



**ESTONIAN PATENT OFFICE
TRADEMARK DEPARTMENT**

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

NOTIFICATION OF PROVISIONAL REFUSAL BASED ON AN OPPOSITION

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:
810420

III. Other information concerning the international registration which is the subject of the provisional refusal: **ESS Support Services Worldwide (Fig.)**

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

Opposition made 01.02.2005 by ESS Puhastustööde AS on the grounds that the company has an earlier trademark and trade name registered in Estonia for the similar kind of services as the international registration nr 810420 in classes 37 and 43 and two marks and above-mentioned trade name are likely to be confused and associated.

The name and the address of the opponent are: ESS Puhastustööde aktsiaselts
Address - Vilde tee 129
12613 Tallinn
Country - EE

V. Provision of the Estonian Trademark Act applicable on the subject (enclosed):
Section 7 subsection 2, section 10 subsection 1(2) and 1(4), section 11 subsection 1(1), section 41 subsection 2 and 3.

VI. The ground referred to in item IV. does not affect following services in class 37: *installing, maintenance and repair of vending machines.*
The ground referred to in item IV. affects following services in class 43: *rental of temporary accommodation, meeting rooms.*

- VII. The holder of the registration has right to participate in the procedure at the Board of Appeal of Intellectual Property of Estonia.

The request has to be filed through the patent agent of the Republic of Estonia (section 13 subsection 2 of the Estonian Trademark Act). List of patent agents is available at <http://www.epa.ee/eng/14attorn.htm>.

The request for participation in the procedure, written observations and the power of attorney must be received by the Board of Appeal no later than within 3 months from the date of the acceptance of the opposition for processing.

Name and address of the Board of Appeal:

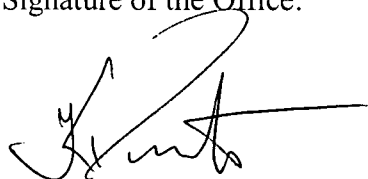
Board of Appeal of Intellectual Property
Ministry of Economic Affairs and Communications
Harju str. 11
15072 Tallinn
ESTONIA

The time limit expires 02/05/2005 (dd/mm/yyyy). The extension of the time limit is not possible.

Please note that the matter will be examined by the Board of Appeal even if the holder of the registration does not request participation in the procedure at the Board of Appeal.

- VIII. Date on which the refusal was pronounced: 09/02/2005 (dd/mm/yyyy).

- IX. Signature of the Office:



Kati Vinter

Senior Examiner of the First International Trademark Examination Division

Extract from the Estonian Trademark Act

§ 7. Recognition of well-known trade marks

(2) The Patent Office shall consider a trade mark to be well-known only in connection with the registration procedure of the trade mark or other trade marks. The Industrial Property Board of Appeal shall consider a trade mark to be well-known only in connection with the adjudication of an appeal against a decision of the Patent Office or an application concerning contestation of the legal protection of the trade mark.

§ 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 public, 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 registration application or the priority date if the area of activity in respect of which a notation has been made in the commercial register includes the goods and services which the trade mark are used to or are going to be used to designate;

§ 11. Earlier trade mark and other earlier rights

(1) "Earlier trade mark" means the following:

1) a trade mark which became well known 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 agent as the person's representative to perform acts related to trade marks in the Patent Office and 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 in 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 the filing of a revocation application is two months as of the publication of the notice of the decision to register a trade mark.

(3) In case an appeal or revocation application is allowed in whole or in part, the Board of Appeal shall annul the decision of the Patent Office and require the Patent Office to continue proceedings taking into account the facts set out in the decision of the Board of Appeal.