

## **TRADEMARK LAW**

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As last amended on 22 December, 1995

### **CHAPTER I. General Provisions ➡**

#### **Article 1**

By registration in accordance with this Law, the sole right will be acquired to a trademark as a special symbol to distinguish goods to be offered for sale, or otherwise purveyed in business, from those of others.

A trademark may be any kind of mark that can be represented graphically and by means of which goods marketed in business can be distinguished from those of others. In particular, a trademark may consist of words, including personal names, figures, letters, numerals or the shape of goods or of their packaging.

The provisions of this Law in respect of goods shall correspondingly apply to services.

#### **Article 2**

A sole right to a trademark may be acquired even without registration after the mark has become established.

By right of establishment, the sole right may be acquired also to other symbols than to the special symbols of business defined in Article 1, paragraph 2.

A trade symbol shall be regarded as established if it has become generally known in the appropriate business or consumer circles in Finland as a symbol specific to its proprietor's goods.

### Article 3

Any person may use his surname, address, or firm in his business as a trade symbol for his goods unless its use is liable to cause confusion with the protected trademark of another, or with a name, an address, or a firm that another is already using lawfully in his business.

What has been said above about the firm applies equally to the subsidiary company and secondary symbol referred to in the Law on Trade Names.

A name or a firm of another may not be included in a trademark. Nor may a subsidiary company or a secondary symbol of another be included in a trademark unless these lack distinguishing power or the branches of trade or types of the goods concerned are different.

### Article 4

The right to a trade symbol as specified in Articles 1 to 3 of this Law means that no one other than the proprietor of a mark may use any symbol liable to be confused with it for his goods, whether on the goods or their packaging, in advertising or commercial documents, or in any other way, including orally. This provision applies equally regardless of whether the goods are offered for sale or intended to be offered for sale in Finland or abroad, or are imported for business purposes.

If spare parts, accessories, or the like, suitable for use with the goods of another, are offered for sale, it is illegal to allude, in the manner specified in the first paragraph of this Article, to the trade symbol of such other party in any way liable to create the impression that the goods offered for sale originate with the proprietor of the said trade symbol or that the proprietor has permitted the use of the trade symbol.

If goods are offered for sale using a particular trade symbol, and if thereafter someone other than the proprietor of the symbol substantially alters them by modifying or repairing them, or in another comparable manner, the symbol may not be used when the goods are again offered for sale in Finland unless the change is clearly indicated or announced, or is otherwise plainly evident.

### Article 5

The sole right to a trade symbol shall not apply to any part of the symbol that is intended mainly to render the goods or their packaging more suitable for their purpose, or else serves some purpose other than that of a trade symbol.

### Article 6

Trade symbols shall, in accordance with this law, be regarded as leading to confusion only if they apply to identical or similar kind of goods.

Paragraph 1 notwithstanding the confusability of symbols can be referred to in favour of such symbol which has a reputation in this country, if using of a symbol of another without due cause would mean taking unfair advantage of, or being detrimental to, the distinctive character or the repute of the earlier mark.

The provision of the second paragraph of this Article shall equally apply to subsidiary companies and secondary symbols referred to in the third paragraph of Article 3.

#### Article 7

If, under Article 1 or 2, several parties demand sole rights to trade symbols bearing confusing similarity, preference shall be given to the party that can claim the earliest entitlement, subject to provisions of Article 8 or 9 below.

#### Article 8

Even if a registered trademark which has been used in this country for a period of five successive years, is liable to be confused with an earlier registered or established mark, the use of the later mark shall not be prohibited, provided that the application for registration was made in good faith and that the proprietor of the earlier mark has been aware of such use of the later mark for such a period.

#### Article 9

If an established trademark is liable to be confused with another earlier registered or established trademark, but the proprietor of the earlier trademark has not subsequently taken steps to prevent the use of the later trademark within a reasonable period of time, he shall no longer be entitled to prohibit the use of the later trademark.

#### Article 10

In the cases referred to in Article 8 or 9, it may be decided, where reasonable, that one or both of the trade symbols may only be used in a specific manner—for example, shaped in a particular way, or with the addition of a place name or some other explanatory feature.

The first paragraph of this Article shall equally apply if there is likelihood of confusion in a case referred to in the first or second paragraph of Article 3.

#### Article 10a

The proprietor of a trademark may not deny the use of the trademark in the goods that the proprietor or someone else with his consent has using this trademark put on the market within the territory of the European Economic Area.

Paragraph 1 shall not apply if the proprietor has justified grounds to oppose putting the goods again in the market, in particular if alterations have been made in the goods or they have been deteriorated after being put in the market.

#### Article 11

At the request of the proprietor of a registered trademark, the author, editor or publisher of a dictionary, glossary, manual or similar publication shall ensure that the trademark is not reproduced without indicating that it is registered as such.

Anyone who fails to observe the above paragraph shall take steps to see that a correction is published in whatever manner and to whatever extent is considered reasonable, and shall bear the cost of publishing the said correction.

## **CHAPTER II. Registration of Trademarks ➡**

### Article 12

A Register of Trademarks shall be kept by the National Board of Patents and Registration.

### Article 13

To qualify for registration, a trademark must be likely to distinguish its proprietor's goods from those of others. A mark that, either solely or with only a few alterations or additions, indicates the type, quality, quantity, purpose, price, or place or time of manufacture shall not, as such, be regarded as distinctive. In assessing whether a trademark possesses distinguishing power, all the factual circumstances shall be borne in mind, particularly the length of time and extent to which the mark has been used.

### Article 14

A trademark shall not be registered:

- 1) if it is contrary to law and order, or to morality;
- 2) if it is liable to mislead the public;
- 3) if, without proper permission, it incorporates national armorial bearings, a national flag or other emblem, a sign or hallmark indicating control and warranty used by the State for goods of the same or a similar type as those for which the trademark is requested, the armorial bearings of a Finnish commune, or the flag, armorial bearings or other emblem, name or abbreviation of name of an international organization or any device or emblem, name or abbreviation of a name liable to be confused with the symbols or emblems, marks, names or abbreviations referred to in this item;
- 4) if it is composed of or contains anything that is likely to give the impression of being the protected firm name of another or the subsidiary company or secondary symbol of another referred to in the third paragraph of Article 3, or of being the name or likeness of another person, unless such name or likeness plainly refers to someone who died a long time ago;
- 5) if it is composed of or contains anything that is likely to give the impression of being the title of another's protected literary or artistic work, whenever such work is of original character, or if it constitutes an infringement of another's copyright in such a work or of his right to a photographic illustration;
- 6) if it is liable to be confused with the name or protected firm name of another trader or with a subsidiary company or secondary symbol of the kind referred to in the third paragraph of Article 3 or with the trademark of another which has been registered on the basis of an earlier application or with the trade symbol of another party that is already established at the time when registration is sought; or
- 7) if it is liable to be confused with a trade symbol being used by another party for his goods at the time of the application, and if the applicant has cognizance of such use at the time of his application and had not used his own mark before the other trade symbol came into use; or

8) if it is liable to be confused with a trademark protected by international registration valid in Finland and the date under paragraph 1 of Article 56c granted by the International Bureau is earlier than the date on which registration is applied for; or

9) if it is liable to be confused with a Community trademark under paragraph 1 of Article 57 that has been registered on the basis of an earlier application.

In the cases referred to in items 4 to 9, registration may be granted if the proprietor of the trademark whose right is concerned agrees thereto, and provided that the registration does not contravene any of the other provisions of the first paragraph of this Article.

#### Article 15

The sole right to a trademark acquired by registration does not cover any part of the mark that cannot be registered as such.

If the trademark contains any such part and there are special reasons to believe that its registration may cause uncertainty regarding the extent of the sole right granted, protection of the said part may be specifically disclaimed when the registration is made.

If a part of a trademark excluded from protection later becomes registrable, a fresh registration can be made to cover such part or to comprise the entire trademark without the exclusion of the said part from protection.

#### Article 16

A trademark shall be registered in one or more classes of goods. The classification of goods shall be established by the National Board of Patents and Registration.

#### Article 17

The application for the registration of a trademark shall be submitted in writing to the registering authority. The application shall indicate the name of the applicant or of his firm and the classes of goods for which the mark is intended. The mark shall be clearly indicated in the application.

A filing fee has to be paid upon filing the application. The application is not considered to be filed until the fee has been paid.

#### Article 18

If a trademark which the applicant used for the first time with goods shown at an international exhibition is submitted for registration within six months of the date on which the goods were first exhibited, the application shall be regarded as having been made on the said date for the purpose of determining priority over other applications for trademarks or the use of other trade symbols.

#### Article 19

If the applicant fails to observe the regulations concerning the filing of an application, or if the registering authority finds that the application cannot be approved for some other reason, the applicant shall submit a statement or rectify his application within a specified time; otherwise his application may be dismissed.

If the registering authority considers the application unacceptable, even after the applicant has submitted a statement, it shall be rejected unless there is cause to issue a new time limit.

#### Article 20

If the application documents comply with the requirements set therefor, and no obstacle to registration has emerged in the matter, the registering authority shall enter the trademark in the Register and give public notice thereof.

Any oppositions to the registration of the trademark shall be filed in writing with the registering authority within two months of the date of the public notice.

Even if the person that filed the opposition withdraws it, the matter may nevertheless be examined if special reasons thereto exist.

#### Article 21

After an opposition the registering authority shall cancel the registration if an obstacle to registration is found. Once the decision to cancel the registration has acquired legal effect, public notice shall be given thereof.

The registering authority shall reject the opposition if no obstacle to registration is found.

#### Article 22

Registration shall take effect as from the date on which the application was filed and shall remain in force for ten years from the date of registration.

Registration may not be renewed earlier than one year before and later than six months after the registration expires.

Renewal shall be requested in writing from the registering authority, if the proprietor wants to alter any of the particulars entered in the Register or if no entries have been made in the Register in respect of the classes to which the goods belong. In other cases registration is considered to be renewed once the renewal fee is paid.

Provisions of Article 19 above shall correspondingly apply to the handling of the applications.

#### Article 23

If the proprietor of a registered trademark so requests, minor changes which do not alter the total impression of the trademark may be entered in the Register.

### **CHAPTER III. Expiry of Legal Protection and Invalidity of Registration**



#### Article 24

If the proprietor of a registered trademark fails to apply for renewal of the registration, as

specified in Article 22, the said trademark shall be deleted from the Register.

A trademark shall also be deleted from the Register, while the registration is valid, if the proprietor so requests. If, according to an entry in the Register, there is a mortgage on the trademark, the mark may not be deleted from the Register without permission from the holder of the mortgage.

Upon application by the proprietor of the trademark, the list of goods or of classes of goods for which the mark has been registered may be reduced. The provision in the second paragraph concerning the consent of the holder of a mortgage shall apply also in this case.

#### Article 25

If a trademark has been registered contrary to the provisions of this Law, the registration shall be declared null and void unless the provisions of Article 8 or 9 are applicable or some other change in circumstances affects the issue.

#### Article 26

An exclusive right to a trademark shall be forfeited:

- 1) if it is obvious that the mark has lost the power to distinguish its proprietor's goods from those of others since the time it was registered or became established; or
- 2) if the mark has become misleading or contrary to law and order or to morality since the time it was registered or became established.

The registration of a trademark shall be forfeited if the mark has not been used during the last five years and the proprietor is unable to give a proper reason therefor. The use of a trademark with the proprietor's consent shall be considered equal to use by the proprietor. The forfeiture of a registration cannot, however, be requested if the trademark has been used after the expiry of a five-year period of non-use, but before the request for forfeiture. However, in this case the use of the mark occurred during the three months preceding the request for forfeiture will not be considered if the preparations for use are commenced only after the proprietor has become aware that a request for forfeiture may be filed.

If the ground for forfeiture of a registration concerns only some of the goods for which the trademark has been registered, the registration will be forfeited only in respect of those goods.

#### Article 27

A court of law shall decide on the declaration of invalidity of a registration and forfeiture of a trademark when a suit to that effect is brought against the proprietor of the mark.

A suit of the kind referred to in the above paragraph may be brought by anyone who suffers inconvenience as a result of the registration. If the case is based on Article 13, on items 1 to 3 of the first paragraph of Article 14 or on Article 26, the suit may also be brought by the public prosecutor or by a body safeguarding the interests of the persons carrying on a trade or profession involved.

If the plaintiff so requests, an entry to the effect that a suit has been brought shall be made in the Register.

## **CHAPTER IV. Special Provisions for the Protection of Foreign Trademarks ➡**

### **Article 28**

If an applicant for a trademark does not carry on his business in Finland, his application must be accompanied by a certificate to the effect that he has had the same trademark registered for the same goods in the foreign country in which he carries on his business or where he is domiciled, or of which he is a national.

No certificate of the kind referred to in the above paragraph shall be required if the foreign country does not require a similar statement from a person who is a Finnish citizen, or who is domiciled or carries on his business in Finland.

### **Article 29**

A trademark registered in a foreign country may be registered in Finland, in the form in which it is registered in such foreign country, provided that reciprocal rights exist, that the registration does not contravene Article 13 or 14, and that the trademark has not lost its distinguishing power.

Notwithstanding the provisions of paragraph 1, minor changes may be made on the basis of reciprocity when registering a foreign trademark, provided that they do not alter the general impression of the trademark.

### **Article 30**

By decree it can be laid down that an application for the registration of a trademark in this country, if registration of the trademark has previously been applied for abroad, shall upon the applicant's request be considered in regard to other applications or other trade symbols in use as having been made at the same time as the application abroad.

Conditions under which priority under paragraph 1 may be obtained can also be laid down by decree.

### **Article 31**

An applicant for a trademark registration or proprietor of a registered trademark not domiciled in Finland shall appoint an agent resident in Finland to represent him in all matters concerning the trademark. A Finnish corporate body may also act as an agent. The name of the agent shall be entered in the Register. Anyone who has filed an opposition and is not domiciled in Finland, shall appoint a representative resident in Finland to represent him in the opposition case.

If the applicant for a trademark registration or the proprietor of a registered trademark does not have a duly empowered agent, the registering authority shall, by using the last known address of the applicant or the proprietor, invite him to remedy the situation within a prescribed time limit, upon pain of the application being considered as withdrawn or the mark being deleted from the register. If the registering authority has no knowledge of the address of the applicant or the proprietor, a public notice has to be published in the Trademark Gazette.



## **CHAPTER V. Assignment and Licenses ➡**

### **Article 32**

A trademark may be transferred to another party; such assignment may cover either all or some of the goods for which it was registered or became established.

When a firm holding a trademark changes hands, the trademark shall accompany the property unless the condition has been made that it shall remain with the previous owner, or that both the previous and the new owner of the firm may use it for different kinds of goods.

### **Article 33**

Upon request, the assignment of a registered trademark shall be recorded in the Register. If the registering authority finds that the use of a trademark subsequent to such assignment is clearly liable to mislead the public, permission to enter the assignment in the Register shall be withheld unless the fault is eliminated by making a change in or addition to the trademark.

An assignment not recorded in the Register shall not affect a third party who, in good faith, has obtained the right to the trademark.

If anyone desires to place a mortgage on his right to a trademark, a written agreement shall be made and entered in the Register. No right to a mortgage shall exist until such an entry has been made.

### **Article 34**

The proprietor of a registered trademark may authorize another to use it in his business without relinquishing his right as such to the trademark. A licence may concern the whole country or some part thereof and it may cover either all or part of the goods protected by the registration. The number of licencees may be one or more. Upon request, such a licence shall be entered in the Register. The registering authority may, however, refuse this entry if the use of the trademark relating to the licence is obviously liable to mislead the public. When a licence is proved to have expired, the entry shall be deleted from the Register.

A license not entered in the Register shall not affect a third party who in good faith has obtained the right to the trademark.

Unless otherwise agreed, the licensee may not transfer his right to a third party.

### **Article 35**

The right to a trademark shall not be seized for debt unless a mortgage has been established on it.

If the property of the proprietor of a trademark is relinquished at bankruptcy, the right to the trademark shall be included in the bankrupt's estate.

## **CHAPTER VI. Prohibition of the Use of Misleading Trade Symbols ➡**

### **Article 36**

If a trade symbol that has been assigned or for which a licence has been issued becomes misleading in the form in which it is used by its new proprietor or licensee, a court of law may, as it sees fit, forbid the new proprietor or licensee to use it.

The use of the symbol may be prohibited also in other cases, if the trade symbol is misleading or if its proprietor or anyone else with his permission uses it in a manner misleading to the public.

A suit under this Article may be brought by the public prosecutor, by anyone who suffers inconvenience as a result of the use of the trade symbol, or by a body safeguarding the interests of the persons carrying on a trade or profession concerned.

### **Article 37**

If the right to use a trade symbol is denied under Article 36, the court may, where reasonable, order that a trade symbol that has been placed on goods, their packaging, brochures, leaflets, commercial documents, or the like, contrary to a prohibition specified in Article 36, shall be erased or altered so as not to be misleading. If this can be done in no other way, the court shall order that the property so marked be destroyed or changed in a specified manner.

Property referred to in the above paragraph may be sequestered pending the said order; in this case, the general regulations on sequestration in criminal cases shall be applied.

## **CHAPTER VIa. Security measures in connection with importation ➡**

### **Article 37a**

If the proprietor of a registered trademark, or the licensee thereof, makes it probable that he has a valid reason to suspect that somebody, without permission, intends to import into this country such goods to which the proprietor of the registered trademark or his licensee has the sole right according to Article 4, paragraph 1, a court may rule, according to the stipulations in Chapter VII of the Code of Procedure unless laid down otherwise in this chapter, that the goods are to be held in the custody of the Customs for the time being.

In addition to what has been laid down in Article 4 of Chapter VII in the Code of Procedure, the security measures defined in this chapter can be decided upon also by the Public Lower Court in whose territorial ambit the importation takes place. If the applicant is not aware of the site of the importation of the goods, the security measures can also be decided upon by the Municipal Court of Helsinki.

### **Article 37b**

If the court agrees to an application according to Article 37a, it has to inform thereof immediately the appropriate customs authorities, who shall take measures according to the decision, applying, to an applicable extent, what is laid down in Chapter VII of the Execution

Act as regards the execution of a security measure decision. If the applicant is not aware of the site of importation of the goods, the aforementioned information shall be communicated to the District Customs Office of Helsinki.

#### Article 37c

If an application referred to in Article 37a has been allowed, the applicant shall, within 10 working days from the notification or, if the goods are imported to this country only after the notification, from the ordering of the goods to the custody of the Customs, initiate a suit in the main cause in a court competent according to Article 42, or to ask, within the same time period, the continuation of the measures according to Article 37a, in pain that the goods otherwise will be liberated from the Customs' custody.

#### Article 37d

A court may rule that the applicant and the importer have the right to inspect the goods subject to the above measures to an extent necessary for defining any claims.

### **CHAPTER VII. Consequences of Infringement of Trademark Rights ➡**

#### Article 38

Whoever infringes the right of the proprietor of a trade symbol protected by this Law can be prohibited by a court order from continuing or repeating such misdeed unless there are special reasons to the contrary.

If the infringement has been deliberate or due to negligence, the aggrieved party shall be entitled to compensation from the defendant for all the damage he has suffered. If the negligence has only been slight, the court may modify the compensation awarded to whatever extent it sees fit.

Even if the defendant is not found guilty of negligence, the court may, where deemed reasonable in view of his financial and other circumstances, rule that he shall hand over to the aggrieved party the profits he has gained from such infringement for up to but not more than the three preceding years.

#### Article 39

Anyone who deliberately infringes the right to a trade symbol protected by this Law shall, unless the act is punishable as a crime against industrial property right under Article 2 of Chapter 49 of the Criminal Code, be sentenced to a fine for violation of a right to a trademark.

Prosecution for infringement according to the above paragraph shall not be brought by the public prosecutor except at the instance of the aggrieved party.

In the case of a registered trademark, no penalty may be imposed unless the infringement occurred after the date of registration.

#### Article 40

A suit for damages according to Article 38 must be brought within three years of the time when the plaintiff learned of the infringement and ascertained the identity of the infringer, and in any case not later than within ten years from the time when the infringement occurred.

Notwithstanding the above paragraph 1, in the case of a registered trademark a suit may be brought for infringement before the date of registration provided that it is brought within a year of that date.

#### Article 41

On the request of one whose right to a trade symbol has been infringed, the court may rule, if it sees reasonable, that a symbol that has without authorization been placed on goods, their packaging, leaflets, commercial documents, or the like, shall be erased or altered in such a way as to ensure that it will no longer be misused. If this can be effected in no other way, the court shall order that the property so marked be destroyed or changed in a specific manner. The court may also, upon request, order that the property be handed over to the plaintiff against payment.

Regardless of whether the infringement is deliberate or not, the public prosecutor or the court may order that the property here referred to be sequestered if the plaintiff so requests and, where considered necessary, gives acceptable surety for any damages the defendant may suffer as a result of the sequestration and for the costs occasioned by said sequestration; otherwise, in this case the general regulations on sequestration in criminal cases shall be applied.

### **CHAPTER VIII. Litigation Concerning Trademarks ➡**

#### Article 42

The competent court of law in matters concerning the right to a trademark, the declaring of the registration of a trademark invalid, the declaring of a trademark forfeited, the prohibition of the use of a trademark, the suit referred to in paragraph 46 or the infringement of trademark rights is the Municipal Court of Helsinki.

A suit brought against the proprietor of a trademark not domiciled in Finland shall be heard in the Municipal Court of Helsinki.

The Municipal Court of Helsinki shall serve as the trademark court according to the Council Regulation referred to in paragraph 1 of Article 57 below.

#### Article 43

A plea for injunction according to Article 38 may be heard at the same time as prosecution brought under Article 2 of Chapter 49 of the Criminal Code or Article 39 of this Law.

#### Article 44

If the defendant in a case concerning the infringement of the right to a trademark based on registration claims that the registration is null and void and the truth of the matter is not immediately clear, the court shall grant him a period of time in which to bring a suit at a separate court hearing in order to have the registration declared null and void; no decision

on the original case may be handed down until the validity of the registration has been finally settled for or against. If the secondary suit is not brought within the time limit granted, the court shall make its decision on the case regardless of the counterclaim.

The above paragraph shall apply equally if the defendant claims that the trademark has been forfeited.

#### Article 45

If someone has been granted the sole right to use a registered trademark in Finland and an entry regarding such licence has been made in the Register, in cases concerning infringements of the right to the trademark both the proprietor of the mark and the licensee, or both, can be regarded as plaintiffs.

If the licensee referred to in the above paragraph wants to bring a suit for infringement, he shall notify the proprietor of the trademark; if he fails to do so, his suit shall not be heard.

This Article shall apply equally if the proprietor has reserved rights to parallel use for himself upon granting another an exclusive licence.

#### Article 46

A suit brought to establish whether or not a right to a trade symbol exists, or whether a specific act infringes such right, can be heard in cases where uncertainty exists and is harmful to the plaintiff.

In such cases, Article 45 shall apply correspondingly.

#### Article 47

A suit to have a trademark registration declared null and void can be continued against the original defendant in the event of the trademark's being assigned to another after legal proceedings have been commenced, and, if the court finds for the plaintiff, its decision shall be equally binding upon the party to whom the trademark has been assigned. This shall apply equally in the case of a suit brought to declare a trademark forfeited.

#### Article 48

When a suit is brought to obtain an injunction in accordance with this Law, the court may, on the request of the plaintiff, issue an injunction against the defendant during the proceedings or in its decision, to be in force until the principal case has been settled with legal effect, or until the same or another court decides otherwise. Before such an injunction is issued, the plaintiff may be ordered to give acceptable surety for the damage the defendant may suffer from the said injunction.

A separate appeal may be made against a court decision handed down during proceedings concerning an injunction or cancellation thereof.

#### Article 49

A copy of any court decision in a case concerning the infringement of trade symbols, or in any of the cases referred to in Articles 10, 25, 26, 36 and 46, shall be sent by the court to the National Board of Patents and Registration. In addition the court shall inform the

Community Trademark Office referred to in paragraph 1 of Article 57 of a suit concerning revocation of a Community trademark and invalidation of the registration and send a copy of the final decision by the court to the Office.

## **CHAPTER IX. Public Notices, Notifications, Appeals and Removals of Decisions** ➡

### Article 50

Besides in the cases referred to in Articles 20 and 21, public notice shall be given when a registered trademark is modified in accordance with Article 23, when registration is deleted under Articles 24 to 26, 31 or 52, or an assignment by virtue of Article 33 or a licence granted under Article 34 is recorded in the Register.

### Article 50a

If it has not been possible to notify the applicant at the address informed by himself, the notification may take place by public notice in the Trademark Gazette.

### Article 51

An appeal against the decision of the registration authority in a case concerning a trademark may be made by the applicant, if the decision was unfavourable to him or if the case has been dismissed. An appeal against a final decision taken by the registration authority on account of opposition filed against the registration may be lodged by the losing party. Even if the person who filed the opposition withdraws his appeal, the case may be examined if special reasons thereto exist.

### Article 51a

An appeal against a decision made by the registration authority under this law shall be filed with the Board of Appeal at the National Board of Patents and Registration. Separate regulations shall apply to the appeals procedure and the trial of cases in the Board of Appeals.

### Article 52

If the registration authority receives from the International Bureau referred to in Article 53 a notice of an international registration and in that registration the date on which the protection begins is prior to the date on which the protection accorded by the Finnish registration of the same mark begins and the goods covered by the international registration are wholly or partly the same as in the Finnish registration, the registration authority shall remove its decision concerning the Finnish registration and take a new decision on the case.

If the registration authority finds after its decision to grant a registration, before the period for filing oppositions has expired, that the decision to grant the registration is based on an obvious handling error, the registration authority may remove its incorrect decision and take a new decision in the case.

## **CHAPTER X. International Registration of Trademarks ➡**

### **Article 53**

By international trademark registration is meant the registration of a trademark effected by the International Bureau of the World Intellectual Property Organization in accordance with the Madrid Protocol issued on 27 June, 1989 relating to the Agreement Concerning the International Registration of Marks concluded on 14 April, 1981.

### **Article 54**

If a Finnish citizen or anyone who is domiciled or has a real and effective industrial or commercial establishment in Finland, wants to apply for international registration, he shall file an application for an international registration with the National Board of Patents and Registration. A condition for applying for an international registration is that he has a registration or pending application concerning the same mark in Finland.

### **Article 55**

An international application shall be filed in writing in compliance with separate provisions. The prescribed fee shall be paid on filing the application.

### **Article 56**

The registration authority shall verify that the international trademark application corresponds to the registration granted to the applicant in Finland or to his pending application in Finland.

If the correspondence under paragraph 1 does not exist, the registration authority shall oblige the applicant to rectify the international application within a time limit on pain of the application being dismissed.

If the correspondence under paragraph 1 exists, the registration authority shall attach a certificate to that effect to the application and transmit it with the application to the International Bureau before two months have passed from the date of filing of the application.

### **Article 56a**

When the registration authority receives from the International Bureau a notice of an international registration that covers Finland, the registration authority shall examine whether any obstacle is found to the registration.

### **Article 56b**

If the registration authority finds that the trademark that is the subject of the international registration does not comply with the conditions for registration laid down in this Law, it shall notify the International Bureau that the international registration is not in force in Finland. The registration authority shall transmit the notice with justifications to the International Bureau within 18 months of the notice by the International Bureau referred to in Article 56a.

If the statement issued by the proprietor of an international registration on account of the notice by the registration authority referred to in paragraph 1 does not present any circumstances on the basis of which the trademark could be deemed to comply with the conditions for registration laid down in this Law, the registration authority shall take a decision that the international registration does not cover Finland. The registration authority shall take a decision with a corresponding content also in the case where the proprietor of the international registration has not submitted his statement on account of the registration authority's notice.

#### Article 56c

If no obstacle is found to registration, the registration authority shall give public notice of the notice by the International Bureau referred to in Article 56a in the manner laid down in paragraph 1 of Article 20. The public notice shall indicate the date granted by the International Bureau to the international registration.

Any opposition against an international registration in Finland shall be filed in writing with the registration authority within two months of the date of notification.

#### Article 56d

If the registration authority after an opposition has been filed finds that the trademark that is the subject of an international registration does not comply with the conditions for registration laid down in this Law, it shall notify the International Bureau, in the manner prescribed in paragraph 1 of Article 56b, that the international registration is not in force in Finland.

If the time limit stated in paragraph 2 of Article 56c expires later than within 18 months of the notice by the International Bureau referred to Article 56a, the registration authority shall notify the International Bureau within 18 months of the above notice that the registration may later cease to be in force. In this case the notice of the fact that the registration is not in force in Finland shall be transmitted within one month of the expiry of the time limit referred to in paragraph 2 of Article 56c.

Once the decision taken after an opposition that the international registration does not cover Finland has taken legal effect, the registration authority shall give public notice of the fact.

#### Article 56e

An international trademark registration that covers Finland is in force as from the date accorded by the International Bureau referred to in paragraph 1 of Article 56c. Provisions laid down in and under this Law shall *mutatis mutandis* apply to the international registration.

#### Article 56f

If the proprietor of an international registration who is not domiciled in Finland wants to submit a statement to the National Board of Patents and Registration, he shall appoint a representative resident in Finland.

#### Article 56g



If the proprietor of a trademark registered in Finland has been granted an international registration in respect of the same mark that is in force in Finland, the international registration of the trademark replaces the Finnish registration if all the goods covered by the Finnish registration are included in the list of goods covered by the international registration.

The registration authority shall on request make an entry in the Register to the effect that the international registration of the trademark is in force and give public notice of the fact.

#### Article 56h

If a trademark is wholly or partly deleted from the international register, the registration authority shall delete the corresponding parts of it from the register it maintains and give public notice of the fact.

#### Article 56i

If an international registration valid in Finland ceases to be in force within five years from the date referred to in paragraph 1 of Article 56c for the reason that the validity of the national registration or pendency of the national application on which the international registration is based has ceased and the proprietor of the trademark seeks registration for the same trademark in Finland, such application shall be considered to have been filed on the date referred to in paragraph 1 of Article 56c on the condition that:

- 1) the application is filed within three months of the expiry of the validity of the international registration;
- 2) the goods covered by the Finnish application were included in the international registration valid in Finland; and
- 3) the application in other respects complies with the requirements set for registration and the applicant pays the prescribed fees.

The registration authority shall make an entry in the Register that the Finnish application is based on the international registration and gives public notice of the fact.

#### Article 56j

If an international registration valid in Finland ceases to be in force because a party to the Protocol referred to in Article 53 gives notice of termination in respect of the Protocol and the proprietor of the trademark applies for registration for the same trademark in Finland, such application shall be considered to have been made on the date referred to in paragraph 1 of Article 56c provided that:

- 1) the application is filed within two years from the date the notice of termination came into force;
- 2) the goods covered by the Finnish application were included in the international registration valid in Finland; and
- 3) the application in other respects complies with the requirements set for registration and the applicant pays the prescribed fees.

The registration authority makes an entry in the Register that the Finnish application is

based on the international registration and gives public notice of the fact.

#### Article 56k

Public notice shall be given of renewals, transfers, deletions under Articles 24 to 26 and licences concerning international registrations.

#### Article 56l

An appeal against a final decision by the registration authority may be made by the applicant for an international registration and the proprietor of an international registration who has required such registration in Finland, if the decision was unfavourable to him or if the case has been dismissed.

An appeal against a decision taken by the registration authority that an international registration is valid in Finland despite an opposition filed may be lodged by the person who filed the opposition. Even if the person who filed the opposition withdraws his appeal, the case may be examined if special reasons thereto exist.

Correspondingly, Article 51a shall apply to appeals under paragraphs 1 and 2 above.

### **CHAPTER Xa. Community Trademark ➡**

#### Article 57

By community trademark is meant a trademark registered by the Office for Harmonization in the Internal Market operating in the Internal Market of the European Community (Community Trademark Office) under Council Regulation ((EC) 40/94) concerning community trademark.

An application in respect of a community trademark can be filed with the National Board of Patents and Registration which transmits it further to the Community Trademark Office. A prescribed fee is payable to the National Board of Patents and Registration for the application.

#### Article 57a

If the validity of the registration of a Community trademark or the lis pendens of a Community trademark application has wholly or partly ended and the proprietor of the Community trademark applies for registration of the same trademark in Finland, such application shall be considered to have been filed on the date of filing of the application for a Community trademark provided that:

- 1) the application is filed within three months of the notice by the Community trademark office that the validity of the registration of the Community trademark or the lis pendens of the application for a Community trademark has ended;
- 2) the goods covered by the Finnish application were included in the application for a Community trademark in so far as its lis pendens has ended or in the registration of a Community trademark in so far as its validity has ended; and

3) the application in other respects complies with the conditions set for registration and the applicant pays the prescribed fees.

If the registration of a Community trademark has ceased to be in force as a result of non-use and the proprietor of the trademark applies for registration of the same trademark in Finland, such application is, subject to compliance with the conditions stated in paragraph 1, deemed to have been filed on the date of filing of the Community trademark application, provided that the Community trademark has been in genuine use in Finland.

If the *lis pendens* of an application for a Community trademark ends because the application is withdrawn or if the registration of a Community trademark ceases to be in force because it is not renewed or because of a decision of a national court of law, the Finnish application shall be filed within three months of the date on which the application was withdrawn, the registration term of the trademark ended or the court decision acquired legal effect.

## **CHAPTER XI. Enforcement and Implementation of the Law ➡**

### **Article 58**

Further instructions on the procedure to be followed by applicants for registration, the giving of public notice, and other procedures in such connection, and on the maintenance of the Register of Trademarks, including changes to be made in the Register, and other orders necessary for the implementation of this Law shall be given by decree.

Fees to be collected in accordance with this law will be laid down separately.

### **Article 59**

This Law shall come into force on the first day of June, 1964. The following shall thereby be rescinded:

The Decree on the Protection of Trademarks of February 11, 1889:

Chapter XXXVI, Article 13, of the Criminal Code;

Article 2 of the Decree of December 21, 1885, granting greater freedom to the iron industry.

### **Article 60**

The validity of trademarks registered before the entry into force of this Law shall be determined in accordance with the earlier regulations.

The right to a trademark can be declared forfeited in accordance with Article 26 even though it was granted or became established before the entry into force of this Law.

Pending applications for registration shall be subject to the new Law.

### **Article 61**

In the case of trademarks registered earlier, the period of five years provided for in Article 8

shall be counted as beginning from the date of the entry into force of this Law.

#### Article 62

The provisions of Article 40 regarding the period of time within which damages shall be claimed shall apply equally if the act for which compensation is payable was committed before the present Law takes effect; if, however, the period of three years referred to in the said Article began before the date of the entry into force of this Law, they shall be counted as having begun on the said date.

#### Article 63

When the registration of an earlier registered trademark is renewed for the first time after the entry into force of this Law, the registration period based on the said renewal of registration shall be regarded as ending on the date corresponding to the original date of registration, even if the registration period according to an earlier renewal was calculated otherwise.

Upon renewal of registration, the classes of goods listed shall be modified to conform to any changes that have been made in the classification.

#### Article 64

A trademark registration that was renewable without application under the former regulations (one granted before 1889) shall be renewed from now on in accordance with the provisions on renewal contained in the present Law. Unless application for renewal is made within one year of the date on which this Law takes effect, the trademark shall be deleted from the Register.

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*This Law shall enter into force on a date to be decreed.*

*This Law shall apply also to trademarks registered before the entry into force of this Law.*

*The provisions of this Law, with the exception of paragraph 1 of Article 17, shall apply to applications for trademark registration pending on the entry into force of this Law. Such registration applications which the registration authority under Article 20 already has given public notice of, shall, however, be handled and decided upon in accordance with regulations valid when this Law enters into force.*