurance and environmental management systems in line with internationally recognized ISO standards; measuring and calibration systems for petroleum and petrochemical products and design, construction and application of calibration systems for flow meters and tanks; development of software for computer-based management of storage, depots and container handling; advice and consultancy services to governments for the implementation, restructuring and reorganisation of their customs systems; testing, measuring and laboratory analysis of products and materials; testing of air, soil, water and waste and general studies/advice related to regulatory compliance in environmental matters; services in the field of health and particularly medical laboratory analyses, hygiene services and appraisal of pharmaceutical products; engineering expertise in damage assessment.

Description

No data

Owners

SGS SOCIETE GENERALE DE SURVEILLANCE S.A.

ID	7404	Country	CH - Switzerland	Correspondence address	
Organisation	SGS SOCIETE GENERALE DE SURVEILLANCE S.A.	State/county	n/a	SGS SOCIETE GENERALE DE SURVEILLANCE S.A. 1, Place des Alpes CH-1201 Geneve SUIZA	Can be accessed and changed by authorised user via the User Area
		Town	Geneve		
Legal status	Legal entity	Post code	1201		Can be accessed and changed by authorised user via the User Area
		Address	1, Place des Alpes		Can be accessed and changed by authorised user via the User Area

Representatives

No data

Correspondence

From	Procedure	Filing number	Subject	Date	Actions
	EUTM	000189381	Surveillance letter	13/07/2018	
	EUTM	000189381	Surveillance letter	25/08/2017	
	EUTM	000189381	Surveillance letter	03/08/2017	

Extract from the Estonian Trademark Act

§ 10. Relative circumstances which preclude legal protection

- (1) Legal protection shall not be granted to the following trade marks:
- 2) trade marks which are identical or similar to an earlier trade mark which has been granted legal protection with regard to identical goods or services or goods or services of a similar kind designated by the trade mark, if there exists a likelihood of confusion on the part of the consumers, which includes association of the trade mark with the earlier trade mark;
- 4) trade marks which are identical or confusingly similar to a business name entered in the commercial register prior to the filing date of the application, the date of international registration or the date of priority, and the area of activity of the respective undertaking is in the same field as the goods and services which the trade mark is used to or is going to be used to designate;
- (2) Circumstances specified in clauses (1) 2)–6) of this section which preclude legal protection are not taken into account if the proprietor of the earlier trade mark or another earlier right consents to the grant of legal protection in writing.

§ 11. Earlier trade mark and other earlier rights

- (1) An “earlier trade mark” means the following:

6) a Community trade mark registered on the basis of the Community Trade Mark Regulation if the filing date of the application, date of priority or the seniority date granted on the basis of the Estonian registration is earlier;

§ 13. Representative for performing acts related to legal protection of trade marks

- (2) A person with no residence, seat or commercial or industrial enterprise operating in Estonia shall authorise a patent attorney as the person’s representative to perform procedures related to trade marks at the Patent Office and at the Board of Appeal, except the filing of an application.

§ 41. Adjudication of appeals and revocation applications

- (2) An interested person may contest an applicant’s right to a trade mark at the Industrial Property Board of Appeal if circumstances specified in subsection 9 (1) or § 10 of this Act which preclude legal protection exist. The term for filing a revocation application is two months from the publication of the notice of the decision to register a trade mark.

§ 38. Examination of trade marks

- (2) If an examination reveals circumstances which preclude the legal protection of a trade mark, the Patent Office shall notify the applicant thereof and set a term of at least two months for the elimination of the said circumstances or provision of explanations. If the applicant fails to respond by the due date, the application is deemed to be withdrawn.

§ 47. Withdrawal of applications, termination and resumption of processing

- (3) An applicant may request that processing be resumed if the Patent Office terminated

processing having deemed the application to be withdrawn pursuant to §§ 37, 38 or 46 of this Act and the applicant failed to perform the acts due to *force majeure* or some other impediment beyond the control of the applicant or a representative of the applicant.

Extract from the Estonian Trademark Act

§ 61. Definition of collective mark and guarantee mark

(1) A collective mark is a trade mark which belongs to an association of persons with active legal capacity and which is used by members of the association to designate their goods and services under the conditions and pursuant to the procedure provided for in the regulations of the collective mark.

(2) A guarantee mark is a trade mark used to designate the goods and services of different persons in order to guarantee a common quality, common geographic origin or method of production or another common feature of such goods and services.

§ 62. Regulations of collective mark or guarantee mark

(1) An application for the registration of a collective mark or guarantee mark shall include the regulations of the collective mark or guarantee mark (hereinafter regulations).

(2) A collective mark or guarantee mark is registered if there are no circumstances which preclude legal protection and:

1) the regulations are not contrary to public order or accepted principles of morality;

2) in the case of a guarantee mark, the regulations include a list of the required common features of goods and services designated with the guarantee mark which can be used as the basis for quality control;

3) in the case of a collective mark, the regulations have a list of members of the association whose goods and services are designated with the collective mark attached thereto and the regulations include the conditions of and procedure for becoming a member of the association.

(3) An amendment of regulations is effective as of the entry of the amendment in the register. An amendment is entered in the register only if the regulations do not conflict with the requirements provided for in subsection (2) of this section.

§ 13. Representative for performing acts related to legal protection of trade marks

(2) A person with no residence, seat or commercial or industrial enterprise operating in Estonia shall authorise a patent attorney as the person's representative to perform procedures related to trade marks at the Patent Office and at the Board of Appeal, except the filing of an application.

§ 41. Adjudication of appeals and revocation applications

(2) An interested person may contest an applicant's right to a trade mark at the Industrial Property Board of Appeal if circumstances specified in subsection 9 (1) or § 10 of this Act which preclude legal protection exist. The term for filing a revocation application is two months from the publication of the notice of the decision to register a trade mark.

§ 47. Withdrawal of applications, termination and resumption of processing

(3) An applicant may request that processing be resumed if the Patent Office terminated processing having deemed the application to be withdrawn pursuant to §§ 37, 38 or 46 of this Act and the applicant failed to perform the acts due to *force majeure* or some other impediment beyond the control of the applicant or a representative of the applicant.