



**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 (2)

**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:

752086

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

Verbal elements of the mark: **ELITE**

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

1. The word **ELITE** is not distinctive for all goods, because it only indicates the quality and value of the goods.
2. The word **ELITE** is not distinctive for all goods, because it is devoid of any distinctive character.

Therefore the above trademark **cannot be registered in Estonia.**

If the grounds for refusal mentioned in the items IV.1, IV.2 will be excluded in the course of the possible appeal proceedings, the international registration cannot be registered in Estonia because of the identical earlier trademark (see below).

3. The trademark is identical with the following trademark, which is registered for identical goods in class 12 (copy of the registration enclosed):

ELITE, registration date 17.02.2011, OHIM trademark number 1092010. The name and the address of the owner of the mark are:

Owner: Group Lotus Plc
Address: Potsah lane, Hethel Norwich
Norfolk NR14 8EZ
Country: GB

V. Provision of the Estonian Trademark Act applicable on the subject (enclosed):
Section 9 subsection 1(3) (see IV.1).
Section 9 subsection 1(2) (see IV.2).
Section 10 subsection 1(1) (see IV.3).

VI. The grounds referred to in items IV.1, IV.2, IV.3 affect **all goods**.

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 **22/05/2014** (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 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: 22/01/2014 (dd/mm/yyyy).

IX. Signature of the Office:



Ekke-Kristian Erilaid

Senior Examiner of the First International Trademark Examination Division


CTM file information

ELITE

Trade mark information

Name	ELITE	Filing date	
Filing number	1092010	Registration date	17/02/2011
Basis	IR (Search on WIPO database)	Expiry date	17/02/2021
Date of receipt	13/10/2011	Designation date	17/02/2011
Type	Word	Filing language	English
Nature	INDIVIDUAL	Second language	French
Nice classes	9, 12, 16, 28, 37 (Nice classification)	Application reference	
Vienna classification		Trade mark status	Opposition pending
		Acquired distinctiveness	No

Goods and services

English (en) 

- 9** Apparatus and instruments for testing vehicles or for use in the operation of vehicles included in this class; computers; parts and fittings for the aforesaid included in this class relating to vehicles and engines for vehicles (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations); electric batteries; sun glasses and sun glass cases; fire extinguishing apparatus; in-car entertainment systems included in this class; spectacles; frames and lenses, all for spectacles; apparatus for recording, transmission or pre-production of sound or images; magnetic data carriers, recording disks; videos; video cassettes; CD ROMs; DVDs; video disks; computer and video game software included; computer software, namely, computer games software and computer games adapted for use with PDAs, handheld devices, mobile telephones and MP3 players and visual display units relating to the test driving of vehicles, vehicles and vehicle engineering; computer games software downloadable from the Internet, or another network, via telecommunications or via any other communications network; computer game cartridges, cassettes, disks, computer games software, computer games tapes, computer games disks, CD-ROMs, DVDs and downloadable MP3 files featuring the test driving of vehicles, vehicles and automobiles and engineering of vehicles and automobiles; downloadable MP3 files and video disk all relating to the test driving of vehicles and vehicle engineering.... Show less
- 12** Apparatus of locomotion by land, air or water; parts and fittings for all the aforesaid goods (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations); land vehicles and parts and fittings therefor included in this class.... Show less
- 16** Printed material, periodical publications, books, photographs, instructional and teaching materials, decalcomania; pens, pencils; pads of papers; paper articles and stickers; printed matter, stationery, writing implements, prints (engravings) pictures, calendars, magazines (periodicals), books, diaries, paper weights, all made of cardboard or paper, maps, guides, decalcomania; all included in this class, but not including handkerchiefs, kitchen rolls, hand towels, table cloths, table napkins, place mats, babies disposable napkins; toilet paper, filter papers and rolls of paper for industrial wiping purposes.... Show less
- 28** Hand-held computer games; hand-held electronic games; all the aforesaid goods embodying games relating to the test driving of virtual vehicles or to engineering of vehicles or to parts and fittings for vehicles; pedal operated vehicles, toys, games, model vehicles (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations); puzzles and playthings; vehicle related games (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations); pedal operated vehicles (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations).... Show less
- 37** Repair and maintenance.

Description

No entry

Owners

Group Lotus Plc

ID	n/a	Country	GB - United Kingdom	n/a
Organisation	n/a	State/county	n/a	
Legal	n/a	Town	n/a	n/a
		Postcode	n/a	
		Address	Potash Lane, Hethel Norwich, Norfolk NR14 8EZ	n/a

Representatives

No entry

IR transformation

No entry

Seniority

No entry

Exhibition Priority

No entry

Priority

Country	Filing number	Date	Status
United Kingdom	2558393	19/08/2010	ACCEPTED
Showing 1 to 1 of 1 entries			

Publications

Bulletin number	Date	Section	Description
2011/195	14/10/2011	M.1	IR_M_1
Showing 1 to 1 of 1 entries			

Cancellation

No entry

Recordals

No entry

Oppositions


Filing number	Date	Grounds	Opponent	Representative	Language	Reference	Status	Extent of opposition
002061433	10/07/2012	Likelihood of confusion	AD PARTS, S.L.,	LEHMANN & FERNANDEZ S.L.,	English		Open	Class 37: Repair and maintenance. Class 09: Apparatus and instruments for testing vehicles or for use in the operation of vehicles included in this class; computers; parts and fittings for the aforesaid included in this class relating to vehicles and engines for vehicles; electric batteries; fire extinguishing apparatus; in-car entertainment systems included in this class. Class 12: Apparatus of locomotion by land, air or water; parts and fittings for all the aforesaid goods (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations); land vehicles and parts and fittings therefor included in this class.
001940801	30/11/2011	Likelihood of confusion	Joh. Winklhofer Beteiligungs GmbH & Co. KG,	WEICKMANN & WEICKMANN,	English		Closed	Class 12: Apparatus of locomotion by land, air or water; parts and fittings for all the aforesaid goods (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations); land vehicles and parts and fittings therefor included in this class.

Showing 1 to 2 of 2 entries

Appeals

No entry

Decisions

	Case Number	Type	Case	Legal	Keywords	Status	DecisionDate
	Opposition 001940801	Opposition		Article 8(1)(b) CTMR		Partially refused CTMA/IR	16/04/2013

Showing 1 to 1 of 1 entries

Renewals

No entry

Trade mark relations

No entry

Extract from the Estonian Trademark Act

§ 9. Absolute circumstances which preclude legal protection

(1) Legal protection shall not be 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;

§ 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

10. Relative circumstances which preclude legal protection

- (1) Legal protection shall not be granted to the following trade marks:
- 1) trade marks which are identical with an earlier trade mark which has been granted legal protection with regard to identical goods or services designated by the trade mark;

§ 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.