

# **Trademarks Act 10.1.1964/7** (Unofficial translation)

*(Amendments up to 2004/1220 included)*

## **Chapter I** General Provisions

### **Article 1**

Registration shall confer exclusive rights in a trademark as a special symbol for distinguishing goods to be offered for sale, or otherwise purveyed in business, from those of others.

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

The provisions of this Act concerning goods shall apply by analogy to services.

### **Article 2**

Exclusive rights in a trademark may be acquired, even without registration, after the mark has become established.

Exclusive rights in symbols other than the special business symbols defined in the second paragraph of Article 1 may also be acquired through their becoming established.

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

### **Article 3**

Any person may use his surname, address or trade name in his business as a trade symbol for his goods unless that use is liable to cause confusion with another's protected trademark, or with a name, address or trade name already being lawfully used by another in his business.

The foregoing provision on trade names applies also to the auxiliary trade name and secondary symbol referred to in the Trade Names Act.

The name or trade name of another may not be included in a trademark; neither may the auxiliary trade name or secondary symbol of another be included in a trademark except where they lack distinguishing power or where the branches of trade or kinds of goods concerned are different.

#### **Article 4**

The effect of the rights in a trade symbol provided for in Articles 1 to 3 of this Act is that no one other than the proprietor of the trade symbol may use in his business any symbol liable to be confused with it for his goods, whether on the goods themselves or on their packaging, in advertising or commercial documents, or in any other way, including oral use. This provision shall apply regardless of whether the goods are offered or intended to be offered for sale in Finland or abroad, or are imported into the Finnish territory to be used, kept or stored for business purposes or to be forwarded to a third country.

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

If goods are offered for sale under a particular trade symbol, and if thereafter a person other than the proprietor of the trade symbol substantially alters them by modification or repair or in another comparable manner, the trade symbol may not be used when the goods are once again offered for sale in Finland unless the alteration is clearly pointed out or announced, or is otherwise plainly apparent.

#### **Article 5**

The exclusive rights in a trade symbol shall not apply to any part of it that is intended mainly to render the goods or their packaging more suitable for their purpose, or serves some other purpose different from that of a trade symbol.

#### **Article 6**

Trade symbols shall be regarded under this Act as liable to cause confusion only if they apply to goods of identical or similar type.

Notwithstanding the foregoing, the confusability of trade symbols may be judged in favor of a symbol that has a reputation in Finland where the use of another's trade symbol without due cause would constitute unfair exploitation of, or action detrimental to, the distinctive character or fame of the earlier trade symbol.

The second paragraph of this Article shall apply also to the auxiliary trade names and secondary symbols referred to in the third paragraph of Article 3.

#### **Article 7**

Where two or more parties demand exclusive rights under Article 1 or Article 2 in confusingly similar trade symbols, preference shall be given to the party who can claim the earliest entitlement, subject to the provisions of Article 8 or 9 below.

## **Article 8**

Even where a registered trademark that has been used in Finland for a period of five consecutive years is liable to be confused with a mark registered or established earlier the use of the later mark may not be prohibited provided that the application for registration was made in good faith and the proprietor of the earlier mark was aware of the use of the later mark for the said period.

## **Article 9**

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

## **Article 10**

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

The first paragraph of this Article shall apply also if there is a risk of confusion in a case provided for in the first or second paragraph of Article 3.

### **Article 10 a**

The proprietor of a trademark may not prevent the use of the trademark on goods that the proprietor, or another person with his consent, has placed on the market under his trademark within the territory of the European Economic Area.

The foregoing paragraph shall not apply if the proprietor has justified grounds for objecting to the goods being once again placed on the market, in particular if alterations have been made to the goods or if they have deteriorated after having been placed on the market.

## **Article 11**

At the request of the proprietor of a registered trademark, the author, editor or publisher of a dictionary, glossary, manual or other similar printed or in a data network released publication shall ensure that the trademark is not reproduced in the publication without a mention that the trademark is registered.

Any person who fails to observe the foregoing paragraph shall ensure that a correction is published in the manner and to the extent considered reasonable, and shall bear the cost of publishing the correction.

## **Chapter II**

### Registration of Trademarks

#### **Article 12**

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

#### **Article 13**

To be eligible for registration, a trademark must be capable of distinguishing its proprietor's goods from those of others. A mark that denotes either alone or with only few alterations or additions, the kind, quality, quantity, use, price or place or time of manufacture of the goods shall not, as such, be regarded as distinctive. Neither shall a mark be regarded as distinctive, if it is solely composed of a form that is characteristic of the goods, necessary for achieving a technical result or that substantially increases the value of the goods. In assessing whether a trademark possesses distinguishing power, all the factual circumstances shall be borne in mind, particularly the length of time and extent to which the mark has been used.

#### **Article 14**

A trademark shall not be registered:

- (1) if it is contrary to law and order, or to morality;
- (2) if it is liable to mislead the public;
- (3) if, without proper permission, it incorporates national armorial bearings, a national flag or other emblem, a sign or hallmark indicating control and warranty used by the State for goods of the same type as those for which the trademark is sought or a similar type, the armorial bearings of a Finnish commune, or the flag, armorial bearings or other emblem, name or abbreviated name of an international organization or any device or emblem, name or abbreviated name liable to be confused with the symbols or emblems, marks, names or abbreviations referred to in this item;
- (4) if it is composed of or contains anything likely to give the impression of being the protected trade name of another or the auxiliary trade name or secondary symbol of another as referred to in the third paragraph of Article 3, or of being the name or likeness of another person, unless such name or likeness plainly relates to a person long dead;
- (5) if it is composed of or contains anything likely to give the impression of being the title of another's protected literary or artistic work, such title being original in character, or if it constitutes an infringement of another's copyright in such a work or of his rights in a photographic illustration or a protected design;
- (6) if it is liable to be confused with the name or protected trade name of another trader, with an auxiliary trade name or secondary symbol of the kind referred to in the third paragraph of Article 3, with the trademark of another which has been registered on the basis of an earlier application or with the trade symbol of another party that is already established when registration is sought;

(7) if it is liable to be confused with a trade symbol being used by another party for his goods at the time of the application, and if the applicant was aware of that use at the time of his application and had not used his own mark before the other trade symbol came into use;

(8) if it is liable to be confused with a trademark protected by an international registration valid in Finland or the European Community that on the basis of this registration enjoys an earlier right in Finland or the European Community;

(9) if it is liable to be confused with a Community trade mark within the meaning of Article 57 that has been registered on the basis of an earlier application or that has seniority from Finland under Article 34 or 35 of the Council Regulation referred to in Article 57;

(10) if it is liable to be confused with a registered name of a plant variety; or

(11) if there is an obstacle to registration within the meaning of Council Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

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

#### **Article 15**

The exclusive rights in a trademark acquired by registration do not cover any part of the mark that cannot be registered as such.

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

If a part of a trademark excluded from protection later becomes registrable, a new registration may be made to cover that part or the entire trademark without the exclusion of the part from protection.

#### **Article 16**

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

#### **Article 17**

The application for registration of a trademark shall be filed in writing with the registering authority. The application shall indicate the name or trade name of the applicant and the goods and classes of goods for which the mark is intended. The mark shall be clearly shown in the application.

A filing fee shall be paid on the filing of the application. The application shall not be considered filed until the fee has been paid.

### **Article 17a**

If an application relates to several goods, part of these may at the applicant's request be divided into one or more applications in a manner to be laid down more specifically by decree. The filing date of the original application shall be considered to be the filing date of these applications. If some of the goods in the original application enjoy priority earlier than the filing date, the priority shall accompany the goods in the divisional application.

The provisions of the first paragraph in respect of an application shall *mutatis mutandis* also apply to registration.

### **Article 18**

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

### **Article 19**

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

If the registering authority considers the application unacceptable even after the applicant has submitted a statement, the application shall be rejected to the extent there is an obstacle to its acceptance unless there is cause to set a new time limit.

### **Article 20**

If the application complies with the requirements to which it is subject, and if no obstacle to registration has emerged in connection with it, the registering authority shall enter the trademark in the Register and give public notice thereof.

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

Even if the person who filed the opposition withdraws it, the matter may nevertheless be examined if there are special reasons for doing so.

## **Article 21**

After an opposition, the registering authority shall revoke the registration to the extent there is an obstacle to registration. Once a decision to revoke a registration has acquired legal effect, public notice shall be given thereof.

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

## **Article 22**

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

Registration may not be renewed earlier than one year before or later than six months after it expires.

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

The provisions of Article 19 above shall apply as appropriate to the prosecution of applications.

## **Article 23**

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

### **Chapter III**

#### **Expiry of Legal Protection and Invalidity of Registration**

## **Article 24**

If the proprietor of a registered trademark fails to request renewal of the registration under Article 22, the trademark shall be removed from the Register.

A trademark shall also be removed from the Register while the registration is still valid if the proprietor so requests. If, according to an entry in the Register, the trademark is pledged, it may not be removed from the Register without the consent of the pledgee.

At the request of the proprietor of the trademark, the list of goods or of classes of goods for which the mark has been registered may be limited. The provision in the foregoing paragraph concerning the consent of the pledgee shall also apply.

## **Article 25**

If a trademark has been registered in breach of the provisions of this Act, the registration shall be declared null and void unless the provisions of Article 8 or 9 apply or some other change of circumstances affects the issue.

## **Article 26**

The exclusive rights in a trademark shall be invalidated:

(1) if it is obvious that the mark has lost the power to distinguish its proprietor's goods from those of others that it had when it was registered or became established;

(2) if the mark has become misleading or contrary to law and order or morality since it was registered or became established.

A trademark registration shall be invalidated if the trademark has not been used for the last five years and the proprietor is unable to give a proper reason for the non-use. Use of a trademark with the proprietor's consent shall be considered equivalent to use by the proprietor. Invalidation of a registration may not be sought, however, if the trademark has been used after the expiry of a five-year period of non-use but before the request for invalidation. In such case any use of the trademark that occurred during the three months preceding the request for invalidation shall not be considered if the preparations for use commenced only after the proprietor became aware that a request for invalidation might be filed.

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

## **Article 27**

A court of law shall rule on whether to invalidate a registration and declare a trademark forfeit when a suit to that end is brought against the proprietor of the mark.

A suit of the kind referred to in the foregoing paragraph may be brought by any person who has suffered a prejudice due to the registration. If the case is based on Article 13, on items (1) to (3) of the first paragraph of Article 14 or on Article 26, the suit may also be brought by the Public Prosecutor or by a body safeguarding the interests of the persons carrying on the trade or profession concerned.

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



## **Chapter IV**

### Special Provisions for the Protection of Foreign Trademarks

#### **Article 28**

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

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

#### **Article 29**

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

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

#### **Article 30**

The Government may decree that an application for registration of a trademark in Finland if the same trademark has previously been filed for registration abroad shall at the applicant's request be considered, in relation to other applications or trade symbols in use, to have been made at the same time as the application filed abroad.

Conditions governing the grant of priority under the foregoing paragraph may also be laid down by decree.

#### **Article 31**

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

If the applicant for a trademark registration or the proprietor of a registered trademark does not have a duly authorized representative, the registering authority shall, using his last known address, invite him to remedy the situation within a prescribed time limit, on pain of the application being considered withdrawn or the mark being removed from the Register. If the registering authority has no address for the applicant or proprietor, a public notice has to be published in the Trademark Gazette.

## **Chapter V**

### Assignment and Licensing

#### **Article 32**

A trademark may be transferred to another party; the transfer may relate to either all or some of the goods for which the trademark has been registered or has become established.

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

#### **Article 33**

The transfer of a registered trademark shall be recorded in the Register on request. If the registering authority finds that use of a trademark after such transfer is clearly liable to mislead the public, permission to record the transfer in the Register shall be withheld unless the misleading element is removed by means of a change or addition to the trademark.

A transfer not recorded in the Register shall not affect a third party who has obtained the trademark in good faith.

If any person wishes to pledge his trademark rights, a written agreement shall be made and entered in the Register. No right of pledge shall be valid until such an entry has been made.

#### **Article 34**

The proprietor of a registered trademark may license another person to use it in his business without relinquishing property rights in the trademark. A license may concern the whole or part of the country, and it may cover either all or part of the goods protected by the registration. The number of licensees may be one or more. On request, such a license shall be entered in the Register. The registering authority may refuse entry, however, if use of the licensed trademark is clearly liable to mislead the public. When a license is proved to have expired, the entry shall be deleted from the Register.

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

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

## **Article 35**

Trademark rights shall not be attachable for a debt unless a right of pledge has been established on it.

If the assets of the proprietor of a trademark are surrendered in the event of bankruptcy, his trademark rights shall be included among those assets.

## **Chapter VI**

### **Prohibition on the Use of Misleading Trade Symbols**

## **Article 36**

If a trade symbol that has been transferred or licensed becomes misleading in the form in which it is used by the new proprietor or licensee, a court of law may, at its discretion, prohibit the new proprietor or licensee from using it.

The use of the symbol may also be prohibited in other cases, namely if the trade symbol is misleading or if its proprietor, or another person with his consent, uses it in a manner liable to mislead the public.

Action under this Article may be brought by the Public Prosecutor, by any person who suffers a prejudice due to the use of the trade symbol, or by a body dedicated to safeguarding the interests of the persons carrying on the trade or profession concerned.

## **Article 37**

If the use of a trade symbol is prohibited under Article 36, the court may, where practicable, order that a trade symbol placed on goods, their packaging, brochures, leaflets, commercial documents or the like contrary to a prohibition under Article 36 be erased or altered so as to be no longer misleading. If this cannot be done in any other way, the court shall order that the material so marked be destroyed or changed in a specified manner.

Material referred to in the above paragraph may be confiscated pending the implementation of the said order in which case the general regulations on confiscation in criminal cases shall apply.

## **Chapter VII**

### **Consequences of Infringement of Trademark Rights**

## **Article 38**

Any person who infringes the right of the proprietor of a trade symbol protected by this Act may be prohibited by court order from proceeding with or repeating the offending act unless there are special reasons for not doing so.

If the infringement is deliberate or due to negligence, the aggrieved party shall be entitled to compensation from the defendant for all the damage he has suffered. If the negligence has only been slight, the court may modify the compensation awarded at its discretion.

Even if the defendant is not found guilty of negligence, the court may, where deemed reasonable in view of his financial and other circumstances, order that he hand over to the aggrieved party the profits he has made from such infringement during a period of not more than the three preceding years.

### **Article 39**

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

Prosecution for infringement under the foregoing paragraph shall not be brought by the Public Prosecutor except at the instigation of the aggrieved party.

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

### **Article 40**

A damages suit under Article 38 must be brought within three years of the time at which the plaintiff learned of the infringement and ascertained the identity of the infringer, and in any case not later than within ten years of the time at which the infringement occurred.

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

### **Article 41**

At the request of a person whose right to a trade symbol has been infringed, the court may order that, if practicable, a symbol placed on goods, their packaging, leaflets, commercial documents or the like without authorization shall be erased or altered in such a way as to ensure that it will no longer be misused. If this cannot be done in any other way, the court shall order that the material so marked be destroyed or changed in a specified manner. The court may also, on request, order that the material be surrendered to the plaintiff against payment.

Regardless of whether or not the infringement is deliberate, the Public Prosecutor or the court may order that the material referred to in the foregoing paragraph be confiscated if the plaintiff so requests and, where considered necessary, gives acceptable security for any damage that the defendant may suffer as a result of the confiscation and for the costs occasioned by it; otherwise, in this case the general provisions on confiscation in criminal cases shall apply.

## **Chapter VIII**

### Litigation Concerning Trademarks

#### **Article 42**

The District Court of Helsinki shall be the competent court of law in matters concerning entitlement to a trademark, invalidation of the registration of a trademark, declaring a trademark forfeit, prohibition of the use of a trademark, action under Article 46 or infringement of trademark rights.

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

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

#### **Article 43**

An application for an injunction under Article 38 may be heard at the same time as an action under Article 2 of Chapter 49 of the Penal Code or Article 39 of this Act.

#### **Article 44**

If the defendant in an action for infringement of registered trademark rights claims that the registration is null and void and the truth of the matter is not immediately clear, the court shall allow him a period within which to bring action in a separate court hearing in order to have the registration declared null and void; no ruling in the original case may be handed down until the matter of the validity of the registration has been finally settled. If the secondary action is not brought within the period allowed, the court shall rule on the case without regard to the counterclaim.

The foregoing paragraph shall apply equally if the defendant claims that the trademark has been invalidated.

#### **Article 45**

If a person has been granted the sole right to use a registered trademark in Finland and an entry regarding the license has been made in the Register, either the proprietor of the mark or the licensee, or both, may be recognized as plaintiffs in actions concerning the infringement of trademark rights.

If the licensee referred to in the foregoing paragraph wants to bring an infringement action, he shall inform the proprietor of the trademark accordingly; if he fails to do so, his suit shall not be heard.

This Article shall apply equally if the proprietor has reserved the right of parallel use on granting an exclusive license to another.

#### **Article 46**

An action to determine whether or not a right to a trade symbol exists, or whether or not a particular act infringes that right, may be taken for consideration by the court where there is uncertainty that is detrimental to the plaintiff.

In such cases, Article 45 shall apply as appropriate.

#### **Article 47**

An action for invalidation of a trademark registration may continue against the original defendant in the event of the trademark being assigned to another after legal proceedings have commenced, and, if the court finds for the plaintiff, its decision shall be equally binding upon the party to whom the trademark has been assigned. This shall apply equally in an action seeking to have a trademark declared forfeit.

#### **Article 48**

When an injunction is applied for under this Act, the court may, at the request of the plaintiff, grant an injunction against the defendant either during the proceedings or in its decision, to remain in force until the main action has been settled with legal effect, or until the same or another court has previously ruled otherwise. Before such an injunction is granted, the plaintiff may be ordered to provide reasonable security for any damage that the defendant might suffer from the injunction.

A separate appeal may be made against court ruling handed down during proceedings concerning an injunction or the lifting thereof.

#### **Article 49**

A copy of any court decision in an action concerning the expired registration of trade symbols, or in any of the actions referred to in Articles 10, 25, 26, 36 and 46, shall be sent by the court to the National Board of Patents and Registration of Finland. In addition the court shall inform the Community Trade Mark Office referred to in the first paragraph of Article 57 of an action for revocation of a Community Trade Mark and invalidation of the registration and send a copy of the court's final ruling to the said Office.

### **Chapter IX**

#### **Public Notices, Notifications, Appeals and Revocation of Decisions**

#### **Article 50**

As well as in the cases referred to in Articles 20 and 21, public notice shall be given when a registered trademark is modified under Article 23, when a Register entry is removed under Articles 24 to 26, 31 or 52, or when an assignment under Article 33 or a license granted under Article 34 is recorded in the Register.

### **Article 50a**

If it is not possible to notify the applicant at the address given by him, notification may take place by public notice in the Trademark Gazette.

### **Article 51**

An appeal against the final decision of the registration authority in a trademark case may be made by the applicant if the decision was unfavorable to him or if the case was dismissed. An appeal against a final decision taken by the registration authority concerning an opposition filed against the registration may be lodged by the losing party. Even if the person who filed the opposition withdraws his appeal, the case may be examined if there are special reasons for doing so.

### **Article 51a**

An appeal against a ruling of the registration authority under this Act shall be filed with the Board of Appeals at the National Board of Patents and Registration of Finland. Separate regulations shall apply to the appeals procedure and the proceedings of the Board of Appeals.

### **Article 52**

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

The provisions of paragraph 1 shall by analogy be applied if the registering authority receives from the Community Trade Mark Office referred to in Article 57 notice of an application for a Community trade mark or of an application within the meaning of Article 57a for the registration of a trademark in Finland.

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

## **Chapter X**

### **International Registration of Trademarks**

### **Article 53**

International trademark registration means the registration of a trademark effected by the International Bureau of the World Intellectual Property Organization in accordance with the Protocol of June 27, 1989, Relating to the Madrid Agreement Concerning the International Registration of Marks concluded on April 14, 1891.

The National Board of Patents and Registration of Finland shall be responsible in Finland for all action relating to international registrations, and shall keep a record of international registrations in force in Finland.

#### **Article 54**

If a Finnish national or any person domiciled or having a real and effective industrial or commercial establishment in Finland wishes to apply for an international registration based on a valid registration or pending application in Finland, he shall file an application for international registration with the National Board of Patents and Registration of Finland.

If the basis for an application for international registration is a Community trade mark referred to in Section 57 or an application therefor, the application for an international registration shall be filed with the Community Trade Mark Office.

#### **Article 55**

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

#### **Article 56**

The registration authority shall satisfy itself that the application for international registration corresponds to the registration that the applicant has been granted in Finland or to his pending application in Finland.

If the correspondence referred to in the foregoing paragraph does not exist, the registration authority shall call upon the applicant to rectify the international application within a specified time limit, on pain of the application being dismissed.

If the correspondence referred to in the foregoing paragraph does exist, the registration authority shall attach a certificate to that effect to the application and convey it with the application to the International Bureau before two months have elapsed from the filing date of the application.

#### **Article 56a**

When the registration authority receives a notification of an international registration having effect in Finland from the International Bureau, it shall examine whether there is any obstacle to the registration.



## **Article 56b**

If the registration authority finds that a trademark filed for international registration does not comply with the conditions of registration laid down in this Act, it shall notify the International Bureau that the international registration has no effect in Finland. The registration authority shall notify its refusal, together with a statement of all grounds, to the International Bureau before the expiry of a period of 18 months from the date of the International Bureau notification referred to in Article 56a.

If the statement issued by the proprietor of an international registration commenting on the notification by the registration authority referred to in the foregoing paragraph does not present any grounds on which the trademark could be deemed to comply with the conditions of registration laid down in this Act, the registration authority shall rule that the international registration has no or only a partial effect in Finland.

If the proprietor of an international registration has not within the given time limit submitted his statement commenting on the registration authority's notification referred to in paragraph 1, the international registration shall not take effect in Finland. If the said notification only concerned some of the goods in the international registration, the international registration shall take effect in Finland in respect of those of the goods that the notification did not concern.

## **Article 56c**

If no obstacle to registration is found, the registration authority shall give public notice of the International Bureau notification referred to in Article 56a as laid down in the first paragraph of Article 20. The public notice shall specify the date accorded to the international registration by the International Bureau.

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

## **Article 56d**

If the registration authority finds, after an opposition has been filed, that the trademark that is the subject of an international registration does not comply with the conditions of registration laid down in this Act, it shall notify the International Bureau, in the manner prescribed in the first paragraph of Article 56b, that the international registration has no effect in Finland.

If the time limit specified in the second paragraph of Article 56c expires more than 18 months after the International Bureau notification referred to in Article 56a, the registration authority shall notify the International Bureau within 18 months of the said notification that the registration may later cease to have effect. In that case the notification of the fact that the registration has no effect in Finland shall be conveyed within one month of the expiry of the time limit referred to in the second paragraph of Article 56c.

Once the decision, taken after opposition has been filed, that the international registration has no effect in Finland, has taken legal effect, the registration authority shall give public notice of the fact.

### **Article 56e**

An international trademark registration having effect in Finland shall be in force as from the date accorded by the International Bureau under the first paragraph of Article 56c. Provisions laid down in and under this Act shall apply mutatis mutandis to the international registration.

### **Article 56f**

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

### **Article 56g**

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

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

### **Article 56h**

If a trademark is wholly or partly removed from the International Register, the registration authority shall remove the corresponding parts thereof from the register that it keeps and give public notice of the fact.

### **Article 56i**

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

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

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

### **Article 56j**

If an international registration valid in Finland ceases to have effect because a party to the Protocol referred to in Article 53 gives notice of termination in respect of the Protocol, and

the proprietor of the trademark files the same trademark for registration in Finland, his application shall be considered to have been made on the date referred to in the first paragraph of Article 56c provided that:

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

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

#### **Article 56k**

Public notice shall be given of renewals, transfers, and removals from the Register of international registrations and of licenses that concern international registrations and have been notified to the registering authority.

#### **Article 56l**

An appeal against a decision by the registration authority may be lodged by the applicant for or proprietor of an international registration who has sought such registration in Finland if the decision has been unfavorable to him or if the case has been dismissed.

An appeal against a decision taken by the registration authority declaring an international registration effective in Finland despite an opposition filed may be lodged by the person who filed the opposition. Even if the person who filed the opposition withdraws his appeal, the case may be examined if there are special reasons for doing so.

Article 51a shall apply as appropriate to appeals under the foregoing two paragraphs.

### **Chapter X a** Community Trade Mark

#### **Article 57**

Community trade mark means a trademark registered by the Office for Harmonization in the Internal Market operating in the Internal Market of the European Community (Community Trade Mark Office) under Council Regulation (EC) No. 40/94 on the Community Trade Mark.

An application for a Community trade mark may be filed with the National Board of Patents and Registration of Finland, which shall forward it to the Community Trade Mark Office. The prescribed fee for the application shall be payable to the National Board of Patents and Registration of Finland.

#### **Article 57 a**

A request which concerns the conversion of a Community trade mark, an application therefor or an international registration designating the European Community into an application for a

national trademark and which the Community Trade Mark Office has forwarded to the office, shall be treated as a national application provided that the applicant:

pays the prescribed fees; (2) submits the registering authority a translation in Finnish or Swedish of the conversion request and the accompanying annex filed in a foreign language; (3) gives the address at which the applicant can be reached in Finland; and (4) provides a representation of the trademark.

An application based on conversion of a Community trade mark or an application therefor is considered to have the same filing date, priority and seniority from Finland as the Community trade mark or the application therefor. An application based on conversion of an international registration designating the European Community has as its filing date the date of the international registration or that of a subsequent designation of the European Community, and it enjoys the priorities and seniorities of the international registration.

## **Chapter XI**

### **Enforcement and Implementation of the Act**

#### **Article 58**

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

Fees to be collected under this Act shall be prescribed separately.

#### **Article 59**

This Act shall enter into force on June 1, 1964. The following shall be repealed at that time: The Decree on the Protection of Trademarks of February 11, 1889; Chapter XXXVI, Article 13, of the Penal Code; Article 2 of the Decree of December 21, 1885, granting greater freedom to the iron industry.

#### **Article 60**

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

The right to a trademark may be invalidated under Article 26 even where it was granted or became established before the entry into force of this Act. Pending applications for registration shall be governed by this Act.

#### **Article 61**

In the case of trademarks registered earlier, the period of five years provided for in Article 8 shall be calculated as from the date of entry into force of this Act.

#### **Article 62**

The provisions of Article 40 regarding the period during which damages are to be claimed shall apply equally if the act for which compensation is payable was committed before the entry into force of this Act; if, however, the period of three years referred to in the said Article began before the date of entry into force of this Act, it shall be counted as having begun on that date.

### **Article 63**

When the registration of an earlier-registered trademark is first renewed after the entry into force of this Act, the registration period based on that renewal shall be regarded as ending on the date corresponding to the original registration date, even if the registration period according to an earlier renewal is calculated differently.

On renewal of registration, the list of classes of goods shall be amended so that it conforms to any changes that have been made in the classification.

### **Article 64**

A trademark registration that was renewable without an application under the earlier provisions shall henceforth be renewed in accordance with the renewal provisions contained in this Act. If no application for renewal is filed within one year of the date on which this Act enters into force, the trademark shall be removed from the Register.

*(transitional provisions not included)*

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