

Decree on Utility Model Rights

No. 1419 of December 5, 1991, as amended by Decrees No. 1701 of December 22, 1995 and No. 119 of February 26, 1996

Utility Model Applications and Record of Applications

Section 1

A utility model application consists of an application document and accompanying documents.

The provisions in this Decree concerning utility model applications shall only apply, unless otherwise specified, to:

- (1) Finnish utility model applications;
- (2) international utility model applications pursued in Finland under Section 45d of the Act on Utility Model Rights or accepted for examination under Section 38 of the Patents Act (No 550/67); and
- (3) European patent applications converted into national utility model applications.

Section 2

The application document shall be signed by the applicant or his representative and shall state:

- 1) the name, domicile and address of the applicant and, if the applicant has appointed a representative, the name, domicile and address of the representative;
- 2) the name and address of the inventor;
- 3) a concise and factual title for the invention to which the utility model application relates;
- 4) a statement as to whether priority under Section 5 of the Act on Utility Model Rights (800 /91) is claimed;
- 5) where registration of a utility model is applied for by several persons jointly, a statement as to whether one of such persons is entitled to receive communications from the Registering Authority on behalf of all applicants;
- 6) a statement as to whether the applicant requests for an examination under Section 12 of the Act on Utility Model Rights;

- 7) a statement as to whether the applicant requests a postponement of the registration of the utility model under Section 18 of the Act on Utility Model Rights;
- 8) where the application includes the deposit of a culture of a microorganism, a statement corresponding to the statement under Section 17b of the Patents Decree; and
- 9) a list of the documents accompanying the application document.

Section 3

The following documents shall accompany the application document:

- 1) a description of the invention together with a picture or pictures to illustrate the invention, and one or more claims;
- 2) if the applicant has appointed a representative, a power of attorney for the representative;
- 3) if the invention has been made by someone other than the applicant, a deed establishing the applicant's title to the invention
- 4) a receipt for the payment of the registration fee;
- 5) where an examination under Section 12 of the Act on Utility Model Rights has been requested, a receipt for the payment of the examination fee.

Section 4

If the document is not written in one of the languages laid down by the first paragraph of Section 7 of the Act on Utility Model Rights, the applicant shall also submit to the Registering Authority a translation of the document into Finnish or Swedish. For a document other than a description or claim, the Registering Authority may waive the requirement for a translation or may accept a translation into a language other than Finnish or Swedish.

Section 5

Where a utility model application is made by converting from a patent application, the applicant shall in connection with the application state the date on which the patent application forming the basis of the application was made or is deemed to have been made, and the number of the patent application. The documents required, however excluding the description, claim, and copies of pictures, are transferred ex officio from the patent application to a utility model application of this kind.

A request for the postponement of registration under Section 18 of the Act on Utility Model Rights shall be filed in connection with the filing of the utility model application.

A request filed subsequently shall not be granted.

Section 5a

The provisions of Sections 52r and 52s of the Patents Decree shall *mutatis mutandis* apply to the conversion of a European patent application into a national utility model application under Section 8a of the Act on Utility Model Rights. The provisions of the second paragraph of Section 7 of the Act on Utility Model Rights shall *mutatis mutandis* apply to the application fee.

Section 6

The Registering Authority shall enter on the utility model application the application number and the date on which it was received at the Registering Authority.

Section 7

The Registering Authority shall keep a record of utility model applications received. The application is entered in the record on payment of the registration fee. The record shall be accessible to the public.

The following particulars shall be recorded for each application:

- 1) the date on which the application was received and the application number;
- 2) the classes according to the International Patent Classification assigned to the application;
- 3) the name, domicile and address of the applicant;
- 4) where the applicant has appointed a representative, the name, domicile and address of the representative;
- 5) the name and address of the inventor;
- 6) the title of the invention;
- 7) where the application results from conversion of a previously filed patent application, the date on which the patent application was filed or is deemed to have been filed;
- 8) if the priority of an earlier application is claimed, the country where the earlier application given as the basis for the priority was filed, the filing date and serial number of that application;
- 9) a statement as to whether the application is a Finnish application or an international application or a European patent application converted into a utility model application;

10) if the application is an international application, the international filing date and the date on which the application was pursued under Section 45d of the Act on Utility Model Rights or was filed under Section 38 of the Patents Act, and the international application number;

10a) if the application has been converted from a European patent application into a national application, the filing date in accordance with the European Patent Convention and the date on which the application was filed with the Patent Authority for conversion, and the serial number of the European patent application;

11) if the application results from division, the serial number in the record of applications and the filing date of the original application;

12) if a new application results from the division, the serial number in the record of applications of the new application;

13) if the application file has been made available to the public under Section 18 of the Act on Utility Model Rights, the date on which it became available;

14) a statement as to whether an examination under Section 12 of the Act on Utility Model Rights has been requested for the application;

15) the documents filed and fees paid in respect of the application;

16) decisions taken in respect of the application.

Section 8

Where notice is given to the Registering Authority that an invention for which a utility model right has been sought has been assigned to another person, the latter person shall be recorded as the applicant in the record of applications only if proof of the assignment is furnished.

Priority

Section 9

To enjoy priority under Section 5 of the Act on Utility Model Rights, the applicant must claim priority in the application filed in Finland and therein state where and when the application given as a basis for the priority was filed and, as soon as possible, its serial number. If the application is made through conversion under Section 8 of the Act on Utility Model Rights, the claim to priority shall apply without a separate request also to the new application resulting from conversion.

Section 10

The Registering Authority may through official action request the applicant to prove the claimed priority by submitting the authority within the prescribed time limit a certificate issued by the authority with which the application for which priority is claimed was filed, stating the filing date of the priority application and the applicant's name and also a copy of the application certified by that same authority. The copy shall be filed in the form prescribed by the Registering Authority.

Section 11

Priority may only be based on the first application in which the invention was disclosed.

If the person who filed the first application or his successor in title has filed a subsequent application with the same authority, relating to the same invention, the subsequent application may be cited as a basis for priority, provided that at the time of filing of the later application the earlier application was withdrawn, dismissed, or rejected without having become available to the public and without there being any rights subsisting, and had not served as a basis for priority. Where priority has been obtained on the basis of the subsequent application, the prior application may no longer serve as a basis for claiming priority.

Section 12

An application may claim priority deriving from several earlier applications even where they have been filed in different countries.

Claim

Section 13

The claim shall contain:

- 1) the title of the invention;
- 2) a statement identifying the art in relation to which the invention is new (prior art), where necessary; and
- 3) a statement of the new and characteristic features of the invention.

A utility model application may incorporate more than one claim. If an application includes more than one claim, they shall be arranged and numbered consecutively.

Each claim may relate to one invention only.

Where a utility model application contains several inventions, they shall be interdependent. In this case there shall be a technical connection between all of the

inventions in that they have, in whole or in part, the same or similar special technical characteristic. The term special technical characteristic shall mean the technical feature contributed by each single invention going, in considering the invention as a whole, beyond the state of the art.

The question whether the inventions share a technical characteristic shall be determined irrespective of whether they are stated in separate patent claims or as alternatives in a single claim.

A claim may not contain any matter irrelevant to the invention disclosed therein or irrelevant to the exclusive right claimed by the applicant.

Description

Section 14

The description may contain only subject matter that assists in understanding the invention. Where a newly-coined word or a technical term that is not generally accepted has to be used, such term shall be explained. The designations and units of measurement may not depart from those in general use in Finland.

Where the invention relates to a product of a microbiological process and a culture of the microorganism shall be deposited under the second paragraph of Section 6 of the Act on Utility Model Rights, the applicant shall in his applications documents give all relevant information regarding the characteristics of the microorganism that are available to him. The Registering Authority shall be notified of the deposit. The provisions of Section 17a, the third and fourth paragraphs of Section 17b, Section 17c and Sections 25a, 25c and 25d concerning the deposit of a microorganism, shall apply *mutatis mutandis* to the deposit of a microorganism that is the subject of a utility model application.

Pictures

Section 15

By a picture is meant a drawing, a photograph or similar. The pictures shall be so accurate as to clearly disclose the object for which protection is sought. The pictures shall be in black and white and reproducible. They may not exceed the size of an A4 sheet.

Amendments to utility model applications

Section 16

Claims may not be amended to include subject matter not disclosed in the original utility model application. Where a claim is amended to add new features, the applicant shall at the same time state where those new features are to be found in the basic document.

If more than one invention has been disclosed in the basic documents, the applicant may divide the application into more than one application. A new application resulting from division may not encompass subject matter that was not disclosed in the original application.

Where an application is divided because it contains more than one mutually independent invention and there is no technical connection between the inventions, the new application shall only be considered to have been filed at the same date as the original application if the new application has been filed no later than two months after the reduction of the original application.

Utility Model Register

Section 17

A utility model is recorded in the Utility Model Register provided it meets the requirements set in the second and third paragraphs of Section 1, and Sections 6 to 12 of the Act.

The following particulars shall be recorded in the register:

- 1) the serial number in the record of applications of the application, the registration number of the utility model and the classes according to the International Patent Classification to which the utility model is assigned;
- 2) the name, domicile and address of the proprietor of the utility model;
- 3) where the proprietor of the utility model has appointed a representative, the name, domicile and address of the representative;
- 4) the name and address of the inventor;
- 5) the following dates:
 - a) the filing date of the application;
 - b) if the utility model application results from conversion of a patent application in accordance with Section 8 of the Act on Utility Model Rights, the filing date of the patent application;
 - c) if the application is an international application, the international filing date and the date on which the utility model was pursued in accordance with Section 45d of the Act on Utility Model Rights or on which the application was filed under Section 38 of the Patents Act, and the international application number;
 - d) if the application has been converted from a European patent application into a

national application, the filing date in accordance with the European Patent Convention and the date on which the application was filed with the Patent Authority for conversion, and the serial number of the European patent application;

e) the date on which the application documents have been made available to the public;

f) the date of registration of the utility model;

6) priority, where claimed, together with an indication of the country where the application given as the basis for priority was filed, the filing date of that application and its serial number;

7) if the application results from division, the serial number of the parent application;

8) a statement as to whether the application has been the subject of an examination under Section 12 of the Act on Utility Model Rights;

9) if the invention relates to a product of a microbiological process, a statement as to whether a culture of the microorganism has been deposited; and

10) the title and picture of the invention.

Section 18

The public notice under Section 17 of the Act on Utility Model Rights concerning the registration of a utility model shall give the serial number and the classification according to the International Patent Classification of the utility model, the title and picture or pictures of the invention, where necessary, the name of the proprietor of the utility model and the serial number of the application, and a statement as to whether the application has been the subject of an examination under Section 12 of the said Act.

Section 19

Any claim made to the Registering Authority to have the registration of a utility model declared invalid and any notification made to the Registering Authority by a person that he has taken legal action to have a utility model right transferred or to obtain a compulsory license shall be recorded in the register.

The communication of copies of court decisions to the Registering Authority in accordance with Section 45 of the Act of Utility Model Rights, or decisions taken by the Registering Authority in cases referred to in paragraph 1 concerning claims to have a utility model declared invalid, shall be recorded in the Utility Model Register. Once the decision becomes final, a note shall be made in the register in such a way that the main findings of the case are apparent in the register.

Section 20

Entries under Section 28 and 29 of the Act on Utility Model Rights shall include the name, domicile and address of the proprietor of the right and the date of the transfer or grant of the license or pledging. In the case of a license, it shall be stated, on request, whether the right of the proprietor of the utility model right to grant additional licenses has been limited.

Where it is not possible to take an immediate decision on the question of recording, an entry shall nevertheless be made in the register that a request has been made.

The provisions of the preceding paragraph 1 shall correspondingly apply to the recording of a compulsory license and a right under Section 1 of the Act on Utility Model Rights.

Section 21

Seizure of a utility model right to cover a debt shall be recorded in the register when reported.

Any change reported in respect of a representative shall also be recorded in the register.

Section 22

If the proprietor of a utility model right, in accordance with the first paragraph of Section 33 of the Act on Utility Model Rights, states that he waives the registration of his utility model and if a license on this model is recorded in the register, the holder of the license shall be notified thereof and a reasonable period of time shall be reserved for him to assert his right in the case before the utility model is deleted from the register.

Section 23

The renewal of a registration shall be recorded in the Utility Model Register.

A public notice regarding a renewal shall state the serial number of the utility model, the date on which the renewed term of protection begins and the name and address of the proprietor of the utility model right.

Section 24

Once a registration has lapsed, the Registering Authority shall remove the utility model from the register.

Once the utility model has been removed from the register or the utility model right by a final court decision has been assigned to another person, the Registering Authority shall give a public notice thereof.

Examination by the Registering Authority

Section 24a

In examining an invention in accordance with the third paragraph of Section 12 of the Act on Utility Model Rights, the Registering Authority shall consider all facts that come to its attention. The examination at the Registering Authority shall be carried out on the basis of publicly available utility model or industrial design applications from Finland and of patent specifications, published specifications and publicly available international applications from Finland, Norway, Sweden, Denmark, the United States of America, the United Kingdom, France, Germany, and the European Patent Office. Other available publications may also be examined if found necessary. The Registering Authority shall notify of the result of the examination and issue a statement thereof where such statement specifically has been requested for.

Receiving Office for International Applications

Section 24b

The National Board of Patents and Registration of Finland shall be the receiving Office for international patent applications where the applicant or one of the applicants is a national of Finland, a natural person domiciled in Finland, a legal entity constituted according to Finnish law or anyone who carries on business in Finland.

The provisions of Sections 46 to 51 and 51a of the Patents Decree shall apply *mutatis mutandis* to the receiving of international utility model applications at the Authority. The provisions of Sections 52 and 52a to 52c shall *mutatis mutandis* apply to the pursuing of international utility model applications designating Finland.

Miscellaneous provisions

Section 25

A utility model application shall be classified according to the International Patent Classification system.

Section 26

Public notices in respect of utility models shall be given in a publication issued by the Registering Authority.

Entry into Force

Section 27

This Decree shall enter into force on January 1, 1992.