



**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:

**1408132**

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

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

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

The trademark cannot be protected, because the word FOTO is devoid of any distinctive character regarding the goods and services named in the list of goods and services. The trademark consists of indication, 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) and 1(6).

VI. The ground referred to in item IV. affects the following **goods in class 9**: *adapter plugs; cases for smartphones; covers for smartphones; carriers adapted for mobile phones; cases adapted for mobile phones; cases for mobile phones; cell phone cases; cell phones; cellular phones; computer game software for use on mobile and cellular phones; conference phones; devices for hands-free use of mobile phones; digital phones; door phones; downloadable graphics for mobile phones; dustproof plugs for jacks of mobile phones; earbuds; ear phones; flip covers for smart phones; hands free devices for mobile-phones; hands free kits for phones; holders adapted for mobile phones; keyboards for mobile phones; keyboards for smartphones; leather cases for mobile phones; mobile phone cases; mobile phone covers; mobile phone sets; mobile phones; mobile phones for use in vehicles; monopods used to take photographs by positioning a smartphone or camera beyond the normal range of the arm; phone appliances; phone covers; phone extension jacks; phone extension leads; phone plugs; protective cases for smartphones; protective covers for smartphones; protective films adapted for smartphones; smartphones; smartphones in the shape of a watch; smartwatches; stands adapted for mobile phones; watches that communicate data to smartphones; wireless headsets for smartphones; wristmounted smartphones; video phones;*  
**and all the services in classes 35, 38 and 42.**

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 **15/07/2019** (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: 13/03/2019 (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.