

# REGISTERED DESIGNS ACT

No. 221 of March 12, 1971\*

(as last amended by Act No. 718 of April 21, 1995)

## Table of Contents\*\*

|              |  | <i>Articles</i> |
|--------------|--|-----------------|
| Chapter I    | General Provisions.....                                      | 1-8             |
| Chapter II   | The Application for Registration and Processing Thereof..... | 9-33            |
| Chapter III  | Period of Validity of Registration of a Design.....          | 54-25           |
| Chapter IV   | Licenses, Compulsory Licenses, Assignments .....             | 56-30           |
| Chapter V    | Termination of Right to a Design .....                       | 31-33           |
| Chapter VI   | Obligation to Provide Information.....                       | 34              |
| Chapter VII  | Responsibility and Obligation to Provide Compensation .....  | 35-40           |
| Chapter VIII | Rules Concerning Legal Proceedings .....                     | 41-44           |
| Chapter IX   | Special Provisions.....                                      | 45-49           |

## Chapter I General Provisions

### *Art. 1*

In this Act, the term “design” means the prototype for an article’s appearance or for an ornament.

The creator of a design or his assignee may obtain, by registration, the exclusive right to use the design in the course of trade in accordance with this Act (*design right*).

### *Art. 2*

A design shall be registered only if it differs substantially from what has become known prior to the date of the application for registration.

In this context, the term “known” shall apply to everything that has been made available to the public, whether as the result of reproduction, exhibition, offering for sale or otherwise. Even a design that is not available to the public shall be deemed to be known if the design is evident from an application in this country for a patent or a utility model or for registration of a trademark or design where that application has been, or is deemed under the relevant provisions to have been, made before the date stated in the foregoing paragraph and where the design is subsequently, when the application is processed, made available to the public.

### *Art. 3*

A design may nevertheless be registered where, during the six months before the application for registration was filed, it has been made available to the public:

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Note: Translation by the International Bureau of WIPO on the basis of a translation supplied by the Finnish authorities.

\*\* Added by the International Bureau of WIPO.

- (1) through manifest abuse to the detriment of the applicant or his predecessor in title;
- (2) through the display of the design, by the applicant or his predecessor in title, at an official or officially recognized international exhibition.

#### *Art. 4*

A design shall not be registered:

- (1) if it, or its use, is contrary to morality or public policy;
- (2) if it includes any of the following without permission:
  - (a) a national coat of arms, a national flag or other State emblem, an official mark or stamp of inspection or warranty for the same or similar articles as those for which the design is intended, a Finnish municipal coat of arms, or the flag, coat of arms or other emblem, designation or abbreviated designation of an international intergovernmental organization, or a figure, designation or abbreviated designation that may be confused with the emblem, indication, designation or abbreviated designation of the kind referred to in this paragraph;
  - (b) anything that may be understood to be another person's protected trade name, trade symbol or trademark which has become commonly known in Finland, or the surname, pseudonym or similar name or the portrait of another person, unless the name or portrait manifestly refers to a person long deceased;
  - (c) anything that may be interpreted as the title of another person's protected literary or artistic work, provided that the title is distinctive, or anything that infringes another's copyright in such a work or his rights to a photographic illustration;
  - (d) anything that does not substantially differ from a design registered in this country in the name of another person;
  - (e) anything that does not substantially differ from a utility model registered in this country in the name of another person.

#### *Art. 5*

Subject to the exceptions specified below, a design right implies that no one other than the owner of the right may, without the owner's permission, use the design in the course of trade by making, importing, offering, offering for sale, assigning or hiring out an article that does not differ substantially from the design or includes something that does not differ substantially from it.

A design right relates only to the articles for which the design has been registered and to similar articles.

A design right does not give its owner the right to prohibit the use of an article protected by it if the article has been placed on the market within the European Economic Area by the owner of the design right or with his consent.

#### *Art. 6*

Any person who has been using a design in this country in the course of trade on the filing of the application for registration may notwithstanding another's design right, continue to use it while retaining "the general character of the use", provided that such use did not involve manifest abuse with respect to the applicant for registration or his predecessor in title. In the same circumstances, any person who has taken substantial steps with a view to using the design in the course of trade in Finland shall have the same right of use.

The right defined in the foregoing paragraph may be transferred only together with the business in which it came into being or in which the design was to be used.

#### *Art. 7*

The Government may decree that spare parts and accessories for aircraft may be imported in this country, notwithstanding design rights, where those spare parts and accessories are to be used for the repair of aircraft belonging to a foreign country in which equivalent benefits are accorded to Finnish aircraft.

#### *Art. 8*

The Government may decree that an application for registration of a design that has previously been included in an application for protection outside this country shall, at the request of the applicant, be deemed for the purposes of Articles 2 and 6 to have been made at the same time as the application outside this country. The decree shall specify in greater detail the conditions under which such priority may be enjoyed.

## **Chapter II**

### **The Application for Registration and Processing Thereof**

#### *Art. 9*

The registering authority shall be the National Board of Patents and Registration of Finland.

#### *Art. 10*

Applications for the registration of designs shall be filed in writing with the registering authority.

The application shall contain information concerning the article for which design registration is applied for. It shall mention the creator of the design. Where the applicant is not the creator, he shall produce evidence of his right to the design.

A representation of the design shall be attached to the application document. Where the applicant also deposits a specimen before the application is published under Article 18, the specimen shall be deemed to disclose the design. An attestation shall also be attached to the application in which the applicant confirms that the design to his knowledge has not, before the date on which the application is made or is deemed under the provisions of Article 8 to have been made, become so known as to preclude its registration under Articles 2 and 3.

On filing the application, the applicant shall pay the application fee and additional fees specified in Article 47.

#### *Art. 11*

An application may include more than one design where the articles for which registration of the design is applied for are related with respect to their manufacture and use. An application for such multiple registration may not comprise more than 20 designs.

Ornaments may not be the subject of multiple registrations.

#### *Art. 12*

An applicant who is not domiciled in this country shall have an agent resident in this country who is empowered to represent him in all matters concerning the application.

#### *Art. 13*

An application for registration of a design shall not be deemed to have been made until the applicant has deposited a representation or specimen of the design with the registering authority.

An application must not be altered so that it relates to a design or an article other than the design or article specified in the application.

#### *Art. 14*

When examining an application for registration of a design, the registering authority shall, to the extent decreed by the Government, establish whether the conditions for such registration have been satisfied. Where the applicant has not observed the prescribed requirements regarding the application, or where the authority finds that there are other objections to acceptance of the application, the applicant shall be invited in an Office instruction to respond to the objections or make a correction within a prescribed period.

Where the applicant fails within the prescribed period to submit a statement or to take steps to remedy a defect to which his attention has been drawn, the application shall be dismissed as abandoned. A warning to that effect shall be included in the Office action.

The application shall be reinstated however if, within two months after the expiration of the prescribed period, the applicant so requests and gives a response to the Office instruction or takes steps to remedy the

defect and within the same period pays the prescribed reinstatement fee. Reinstatement may be granted only once.

*Art. 15*

If there is still some objection to acceptance after the applicant's response to the Office action and provided that the applicant has had an opportunity to answer the objection, the application shall be rejected unless there are grounds for delivering a further Office action to the applicant.

*Art. 16*

Where a person claims to the registering authority that he has a better right to the design than the applicant, and where the matter is found to be unclear, the authority may instruct him to institute legal proceedings within a certain period, failing which his claim will be disregarded when the application is examined further.

Where a dispute concerning an allegedly better right to a design is pending before a court of law, the application for registration may be suspended until the case is finally settled.

*Art. 17*

Where a person proves to the registering authority that he has a better right to the design than the applicant, the authority shall transfer the application to him if he so requests. The transferee shall pay a new application fee.

Where transfer is requested, the application must not be altered, dismissed, rejected or accepted until the transfer request has been finally ruled upon.

*Art. 18*

Where the application documents are in the prescribed form and no objection to registration has been found, the registering authority shall publish the application in order to give the public an opportunity to file opposition.

At the applicant's request, publication may however be deferred for a period of up to six months counted from the filing date or the date from which priority is claimed under Article 8. Requests for deferment shall be made on the application form.

Opposition shall be filed in writing with the registering authority within two months from the date of publication.

*Art. 19*

Unless the application documents are to be kept secret following the applicant's request for deferment under Article 18, they shall be available to the public.

Where deferment of publication has been requested, the application documents shall be available to the public on the expiration of the prescribed period, but not later than six months counted from the filing date or the date from which priority is claimed under Article 8. If during the prescribed period the authority decides to dismiss or reject the application, the documents shall not be available to the public unless the applicant requests reinstatement of the application for examination or lodges an appeal.

*Art. 20*

On the expiration of the period prescribed in the third paragraph of Article 18, a further examination of the application shall be carried out. Articles 14, 15, 16 and 17 shall be applicable to that examination.

In the event of opposition the applicant shall be informed thereof. Where the opposition is not manifestly unjustified, the applicant shall be given an opportunity to respond to it.

*Art. 21*

An applicant for registration of a design may appeal against a final decision of the registering authority that has found in his disfavor. A person who has duly filed opposition may appeal against a decision accepting the application. Where the opponent withdraws his appeal, it may nevertheless be considered if there are special reasons for doing so.

An applicant may appeal against the rejection of a request for reinstatement under the third paragraph of Article 14, and against the acceptance of a request for transfer under Article 17. The person requesting transfer may appeal against the rejection of his request.

*Art. 22*

Appeals from decisions of the registering authority under this Act shall be lodged with the Board of Appeals of the National Board of Patents and Registration of Finland. Special rules shall apply to the appeal procedure and to the hearing of cases by the Board of Appeals.

*Art. 23*

Where an application for registration of a design is accepted by a decision having force of law, the design shall be entered in the Register of Designs and the registration shall be published.

A decision to dismiss or to reject an application that has been published under Article 18 shall be published after the decision has acquired force of law.

### **Chapter III**

#### **Period of Validity of a Design Registration**

*Art. 24*

The registration of a design shall be valid for five years, counted from the day on which the application for registration was filed. Registration may, on request, be renewed for two further periods of five years, each such period running from the expiration date of the preceding period.

*Art. 25*

Applications for renewal of registration shall be filed in writing with the registering authority, not earlier than one year before or later than six months after the expiration of the current period of registration. The renewal and other fees specified in Article 47 shall be paid within the same period, failing which the application shall be rejected.

Renewal of a registration shall be published.

### **Chapter IV**

#### **Assignment, Licensing, Compulsory Licensing**

*Art. 26*

A design right may be transferred.

Where the registered owner of a design has given another person the right to use the design in the course of trade (a license), the licensee may not assign that right in the absence of an agreement to that effect.

A license forming part of a business may however be assigned, when the business is assigned, in the absence of agreement to the contrary. In such a case the assignor shall remain responsible for ensuring the fulfillment of the license agreement.

*Art. 27*

In the event of the transfer or licensing of a design right, an entry to that effect shall, on request and for a prescribed fee, be made in the Register of Designs. The same shall apply to any pledge on the design right. If it is proved that a license or pledge recorded in the Register has ceased to be valid, the entry shall be removed.

The foregoing paragraph shall apply as appropriate to a compulsory license and to the right referred to in the second paragraph of Article 32.

In the case of a multiple registration, the transfer of a design right may be entered only in respect of all of the designs.

In legal proceedings or other business concerning a design right, the person whose name was last entered in the Register of Designs as the registered owner of the design shall be deemed to be the registered owner thereof.

Any person requesting the entry in the Register of an assignment of a design right or a license or a pledge on such a right shall, provided that he was acting in good faith at the time of the request, be unaffected by an earlier assignment of the design right or a right relating thereto that had not previously been the subject of a request for entry.

#### *Art. 28*

Any person who in the course of trade has been using in this country a design that is the subject of an application for registration when a document disclosing the design becomes available to the public may, where the application leads to registration, obtain a compulsory license to use the design, provided that there are extraordinary reasons therefor and that the person had no knowledge of the application and could not reasonably have obtained knowledge of it. In the same circumstances, any person who has taken substantial steps to use the design in the course of trade in Finland shall have a right to such a compulsory license. A compulsory license may also relate to a period before the design was registered.

#### *Art. 29*

A compulsory license shall not be granted to any person who appears unable to use the design in an acceptable way and in accordance with the terms of the license.

A compulsory license shall not prevent the registered owner of the design from using the design himself or from granting a license. A compulsory license may be transferred only together with the business in which it is used or intended to be used.

#### *Art. 30*

A compulsory license shall be issued by the Court, which shall also decide on the extent to which the design may be used and determine the compensation and other terms of the license. When a substantial change in circumstances so dictates, the Court may, if so requested by the person concerned, revoke the license or specify new terms.

## **Chapter V**

### **Termination of a Design Right**

#### *Art. 31*

Where a design has been registered in violation of Articles 1, 2, 3 and 4 and an obstacle to registration still remains, the court shall, if an action is brought to that end, cancel the registration. Registration may not be canceled, however, on the ground that the person in whose name the registration was made is only a partowner of the design right.

An action for cancellation of registration based on the grant of registration to a person who is not the rightful owner as defined in Article 1 may be brought only by the person claiming entitlement to the design. Such action shall be brought within one year after the plaintiff had knowledge of the registration and of the other circumstances on which the action is based. Where the registered owner of the design was acting in good faith when the design was registered or when the design right was transferred to him, the action may not be instituted more than three years after the registration.

In other cases the action may be brought by any person who suffers damage as a result of the registration. An action based on Article 4(1) or (2)(a) may be brought also by the Public Prosecutor.

#### *Art. 32*

Where a design has been registered in the name of a person who is not the rightful owner as defined in Article 1, the Court shall, when an action is brought by the rightful owner, transfer the registration to him. The action shall be instituted within the periods stated in the second paragraph of Article 31.

Where a person who has been refused registration of a design has begun in good faith to use the design in the course of trade in Finland or has taken substantial steps to that end, he may, subject to payment of reasonable

compensation and the fulfillment of other reasonable terms, continue such use or start the intended use, provided that its general character is preserved. In similar circumstances, the holder of a license entered in the Register shall have the same right.

The right defined in the foregoing paragraph may be transferred only together with the business in which the design is used or intended to be used.

*Art. 33*

Where the registered owner of a design declares in a written statement that he renounces his design right, the registering authority shall remove the design from the Register.

Where the design right is the subject of attachment or a pledge on it has been recorded in the Register, or where a dispute concerning the transfer of registration is pending before a court, the design may not be removed from the Register at the request of the registered owner for as long as the attachment or pledge subsists or the dispute has not been finally settled.

## **Chapter VI**

### **Obligation to Provide Information**

*Art. 34*

Where a person who has applied for registration of a design invokes his application when making a claim against another person before the application documents have become available to the public, he shall on request allow such other person to be given access to the documents.

Any person who by direct contact with another person, in an advertisement, in an inscription or label on an article or its packaging or otherwise that registration of a design has been applied for or granted, but does not at the same time give information on the application or registration number, shall, if so requested, give such information without delay. Where it is not expressly stated that registration has been applied for or granted but where the circumstances so suggest, information shall, if requested, be given without delay on whether registration has indeed been applied for or granted.

## **Chapter VII**

### **Liability and Obligation to Provide Compensation**

*Art. 35*

Anyone who infringes a design right may be restrained by the Court from continuing or repeating the act.

Where the infringement of the design right was intentional he shall, unless the act is punishable as an industrial property right offense under Article 2 of Chapter 49 of the Penal Code, be liable to a fine for violation of the design right.

Prosecution for the violation of the design right may be instituted by the Public Prosecutor only if the aggrieved party brings a legal action claiming the violation.

*Art. 36*

Any person who intentionally or through negligence infringes a design right shall pay reasonable compensation for the use of the design, as well as compensation for the further damage caused by the infringement. If the negligence was minimal, the amount of compensation may be reduced.

Anyone who infringes a design right unintentionally or without negligence shall pay compensation for the use of the design in so far as such compensation is found reasonable.

Proceedings for compensation on the grounds of infringement of the design right shall be instituted within five years from the time at which the damage was done, failing which the right to compensation will be forfeited.

*Art. 37*

If so requested by a person whose design right has been infringed, the Court may order, on the basis of what is reasonable for preventing continued infringement, that an article made in or imported into this country violation of another person's design right, or an article whose use would constitute infringement of the design right, be altered in a certain way, be deposited in safe custody for the remainder of the period of protection, be destroyed or, where the article has been illegally manufactured or imported, be surrendered, against remuneration, to the person whose right has been infringed. This provision shall not apply to a person who has acquired the goods or a special right to them in good faith and who has not himself infringed the design right.

The goods defined in the foregoing paragraph may be confiscated if it appears that an offense under Article 2 of Chapter 49 of the Penal Code or Article 35 of this Act has been committed. The provisions of the general legislation on confiscation in criminal matters (Coercive Criminal Investigation Means Act (450/87) shall be applicable in such an event.

Notwithstanding the provisions of the first paragraph of this Article, the court may, where special circumstances obtain and if so requested, issue an order giving the owner of the goods referred to in the said paragraph the right of disposal over those goods during the remainder of the period of protection, or part of it, in return for reasonable compensation and on other reasonable terms.

#### *Art. 38*

If any person without authorization uses in the course of trade a design that is the subject of an application for registration after the application documents have become available to the public, the provisions of this Act on infringement of a design right shall apply as appropriate in so far as the application leads to registration. No penalty may be inflicted, however, and compensation for damage caused by use made before the application was published under Article 18 may be determined only in accordance with the second paragraph of Article 36.

The provisions of the third paragraph of Article 36 shall not apply where the proceedings for compensation are instituted within one year after registration of the design.

#### *Art. 39*

Where a design registration has been canceled as a result of a judgment having force of law, the penalties, compensation or protective measures provided for in Article 2 of Chapter 49 of the Penal Code or Articles 35 to 38 of this Act shall not be ordered.

Where the defendant in an action for infringement of a design right claims that the registration of the design is invalid, the court shall, if the defendant so requests, adjourn the case pending a final examination of the question of cancellation of the registration. If no action to that end has been instituted, the court shall, at the time of adjournment, specify a period for the institution of such action.

#### *Art. 40*

A fine shall be imposed upon any person who deliberately or through negligence, where such negligence is not minimal, fails to fulfill his obligations under Article 34.

A fine shall be imposed upon any person who, in any case provided for in Article 34, gives wrong information, where punishment for the act is not specified in the Penal Code.

Any person who is guilty of an offense under this Article shall provide compensation for the damage caused. Where negligence is minimal, the amount of compensation may be reduced.

Proceedings based on the offenses defined in this Article may be instituted by the Public Prosecutor only if the aggrieved party brings a legal action claiming the offense.

## **Chapter VIII**

### **Rules Concerning Legal Proceedings**

#### *Art. 41*



The registered owner of a design, or any person entitled to use the design under a license or compulsory license, may bring an action to determine whether the registration protects him against another person where there is some uncertainty as to the relationship that is detrimental to him.

Subject to the same conditions, any person who carries on or intends to carry on a business activity may bring an action against the registered owner of a design to determine whether the registration is an impediment of any kind to the activity.

Where it is claimed, in a case provided for in the first paragraph of this Article, that the registration of a design is invalid, the second paragraph of Article 39 shall apply correspondingly.

#### *Art. 42*

Any person wishing to bring an action for cancellation or transfer of the registration of a design or for the grant of a compulsory license shall notify the registering authority accordingly and inform all persons who, according to the Register of Designs, hold licenses to use the design or pledges thereon. A licensee wishing to bring an action for infringement of a design right or for a ruling under the first paragraph of Article 41 shall inform the registered owner of the design accordingly.

The obligation to give notice under the foregoing paragraph shall be deemed to have been fulfilled when such notice has been sent by registered mail to the address recorded in the Register.

If it is not shown, when the action is brought, that notice or information has been given in accordance with the first paragraph of this Article, the court shall allow the plaintiff time to do so. If he fails to make use of the time allowed, his action may not be taken up for examination.

#### *Art. 43*

The District Court of Helsinki shall have jurisdiction in actions claiming a better right to a design, seeking cancellation of a registration, seeking transfer of an application or registration, claiming design infringement, seeking a compulsory license or the right provided for in the second paragraph of Article 32, in criminal proceedings and compensation claims under Article 40 and in actions seeking a ruling under the provisions of Article 41.

#### *Art. 44*

A copy of the final decision in a case referred to in Article 2 of Chapter 49 of the Criminal Code or in Article 16, 30, 31, 32, 35, 36, 37, 38 or 41 of this Act shall be sent to the registering authority.

## **Chapter IX Special Provisions**

#### *Art. 45*

The registered owner of a design who is not domiciled in this country shall have an agent resident in this country who shall be empowered to receive on the registered owner's behalf service of a writ or summons and other documents in cases and matters concerning a design right, with the exception of a summons for a criminal offense or a subpoena. The agent shall be made known to the person responsible for the Register of Designs and shall be entered therein.

Where the registered owner of a design does not have an agent under the foregoing paragraph, service may be effected by sending him the document to be served by registered mail to his address as recorded in the Register of Designs. If no full address is recorded in the Register, service may be effected by publication in the Official Finnish Gazette. Service shall be deemed to have been effected when the provisions of this paragraph have been fulfilled.

#### *Art. 46*

The Government may decree, provided that reciprocity exists, that the rules set forth in Article 12 or 45 shall not be applicable to an applicant for or registered owner of a design right who is resident in a foreign country or who has in that country an agent recorded in the Finnish Register as having the powers referred to in those Articles.

*Art. 47*

For an application for registration, or for renewal of registration, of a design right, the applicant shall pay an application fee or renewal fee, as the case may be, and, if necessary, the following additional fees: a class fee for each class of articles in excess of the first, a multiple registration fee for each design in excess of the first, a storage fee for the storage of a specimen, a publication fee for publication of each representation in excess of the first and a separate fee for other entries in the Register of Designs. An increased renewal fee shall be payable after the expiration of a current period of registration.

The Government shall specify the amounts of the fees payable under this Act.

*Art. 48*

More detailed regulations for the implementation of this Act shall be enacted by Government decree.

*Art. 49*

This Act shall enter into force on April 1, 1971.