

Translation from Finnish

Legally binding only in Finnish and Swedish

Ministry of Economic Affairs and Employment, Finland

Trade Marks Act

544/2019

By decision of Parliament, the following is enacted:

Chapter 1

General provisions

Section 1

Scope of application

This Act lays down provisions on trade marks and on collective and certification marks.

Section 2

Definitions

In this Act:

- 1) *trade mark* means a sign, used in trade as a symbol for goods and services, to which exclusive rights have been obtained in accordance with the provisions of this Act;
- 2) *EU trade mark* means the trade mark referred to in Article 1 of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, hereinafter the *EU Trade Mark Regulation*;
- 3) *collective* mark means a trade mark intended for use in the trade of the members of the proprietor of the collective trade mark;
- 4) *certification mark* means a trade mark intended for use for goods or services subject to inspection or supervision;
- 5) *International Bureau* means the International Bureau of the World Intellectual Property Organization (WIPO);
- 6) *international registration* means registration of a trade mark by the International Bureau.

Chapter 2

Exclusive rights to a trade mark

Section 3

Exclusive rights through registration

Exclusive rights to a trade mark are obtained by registering the trade mark in the Register of Trademarks kept by the Finnish Patent and Registration Office or by approving an international registration as valid in Finland.

The provisions on exclusive rights to an EU trade mark are laid down in the EU Trade Mark Regulation.

Section 4

Exclusive rights through establishment

Exclusive rights to a trade mark may be obtained without registration of the trade mark when the trade mark has become established. A trade mark is considered to have become established when it is generally recognised in Finland by the relevant public as the sign of the proprietor's goods or services.

Section 5

Substance of exclusive rights

Without the consent of the trade mark proprietor, the following may not be used as a symbol of goods and services in trade:

- 1) a sign that is identical with a trade mark that has been registered or become established for the identical goods or services;
- 2) a sign that causes a likelihood of confusion among the public because it is identical with or similar to a trade mark that has been registered or become established for identical or similar goods or services;
- 3) a sign that is identical with or similar to a trade mark that has a reputation in Finland regardless of whether it is used for identical or similar goods or services when:

- a) the use of the sign without due cause would take unfair advantage of the distinctive character or repute of the trade mark that has a reputation in Finland; or
- b) the use of the sign without due cause would be detrimental to the distinctive character or the repute of the trade mark that has a reputation in Finland.

Section 6

Right, included in exclusive rights, of trade mark proprietor to prohibit use of trade mark

The proprietor of a trade mark has the right to prohibit the use of a sign referred to in section 5 in trade when the use involves:

- 1) the use of the sign in goods or services or in the packaging of goods;
- 2) offering the goods or putting them on the market, or stocking them for those purposes under the sign;
- 3) offering or supplying services under the sign;
- 4) importing or exporting the goods under the sign;
- 5) using the sign on business papers or in marketing;
- 6) using the sign as a trade or company name or part of a trade or company name;
- 7) other equivalent use of the sign.

The proprietor of the trade mark shall additionally have the right to prohibit the use of the sign referred to in section 5 in comparative advertising when such conduct would be contrary to section 2a of the Unfair Business Practices Act (1061/1978).

The proprietor of the trade mark shall additionally have the right to prohibit any acts preparatory to trade mark infringement.

The provisions on exclusive right in transit are laid down in section 7.

Section 7

Right, included in exclusive rights, to prohibit transit

The proprietor of a registered trade mark has the right to prohibit third parties from bringing goods to Finland from a third country in connection with trade even if the goods are not released for free circulation when the goods bear a sign that is identical with the trade mark registered for

the said goods or a sign that cannot be distinguished in its essential aspects from such a trade mark.

The right provided above in subsection 1 shall lapse if evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

Section 8

Restrictions on exclusive rights

Exclusive rights to a trade mark shall not preclude use of the following by another in the course of trade in accordance with honest practices in industrial or commercial matters:

- 1) a natural person's own name or address;
- 2) a sign which describes the kind, quality, quantity, intended purpose, value or geographical origin of goods, the time of production of goods or of rendering of the service, or other characteristics of goods or services;
- 3) a sign which in other respects is devoid of distinctive character; or
- 4) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of the trade mark is necessary to indicate the intended purpose of a product or service or for another comparable reason.

Section 9

Exhaustion of exclusive rights

The proprietor of a trade mark may not prohibit the use of the trade mark in relation to goods which have been put on the market in the European Economic Area under that trade mark by the proprietor or with the proprietor's consent.

Notwithstanding the provisions laid down in subsection 1, the proprietor of the trade mark may prohibit the use of the trade mark in relation to goods where there exist legitimate reasons for the proprietor to oppose subsequent supply or placement on the market of the goods. In particular, the proprietor of the trade mark may prohibit the use of the trade mark if the condition of the goods has been altered or the quality of the goods impaired after they have been put on the market.

Section 10

Reproduction of a trade mark in certain publications

The publisher of a dictionary, encyclopaedia, textbook or similar publication shall, at the request of the proprietor of the trade mark, ensure that the trade mark is not reproduced in the publication without indicating that it is a registered trade mark. This duty may be deemed to be fulfilled when the symbol ® is inserted in connection with the trade mark.

The provisions laid down above in subsection 1 also apply to the distribution of the publication via an information network or by other electronic means.

A publisher who fails to comply with the duty to indicate laid down in subsection 1 shall be liable, at its own expense, to have a correction published in a reasonable manner and to a reasonable extent.

Chapter 3

Requirements for obtaining exclusive rights

Section 11

Signs of which a trade mark may consist

Any sign may be registered as a trade mark when:

- 1) it is capable in trade of distinguishing the goods or services of the proprietor of the trade mark from those of other parties; and
- 2) it is capable of being represented on the Register of Trademarks in a manner which enables the authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

The following shall be considered to be devoid of distinctive character:

- 1) trade marks that may describe the kind, quality, quantity, intended purpose, value or geographical origin of goods or services, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
- 2) trade marks which have become a generic name in trade for the good or service; or

3) trade marks which cannot in other respects be used to distinguish the goods or services of the proprietor of the trade mark from those of another party.

Exclusive rights also to a sign other than referred to in subsection 1 may be obtained through establishment.

Even on the basis of establishment, a trade mark may not consist of a sign which consists exclusively of a shape or another characteristic that:

- 1) results from the nature of the goods or services;
- 2) is necessary to obtain a technical result; or
- 3) gives substantial value to the goods or services.

Section 12

Absolute grounds for refusal and invalidity

A trade mark may not be registered or, if registered, shall be invalidated if:

- 1) trade mark which is not capable of being represented on the Register of Trademarks in the manner laid down in section 11, subsection 1, paragraph 2;
- 2) trade mark which cannot constitute a trade mark under section 11, subsection 4;
- 3) trade mark which is devoid of any distinctive character as provided in section 11, subsection 1, paragraph 1, and section 11, subsection 2;
- 4) trade mark which is contrary to law, public policy or accepted principles of morality;
- 5) trade mark which is of such a nature as to deceive the public;
- 6) trade mark which, without proper consent, includes a state escutcheon, state flag or other state emblem, the escutcheon of a Finnish municipality, or the flag, escutcheon or other badge or emblem of an international intergovernmental organisation, or some other protected badge based on an international treaty that is binding on Finland;
- 7) trade mark which, without the proper consent, includes an official certification or guarantee mark, or official sign or hallmark, for goods for which the mark is to be registered or for goods similar to them;
- 8) trade mark which, without the proper consent, includes something, the inclusion of which in the mark may cause a risk of the public confusing the trade mark with the sign, flag, escutcheon, badge, emblem or hallmark referred to in paragraphs 6 or 7;

- 9) trade mark which is excluded from registration in Finland or in the European Union pursuant to a provision concerning protection of designations of origin and geographical indications, traditional terms for wine, or traditional specialities guaranteed;
- 10) trade mark which consists of, or reproduces in its essential elements, an earlier plant variety denomination protected in Finland or in the European Union, and the goods or services covered by the trade mark application or trade mark registration are of the same or closely related species with the plant variety;
- 11) trade mark for which an earlier collective mark application or collective mark registration concerning the identical sign already exists in the Register of Trademarks for identical goods or services;
- 12) trade mark for which an earlier certification mark application or certification mark registration concerning the identical sign already exists in the Register of Trademarks for identical goods or services or such a certification mark registration, the validity of which has expired due to lack of renewal, has existed in the Register of Trademarks.

A trade mark shall also be invalidated when the application for registration of the trade mark was filed in bad faith by the proprietor of the trade mark.

The registration of a trade mark may not be refused pursuant to subsection 1, paragraph 3 when the trade mark, prior to the date of filing, has acquired a distinctive character in use among its relevant public as the sign of the goods or services of the applicant for the trade mark. A trade mark may not be invalidated pursuant to subsection 1, paragraph 3 when the trade mark, prior to the date of filing of an application or action for invalidation, has acquired a distinctive character in use in a corresponding manner.

Section 13

Relative grounds for refusal and invalidation

A trade mark may not be registered or, if registered, shall be invalidated if:

- 1) the trade mark is identical with an earlier trade mark that has been registered or become established for identical goods or services;
- 2) the trade mark causes a likelihood of confusion on the part of the public because of its identity with, or similarity to, the earlier trade mark that has been registered or become established for identical or similar goods or services;

3) the trade mark is identical with or similar to an earlier trade mark that has a reputation in Finland or in the European Union regardless of whether used for identical or similar goods or services if:

a) the use of the trade mark without due cause would take unfair advantage of the distinctive character or the repute of the trade mark that has a reputation; or

b) the use of the trade mark without due cause would be detrimental to the distinctive character or the repute of the trade mark that has a reputation;

4) the trade mark creates a likelihood of confusion on the part of the public with an earlier protected company name, auxiliary company name, translation of company name or secondary symbol of another trader:

a) whose line of business is identical with or similar to the goods or services included in the list of goods or services;

b) who is very well established and well-known, and the use of a similar trade mark would constitute improper exploitation of the goodwill associated with the company name; or

c) who is established and, relative to the particular nature of the activities, the use of a similar trade mark would be liable to diminish the goodwill associated with the company name;

5) the use of the trade mark would infringe an earlier copyright as referred to in section 1 of the Copyright Act (404/1961) or an earlier right to control a photographic picture as referred to in section 49a of the Copyright Act;

6) the use of the trade mark would infringe the earlier design right of another;

7) the trade mark is likely to give the impression that it is the name or likeness of another person, unless the name or likeness is evidently that of someone deceased a long time ago;

8) the representative of the proprietor of the trade mark applies for registration of the trade mark in its own name without the consent of the proprietor, unless there is a proper reason for the registration;

9) an application for a designation of origin or a geographical indication under the legislation of Finland or the European Union has been submitted prior to the date of filing or the date of priority of the trade mark, provided that the said designation or indication is subsequently registered and the registration confers the right to prohibit the use of the later trade mark.

A trade mark shall also not be registered when the trade mark is liable to be confused with an earlier trade mark protected abroad, provided that the application for registration was submitted in bad faith by the applicant.

Earlier trade mark within the meaning of subsection 1, paragraphs 1–2 means:

- 1) a national trade mark or application for a trade mark with an earlier date of filing or otherwise with an earlier priority;
- 2) a trade mark that has become established at the date of filing or date of priority;
- 3) an EU trade mark or application for an EU trade mark with an earlier date of filing or otherwise with an earlier priority;
- 4) an EU trade mark that has the seniority provided in Article 39 or 40 of the EU Trade Mark Regulation over a national trademark or over an international registration designating Finland; or
- 5) an international registration designating Finland or the European Union with a prior date of registration or date of filing of extension request or otherwise with an earlier priority.

Notwithstanding the provisions of subsection 1, paragraphs 1–8 and subsection 2, a trade mark may be registered with the consent of the person whose right is concerned. A trade mark shall not be invalidated pursuant to subsection 1, paragraphs 1–9 when the person whose right is concerned has given consent.

Section 14

Precedence of earlier legal grounds

If several parties claim exclusive rights to trade marks that are identical or similar in the manner laid down in section 5, the party able to invoke the earliest legal grounds shall have precedence.

Section 15

Effects of passivity on the part of the proprietor of the trade mark

Exclusive rights to a trade mark shall be retained alongside an earlier trade mark if

- 1) the later trade mark registration application was filed in good faith or the later established trade mark was introduced in good faith; and
- 2) the proprietor of the earlier trade mark, within five years of learning of the use of the later trade mark, has not taken action to prevent the use of the later trade mark.

If a trade mark registered later was only used for some of the goods or services for which it was registered, the later exclusive rights shall apply to use of the trade mark only in respect of the said goods or services.

Chapter 4

Registration of a trade mark

Application procedure

Section 16

Applying for registration

The application for the registration of a trade mark shall be filed electronically with the Finnish Patent and Registration Office. For a particular reason, the Finnish Patent and Registration Office may accept the filing of an application on paper.

The application for registration shall include:

- 1) the identification details of the applicant;
- 2) a list of the goods or services for which the registration is sought; and
- 3) a representation of the trade mark that satisfies the requirements laid down in section 11, subsection 1, paragraph 2.

The date of filing of the trade mark is the date on which the applicant submits to the Finnish Patent and Registration Office an application that satisfies the requirements laid down in subsection 2 and pays the application fee.

The trade mark application may also be filed in English, in which case the applicant shall choose either Finnish or Swedish as the processing language for the application.

Section 17

Classification of goods and services

The system of classification established by the edition and version valid at the date of filing of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 ('the Nice Classification') shall be applied to the classification of the goods and services.

The applicant shall classify and group the goods and services for which registration is sought in accordance with the Nice Classification and with sufficient clarity and precision to enable the extent of the protection sought to be determined.

The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term.

Section 18

Priority based on a foreign application

An application for the registration of a trade mark filed in Finland shall be deemed to have been filed simultaneously with an application for an EU trade mark or an application filed in another State when the registration in Finland is sought within six months of the filing of the EU trade mark application or the filing of the application in another State that has acceded to the Paris Convention for the Protection of Industrial Property (Treaty Series 43/1975) or the Agreement Establishing the World Trade Organization (Treaty Series 5/1995). The provisions laid down in this subsection shall also apply when registration of a trade mark is sought with an application filed outside Finland that the Finnish Patent and Registration Office for particular reasons deems to be equivalent with an application filed in a contracting State.

In order to obtain the priority referred to in subsection 1, the applicant shall request the priority in writing in an application as provided in section 16, subsection 1, and shall on the same occasion state the place and time of the filing of the application claimed as the basis for the priority and also, as soon as possible, give its application number. When the priority does not concern all goods or services, the goods and services which it does concern shall moreover be stated.

Priority can only be based on the first application for registration referred to in subsection 1.

Section 19

Priority based on display at an international exhibition

If an applicant has used the trade mark for the first time on a good or service displayed at an international exhibition and the application for the registration of the trade mark is filed within six

months of the date of the first display of the good or service, the application shall be deemed to have been filed on the said date of display.

The request for priority shall be made in an application as provided in section 16, subsection 1, and the time and place of the display of the good or service shall be stated on the same occasion. When the priority does not concern all goods or services, the goods and services which it does concern shall moreover be stated.

Section 20

Division of an application or registration

At the request of the applicant, an application for the registration of a trade mark may be divided into two or more separate applications. The date of filing of the original application shall be deemed to be the date of filing of the applications obtained through division. When some goods or services in the original application have priority that is earlier than the filing date, in the division the priority shall follow these goods or services.

The provisions laid down in subsection 1 concerning the division of an application shall also apply to the division of a registration. In such a case, the request for division may be made by the proprietor of the trade mark.

Section 21

Processing of a deficient application

If an application does not satisfy the requirements laid down in sections 16--19 or if the registration is subject to grounds for refusal under sections 12-13, the Finnish Patent and Registration Office shall impose a time period of two months for the applicant to remedy the deficiency, submit a statement and present information.

If the applicant fails to submit a statement, provide information or remedy the deficiency within the time period imposed, the application shall be dismissed in respect of the parts which the request concerns. The provisions laid down in section 6 of the Act on the Finnish Patent and Registration Office (578/2013) shall apply to appeal against a decision of dismissal. The applicant may also request the continued processing of the application in the manner laid down in section 22.

When there is an impediment to registration subsequent to the statement or information provided by the applicant, the application shall be refused in these respects. However, the Finnish Patent and Registration Office may issue a new request to remedy the application when warranted.

Section 22

Continued processing of an application

If an applicant within the time period imposed for remedying a deficiency, submitting a statement and providing information fails to submit a statement, provide the information or remedy the deficiency, the processing of the application shall nonetheless be continued when the applicant, within two months of the expiry of the time period imposed:

- 1) requests the continued processing of the application;
- 2) in the context of the request submits the statement, provides the information or remedies the deficiencies; and
- 3) in the context of the request pays the fee imposed for continued processing of application.

Section 23

Observations by third parties

Prior to the registration of a trade mark, third parties may submit to the Finnish Patent and Registration Office observations concerning the registrability of the trade mark. Submitting an observation shall not make a person party to the registration proceedings.

Section 24

Registration of a trade mark and publication of registration

When the application satisfies the requirements laid down for it in this Act, the Finnish Patent and Registration Office shall register the trade mark and publish the registration on its website or by other generally accessible means.

Section 25

Alteration of a trade mark

Minor changes that do not alter the overall impression of the trade mark may be made to the trade mark at the request of the applicant for or proprietor of the trade mark.

Section 26

Data contents of the Register of Trademarks, processing of personal information and disclosures of information

The Finnish Patent and Registration Office maintains a Register of Trademarks into which is recorded/entered the information included in the applications and documents submitted to it, the identification and contact information for persons that is necessary for the processing of trade marks, the information concerning the trade mark sought or registered, the information relating to the validity and extent of the trade mark, and the actions taken concerning the trade mark or the trade mark application.

The Finnish Patent and Registration Office processes the identification and contact information concerning persons included in the Register of Trademarks for the following purposes:

- 1) administration of trade marks and trade mark applications in the manner provided in this Act;
- 2) implementation of procedures concerning trade marks in the manner provided in this Act;
- 3) communication with applicants and other parties to the procedures; and
- 4) preparation of reports and statistics.

Notwithstanding the provisions of section 13, subsection 2 and section 16, subsection 3 of the Act on the Openness of Government Activities (621/1999), anyone shall have the right to obtain from the Register of Trademarks copies and information about the name and domicile of a trade mark applicant or proprietor in the form of an individual query over a public information network.

Section 27

Removal of a registration and register entry

Notwithstanding the provisions of section 50, subsection 2 and section 51, subsection 2 of the Administrative Procedure Act (434/2003), the Finnish Patent and Registration Office may remove a registration or an entry made in the register and issue a new decision in the matter to the detriment of the trade mark proprietor without the proprietor's consent when the registration or entry is based on an obvious factual, procedural or typographical error. The removal of the

registration or the entry shall be done within two months of approval of the application for registration or the making of the register entry.

When the Finnish Patent and Registration Office is notified by the International Bureau of an international registration having a protection commencement date earlier than that of the national registration concerning the same trade mark and the goods or services covered by the international registration are identical with those of the national registration either in part or in full, the Finnish Patent and Registration Office shall rescind its decision on the national registration and issue a new decision in the matter.

The provisions laid down in subsection 2 shall apply correspondingly when the Finnish Patent and Registration Office is notified by the European Union Intellectual Property Office (EUIPO) of an application for an EU trade mark or a request for the conversion referred to in section 102.

Section 28

Representatives

A representative may be recorded in the Register of Trademarks who is entitled to represent the applicant for or proprietor of the trade mark in matters concerning the trade mark and to accept, on behalf of the applicant or proprietor, service of notices, invitations and other documents in matters concerning the trade mark with the exception of a criminal summons and an order by which the party concerned is ordered to appear in court in person. The representative may also be a corporation.

An applicant for or proprietor of a trade mark who is not domiciled in the European Economic Area shall have a representative as referred to in subsection 1 who is domiciled in the European Economic Area.

If the applicant for or proprietor of a trade mark referred to in subsection 2 does not have a duly authorised representative, the Finnish Patent and Registration Office shall invite the applicant or proprietor, by using their most recently notified address, to notify of a representative within a time period of two months under pain that otherwise the application is considered to be withdrawn or that the trade mark is removed from the Register of Trademarks.

An opponent who is not domiciled in the European Economic Area shall have a representative who is domiciled in the European Economic Area and who represents the opponent in the opposition. Otherwise the opposition is deemed not to have been filed.

The applicant in an application for revocation or invalidation who is not domiciled in the European Economic Area shall have a representative who is domiciled in the European Economic Area and who represents the applicant in the matter of the revocation or invalidation. Otherwise the application is deemed not to have been filed.

The proprietor of an international registration who is not domiciled in the European Economic Area who wishes to submit a statement to the Finnish Patent and Registration Office shall use for this purpose a representative who is domiciled in the European Economic Area.

In derogation from section 12, subsection 1 of the Administrative Procedure Act, the Finnish Patent and Registration Office may request the representative to provide a power of attorney whenever there is particular cause to suspect the existence or scope of the powers of the representative.

Section 29

Reciprocity and certificate of foreign registration

A trade mark that has been registered in another State may be reciprocally registered in Finland as it is registered in the other State when the registration is not in conflict with the provisions of sections 11–13 and the trade mark retains its distinctive character.

Notwithstanding the provisions laid down in subsection 1, minor changes that do not alter the overall impression of the trade mark may be made when registering a foreign trade mark on the basis of reciprocity.

If the application for the registration of the trade mark is filed by a person who does not carry on business in Finland, the application shall be accompanied by a certificate verifying that the applicant has had the identical trade mark registered for identical goods or services in the other State where the applicant carries on business or in which the applicant is domiciled or holds citizenship.

However, the certificate referred to above in subsection 3 shall not be required when the other State requires no equivalent verification from a person who is a Finnish citizen or who is domiciled or carries on business in Finland.

Section 30

Duration and renewal of a registration

The registration of a trade mark is valid for a period of ten years from the date of filing of the application. A renewal is valid for a period of ten years and it takes effect on the day following the expiry of the registration.

The Finnish Patent and Registration Office notifies the proprietor of the trade mark of the expiry of the registration not less than six months before the end of the registration period. Failure to notify shall not affect the expiry of the validity of the registration, however. The registration may be renewed no earlier than one year before and no later than within six months of the end of the registration period. A renewal taking place after the end of the registration period shall be subject to an increased fee. The application for the renewal of a registration shall be filed in the online service of the Finnish Patent and Registration Office and the renewal fee shall be paid in this context. For a particular reason, the Finnish Patent and Registration Office may accept the filing of a renewal application on paper. If the renewal application filed on paper does not identify the goods or services to which the renewal applies and the fees paid are insufficient to cover the renewal of all goods or services, the goods or services shall be renewed in the order of classification for as long as covered by the fee paid. Provisions on the more specific contents of renewal applications on paper may be issued by Government decree.

When a registration has not been renewed in the manner provided in subsection 2, the trade mark shall be removed from the Register of Trademarks.

Opposition procedure

Section 31

Grounds for opposition

The Finnish Patent and Registration Office may revoke a registration on the basis of opposition to the extent that the registration fails to satisfy the requirements for registration under this Act. When there is no impediment to registration, the opposition shall be rejected.

Section 32

Filing of opposition

Opposition shall be filed within two months of the publication of the registration by notifying the Finnish Patent and Registration Office in writing of the identification information of the opponent, details of the registration and the goods or services covered by the registration against which the opposition is directed, and the grounds for the opposition, and by paying the opposition fee.

Opposition may be directed at all or some of the goods or services for which the trade mark has been registered. When the opposition is based on a prior right, the opponent shall be the proprietor of that right.

Section 33

Suspension of opposition procedure

At the joint written request of the opponent and the proprietor of the trade mark, opposition procedure shall be suspended for a period of two months. Such request shall be submitted to the Finnish Patent and Registration Office while the opposition procedure is ongoing but before the decision in the opposition procedure is issued.

The suspension of the opposition procedure may be extended twice for five months at a time at the joint written request of the parties, which request shall be submitted to the Finnish Patent and Registration Office before the expiry of the ongoing suspension period.

The suspension period shall end by written notice to this effect from either party to the Finnish Patent and Registration Office.

Section 34

Proving genuine use in opposition procedure

The provisions laid down in section 49, subsections 2–5 concerning the duty of the proprietor of an earlier registered trade mark, company name, auxiliary company name and EU trade mark to prove the use of its trade mark, company name or auxiliary company name in the five years preceding the date of filing or date of priority of the application or action for invalidation of the trade mark shall apply in opposition procedure. If the proprietor of the trade mark does not invoke the lack of genuine use of the earlier trade mark, company name, auxiliary company name or EU trade mark when first responding to the opposition, the proprietor is precluded from invoking it at a later date.

Section 35

Service of notice of opposition on a pledgee and licensee

When a pledge right or licence has been recorded in the Register of Trademarks for the trade mark against which opposition is filed, the Finnish Patent and Registration Office shall serve notice of the opposition on the pledgee or licensee and reserve for them an opportunity to respond to the opposition within a specific period of time. Submitting a response shall not make the responding person a party to the opposition procedure in the Finnish Patent and Registration Office.

Chapter 5

Surrender of a trade mark and transfer, pledge and licensing of a trade mark

Section 36

Surrender of a trade mark

The applicant for or proprietor of a trade mark may surrender the trade mark or the application for a trade mark in respect of all or some of the goods or services for which the trade mark is sought or registered or has become established.

A trade mark shall be removed either in part or in full from the Register of Trademarks at the request of the proprietor of the trade mark. When a right of pledge has been recorded for the trade mark, the consent of the pledgee is required for removal from the Register of Trademarks either in part or in full. When a licence has been recorded for the trade mark, before the removal of the trade mark can be recorded in the Register of Trademarks the proprietor of the trade mark shall prove that the licensee has been notified of the surrender.

The provisions laid down in subsection 2 concerning removal of a trade mark from the Register of Trademarks shall apply to the surrender of a trade mark application and its withdrawal from the Register of Trademarks.

Section 37

Transfer of a trade mark

A trade mark or an application for a trade mark may be transferred. The transfer may concern all or some of the goods or services for which the trade mark is sought or registered or has become established.

Unless otherwise agreed or clearly indicated by the circumstances, a trade mark and an application for a trade mark shall transfer in connection with the transfer of an undertaking.

Section 38

Register entry on transfer of a trade mark

Upon request, the transfer of a registered trade mark or an application for a trade mark shall be recorded in the Register of Trademarks. Such request may be made by the applicant for or proprietor of the trade mark or by the transferee.

When the trade mark when used by the transferee becomes misleading, the transfer shall not be recorded unless the misleading character is eliminated by altering the trade mark or amending the application for the trade mark.

A transfer that has not been recorded in the Register of Trademarks shall not be binding towards a third party acting in good faith or the creditors of the applicant for or proprietor of the trade mark.

Section 39

Pledging a trade mark

A trade mark or an application for a trade mark may be pledged.

A pledgee may institute trade mark infringement proceedings if the proprietor of the trade mark, after learning of the trade mark infringement, does not itself bring infringement proceedings within a reasonable period of time, or unless otherwise agreed.

Section 40

Register entry on pledging

Upon request, the pledging of a registered trade mark or an application for a trade mark shall be recorded in the Register of Trademarks. Such request may be made by the applicant for or proprietor of the trade mark or by the pledgee.

A pledge that has not been recorded in the Register of Trademarks shall not be binding towards a third party acting in good faith or the creditors of the applicant for or proprietor of the trade mark.

The entry on pledging shall be removed from the Register of Trademarks when the pledge is established to have expired, or at the request of the pledgee.

Section 41

Foreclosure of a trade mark and bankruptcy

The right to a trade mark or an application for a trade mark may not be foreclosed on unless a right of pledge to it has been created and recorded.

If the assets of the applicant for or proprietor of a trade mark are surrendered into bankruptcy, the trade mark shall belong to the bankruptcy estate.

Section 42

Licence

The proprietor of or applicant for a trade mark may grant to another the right to use the trade mark (*licence*).

A licensee may transfer its rights onward only when this has been agreed.

The proprietor of the trade mark may invoke the rights conferred by the trade mark against a licensee who violates the provisions of the licensing contract in respect of the following:

- 1) the duration of the licensing contract;
- 2) the form covered by the registration in which the trade mark may be used;
- 3) the scope of the goods or services covered by the licence;
- 4) the territory in which the trade mark may be affixed;
- 5) the quality of the goods manufactured or services provided by the licensee.

The licensee may institute trade mark infringement proceedings only with the consent of the proprietor of the trade mark, or unless otherwise agreed. However, the holder of an exclusive licence may institute such proceedings if the proprietor of the trade mark, after learning of the trade mark infringement, does not itself bring infringement proceedings within a reasonable period of time.

A licensee shall be entitled to intervene in infringement proceedings brought by the proprietor of the trade mark and to claim damages for the harm suffered by the licensee.

Section 43

Register entry on a licence

Upon request, the licensing of a registered trade mark or an application for a trade mark shall be recorded in the Register of Trademarks. Such request may be made by the applicant for or proprietor of the trade mark or by the licensee.

A licence that has not been recorded in the Register of Trademarks shall not be binding towards a third party acting in good faith or the creditors of the applicant for or proprietor of the trade mark.

The entry on licence shall be removed from the Register of Trademarks when the licence is established to have expired, or at the request of the licensee.

Section 44

Requests for register entries and amendments

An entry on the transfer, pledging or licensing of a trade mark or an application for a trade mark or another amendment concerning the trade mark application or trade mark registration may be

requested from the Finnish Patent and Registration Office. Provisions on the more specific content of such requests and the documents that shall accompany such requests shall be laid down by Government Decree.

When a request is deficient or the requesting party fails to pay the fee charged for the request, the Finnish Patent and Registration Office shall impose a time period of two months for remedying the deficiency, submitting a statement and providing information. The provisions laid down in section 21, subsections 2 and 3 concerning dismissal and refusal of deficient application and in section 22 concerning continued processing of application shall apply to the processing of requests.

Section 45

Applicant for and proprietor of a trade mark

In civil and other cases concerning a trade mark, the proprietor of the trade mark shall be deemed to be the person most recently entered as such in the Register of the Trademarks. In civil and other cases concerning an application for a trade mark, the applicant for the trade mark shall be deemed to be the person most recently entered as such in the Register of Trademarks. In civil and other cases concerning an international registration, the proprietor of the trade mark shall be deemed to be the person most recently entered as such in the International Bureau's register of trademarks.

Chapter 6

Revocation and invalidation of a trade mark

Grounds for revocation and invalidation and their effects

Section 46

Lack of genuine use

The registration of a trade mark may be revoked if the proprietor of the trade mark, within five years of the registration, has not taken the trade mark into genuine use in the goods or services for which it was registered, or if such use has been suspended for five successive years, unless the proprietor can establish proper reasons for non-use.

The period of time referred to above in subsection 1 of five years from registration is calculated from the date on which opposition against the trade mark can no longer be filed or, if opposition was filed, the date on which the decision concluding the opposition procedure became final or on which the opposition was withdrawn. With regard to international registrations, the period of five years from registration is calculated from the date on which the trade mark can no longer be refused or on which opposition against it can no longer be filed. If opposition has been filed, the period of five years shall be calculated in the manner laid down above in this subsection. If the Finnish Patent and Registration Office has notified of refusal on absolute or relative grounds, the time period of five years shall be calculated from the date on which the refusal became final.

The following shall also constitute genuine use of the trade mark:

- 1) using the trade mark in a form that differs from the registered trade mark only in such respects that the difference does not affect the distinctive character of the trade mark;
- 2) affixing the trade mark on goods or their packaging for export only; or
- 3) using the trade mark with the consent of its proprietor.

However, a registration shall not be revoked if the trade mark has been in genuine use after the end of the five-year period of non-use but before any application or action for revocation was filed. In such a case, any such use of the trade mark that took place during the three months preceding the filing of the application or action for revocation shall be disregarded if the preparations for such use commenced only once the proprietor of the trade mark became aware that an application or action for revocation may be filed.

If the genuine non-use of the registration concerns only some of the goods or services for which the trade mark is registered, the registration may be revoked only in respect of these goods or services.

Section 47

Trade mark having become generic or misleading

Exclusive rights to a trade mark may be revoked if, subsequent to registration or establishment, the trade mark:

- 1) as a result of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered or has become established; or

2) as a result of the use made of it by the proprietor of the trade mark or with the proprietor's consent it is has become misleading.

When a ground for revocation under subsection 1 concerns only some of the goods or services for which the trade mark is registered or for which the trade mark has become established, exclusive rights to the trade mark may be revoked only in respect of these goods or services

Section 48

Invalidation on absolute and relative grounds for invalidation

The provisions on the grounds for the invalidation of a trade mark are laid down in sections 12 and 13 and on the effects of the passivity of the proprietor of the trade mark on invalidation in section 15. In invalidation, regard shall moreover be had to any changed circumstances.

Section 49

Proving genuine use in invalidation procedures

If invalidation is claimed on the basis of a trade mark registered earlier, the proprietor of the earlier registered trade mark shall, at the request of the proprietor of the later trade mark, prove that the earlier trade mark was in genuine use, in the manner provided in section 46, during the period of five years preceding the date of the filing of the application or action for invalidation in those goods or services on which the application or action is based, or that there were proper reasons for non-use. The proprietor of the trade mark registered earlier shall prove use if the registration procedure in the earlier trade mark was completed not less than five years prior to the filing of the application or action for invalidation.

If the period of five years referred to in section 46 had ended before the date of filing or date of priority of the later trade mark, the proprietor of the earlier trade mark shall additionally prove that the earlier trade mark had been taken into genuine use during the period of five years preceding the date of filing or date or priority or that there were proper reasons for non-use.

In the consideration of an application or action for invalidation, regard shall be had of the earlier trade mark only in respect of those goods or services in which its use has been proved in accordance with subsection 1 or 2 or in respect of which there are proper reasons for non-use.

If the proprietor of the earlier trade mark does not prove that the earlier trade mark was used in accordance with subsection 1 or 2, the application or action for invalidation shall be rejected.

The provisions laid down in subsections 1–4 concerning a trade mark registered earlier shall also apply to a company name and an auxiliary company name registered earlier. The provisions on the genuine use of a company name are laid down in section 19, subsection 2, paragraph 3 of the Trade Names Act (128/1979). Subsections 1–4 of this section shall also apply when the earlier trade mark is an EU trade mark. The provisions on the genuine use of an EU trade mark are laid down in Article 18 of the EU Trade Mark Regulation.

Section 50

Lack of distinctive character or lack of reputation of an earlier trade mark as an impediment to the invalidation of a registered trade mark

A trade mark cannot be invalidated on the basis of an earlier trade mark if at the date of filing or date of priority of the later trade mark:

- 1) the earlier trade mark, liable to be invalidated pursuant to section 12, subsection 1, paragraph 3, had not yet acquired a distinctive character as referred to in section 12, subsection 3;
- 2) the application or action for invalidation is based on section 13, subsection 1, paragraph 2, and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 13, subsection 1, paragraph 2; or
- 3) the application or action for invalidation is based on section 13, subsection 1, paragraph 3 and the earlier trade mark had not yet acquired a reputation.

Section 51

Consequences of revocation and invalidity

A registered or established trade mark shall be deemed not to have had, as from the date of the application or action for revocation, the effects specified in this Act, to the extent that the rights of the proprietor have been revoked. An earlier date on which one of the grounds for revocation occurred may be fixed in the decision on the revocation, at the request of the claimant or the applicant.

A registered trade mark shall be deemed not to have had, as from the outset, the effects specified in this Act, to the extent that the trade mark has been invalidated.

A trade mark that has been revoked or invalidated shall be removed from the Register of Trademarks to the extent that it has been revoked or invalidated.

Section 52

Establishment a posteriori of invalidity or revocation of a trade mark

If a national trade mark or an international registration in effect in Finland has been the basis for the claim of seniority of an EU trade mark and the trade mark or the international registration has been surrendered or its validity has been allowed to lapse, its revocation or invalidity may be established a posteriori, provided that the revocation or invalidity could also have been invoked at the time when the trade mark was surrendered or its validity expired. In such a case, the seniority shall cease to produce its effects.

Processing of revocation and invalidation of a trade mark

Section 53

Procedure

The revocation or invalidation of a trade mark may be claimed with an application in administrative procedure or with an action in a court of law. The provisions on the processing of cases of revocation and invalidation in the Finnish Patent and Registration Office on the basis of an application are laid down in sections 54–57 and in a court on the basis of an action in sections 58–60.

Section 54

Application

The administrative trade mark revocation or invalidation procedure is initiated by submitting to the Finnish Patent and Registration Office a written application and paying the application fee. The application shall state the claim and the grounds for it, give the applicant's identification details and specify the registration and the goods or services covered by the registration which the application concerns.

When a claim of invalidation is based on a prior right, the application may only be filed by the proprietor of that right.

The administrative trade mark revocation or invalidation procedure may only be initiated after expiry of the period for filing opposition provided in section 32, subsection 1. When opposition has been filed, the procedure may be initiated once the decision concluding the opposition procedure has become final or the opposition has been withdrawn.

Section 55

Service on the proprietor of a trade mark

The Finnish Patent and Registration Office shall serve in a verifiable manner the application referred to in section 54, subsection 1 on the proprietor of the trade mark or, if a representative has been recorded in the Register of Trademarks in accordance with section 28, subsection 1, on this representative, and invite the proprietor of the trade mark to respond to the application within the deadline. If the proprietor submits no response, the Finnish Patent and Registration Office may nonetheless examine and decide the matter.

If the proprietor of the trade mark does not invoke lack of genuine use of earlier trade mark, company name, auxiliary company name or EU trade mark as referred to in section 49 when first responding to the application, the proprietor is precluded from invoking it at any later date.

Section 56

Service on a pledgee and licensee

When a right of pledge or a licence is recorded in the Register of Trademarks for the trade mark concerned in the application for revocation or invalidation, the Finnish Patent and Registration Office shall serve the application on the pledgee or licensee and reserve for them an opportunity to respond to the application within the deadline. Submitting a response does not make the responding person a party to the proceedings in the Finnish Patent and Registration Office.

Section 57

Decision on application

The decision shall be taken on the basis of the application and the responses submitted in consequence of it.

When the revocation application is based on a lack of genuine use of the trade mark and the proprietor of the trade mark has failed to prove the genuine use of the trade mark, the trade mark registration shall be revoked, either in part or in full, as requested in the application, unless the application is manifestly baseless.

Section 58

Bringing an action

An action for the revocation or invalidation of a trade mark shall be instituted in court by bringing an action against the proprietor of the trade mark.

When the action is based on section 12, subsection 1, paragraph 4, the proceedings may also be instituted by the prosecutor.

When the claim for invalidation is based on a prior right, the action may only be brought by the proprietor of that right.

Section 59

Transfer of a trade mark during legal proceedings

An action for the revocation or invalidation of a trade mark may be pursued against the original defendant even if the trade mark is transferred to another subsequent to the initiation of the legal proceedings. A judgment to grant the action shall be effective also against the transferee.

Section 60

Adjournment of proceedings

At its discretion, the court may adjourn the proceedings in a trade mark revocation or invalidation case instituted before the opposition period following the grant of the trade mark has ended or before a final decision on opposition has been issued.

Section 61

Lis pendens and res judicata

An application for the revocation or invalidation of a trade mark shall not be taken under examination by the Finnish Patent and Registration Office when an action between the same parties and concerning the same trade mark is pending in court.

An application for the revocation or invalidation of a trade mark shall lapse in the Finnish Patent and Registration Office when an action between the same parties and concerning the same trade mark is brought in court.

The action for the revocation or invalidation of a trade mark referred to above in section 58 shall be declared inadmissible by the court when an application as referred to in section 54 concerning the same parties and the same trade mark has resulted in the issue of a decision that may be or has been appealed against and a final decision on the appeal is yet to be issued.

When a final decision has been issued on an application or action for the revocation or invalidation of a trade mark, a new application or action for revocation or invalidation shall be declared inadmissible when the case involves the same parties, the same trade mark, the same claim and the same grounds, unless there has been a material change in the circumstances.

Chapter 7

Consequences of infringement of trade mark right and jurisdiction of courts

Consequences of infringement of trade mark right

Section 62

Prohibition

When a person infringes the exclusive rights to a trade mark, the court may prohibit that person from continuing or repeating the act under pain of a penalty.

The prohibition referred to above in subsection 1 may also be directed at a person who has taken preparatory action to infringe the exclusive rights to a trade mark.

Section 63

Exceptions to prohibition

A court may not prohibit the use of a later trade mark when:

- 1) the proprietor of the earlier trade mark has been passive in the manner laid down in section 15;
- 2) the later trade mark would not be liable to invalidation because of the lack of genuine use of the earlier trade mark or EU trade mark in the manner laid down in section 49; or
- 3) the later trade mark would not be liable to invalidation because one of the grounds laid down in section 50 precluding the invalidation of the later trade mark is at hand.

A court may not prohibit the use of an EU trade mark registered later when the said later trade mark would not be liable to invalidation pursuant to Article 60(1)(a–c) and (3–4), Article 61(1 or 2) or Article 64(2).

A court may not prohibit the use of the earlier trade mark in the situations referred to in subsections 1 and 2 even if the prior right could not be invoked against the later trade mark.

Section 64

Injunction

When hearing an infringement action as referred to in section 62, subsection 1 the court may, at the request of the proprietor of the trade mark, enjoin the keeper of a transmitter, server or other similar device or other service provider acting as an intermediary, under penalty of a fine, from continuing the allegedly infringing use of the trade mark (*injunction*). The issue of an injunction is conditional upon the injunction not being considered unreasonable in view of the rights of the alleged infringer of the trademark, the intermediary or the proprietor of the trade mark. An injunction may not jeopardise the right of a third party to send and receive messages.

Before the bringing of an action referred to above in subsection 1, the court may, on the application of the proprietor of the trademark, issue an injunction if the conditions for it set out in subsection 1 exist and if it is apparent that the realisation of the rights of the proprietor of the trade mark would otherwise be seriously jeopardised.

The court shall reserve both the intermediary and the alleged infringer an opportunity to be heard. Service on the intermediary may be accomplished by mail, email or other electronic means of effecting service.

Upon request, the court may issue the injunction referred to in subsection 2 as an interim order under pain of a penalty without hearing the alleged infringer when this is required of necessity by the urgency of the case. An interim injunction shall remain in effect until other disposition is made in the matter. Subsequent to the issue of an interim injunction, the alleged infringer shall without delay be reserved an opportunity to be heard. Once the alleged infringer has been heard, the court shall without delay decide whether to maintain the injunction or to withdraw it.

An injunction shall take effect when the applicant lodges with the bailiff the security referred to in chapter 8, section 2 of the Enforcement Code (705/2007). Provisions on the possibility of being released from the lodgement of security are laid down in chapter 7, section 7 of the Code of Judicial Procedure (4/1734). An injunction issued pursuant to subsection 2 or 4 above shall lapse if the action referred to in subsection 1 is not brought in a court within one month of the date of issue of the injunction.

The party which requested the injunction shall compensate the party against whom the injunction was issued as well as the alleged infringer for any harm arising from the enforcement of the injunction and for the costs incurred in the matter if the action referred to in subsection 1 is dismissed or declared inadmissible or if the case is removed from the docket because the claimant has withdrawn its action or failed to appear in court. The same applies if the injunction is withdrawn pursuant to subsection 4 or lapses pursuant to subsection 5. The provisions of chapter 7, section 12 of the Code of Judicial Procedure shall apply to bringing an action for compensation of damages and costs.

Section 65

Prohibiting the use of a misleading trade mark

If a trade mark is misleading or if the proprietor of the trade mark or another person with the proprietor's consent uses the trade mark in a way as to mislead the public, the court to the extent deemed necessary may prohibit the use of the trade mark under pain of a penalty.

Section 66

Trade mark registered without consent in the name of a representative

If a trade mark is registered in the name of the proprietor's representative without the proprietor's consent, the proprietor shall have the right to prohibit the representative from using the trade mark. The representative may also be ordered to transfer a trade mark registered in its name to the proprietor of the trade mark. The provisions laid down in sections 38 and 44 shall apply to the transfer of the trade mark.

The provisions of subsection 1 shall not apply when the representative had a valid reason for its action.

Section 67

Proving genuine use in a prohibition case

The provisions laid down in section 49 concerning the burden of proof on the proprietor of the earlier trade mark and EU trade mark shall apply to the duty of the claimant to prove, at the request of the proprietor of the later trade mark, the genuine use of its trade mark or EU trade mark during the period of five years preceding the institution of the proceedings. The claimant shall furnish proof of use when the registration procedure in the claimant's trade mark or EU trade mark was concluded not less than five years prior to the institution of the proceedings. A court may not prohibit the use of the later trade mark to the extent that a claim of revocation could be made against the right of the claimant pursuant to section 46 at the time of the institution of the infringement proceedings.

Section 68

Action for declaratory judgment

By an action for declaratory judgment a court may declare whether the right to the trade mark exists or whether given conduct infringes the exclusive rights to the trade mark.

A pledgee may bring an action for declaratory judgment subject to the conditions laid down in section 39, subsection 2. A licensee may bring an action for a declaratory judgment subject to the conditions laid down in section 42, subsection 4.

Section 69

Compensation and damages

Anyone who intentionally or through negligence infringes the exclusive rights to a trade mark shall be liable to pay to the infringed party reasonable compensation for the use of the trade mark as well as compensation for all damage caused by the infringement. In the event of only slight negligence the compensation may be adjusted.

In the absence of even negligence the infringer shall be liable to pay reasonable compensation for the use of the trade mark.

Section 70

Statute of limitations on right to compensation and damages

Compensation and damages may be claimed pursuant to section 69 only for the five years preceding the institution of proceedings. The right to compensation and damages shall be forfeited if an action for these has not been instituted within five years of the damages arising.

Where a registered trade mark is concerned, compensation and damages may be claimed, notwithstanding the provisions laid down in subsection 1 concerning the time limit for bringing an action, for an infringement taking place prior to the date of registration when the proceedings are instituted within one year of the date of registration. In such a case, compensation and damages may also only be claimed for the five years preceding the institution of the proceedings.

Section 71

Alteration and destruction sanctions

When a request to this effect is made by the proprietor of the trade mark, the court may order that the infringing mark is to be removed from the property to which it is affixed or that the mark is to be altered in a way as to prevent its further misuse. If such a measure is not feasible, the property to which the infringing mark is affixed shall be ordered to be destroyed or altered in a specific way. In such a case, the court may also upon request order that the property is to be handed over to the infringed party against compensation.

Regardless of whether the infringement was intentional, the property to which the infringing mark is affixed may, by decision of the court, be confiscated when the infringed party requests this and,

when deemed necessary, lodges acceptable security for the costs arising from the confiscation and the harm which the opposing party may suffer due to the confiscation. The provisions laid down in chapter 7 of the Coercive Measures Act (806/2011) concerning confiscation shall apply to the confiscation.

When prohibiting, pursuant to section 65, the use of a trade mark, the court may order that a mark used in violation of the prohibition is to be removed from the property to which it is affixed or that the mark is to be altered so as to no longer be misleading. If such a measure is not feasible, the marked property shall be ordered to be destroyed or altered in a specific way.

Section 72

Publication of judgments

At the request of the claimant in a civil case concerning trade mark infringement the court may order that the defendant is to compensate for the costs arising to the claimant from taking appropriate action to publish information of a final judgment in which the defendant is found to have infringed the exclusive right to a trade mark. Such an order may not be issued if disclosure of the information is restricted under another Act. When considering the issuance and contents of the order, the court shall have regard to the general significance of the publication, the nature and scope of the infringement, the costs arising from publication and other equivalent factors.

The court shall impose a ceiling on the reasonable costs of publication for which the defendant is liable to compensate. The claimant shall not be entitled to compensation if information about the judgment has not been made public within the period of time specified by the court from the judgment becoming final.

Section 73

Parallel rights

In the cases referred to in section 8, subsection 1 or section 15, the court may order that one or both of the trade marks may only be used when formed in a specific manner, by adding to them the name of a location or of the proprietor of the trade mark, or by limiting the use of the trade mark to certain goods or services, a certain territory, or in another equivalent manner.

Section 74

Trade mark violation

Anyone who intentionally infringes the exclusive rights to a trade mark provided in sections 3–9 or the exclusive rights to an EU trade mark provided in the EU Trade Mark Regulation by using, without the consent of or in violation of a prohibition issued by the proprietor of the trade mark or the EU trade mark or by other comparable means, a mark, sign or indication that is identical or similar, causes a likelihood of confusion or is indistinguishable in essential respects, shall be sentenced, unless the act is punishable as an intellectual property offence as referred to in chapter 49, section 2 of the Criminal Code of Finland (39/1889), to a penalty for a *trade mark violation*.

The charge for a trade mark violation may be brought by the prosecutor only when a request to this effect is made by the injured party.

In cases involving the infringement of a right based on a registered trade mark, a sentence shall be imposed only if the infringement takes place after the date of registration.

Court jurisdiction

Section 75

Jurisdiction of the Market Court

Civil cases and non-contentious civil cases based on this Act shall be heard by the Market Court. The provisions on proceedings in the Market Court in civil and non-contentious civil cases are laid down in the Market Court Proceedings Act (100/2013).

The Market Court acts as the EU trade mark court referred to in Article 123 of the EU Trade Mark Regulation.

The provisions on appeal against a decision of the Finnish Patent and Registration Office in a matter concerning a trade mark are laid down in section 6 of the Act on the Finnish Patent and Registration Office. The provisions on proceedings in the Market Court in appeal cases are laid down in the Market Court Proceedings Act.

Section 76

Jurisdiction of Helsinki District Court

A charge of industrial property offence infringing the exclusive right to a trade mark, as referred to in chapter 49, section 2 of the Criminal Code of Finland, and of the trade mark violation referred to in section 74, subsection 1 of this Act shall be heard by Helsinki District Court.

Notwithstanding the provisions laid down in section 75, a claim for compensation and damages under section 69 and a claim under section 71, subsections 1 and 2 arising from the criminal offence charged may be heard in conjunction with the charge referred to above in subsection 1.

The court shall retain jurisdiction to hear a claim referred to in subsection 2 even if changes in the circumstances establishing jurisdiction take place subsequent to the filing of the claim.

Section 77

Opinion of the Finnish Patent and Registration Office

The provisions laid down in chapter 4, section 22 of the Market Court Proceedings Act concerning the right of the Market Court to request an opinion shall apply to the right of the court hearing a case as referred to above in section 76 to request an opinion from the Finnish Patent and Registration Office.

Section 78

Consultation of an expert

In cases concerning an intellectual property offence or trade mark violation, the District Court may be assisted by no more than two experts who shall be persons as referred to in chapter 17, section 10, subsection 2 of the Courts Act (673/2016).

The expert shall provide the District Court with a written opinion on the questions put to them by the District Court. The expert shall be entitled to put questions to the parties and to witnesses. Before deciding a case, the District Court shall reserve for the parties an opportunity to respond to the expert's opinion.

The provisions laid down in chapter 17, section 22 of the Courts Act concerning the fees for expert members shall apply to the fee of the expert.

Section 79

Notification to the Finnish Patent and Registration Office of the filing of actions and the decisions thereon

The Market Court shall notify the Finnish Patent and Registration Office of the filing of an action for the revocation or invalidation of a trade mark as provided in section 58, an action for declaratory judgment as provided in section 68, and an action concerning transfer of trade mark as provided in section 66. The Finnish Patent and Registration Office shall record the pending action in the Register of Trademarks.

The provisions laid down in chapter 4, section 23 of the Market Court Proceedings Act concerning the duty of the Market Court to provide notice of a decision shall apply to the duty of a court hearing a case as referred to in section 76 above to notify the Finnish Patent and Registration Office of its decision.

Chapter 8

Collective marks and certification marks

Section 80

Collective mark and certification mark

This Act and the provisions issued pursuant to it shall apply to collective marks and certification marks, subject to the provisions laid down in this chapter.

Exclusive rights to a collective mark may only be obtained by a legal person that has members.

Exclusive rights to a certification mark may only be obtained by registration. The applicant for or proprietor of a certification mark shall inspect or supervise the goods or services specified in the application for the certification mark or issue regulations concerning these, and the applicant or proprietor may not carry on a business involving the supply of goods or services of the kind certified.

Section 81

Application for a collective or certification mark

Information about the nature of the applicant's activities shall accompany the application for a collective mark or certification mark. The application shall also be accompanied by the articles of association of the legal person. No explanation or articles of association need be submitted when the Finnish Patent and Registration Office can access the said information from the registers available to it.

The application for a collective or certification mark shall be accompanied by the regulations governing the use of the mark which indicate the parties authorised to use the mark as well as the other conditions of the use of the mark, including the sanctions for use in violation of the regulations. The regulations governing the use of collective marks shall furthermore indicate the requirements for becoming a member in the legal person.

The regulations governing use shall comply with law, public policy and accepted principles of morality.

Section 82

Amendment of the regulations governing use

The proprietor of a collective or certification mark shall notify the Finnish Patent and Registration Office of any amendment to the regulations governing use referred to in section 81, subsection 2.

The amended regulations shall satisfy the requirements under section 81, subsections 2 and 3, and they shall take effect as of the date on which the amendment is approved and recorded in the Register of Trademarks.

Section 83

Supplementary grounds for refusal and invalidation

In addition to the provisions laid down in this Act concerning the grounds for the refusal and invalidation of a trade mark, the application for a collective or certification mark shall be refused or its registration shall be invalidated if:

1) the application or the registration does not satisfy the requirements laid down in section 80, subsections 2 or 3, or in section 81;

- 2) the collective mark is liable to mislead the public in respect of its nature or significance, in particular if it is liable to appear to be a mark other than a collective mark; or
- 3) there is already in the Register of Trademarks an earlier application for or registration of the identical trade mark for the identical goods or services.

Section 84

Supplementary grounds for revocation

In addition to the provisions laid down in sections 46 and 47, the exclusive rights to a collective or certification mark may be revoked if:

- 1) the proprietor of the collective or certification mark does not take reasonable action to prevent use of the mark that is contrary to the regulations governing use; or
- 2) the amendment of the regulations governing use has been recorded in the Register of Trademarks in violation of section 82, subsection 2, unless the proprietor of the collective or certification mark satisfies the requirements under the said provision by making a new amendment to the regulations governing use.

Additionally, the exclusive rights to a collective mark may be revoked if the use of the collective mark by those authorised to use it has led to the collective mark being liable to mislead the public in respect of its nature or significance, in particular if it is liable to appear to be a mark other than a collective mark.

Section 85

Genuine use of a collective or certification mark

The use of a collective or certification mark by a party authorised to do so shall also constitute genuine use of the collective or certification mark.

Section 86

Conversion of type of mark

A trade mark may be converted to a collective or certification mark provided that the requirements laid down in section 80, subsections 2 or 3 are satisfied and the mark is not subject to the grounds for refusal or invalidation laid down in section 83. A collective mark may be converted into a

certification mark provided that the requirements under section 80, subsection 3 and section 81 are satisfied. A collective mark may also be converted into a trade mark.

A certification mark may not be converted into a trade mark or into a collective mark.

Section 87

Right of action against infringement of collective or certification mark

A party authorised to use the collective or certification mark may institute proceedings in the infringement of the collective or certification mark only with the consent of the proprietor of the collective or certification mark, unless otherwise agreed. However, a party authorised to use the collective or certification mark may institute legal proceedings if the proprietor of the collective or certification mark, after becoming aware of the infringement of the collective or certification mark, does not itself bring infringement proceedings within an appropriate period.

The proprietor of a collective or certification mark may claim damages on behalf of a party authorised to use the mark for damage suffered by that party. A party authorised to use the collective or certification mark shall have the right to intervene in infringement proceedings brought by the proprietor of the collective or certification and claim damages for the harm suffered by the party.

Chapter 9

International registrations

International registration system

Section 88

Approval and publication of an international registration

An international registration shall be registered by the International Bureau in accordance with the Protocol of 27 June 1989 relating to the Madrid Agreement Concerning the International Registration of Marks of 14 April 1891 (*Madrid Protocol*). The Finnish Patent and Registration Office deals with international registration duties in Finland and publishes on its website or by other generally accessible means the international registrations in effect in Finland.

This Act and the provisions issued pursuant to it shall apply to international registrations, subject to the provisions laid down in this chapter.

Application for an international registration based on a Finnish trade mark or application for a trade mark

The application for an international registration based on a Finnish trade mark registration or a pending application for a trade mark may be filed by Finnish citizens and persons domiciled in Finland and by corporations that carry on ongoing business in Finland. The procedure for applying for an international registration is to submit to the Finnish Patent and Registration Office an application in English in the form required by the International Bureau and to pay the application fee.

Section 90

Requirement of correspondence in international application

The Finnish Patent and Registration Office shall verify that the international application corresponds to the applicant's Finnish trade mark application or trade mark registration.

When the correspondence referred to in subsection 1 is absent or the application fails to satisfy the requirements laid down in section 89, the Finnish Patent and Registration Office shall invite the applicant to remedy the international application under pain that the application shall otherwise be dismissed.

When the correspondence referred to in subsection 1 is present, the Finnish Patent and Registration Office shall submit a certificate of correspondence to the International Bureau together with the international application.

Section 91

Notification of expiry of the validity of a national registration

If the validity of the national registration or the pendency of the national application on which the international registration is based has expired within five years of the date of registration issued by the International Bureau, the Finnish Patent and Registration Office shall notify the International

Bureau and request that the international registration be revoked in the register of the International Bureau in the corresponding respects.

International registration designating Finland

Section 92

Examination of an international registration

When the Finnish Patent and Registration Office is notified by the International Bureau of an international registration designating Finland, the Finnish Patent and Registration Office shall examine whether there is any impediment to the validity of the registration in Finland.

If the trade mark that is subject to international registration does not satisfy the requirements for registration under this Act, the Finnish Patent and Registration Office shall submit to the International Bureau a notification of refusal, inclusive of grounds, within 18 months of the notification by the International Bureau referred to in subsection 1.

If the proprietor of the international registration submits a response in consequence of the notification under subsection 2 by the Finnish Patent and Registration Office and the response does not remedy a defect pointed out in the notification of refusal or put forward facts on the basis of which the trade mark could be found to satisfy the requirements for registration under this Act, the Finnish Patent and Registration Office shall issue a decision that the international registration is not valid in Finland or that it is valid only in part.

If the proprietor of the international registration fails to submit a response within the deadline imposed, the international registration shall not take effect in Finland in respect of the parts pointed out in the notification.

The Finnish Patent and Registration Office shall publish an international registration on its website or by other generally accessible means to the extent that there is no impediment to registration. When a final decision has been issued in the matter, the Finnish Patent and Registration Office shall notify to the International Bureau the parts of the international registration that are valid in Finland or notify that the international registration is not valid at all in Finland, and make the corresponding entries in the Register of Trademarks.

Section 93

Opposition against an international registration

When opposition is filed against an international registration, the Finnish Patent and Registration Office shall notify the International Bureau of the opposition and the grounds for it.

If the international registration does not satisfy the requirements for registration under this Act, the Finnish Patent and Registration Office in consequence of the opposition filed shall decide that the international registration is no longer valid in Finland or that it is only valid in part. If there is no impediment to the international registration in Finland, the opposition shall be rejected.

Once a final decision on the opposition has been issued, the Finnish Patent and Registration Office shall notify the International Bureau of the outcome of the opposition against the international registration and the ensuing validity of the international registration in Finland and make the entries in the Register of Trademarks warranted by the decision on the opposition.

Section 94

Validity and legal effect of an international registration

An international registration approved as valid in Finland shall remain in effect as from the date of registration issued by the International Bureau or the date of filing of the request to extend the international registration to Finland, subject to the priority recorded in the register of the International Bureau. An international registration valid in Finland shall have the same legal effects as the national registration of a trade mark.

An international registration shall remain in effect for a period of ten years from the date of registration issued by the International Bureau. An international registration may be renewed by the International Bureau on the conditions mentioned in the Madrid Protocol. The Finnish Patent and Registration Office shall record the renewal of an international registration in the Register of Trademarks after being notified of it by the International Bureau.

Section 95

Revocation or invalidation of an international registration

When a final decision has been issued on the revocation or invalidation of an international registration, the Finnish Patent and Registration Office shall submit to the International Bureau a notification of the revocation or invalidation and the grounds for it and shall make the consequent entries in the Register of Trademarks.

Section 96

Replacement of a national registration with an international registration

If the proprietor of a trade mark holds an international registration valid in Finland concerning the identical mark, the international registration shall replace the national registration if all goods or services covered by the national registration are included in the list of goods or services covered by the international registration and the international registration is later than the national registration.

On request, the Finnish Patent and Registration Office shall record in the Register of Trademarks that the national registration has been replaced with the international registration and shall notify this to the International Bureau.

Section 97

Removal of an international registration

When an international registration is removed in part or in full from the register of the International Bureau, the Finnish Patent and Registration Office shall remove it in corresponding parts from the Register of Trademarks.

Section 98

Expiry of the validity of an international registration due to expiry of the validity of the national trade mark on which the international registration is based

If the validity of an international registration has expired in Finland because the validity of the registration or the pendency of the application on which the international registration is based has expired within five years of the date of registration issued by the International Bureau and the proprietor of the international registration applies for the registration of the identical trade mark in Finland, such an application shall be deemed to have been filed on the date referred to in section 94, subsection 1, provided that:

- 1) the application is filed within three months of the expiry of the validity of the international registration;
- 2) the goods or services which the application concerns were included under the international registration that was valid in Finland; and
- 3) the application in other respects satisfies the requirements for registration and the applicant pays the fees laid down.

The Finnish Patent and Registration Office shall record in the Register of Trademarks that the national application is based on international registration.

Section 99

Expiry of the validity of an international registration due to denunciation

If the validity of an international registration valid in Finland expires due to denunciation of the Madrid Protocol by a party to it and the proprietor of the international registration applies for registration of the identical trade mark in Finland, such an application shall be deemed to have been filed on the date referred to in section 94, subsection 1, provided that:

- 1) the application is filed within two years of the denunciation taking effect;
- 2) the goods or services which the application concerns were included under the international registration that was valid in Finland; and
- 3) the application in other respects satisfies the requirements for registration and the applicant pays the fees laid down.

The Finnish Patent and Registration Office shall record in the Register of Trademarks that the national application is based on international registration.

Chapter 10

Miscellaneous provisions

Section 100

Right of appeal of the Finnish Patent and Registration Office

The Finnish Patent and Registration Office shall have the right, as provided in chapter 7, section 2, subsection 1 of the Market Court Proceedings Act, to appeal against a decision of the Market Court

by which the Market Court overturns or amends a decision issued by the Finnish Patent and Registration Office.

Section 101

EU trade mark

Unless otherwise provided in the EU Trade Mark Regulation, the provisions laid down in sections 62–64, 68–72 and 74 concerning trade mark infringement shall apply to EU trade marks. A counterclaim for revocation or invalidation of an EU trade mark shall be filed as provided in section 58. Instead of filing a counterclaim for invalidation, the proprietor of the EU trade mark may request the court to order the representative to transfer the EU trade mark to the proprietor in accordance with section 66.

Section 102

Conversion of EU trade mark

The request, submitted by the EUIPO to the Finnish Patent and Registration Office, concerning the conversion of an EU trade mark, an application for an EU trade mark or an international registration designating the European Union into a national application for a trade mark shall be processed as a national application for a trade mark when the applicant:

- 1) pays the fees laid down;
- 2) when the conversion request and a document accompanying it is in a language other than Finnish, Swedish or English, provides the Finnish Patent and Registration Office with a translation thereof into one of the aforementioned languages and notifies the language of the proceedings on which provisions are laid down in section 16, subsection 4;
- 3) notifies the address at which the applicant may be reached in the European Economic Area; and
- 4) supplies the representation of the trade mark as provided in section 16, subsection 2, paragraph 3.

An application based on the conversion of an EU trade mark or an application for an EU trade mark is deemed to have the same date of filing, priority and seniority in Finland as the EU trade mark or application for an EU trade mark. An application based on the conversion of an international registration designating the European Union shall be deemed to have as its date of filing the date of the international registration or the date of designating the European Union, if later, and to have the priorities and seniorities of the international registration in other respects.

Section 103

Service

When service of a document or decision cannot be effected, the Finnish Patent and Registration Office, in derogation from section 62 of the Administrative Procedure Act, may effect service by publishing a notice of the matter on its website or by other appropriate means. Service of the decision or other document is deemed to have taken place at the time of publication of the notice.

Section 104

Mechanical signature

Decisions of the Finnish Patent and Registration Office and other documents prepared with automated data processing may be signed mechanically. This shall be mentioned on the document.

Section 105

Fees

The services provided by the Finnish Patent and Registration Office on the basis of this Act shall be subject to a fee, the criteria for which are laid down in the Act on the Fees Charged by the Finnish Patent and Registration Office (1032/1992) and the provisions issued pursuant thereto.

Chapter 11

Entry into force

Section 106

Entry into force

This Act enters into force on 1 May 2019.

This Act repeals the Trademarks Act (7/1964) and the Act on Collective Marks (795/1980).

Section 107

Transitional provisions

The provisions in force at the time of this Act's entry into force shall be applied to the hearing of an administrative or administrative judicial case and to the hearing of a civil case that is pending at the time of this Act's entry into force. The provisions in force at the time of this Act's entry into force shall also apply when appealing against a decision of the Finnish Patent and Registration Office or the Market Court in a case to which the provisions in force at the time of this Act's entry into force apply.

Except section 30, subsection 1 concerning the validity of the registration and sections 31–35 concerning opposition procedure, the provisions of this Act shall apply, subsequent to their registration, to trade mark applications pending at the time of this Act's entry into force.

Registration applications concerning a black and white mark pending at the time of this Act's entry into force and black and white trade marks registered prior to this Act's entry into force shall be deemed to cover all colour variations of the mark.

Except for section 30, subsection 1 concerning the validity of the registration and sections 31–35 concerning opposition procedure, this Act shall apply to trade marks registered prior to its entry into force.

Notwithstanding the provisions laid down in subsection 1, the provisions in force at the time of infringement shall apply to the infringement of the exclusive rights to a trade mark. The provisions in force at the time of this Act's entry into force shall apply to compensation for damage arising prior to this Act's entry into force from infringement of exclusive rights even if such damage only comes to light subsequent to this Act's entry into force.

Applicants for or proprietors of trade marks whose application for a trade mark or international registration designating Finland was filed before 1 October 2012 and whose trade mark application or registration covers the entire class heading under the Nice Classification in a certain class of goods or services may specify their list of goods and services by notification. The notification of specification of the list of goods and services shall be submitted to the Finnish Patent and Registration Office no later than on the date on which the application for the renewal of the trade mark is filed for the first time following this Act's entry into force. However, if the final possible date on which the trade mark may be renewed falls within six months of the Act's entry into force, the notification of specification of the list of goods and services may be filed no later than within

six months of this Act's entry into force. The notification shall present the goods and services in the manner laid down in section 17, subsection 2. The specification may only concern such goods and services that the list of goods and services may be deemed to have covered at the date of filing of the trade mark and which the list continues to cover. If the specification does not satisfy the requirements under section 17, subsection 2, the Finnish Patent and Registration Office will invite the applicant for or proprietor of the trade mark to remedy the deficiencies. If the deficiencies are not remedied, the list of goods and services in respect of the deficient parts will remain in effect in the form preceding the submission of the specification notification. A specification of the list of goods and services that satisfies the requirements under section 17, subsection 2 will be recorded in the Register of Trademarks by the Finnish Patent and Registration Office. The Finnish Patent and Registration Office will inform the proprietors of trade marks of the opportunity for specification in connection with the notice concerning registration renewal.

Applicants for or proprietors of trade marks whose trade mark application was filed no earlier than on 1 October 2012 and no later than on 31 December 2013 and whose list of goods and services includes, besides the class heading, a reference to the alphabetical list of the Nice Classification may specify the list of goods and services as provided in subsection 6 by notifying of the goods and services included on the alphabetical list of the Nice Classification at the date of filing of the trade mark which the trade mark is desired to cover. When no specification is notified by the applicant for or proprietor of the trade mark, the Finnish Patent and Registration Office after the expiry of the period provided in subsection 6 will supplement the list of goods and services with the goods and services included on the alphabetical list of the Nice Classification at the date of filing and will remove from the list of goods and services the reference to the alphabetical list of the Nice Classification.

If the applicant for or proprietor of the trade mark fails to notify of the specification of the list of goods and services as provided in subsection 6, the Finnish Patent and Registration Office shall supplement the list of goods and services in such trade mark applications or registrations in which the lists of goods and services include a reference to all goods or services in a given class or the date of filing of which is prior to 1 April 1996 and which contain only the number of a class of goods or services. In such a case, the class heading in the said class in the Nice Classification in effect at the filing date shall be recorded as the list of goods or services.

The list of goods or services of a trade mark referred to in subsection 6 shall be interpreted in accordance with section 17, subsection 3:

- 1) after a final decision has been issued on the specification notification provided in subsection 6;
- 2) after the application for trade mark renewal has been filed and no specification for the list of goods and services has been notified; or
- 3) as from the day following the date on which six months have elapsed from the date of this Act's entry into force when no specification of the list of goods and services has been notified within six months of the Act's entry into force in the situations provided for in subsection 6.

Where any reference elsewhere in legislation is made to the Trademarks Act in force at the time of this Act's entry into force, this Act shall be applied in its stead.