



EUROPEAN COMMISSION

DIRECTORATE-GENERAL INTERNAL MARKET, INDUSTRY, ENTREPRENEURSHIP
AND SMES
Competitiveness Coordination
D.3 – Intellectual Property

Brussels
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Ministry of Justice and Digital
Affairs of Estonia
Attention of Mr. Kärt Nemwalts
Head of Intellectual Property and
Competition Law Division

By e-mail to:
Kart.Nemvalts@justdigi.ee

Subject: Transposition of the Trade Marks Directive (EU) 2015/2436 – definition of “third countries” in § 14(2) of the Estonian Trade Marks Act

Dear Mr Nemwalts,

We are currently looking into some issues concerning the transposition of the Trade Marks Directive (EU) 2015/2436 (TM Directive) into national law, which have remained open due to the recent Design law reform.

As far as transposition by Estonia is concerned, we understand that Article 10(4) of the TM Directive on counterfeit goods in transit and other customs situations has been transposed by § 14(2) of the Estonian Trade Marks Act. While the latter provision seems to be literally almost identical with the corresponding provision in the TM Directive, it is noted, however, that in contrast to the text of Article 10(4) TM Directive covering counterfeit goods coming from “third countries”, the new right to prevent third parties from bringing relevant counterfeit goods into Estonia under § 14(2) of the Estonian Trade Marks Act is surprisingly limited to goods or their packaging that “come from outside the states which are Member States of the European Economic Area”.

In our understanding, Article 10(4) of the TM Directive requires that relevant goods including their packaging come from third countries and have not been released for free circulation in the EU. The relevant goods must therefore be non-Union goods. „Third countries” as referred to both in Article 10(4) of the TM Directive and in Article 9(4) of the EUTM Regulation (EU) 2017/1001 are thus to be considered as all those countries

which do not form part of the customs territory of the Union as defined in Article 4 of Regulation (EU) No 952/2013 laying down the Union Customs Code.

The correctness of the above understanding is in our view further confirmed by the fact that the scope of the IP Customs Border Regulation (EU) No 608/2013, which the second sub-paragraph of Article 10(4) of the TM Directive refers to, is limited to the (customs) territory of the Union as well and does explicitly not cover infringements resulting from so-called illegal parallel trade (for which actually the territory of the European Economic Area would be relevant).

Therefore, it is our understanding that the countries Iceland, Liechtenstein and Norway that are members of the European Economic Area but not part of the EU are in fact also to be regarded as “third countries” within the meaning of Article 10(4) of the TM Directive (and Article 9(4) of the EUTM Regulation).

We would therefore be very grateful if we could receive your comments on this issue of transposition into Estonian law, including information also as to whether there are possibly any plans to have the relevant provision in § 14(2) of the Trade Marks Act amended in the near future.

Yours sincerely,

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Head of Unit

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