

ACT 800/1991 ON UTILITY MODEL RIGHTS

2010 UPDATE

Chapter 1

General provisions

Section 1

Anyone who has made an invention, or his successor in title, shall be entitled, on application, to a utility model right to his invention, and thereby to the exclusive right to exploit the invention commercially, in accordance with the provisions of this Act.

For the purposes of this Act, “invention” shall mean a technical solution that is commercially exploitable. (1396/1995)

The following, as such, shall not be regarded as inventions:

- (1) discoveries, scientific theories or mathematical methods;
- (2) aesthetic creations;
- (3) schemes, rules or methods for performing mental acts, playing games or doing business, or programs for computers; and
- (4) presentations of information. (1396/1995) Utility model rights shall not be granted for:
 - (1) inventions the exploitation of which would be contrary to morality or public policy;
 - (2) plant or animal varieties; and
 - (3) processes. (1396/1995)

Section 2

An invention must be new in relation to what was known before the filing date of the utility model right application and must differ essentially therefrom. (700/2008)

The prior art shall be held to comprise everything made available to the public by means of a written or oral description, by use or in any other way. Additionally, the content of utility model right, patent and design applications as filed in this country prior to the abovementioned filing date, shall be regarded as included in the prior art if such applications are made available to the public under section 18 of this Act, section 22 of the Patents Act (550/1967) or section 19 of the Registered Designs Act (221/1971). However, in such cases, the requirement set out in subsection 1, that the invention must differ distinctly from the prior art known before the filing date of the application for a utility model right, shall not apply. (700/2008)

Applications referred to in Chapter 8a shall, for the purposes subsection 2, have the same legal effect as applications for utility model rights filed in this country, pursuant to the provisions laid down in sections 45b and 45f. (1396/1995)

A utility model may nevertheless be registered for inventions made available to the public within the six months preceding the filing date of the application, if disclosure was the result of:

- (1) an evident abuse in relation to the applicant or his predecessor in title; or
- (2) the fact that the applicant or his predecessor in title had displayed the invention at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions (Finnish Treaty Series 36/37).

(1396/1995)

For the purposes of subsection 2, publication according to Article 93 of the Convention on the Grant of European Patents of 5 October 1973 (Finnish Treaty Series 8/1996), hereinafter European Patent Convention, shall be equated with the making available to the public of application documents, in accordance with section 22 of the Patents Act. What is said above also applies to publication according to Article 153(3) of the European Patent Convention, where the European Patent Office equates such publication with publication according to Article 93. (700/2008)

Section 3

Subject to the exceptions stated below, the exclusive right conferred by the registration of a utility model shall imply that no one, without the consent of the proprietor of the utility model right, may exploit an invention by making, offering, putting on the market or using a product protected by the utility model right, or by importing or possessing such product for these purposes.

The exclusive right shall also confer on its proprietor the exclusive right to prevent any person, without his consent, from supplying or offering to supply any other person not entitled to exploit the invention with the means of working the invention in this country in relation to an essential element of the invention, where said other person knows, or on

the basis of the circumstances should have known, that the means are suitable and intended for working the invention. This provision shall not apply where the means are staple commercial products, except where said other person attempts to induce the receiver to commit any act infringing the exclusive right referred to in subsection 1. For the purposes of this subsection, any person using the invention in a manner referred to in subsection 3(1) or (3) shall not be regarded as entitled to exploit the invention. (1396/1995)

The exclusive right shall not apply to:

(1) use which is not commercial;

(2) use of a product protected by a utility model right that has been put on the market within the European Economic Area by the proprietor of the utility model right or with his consent; and (1410/1992)

(3) use in experiments relating to the invention as such.

(1396/1995)

Section 4

The provisions of sections 4 and 5 of the Patents Act regarding the commercial use or exploitation of an invention on foreign vessels, aircraft or other means of transport for their needs, shall apply where applicable to an invention for the purposes of this Act.

Section 5 (700/2008)

An application for registration of a utility model right relating to an invention disclosed no earlier than 12 months before the date of filing an application for a patent or for the registration of a utility model filed in Finland, or disclosed in an application for a patent, an inventor's certificate or utility model protection filed in another country party to the Paris Convention for the Protection of Industrial Property (Finnish Treaty Series 5/1921) or the Agreement Establishing the World Trade Organization (Finnish Treaty Series 5/1995), shall be deemed, for the purposes of section 2(1) and(2), and section 4, to have been filed at the same time as the earlier application if the applicant so requests. Such priority may also be enjoyed under an earlier application for protection filed in a country not party to the abovementioned conventions if the corresponding priority deriving from a Finnish application is granted in such country and if the laws of said country substantially conform to those conventions.

A government decree shall lay down the manner in which claims referred to in subsection 1 shall be filed as well as the documents to be enclosed.

Chapter 2

Applications for utility model rights and their processing

Section 6

Applications for utility model rights, hereinafter referred to as “utility model applications”, shall be filed in writing with the National Board of Patents and Registration, acting as the Registration Authority. In the cases referred to in Chapter 8a, applications may also be filed with the patent authority of another country or with an international organisation. (1396/1995)

The application shall contain a description of the invention, accompanied by drawings where necessary, and a precise statement of the subject matter for which utility model right protection is sought (a claim). More specific provisions regarding illustrations accompanying the application shall be laid down by Government Decree. The description shall be sufficiently clear to enable a person skilled in the art to carry out the invention with the guidance thereof. Where the invention relates to a biological material or involves the use of biological material when being carried out, section 8a and section 22(6) and (8) of the Patents Act shall apply mutatis mutandis. (700/2008)

The inventor’s name shall be stated in the application. If a utility model right is applied for by a person other than the inventor, the applicant shall be required to prove his title to the invention.

Section 7

In compliance with the language laws in force, the description and claim shall be written in Finnish or Swedish. If the claim is written in one only of the two national languages, the Registration Authority shall have the claim translated into the other national language before the utility model is registered. The applicant shall pay the prescribed translation fee. Where the applicant is a foreigner, the description shall be written in Finnish and the claim in Finnish and Swedish. However, all applicants shall be entitled to write the description of the invention and the claim in both Finnish and Swedish.

The applicant shall pay the prescribed registration fee. (700/2008)

Section 7a (700/2008)

The Registration Authority must accord a filing date for a utility model application, if:

- 1) the application contains an indication that its elements are intended to be a utility model application;
- 2) the application contains indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Authority; and

Source: World Intellectual Property Organization
<http://www.wipo.int>

3) the documents submitted on filing the application contain anything that can be regarded as a description or a drawing, or the application contains a reference to an earlier filed patent or utility model application and the applicant has submitted information on the filing date of the patent or utility model application, the serial number and the patent or registration authority with which the application was filed.

If the applicant has not complied with the provisions of subsection 1 for being accorded a filing date for the application, the applicant is invited to correct the deficiencies within a time limit laid down by the Registration Authority. If the applicant fails to correct the deficiencies within that time limit or if the Authority has failed to contact the applicant within two months of the receipt of the application, the application is deemed not to have been filed.

If the applicant, to be accorded a filing date, has, within the time limit provided in subsection 2, corrected all deficiencies contained in the application, the date on which all deficiencies have been corrected will be taken to be the filing date.

Section 7b (700/2008)

If an application which has been filed in compliance with the provisions of section 7a is defective and the Registration Authority finds that an element or elements of the description or the drawings to which reference is made in the description or the claims are missing, the applicant is invited to supplement his or her application within the time limit laid down by the Registration Authority. If the missing elements are supplied within the set time limit, the filing date shall be the date on which all deficiencies have been corrected, unless otherwise provided in subsections 2 and 3.

If the subsequently furnished elements referred to in subsection 1 are cancelled within one month from the date of furnishing, the original filing date will be taken to be the filing date.

If the missing elements are furnished in compliance with the provisions of subsection 1 and priority is claimed from an earlier application and the missing elements in their entirety appear from that application, the date of the initial filing will be taken to be the filing date, if the applicant so requests and submits a copy of the application given as the basis of priority within the time limit laid down in subsection 1.

Section 8 (700/2008)

A utility model application may also result from conversion of a pending patent application or a pending European patent application relating to the same invention into an application for a utility model right, which shall be deemed to have been made on the filing date of the patent application or European patent application. However, conversion shall not be allowed after the expiry of ten years from the day the patent application or European patent application is deemed to have been filed. In other respects, the

provisions relating to applications for utility models shall also apply in the case of such utility model applications.

A patent application shall remain pending even if it is converted into a utility model application unless the applicant specifically withdraws the patent application.

When converting a patent application complying with subsection 1 into a utility model application, the applicant must, simultaneously or within the time limit set by the Registration Authority, pay the renewal fees that have fallen due. If the renewal fees are not paid within said time limit, the application shall be dismissed.

Section 8a (1696/1995)

If a European patent application under the European Patent Convention is to be deemed withdrawn because it has not been received in due time by the European Patent Office from the national Registration Authority of the Contracting State of the European Patent Convention with which the application was filed, it shall, at the applicant's request, be converted into a utility model application, provided that:

- (1) the request is submitted to the national Registration Authority of the Contracting State of the European Patent Convention within three months of the date on which the European Patent Office notified the applicant that the application is deemed withdrawn;
- (2) the request is received by the Registration Authority within 20 months of the filing date of the application or, where priority is claimed, from the date of priority; and
- (3) the applicant pays the prescribed application fee and submits the translation pursuant to section 7 of the utility model application within the prescribed time limit.

If a European patent application is to be deemed withdrawn because no translation in its language of proceedings has been submitted to the European Patent Office within the prescribed time limit, it may, at the request of the applicant, be converted into a national utility model application in compliance with the provisions of Article 135 of the European Patent Convention. The applicant shall additionally pay the Registration Authority the prescribed registration fee and submit a translation pursuant to section 7 of the utility model application within the prescribed time limit. (700/2008)

If a utility model application within the meaning of subsections 1 and 2 satisfies the requirements as to form of the European Patent Convention and its Implementing Regulations, it shall be accepted in these respects.

Section 9 (1396/1995)

A utility model right may not be applied for in respect of two or more mutually independent inventions within the same application.

At the applicant's request, a utility model application may be divided, in which case the new application shall be deemed as having been filed at the same time as the original application.

Section 10 (700/2008)

An applicant for and a proprietor of a utility model right not domiciled in Finland shall be required to appoint a representative domiciled in the European Economic Area to represent him in all matters concerning the application and the registered utility model.

If it has not been possible to notify the applicant, proprietor or invalidation requester, at the address he has furnished, of a decision taken in respect of a utility model application or registered utility model, notification can be effected by publishing an announcement in the Utility Model Gazette published by the National Board of Patents and Registration of Finland. Such notification is deemed to have been effected once the abovementioned action has been taken.

Section 11

A utility model application may not be amended in such a way that a utility model right is claimed for matter not disclosed in the original application.

Section 12

The Registration Authority shall check that the application complies with section 1(2 and 3) and sections 6 to 11. (700/2008)

The Registration Authority shall classify the application.

The applicant or, after the utility model has been entered into the Register or been made available to the public under section 18, anyone may submit a request in writing for an examination to assess whether an invention for which utility model registration has been granted or a utility model application filed satisfies the requirements laid down in section 2(1). The prescribed fee is payable for such an examination. (1396/1995)

Section 13

If the applicant fails to satisfy the requirements for the application, or if the authority finds other obstacles to the registration of the utility model, the applicant shall be notified thereof by official action and be invited to file his comments or the necessary corrections within the specified period of time.

If the applicant fails to file his comments or to take steps to remove the obstacles within the specified period of time, the application shall be dismissed. Official action issued pursuant to subsection 1 shall include a notice to that effect.

A dismissed application may be reinstated if, within two months of the expiration of the time limit laid down in the official action, the applicant so requests and files comments or takes steps to correct the application and, within the same period of time, pays the prescribed reinstatement fee. An application may be reinstated only once.

Section 14

If, after the applicant has filed his comments, there remains an obstacle to the registration of the utility model on which the applicant has had an opportunity to comment, the application shall be rejected, unless there is reason to issue a further official action to the applicant.

Section 15

If a person other than the applicant claims title to the invention before the Registration Authority, and if the circumstances are held to be uncertain, the Registration Authority may invite said other person to institute legal proceedings before a court of law within a specified period of time, failing which the claim will not be taken into consideration.

If proceedings for title to an invention in respect of which utility model protection has been applied for are pending before a court, the processing of the utility model application may be suspended until a final decision has been given in such proceedings.

Section 16

If a person proves to the Registration Authority that he has title to the invention and not the applicant, the Registration Authority shall, if said person so requests, transfer the application to him. At the same time, he shall pay a new registration fee.

The application shall not be dismissed, rejected, granted or withdrawn until a final decision has been taken on the request.

Section 17 (700/2008)

If the application satisfies the requirements of section 1(24) and of sections 6 to 11, the utility model shall be recorded in the Utility Model Register. Public notice shall be given of the registration and a certificate of registration shall be issued to the applicant.

When a utility model application has become public, the Registration Authority shall publish it in Finnish and Swedish through a claim publication. Such a publication will be issued in electronic format.

Provisions regarding the contents of claim publications shall be issued by government decree.

Section 18 (1396/1995)

The application file shall be available to the public as from the date of registration or no later than 15 months having elapsed since the date the application was filed or is deemed to have been filed, or, where priority is claimed, from the priority date.

At the request of the applicant, registration may be postponed for a period of no more than 15 months from the date the application was filed or is deemed to have been filed, or, where priority has been claimed, from the priority date. If the application has been dismissed or rejected, the file shall become available to the public only if the applicant requests the reinstatement of the application or appeals against the decision by which the application was rejected. A prescribed fee is payable for the postponement of the registration.

At the applicant's request, the application file may be made available to the public earlier than provided for in subsection 1.

Chapter 3

Possibility to request that the registration be declared invalid

Section 19

A utility model registration shall be declared wholly or partially invalid in response to a request to that effect, provided that:

- 1) the registration relates to an invention that does not satisfy the requirements of section 1(24) and section 2;
- 2) the registration relates to an invention the description of which is not sufficiently clear to enable a person skilled in the art to carry out the invention;
- 3) the utility model right concerns a matter which was not included in the original application;
- 4) when converting a patent application into a utility model application, the requirements of sections 8 or 8a have not been observed; or
- 5) the claim was extended after the registration of the utility model right.

(700/2008)

Any person may request that the registration be declared invalid. Such a request shall be made to the Registration Authority in writing and state the facts on which it is based. The person making the invalidation request shall pay the prescribed fee. If payment is not made, the request will not be considered. (700/2008)

Source: World Intellectual Property Organization
<http://www.wipo.int>

An invalidation request shall not be considered if proceedings are pending concerning the transfer of the registration.

Section 20 (700/2008)

The Registration Authority shall notify the proprietor of the utility model right of any invalidation request made under section 19 and give him an opportunity to file comments on the request within a specified period of time. If the proprietor requests limitation of the protection established through the registration, he shall submit a reworded claim to the Registration Authority within the same specified time period.

If the proprietor of the utility model right opposes the request, the invalidation request shall be examined by the Registration Authority. If the proprietor of the utility model right submits a reworded claim, the Registration Authority shall examine the invalidation request on the basis of the reworded claim.

If the proprietor of the utility model right does not oppose the invalidation request within a specified period of time, the registration of the utility model shall be declared invalid in whole.

Section 21 (700/2008)

The Registration Authority must declare the utility model registration invalid if there are grounds for doing so as stipulated in section 19(1). If the proprietor of the utility model right has submitted a reworded claim, this shall be the subject of invalidation procedures.

If there are no grounds for invalidation as stipulated in section 19(1) as regards the reworded claim submitted by the proprietor of the utility model right, the registration shall be held in force in accordance with the reworded claim. In such a case, the Registration Authority shall publish the reworded claim.

If a registration has been declared invalid, the decision shall be published once it becomes final.

Chapter 4

Appeals

Section 22

A utility model right applicant or proprietor may seek to appeal against a final decision concerning registration or invalidation request of the utility model right, if the decision is not in his favour. The person requesting a declaration of invalidation of a utility model may seek appeal if his request is rejected by the decision.

Appeal against a decision rejecting a request for reinstatement under section 13(3) or a decision granting a request for transfer of an application under section 16, may be sought by the applicant. Appeal against a decision rejecting a request for transfer of an application may be sought by the person making the request.

An applicant or proprietor may seek to appeal against the Registration Authority's final decision by which a proposal referred to in section 26a (13) has been rejected or dismissed. (700/2008)

A proprietor may seek to appeal against the Registration Authority's final decision as referred to in section 33(1), if the decision is not in his favour. (700/2008)

Section 23 (580/1992)

Any appeal shall be brought against a decision taken by the Registration Authority under the present Act by filing an appeal with the Board of Appeal of the National Board of Patents and Registration. Separate provisions shall apply to the appeal procedure and the proceedings before the Board of Appeal.

Chapter 5

Scope and term of protection and restoration of rights (700/2008)

Section 24

The scope of protection conferred by a utility model right shall be determined by the claim. The description and illustrations may be used to interpret the claim.

Section 25 (700/2008)

The term of protection of a utility model registration shall be four years from the filing date of the application and may, on request, be renewed twice, first for a period of four years and then for a period of two years.

Section 26

The registration renewal fee shall fall due on the last day of the month during which the registration term expires. The renewal fee may be paid within six months from the due date. After the expiration of the running registration term, a renewal fee must be paid, raised by a prescribed amount. Renewal fees may not be paid earlier than one year before the due date. (700/2008)

Any renewal of registration must be announced.

Section 26a (700/2008)

If an applicant or proprietor of a utility model right has suffered loss of rights because he has not taken action before the Registration Authority within the time limit laid down in this Act or in the provisions issued under it, but has taken all due care required by the circumstances to observe the time limit, and if that person takes such action within two months of the time at which the cause of his noncompliance ceases—and in any event no later than one year after expiration of the time limit—the Registration Authority must deem the act to have been performed within the prescribed time limit. The applicant or proprietor of a utility model right must inform the Registration Authority about it in writing within the aforementioned time limit and pay the prescribed fee.

If the applicant of a utility model right has suffered loss of rights in the observation of the time limit under section 5(1) but has filed the application within two months of the end of the priority year, the provisions of subsection 1 will apply only if the request has been made and the prescribed fee paid within the same time limit of two months.

Subsections 1 and 2 of this section also apply to an international patent application which has been pursued in the form of a utility model application in Finland, as regards the time limit to be observed concerning the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau of World Intellectual Property Organization (WIPO). Failure to observe this time limit must then be remedied at the Registration Authority.

However, a request filed in accordance with the provisions of subsection 1, 2 or 3 may not be refused, nor may its admittance be refused, until the utility model right applicant or proprietor has been given an opportunity to file his comments within the time limit laid down by the Registration Authority.

Section 26b (700/2008)

If a request under section 26a (1–3) is granted and if, as a result, the examination of a utility model application that has been dismissed or rejected after becoming available to the public is resumed or a lapsed utility model is reinstated, an announcement to that effect shall be made.

Chapter 6

Assignment, licences and compulsory licences

Section 27

A utility model right may be transferred.

If another person has obtained the right to exploit the invention commercially (licence), such a person may transfer his right further only if such has been agreed.

However, if the licence has been granted to an enterprise, it may be transferred together with the enterprise, unless otherwise agreed. In such a case the assignor shall remain liable for compliance with the licence agreement.

Section 28

The transfer of a utility model right or the granting of a licence shall be recorded in the Utility Model Register on request and upon payment of the prescribed fee. This shall also apply to the pledging of a utility model right. Upon proof that a licence or a pledge recorded in the Register is no longer in force, the entry shall be deleted from the Register.

Subsection 1 shall apply mutatis mutandis to compulsory licences and to the right referred to in section 32(1).

The person last recorded in the Utility Model Register as the proprietor of the utility model right shall be deemed the proprietor for the purposes of legal proceedings and for other matters concerning the utility model.

Section 29

If a person acting in good faith has requested that the Registration Authority record in the Register that a utility model right has been transferred to him or that he has obtained a licence to a utility model or a pledge in a utility model, no earlier transfer of the utility model right or of rights therein shall be enforceable against him, if the other party has not previously requested registration of his acquisition in the Utility Model Register.

Section 30

Where two years have elapsed since the registration of the utility model and the invention has not been worked or brought into use to a reasonable extent in Finland, any person who wishes to work the invention in the country may obtain a compulsory licence to do so unless there are legitimate grounds for the failure to work. (1696/1995)

The provisions of sections 46 to 50 of the Patent Act relating to compulsory licences to exploit inventions protected by patents shall apply mutatis mutandis with respect to utility model rights.

Chapter 7

Termination of utility model right and obligation to furnish information

Section 31

Where a utility model has been registered in the name of a person other than the person entitled under section 1 and where an action is brought by the person having the right to the utility model, the court shall transfer the utility model to the entitled person.

Source: World Intellectual Property Organization
<http://www.wipo.int>

Such actions shall be brought within one year of the plaintiff's gaining knowledge of the registration and of any other circumstances on which the action is founded. Such action may not be brought more than three years after registration of the utility model if the proprietor of the utility model acted in good faith at the time the utility model was registered or was transferred to him.

Section 32

Where a person dispossessed of a registration in accordance with section 31 had, in good faith, begun commercial exploitation of the invention in this country or had made substantial preparations therefore, he shall be entitled, against reasonable remuneration and on other reasonable terms, to continue the exploitation or to commence the intended exploitation, provided that its general nature is maintained. A licensee recorded in the Utility Model Register shall have the same right subject to equivalent conditions.

The right referred to in subsection 1 may only be transferred to others together with the enterprise in which it is exploited or intended to be exploited.

Section 33

Where the proprietor of a utility model right notifies in writing that he relinquishes his registration, the Registration Authority shall delete the utility model from the Register. Such relinquishment of registration shall become effective as of the filing date of the utility model application. (700/2008)

Where a utility model is seized for debt or is subject to a pledge that has been recorded in the Register or if an action for a transfer of registration is pending, the utility model may not be deleted from the Register at the proprietor's request as long as the seizure or pledge is in force or until a final decision has been given in the action.

Section 34

Where a utility model registration has been transferred by final decision of a court, the Registration Authority shall publish a notice to that effect.

Section 35

The provisions of section 56 of the Patents Act concerning the obligation to furnish information in respect of a patent shall apply mutatis mutandis to a utility model right.

Chapter 8

Liability, payment of compensation and court proceedings

Section 36

The court may forbid any person who infringes the exclusive right conferred by a utility model right from continuing or repeating the act.

Section 36a (686/2006)

When hearing an action referred to in section 36, the court may at the utility model right holder's request prohibit 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 use alleged to infringe the utility model (injunction order), unless this can be considered disproportionate in view of the rights of the alleged infringer of the utility model or in view of the rights of the intermediary or utility model right holder.

Before the bringing of an action referred to in section 36, the court referred to in that subsection may, at the utility model right holder's request, issue an injunction, if the preconditions for that set out in subsection 1 exist and if it is obvious that the realisation of the utility model right holder's rights would otherwise be seriously endangered. The court must provide an opportunity to be heard both for the party against whom the injunction is sought and for the party who is claimed to be infringing the utility model right. Communications to the parties against whom the injunctions have been sought may be delivered by mail or by facsimile or email. Otherwise, the provisions of Chapter 8 of the Code of Judicial Procedure shall apply to the processing of the case.

Upon request, the court may issue the injunction referred to in subsection 2 as an interlocutory injunction without hearing the alleged infringer, if the urgency of the case imperatively so requires. The injunction will remain in force until otherwise ordered. After the injunction is issued, the alleged infringer must be provided an opportunity to be heard without delay. When the alleged infringer has been heard, the court must decide without delay whether to keep the injunction in force or withdraw it.

An injunction issued under this section must not endanger the right of a third party to send and receive messages. Subject to the provisions of Chapter 7, section 7, of the Code of Judicial Procedure, the injunction will enter into force when the plaintiff provides the bailiff with the security referred to in Chapter 7, section 16, of the Execution Act (37/1895). An injunction issued under subsection 2 or 3 of this Section will lapse if the action referred to in section 36 is not brought within a month of the issuance of the injunction.

The party who has demanded the injunction must compensate the party against whom the injunction is issued as well as the alleged infringer for the damage caused by the implementation of the injunction and for any other costs resulting from the case, if the

action referred to in section 36 is rejected or ruled inadmissible, or if the processing of the case is removed from the cause list because the plaintiff has abandoned his action or failed to arrive at the court. The same applies if the injunction is withdrawn under subsection 3 or lapses under subsection 4. When an action is brought for compensation for damage and costs, the provisions of Chapter 7, section 12, of the Code of Judicial Procedure apply.

See the act on safeguarding the presentation of evidence in disputes on industrial property rights and copyrights (344/2000). The Execution Act (37/1895) has been repealed by the Enforcement Code (705/2007), see Chapter 8, section 2 of the Enforcement Code (705/2007).

Section 37

Any person who intentionally or negligently infringes a utility model right shall be liable to pay reasonable compensation for the exploitation of the invention, as well as compensation for other damages caused by the infringement. If only slight negligence is in question, the compensation may be adjusted accordingly.

A person found guilty of utility model right infringement that is neither intentional nor negligent shall pay compensation for the exploitation of the invention to the extent held reasonable.

An action for compensation for utility model right infringement may only be brought with respect to damages suffered during the five years preceding the institution of the action. If an action is not instituted within that period, the right to compensation shall be forfeited.

Section 38

The provisions of section 59 of the Patents Act concerning measures to prevent further infringement shall apply *mutatis mutandis* to utility model rights.

Section 38a (686/2006)

In a dispute concerning an infringement of a utility model right the court may, at the plaintiff's request, order the defendant to compensate the plaintiff for any costs incurred by him for the publication, based on suitable measures, of information concerning the final decision in which the defendant is found to have infringed the utility model right. Such an order may not be given if the dissemination of the information is limited elsewhere under law. In considering the issuance and contents of the order, the court must pay attention to the general significance of the publication of the issue, the kind and scope of the infringement, the costs involved in the publishing process and other corresponding facts.

The court lays down a maximum amount for the reasonable publishing cost to be paid by the defendant. The plaintiff is not entitled to compensation if information on the

decision has not been published within a period laid down by the court, counted from the date when the final decision was issued.

Section 39

Any person who infringes an exclusive right conferred by a utility model right intentionally, shall, unless the act is punishable as an industrial property right offence under section 2 of Chapter 49 of the Penal Code, be liable to a fine for violation of a utility model right. (720/1995)

Indictment for an offence referred to in subsection 1 may be brought by the Public Prosecutor only if so requested by the injured party.

Section 40

Any person who intentionally or by negligence, other than slight negligence, fails to comply with an obligation under section 35, shall be liable to a fine for failure to comply with the obligation to furnish information relating to a utility model.

Any person who provides false information in a case referred to in said section shall also be liable to the same penalty, unless the act is punishable under the Penal Code.

Indictment for an offence referred to in the present section may be brought by the Public Prosecutor only if so requested by the injured party.

Section 41

Where a utility model registration has been declared invalid by a final decision, no penalty, payment of compensation or other sanction may be ordered under section 2 of Chapter 49 of the Penal Code or sections 36 to 39 of this Act. (720/1995)

Where it is claimed in an action for infringement of a utility model right that the registration does not comply with this Act, the court may, at the defendant's request, stay proceedings or the decision until a final decision has been taken on the invalidity request. Where no request for invalidation has been filed with the Registration Authority, the court shall order the defendant, in connection with the stay of proceedings, to file such a request within the period of time it shall determine.

Section 42

Any person who wishes to bring an action for transfer of a utility model right or for the granting of a compulsory licence shall give the Registration Authority notice thereof and shall notify all persons recorded in the Utility Model Register as licensees under the utility model right or as proprietors of a pledge therein. If a licensee wishes to bring an action for utility model infringement, he shall notify the proprietor of the right thereof.

The requirement to notify pursuant to subsection 1 shall be deemed satisfied when notification by registered letter has been sent to the addresses recorded in the Utility Model Register.

If the plaintiff cannot prove, at the time the action is brought, that he has given notice pursuant to subsection 1, he shall be given a sufficient period of time to do so. If he does not avail himself of that period of time, the action shall be dismissed.

Section 43 (700/2008)

The District Court of Helsinki shall be the competent court in which proceedings are heard in respect of:

- (1) proper title to an invention for which a utility model right has been sought;
- (2) transfer of a utility model right;
- (3) the granting of compulsory licences, the amendment of conditions for compulsory licences or the revocation of a right referred to in 32(1);
- (4) infringement of a utility model right or noncompliance with the obligation to furnish information relating to a utility model; or
- (5) assessment of the compensation due under section 37.

Section 44

The provisions of sections 66 and 67 of the Patents Act shall apply *mutatis mutandis* to the proceedings referred to in section 43.

Section 45

The court shall communicate to the Registration Authority a copy of any decisions given in the proceedings referred to in section 43, together with a statement as to whether the decision is final.

The court's obligation to give notice of the decision by registering it in the decision notification system included in the judicial administration's national information system, or by issuing the information to the Legal Register Centre for further delivery to the Registration Authority, shall, if necessary, be stipulated by a Decree of the Ministry of Justice. In the registration or delivery of such information, the act on the judicial administration's national information system (372/2010) and the provisions issued under it shall apply. (395/2010)

Subsection 2 as amended by the Act 395/2010 shall enter into force on 1 December 2010.

Chapter 8a (1396/1995)

International applications

Section 45 a (1396/1995)

In this Act "an international application" shall mean an application relating to a utility model filed under the Patent Cooperation Treaty (Finnish Treaty Series 58/80).

International applications shall be filed with a registration authority or an international organisation (receiving office) authorised under the Patent Cooperation Treaty and its Regulations to receive such applications. The receiving office in Finland shall be the National Board of Patents and Registration, as laid down by Government decree. Applicants filing an international utility model application in Finland shall pay the prescribed fees.

Unless otherwise provided in sections 45b to 45d or 45f, the provisions of Chapter 3 of the Patents Act in respect of the processing of international patent applications shall mutatis mutandis apply to the processing of international utility model applications designating Finland. (700/2008)

Section 45b (700/2008)

An international utility model application to which a receiving office has assigned an international filing date shall have the same effect in this country as a Finnish utility model application filed on the same date. The second sentence in section 2(2) shall only apply to an international application that has been pursued under section 45d.

Section 45c (1396/1995)

An international utility model application shall be deemed withdrawn as far as the designation of Finland is concerned in the cases referred to in Article 24(1)(i) and (ii) of the Patent Cooperation Treaty.

Section 45d (700/2008)

If an applicant wishes to pursue an international utility model application in Finland, he shall file with the Patent Authority a translation in Finnish or Swedish of the international application within 31 months of the international filing date or, where priority is claimed, of the priority date, or a copy of the application where it is written in Finnish or Swedish. The applicant shall pay the prescribed registration fee to the Registration Authority within the same period.

If the applicant has paid the prescribed registration fee within the time limit laid down in subsection 1, the required translation or a copy of the application may be filed within a further period of two months, provided the prescribed additional fee is paid within that same period.

Source: World Intellectual Property Organization
<http://www.wipo.int>

If the application, in cases referred to in subsection 1, does not satisfy the requirements of this Act, the applicant may within a period of two months from the time limits referred to in subsection 1 render the application so as to comply with the requirements as to the form and content of the Implementing Regulations of the Patent Cooperation Treaty. If the applicant does not satisfy the requirements of this section, the application shall be deemed withdrawn as far as Finland is concerned.

Section 45e (700/2008)

Section 45e has been repealed by the Act of 7 November 2008.

Section 45f (700/2008)

Where an international application has been pursued under section 45d, the provisions of Chapters 2 and 5 shall apply in respect of the application and examination, unless otherwise provided in this section or in sections 34 to 38 of the Patents Act. However, the application may be taken up for examination prior to the expiration of the period laid down in section 45d(1), only if so requested by the applicant.

The obligation under section 10 of the applicant to have a representative domiciled in the European Economic Area does not begin until the date when the application may be taken up for examination.

When 18 months have elapsed since the filing date of the application or, if priority is claimed, from the priority date, and the applicant has satisfied his obligation under section 45d to submit a translation or, where the application has been written in Finnish or Swedish, the applicant has submitted a copy of the application to the Registration Authority, the application documents shall be available to the public even before the applicant has pursued the application.

Chapter 9

Miscellaneous provisions

Section 46 (1037/1992)

Separate provisions shall apply to the amounts of fees to be paid under the present Act.

Section 47 (700/2008)

Further provisions on utility model applications, the Utility Model Register and the Registration Authority will be issued by Government Decree. Detailed technical regulations concerning utility model applications may be issued by the Registration Authority. Such regulations may concern the utility model application and its processing, registration, amendments and time limits and other comparable technical issues.

Section 48

The provisions of section 75 of the Patents Act concerning the obligation to surrender rights in an invention in certain cases and the compensation to be paid therefore shall apply mutatis mutandis to utility model rights.

Separate provisions shall apply in respect of inventions of importance to the defence of the country. (1396/1995)

Chapter 10

Entry into force and transitional provisions

Section 49

This Act will enter into force on a date to be defined by decree.

Applications filed prior to the entry into force of this Act may not serve as a basis for a priority claim under section 5.

Patent applications filed or deemed to have been filed prior to the entry into force of this Act may not be converted into applications for utility models under section 8..