



**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:

**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:

**1404739**

III. Other information concerning the international registration which is the subject of the provisional refusal:

Figurative mark / verbal elements of the mark: **ZAKKA**

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

The trademark cannot be protected, because the word ZAKKA (in Cyrillic as well as in Latin characters) is devoid of any distinctive character regarding some goods and services named in the list of goods and services. The trademark consists of indication (Zakka fashion and design phenomenon), which may serve, in trade, to designate the kind, quality, intended purpose, value and other characteristics of the goods and services.

V. Provision of the Estonian Trademark Act applicable on the subject (enclosed):  
Section 9 subsections 1(2), 1(3).

VI. The ground referred to in item IV. affects **all the goods in classes 14, 16, 18, 20, 21, 24 and 25**. The ground referred to in item IV. affects the following goods in **class 6**: *window fasteners of metal; door closers, non-electric; ironwork for windows; sealing caps of metal; partitions of metal; casks of metal; furnace fireguards of metal; box fasteners of metal; pot hooks of metal; tool chests of metal, empty; locks of metal for vehicles; foundry molds [moulds] of metal; monuments of bronze for tombs; rivets of metal; monuments of metal for tombs; door openers, non-electric; tinsplate packings; door fasteners of metal; figurines [statuettes] of common metal; metal knockers; containers of metal [storage, transport]; fittings of metal for beds; letter boxes of metal; ice moulds of metal; aluminium foil; monuments of metal; fittings of metal for furniture; door fittings of metal; tombstone plaques of metal; tombs of metal; hardware of metal, small; identity plates of metal; jalousies of metal; shutters of metal; foot scrapers; bells; tombac; sash fasteners of metal for windows; tree protectors of metal;*

*busts of common metal; window stops of metal; safes [strong boxes]; towel dispensers, fixed, of metal; spring locks; latches of metal; locks of metal, other than electric; cask stands of metal; weather- or wind-vanes of metal; letters and numerals of common metal, except type; bronzes [works of art]; signalling panels, non-luminous and non-mechanical, of metal; knobs of metal; trays of metal; chests of metal for food; door handles of metal; handcuffs; buckles of common metal [hardware]; hooks of metal for clothes rails; chimney pots of metal; ladders of metal; fire dogs [andirons]; bells for animals; memorial plates of metal; roller blinds of steel; clothes hooks of metal; boxes of common metal; hinges of metal; barrels of metal; registration plates of metal; metal cages for wild animals; grave slabs of metal; fittings of metal for windows; advertisement columns of metal; tombstone stelae of metal; statues of common metal; enclosures of metal for tombs; signboards of metal; chill-molds [foundry]; packaging containers of metal; door stops of metal; taps of metal for casks; signs, non-luminous and non-mechanical, of metal; padlocks; hooks [metal hardware]; baskets of metal; bottle caps of metal; steps [ladders] of metal; tanks of metal; vats of metal; cashboxes of metal; moldings of metal for cornices; fittings of metal for coffins; works of art of common metal; cornices of metal; identification bracelets of metal; duckboards of metal; screw tops of metal for bottles; wind-driven bird-repelling devices made of metal; door bolts of metal; chests of metal; outdoor blinds of metal; strap-hinges of metal; chimneys of metal; ironwork for doors; keys; tin cans; window pulleys; badges of metal for vehicles; tinfoil; insect screens of metal; tool boxes of metal, empty; beacons of metal, non-luminous; building or furniture fittings of nickel-silver; locks of metal for bags; house numbers of metal, non-luminous; bottle closures of metal; split rings of common metal for keys; door bells of metal, non-electric; aviaries [structures] of metal; step stools of metal; bird baths [structures] of metal; window openers, non-electric; window closers, non-electric*

and the following services in **class 35**: *distribution of samples; organization of exhibitions for commercial purposes; procurement services for others [purchasing goods and services for other businesses]; auctioneering; organization of trade fairs for commercial purposes; administrative processing of purchase orders; import-export agency services; marketing; telemarketing services; retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; demonstration of goods; sales promotions at point of purchase or sale, for others; presentation of goods on communication media, for retail purposes.*

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 **04/06/2019** (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 review of the provisional refusal an interested person may contest the owner's 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: 04/02/2019 (dd/mm/yyyy).

IX. Signature of the Office:

Jana Redkin  
Senior Examiner

Number of continuation sheets: 1

## **Extract from the Estonian Trademark Act**

### **§ 9. Absolute circumstances which preclude legal protection**

(1) Legal protection is not granted to the following signs:

- 2) signs which are devoid of any distinctive character, including single letters in non-stylised form, single numbers in non-stylised form and single colours;
- 3) signs which consist exclusively of signs or indications which designate the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services, or which describe the goods or services in another manner, or which consist of the above-mentioned signs or indications which are not considerably altered;
- 6) signs which are of such a nature as to mislead the consumer as to the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services.

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

[RT I 2004, 20, 141 – entry into force 01.05.2004]

(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.

[RT I 2004, 20, 141 – entry into force 01.05.2004]

### **§ 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.

### **§ 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.

[RT I 2009, 4, 24 – entry into force 01.03.2009]

### **§ 69. Effect of international registration**

(1) Legal protection arising from an international registration valid in Estonia is equal to legal protection arising from a national registration and the rights and obligations arising from an internationally registered trade mark are equal to those arising from a nationally registered trade mark.