

# **TRADEMARKS ACT, 10 January 1964, 1964/7**

## **Chapter I General Provisions**

### Section 1

This act lays down provisions on an exclusive right to a trademark used in the course of trade for goods and services. This act also lays down provisions on the Community trademark and the international registration of trademarks.

The provisions on goods laid down in this act also apply to services.

### Section 2

A trademark can be any distinctive mark that is used in the course of trade and can be represented graphically.

### Section 3

A mark is deemed to be distinctive if it can be used to distinguish goods from those of others in the course of trade. A mark denoting the kind, quality, quantity, purpose, price, or place or time of manufacture either exclusively or with only minor modifications or additions cannot as such be deemed to be distinctive. When evaluating the distinctiveness of a mark, attention must be paid to all circumstances, particularly to how long and how broadly the mark has been used.

### Section 4

An exclusive right to a trademark can be obtained by registering it with the register of trademarks referred to in Chapter 2.

### Section 4a

An exclusive right to a trademark can be obtained without registration, if the trademark has been established.

An exclusive right can through establishment also be obtained to a mark other than one referred to in section 2 that is used in the course of trade.

A trademark is deemed to have been established if it is commonly known as a distinct mark of the proprietor's goods in the relevant Finnish business or consumer circles.

### Section 5

An exclusive right cannot be obtained to a mark that is solely formed by the characteristic shape of the goods, the shape of the goods necessary for achieving a technical result, or a shape that has essential effect on the value of the goods.

### Section 5a

The name or company name of another party may not be included in a trademark. Nor may the auxiliary company name or secondary symbol of another party be included in a trademark, unless they are devoid of distinctive character or are from different lines of business or of a different type of goods.

## Section 6

With the exceptions laid down later, the exclusive right to a trademark includes that no-one other than the proprietor of the trademark may use the following as a mark of their goods in the course of trade without the proprietor's consent:

- 1) a mark that is identical with the protected trademark for identical goods;
- 2) a mark that, due to its identicalness with or similarity to the protected trademark for identical or similar goods causes a risk of confusion among the public, which also includes a risk of association between the mark and the trademark.

If the trademark has a reputation in Finland, and the use of the mark without due cause would take unfair advantage of the distinctive character or the repute of the trademark, or be detrimental to the distinctive character or the repute of the trademark, no-one other than the proprietor of the exclusive right to the trademark may in the course of trade use a mark that is identical with or similar to the trademark with a reputation without the consent of the proprietor, even if the goods for which the mark is used are not identical or similar to those for which the trademark with a reputation is protected.

The following are deemed to be usage in the course of trade:

- 1) affixing the mark to the goods or to the packaging thereof;
- 2) offering the goods or putting them on the market, or stocking them for those purposes, under the mark;
- 3) importing or exporting the goods under the mark, or importing the goods for transport to a third country;
- 4) using the mark on business papers in marketing; and
- 5) other corresponding use of the mark.

Verbal usage is also deemed to be the usage of the mark in the course of trade referred to in subsection 3 above.

## Section 7

An exclusive right to a trademark does not prevent another party from using any of the following in the course of trade in accordance with good business practices:

- 1) one's own name, company name, auxiliary company name, secondary symbol or address;
- 2) markings indicating the kind, quality, quantity, purpose, value, geographical origin, manufacturing time or other characteristics of the goods; and
- 3) the trademark, if its use is necessary for indicating the purpose of the goods.

## Section 8

The proprietor of a trademark may prohibit the use of the trademark on goods that the proprietor or some other party with the proprietor's consent has placed on the market in the European Economic Area using the trademark only if changes have been made to the goods

or if they have been made worse after being placed on the market, or if the proprietor of the trademark has some other justified reason to prohibit the use of the trademark.

#### Section 9

If several parties demand exclusive rights to trademarks that are identical or similar in the manner referred to in section 6, the party able to invoke the earliest legal grounds has precedence, unless otherwise provided in section 10 or 10a.

#### Section 10

The exclusive right to a registered trademark is retained parallel to a trademark registered or established previously, if the registration was applied for in good faith, and the proprietor of the previously registered or established trademark has not taken action to prevent the use of the trademark registered later although the proprietor has been aware of its use for a period of five years.

If the trademark registered later has only been used on some of the goods for which it was registered, the exclusive right will only apply to the use of the trademark on the goods in question.

#### Section 10a

The exclusive right to an established trademark is retained parallel to a trademark registered or established previously, if the proprietor of the previously registered or established trademark has not taken action within a reasonable time to prevent the use of the trademark established later, and the trademark established later was adopted in good faith.

If the trademark registered or established previously has a reputation in Finland, the reasonable time referred to in subsection 1 is considered to be five years from the proprietor of the previously registered or established trademark becoming aware of the use of the trademark established later.

#### Section 11

If found reasonable in cases referred to in paragraph 1 of section 7, or section 10 or 10a, the Market Court will order that one or both trademarks may be used only when formed in a specific way, by adding a place name or the proprietor's name, or by limiting its use to specific goods or a certain area or in other such manner.

#### Section 11a

At the request of the proprietor of a registered trademark, the author, editor-in-charge and publisher of a dictionary, manual, textbook or other such print product is obligated to ensure that the trademark is not replicated in the publication without a notice of the trademark being registered. The provisions laid down above in this subsection also apply to the distribution of the publication via an information network or by other electronic means.

Whoever fails to comply with the provisions of subsection 1 is obligated to ensure that a correction is published in a reasonable manner and extent, and to finance the publication of such correction.

The notification obligation concerning the registration of a trademark referred to in subsection 1 can be considered to have been fulfilled when the ® symbol is inserted in connection with the trademark.

## **Chapter II Registration of Trademarks**

### Section 12

A Register of Trademarks shall be kept by the Finnish Patent and Registration Office.

### Section 13

A mark that is not distinctive in accordance with section 3 or for which an exclusive right cannot be obtained under section 5 does not meet the conditions of registration.

A trademark may not however be refused registration on the grounds of lack of distinctive character, if the trademark has become distinctive through use prior to the date on which the application for registration was filed.

### Section 14

A trademark is not registered, if:

- 1) it is contrary to law and order or morality;
- 2) it is liable to mislead the public;
- 3) without proper permission, it includes state armorial bearings, a state flag or other state emblem; an official sign or hallmark, indicating control and warranty, for goods for which the mark is to be registered or for goods similar to them; the armorial bearings of a Finnish municipality, or the flag, armorial bearings or other emblem, name or abbreviation of an international intergovernmental organisation; or some other device, name or abbreviation, if its inclusion in the trademark can cause a risk of the public confusing the trademark with said emblem, sign, hallmark, name or abbreviation;
- 4) it is formed of something, or includes something, that is likely to give the impression that it is another party's protected company name or another party's auxiliary company name or secondary symbol of the kind referred to in section 5a, or the name or likeness of another person, unless the name or likeness is evidently that of someone deceased a long time ago;
- 5) it is formed of something, or includes something, that is likely to give the impression that it is the name of another's protected literary or artistic work, if the name is of a special nature, or if it infringes another's copyright in a work or another's rights in a photograph or a protected design;

- 6) it causes a risk that the public confuses it with the name, protected company name or auxiliary company name of another trader in such a manner that the confusion could be invoked under section 5 of the Trade Names Act (128/1979);
- 7) the proprietor of an earlier trademark possesses the exclusive right to using the mark as a sign of the goods in the course of trade;
- 8) the trademark applicant has made the application for registration in bad faith;
- 9) it causes a risk of confusion with the name of a plant variety protected in Finland or in the European Union;
- 10) there is an obstacle to the registration as referred to in Regulation (EU) No 1151/2012 of the European Parliament and of the Council on quality schemes for agricultural products and foodstuffs; Regulation (EU) No 1308/2013 of the European Parliament and of the Council establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007; Regulation (EC) No 110/2008 of the European Parliament and of the Council on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks and repealing Council Regulation (EEC) No 1576/89; or Regulation (EU) No 251/2014 of the European Parliament and of the Council on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products and repealing Council Regulation (EEC) No 1601/91.

An earlier trademark referred to above in paragraph 7 of subsection 1 means:

- 1) a national trademark that was registered based on an earlier application, or that otherwise has earlier priority than the trademark applicant;
  - 2) a trademark that is protected by an international registration and is valid in Finland or in the European Union, and that based on this registration has an earlier right in Finland or the European Union than the trademark applicant;
  - 3) a Community trademark referred to in section 57, registered based on an earlier application than the trademark application, or that has seniority from Finland under Article 34 or 35 of the Council Regulation mentioned in section 57;
  - 4) a trademark that is established when the registration is applied for.
- In cases referred to in paragraphs 4—8 of subsection 1, the trademark can be registered with the consent of the party whose right is in question, and there is, according to subsection 1, otherwise no obstacle to registration.

## Section 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.

#### Section 16

A trademark shall be registered in one or more classes of goods. The classification of goods shall be established by the Finnish Patent and Registration Office.

#### Section 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.

#### Section 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.

#### Section 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.

#### Section 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.

#### Section 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.

#### Section 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.

#### Section 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 section 19 above shall apply as appropriate to the prosecution of applications.

#### Section 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**

#### Section 24

If the proprietor of a registered trademark fails to request renewal of the registration under section 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.

## Section 25

If a trademark has been registered in breach of this act, the registration is invalid, subject to the circumstances referred to in section 10 or 10a or another change of circumstances.

## Section 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.

## Section 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 section 13, on items (1) to (3) of the first paragraph of section 14 or on section 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**

### Section 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.

### Section 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 section 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.

### Section 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.

### Section 31

An applicant for registration of a trademark not domiciled in Finland must have a representative resident in the European Economic Area who is authorised to represent the applicant in matters concerning the application.

A proprietor of a registered trademark who is not domiciled in Finland must have a representative resident in the European Economic Area who is authorised to represent the proprietor in matters concerning the trademark, and is entitled to receive summons or other documents on behalf of the proprietor in matters concerning the trademark, except for

summons in criminal matters or orders to a party to appear in person before a court. The name of the representative shall be entered in the Register.

If the applicant for registration of a trademark or the proprietor of a registered trademark does not have a duly authorised representative, the registering authority shall, using their last known address, invite them 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 the proprietor, a public notice has to be published in the Trademark Gazette.

Any person not domiciled in Finland who has filed an opposition must have a representative resident in the European Economic Area to represent them in the opposition proceedings.

A corporate body domiciled in the European Economic Area may also act as a representative.

## **Chapter V Assignment and Licensing**

### Section 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.

### Section 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.

### Section 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.

#### Section 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**

#### Section 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 section 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.

#### Section 37

If the use of a trade symbol is prohibited under section 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 section 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**

#### Section 38

Anyone who infringes the right to a trade symbol may be prohibited by court order from proceeding with or repeating the act.

Any person who deliberately or due to negligence infringes the right to a trade symbol shall be obliged to pay the aggrieved party a reasonable compensation for the use of the symbol and a compensation for all the damage caused by the infringement. If the negligence has only been slight, the compensation for the damage may be adjusted.

Even if no negligence is found, the infringer is obliged to pay a reasonable compensation for the use of the symbol.

### Section 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 Chapter 49, section 2, of the Criminal Code of Finland, 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.

### Section 40

A compensation and damages suit under section 38 may only be brought for the period of the last five years preceding the bringing of the action. The right to compensation and damages is lost if the action for it is not brought within the period stated above.

Where a trademark protected by registration is concerned, compensation and damages may, despite the provisions of paragraph 1, be claimed on account of an infringement that has occurred before the date of registration, if the action is brought within a year from the registration date.

### Section 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.

#### Section 41 a

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

The court lays down a maximum amount for the reasonable publishing cost to be paid by the defendant. The plaintiff is not entitled to the compensation if information about the decision has not been published within a period laid down by the court counted from the date when the final decision was issued.

### **Chapter VIII Litigation Concerning Trademarks**

#### Section 42

Disputes and application cases under this Act are heard by the Market Court.

The Market Court shall serve as the Community trademark court according to the Council Regulation referred to in section 57(1) below.

The provisions of the Act on the Judicial Proceedings at the Market Court (100/2013) apply to the hearing of disputes and application cases by the Market Court.

#### Section 43

Charges of an intellectual property offence, as referred to in Chapter 49, section 2, of the Criminal Code of Finland, which infringes the right to a trade symbol; and charges of violation of a trademark, as referred to in section 39(1) of this Act, are heard by the Helsinki District Court.

Claims for compensation under section 38(2) and (3) or claims under section 41, arising from an offence referred to in the charge, may be heard in connection with a charge referred to in subsection 1 above, notwithstanding the provisions of section 42.

The court remains competent to examine a claim referred to in subsection 2 even if the circumstances on which its competence is based change after the claim is being made.

#### Section 43 a

The provisions of Chapter 4, section 22, of the Act on the Judicial Proceedings at the Market Court, on the right of the Market Court to request a statement, apply to the right of the court

hearing a case referred to in section 43 above, to request a statement from the registering authority.

#### Section 43 b

When hearing a case referred to in section 43, the District Court may be assisted by a maximum of two expert members referred to in chapter 17, section 10(2) of the Court Act (673/2016).

The experts must give their statement in writing on the matters submitted to them by the District Court. The experts are entitled to question the parties and the witnesses. The District Court must reserve the parties an opportunity to state their views on the expert's statement before decision in the case.

The provisions on the expert's right to a fee are laid down in chapter 17, section 22 of the Courts Act.

#### Section 44

The provisions of Chapter 4, section 23, of the Act on the Judicial Proceedings at the Market Court, on the obligation of the Market Court to notify of its decisions, apply to the obligation of the court hearing a case referred to in section 43 above, to notify the registering authority of a decision.

#### Section 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.

Section 45(2) has been repealed by Act 31.1.2013/107.

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

#### Section 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, section 45 shall apply as appropriate.

#### Section 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.

#### Section 48

Section 48 has been repealed by Act 31.1.2013/107.

#### Section 48 a

When hearing an action referred to in section 38(1) the court may at the trademark holder's request prohibit the keeper of a transmitter, server or other similar device or other service provider acting as an intermediary, under penalty of a fine, from continuing the use alleged to infringe the trademark (injunction order) unless it can be considered disproportionate in view of the rights of the alleged infringer of the trademark or in view of the rights of the intermediary or trademark holder.

Before the bringing of an action referred to in section 38(1), the court may, at the trademark holder's request, issue an injunction if the preconditions for it set out in subsection 1 exist and if it is obvious that the trademark holder's rights otherwise would be seriously endangered. The court must provide both for the party against whom the injunction is sought and for the party who is claimed to infringe the right to a trade symbol an opportunity to be heard. Communications to the party against whom the injunction has been sought may be delivered by mail, facsimile or email.

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

An injunction issued under this section must not endanger the right of a third party to send and receive messages. The injunction comes into force when the applicant lodges with the bailiff security referred to in Chapter 8, section 2, of the Enforcement Code (705/2007). The provisions of Chapter 7, section 7, of the Code of Judicial Procedure apply to the possibility to be released from lodging security. An injunction issued under subsection 2 or 3 above lapses if the action referred to in section 38(1) is not brought before a court within a month from the issuance of the injunction.

The party who has demanded the injunction must compensate the party against whom the injunction is issued as well as the alleged infringer for the damage caused by the implementation of the injunction and for any other cost resulting from the case, if the action referred to in section 38(1) is rejected or ruled inadmissible, or if the processing of the case is removed from the cause list because the plaintiff has abandoned his action or failed to arrive to the court. The same applies if the injunction is withdrawn under paragraph 3 or lapses

under paragraph 4. When an action is brought for compensation for damage and cost, the provisions of Chapter 7, section 12, of the Code of Judicial Procedure apply.

#### Section 49

Section 49 has been repealed by Act 31.1.2013/107.

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

#### Section 50

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

#### Section 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.

#### Section 51

An appeal against the final decision of the registering authority in a trademark case may be made by the applicant if the decision was unfavourable to him or if the case was dismissed. An appeal against a final decision taken by the registering authority concerning an opposition filed against the registration may be lodged by the losing party.

#### Section 51a

Provisions on appeals against a decision of the Finnish Patent and Registration Office in a trademark matter are laid down in section 6 of the Act on the Finnish Patent and Registration Office (578/2013).

#### Section 52

If the registering authority receives notice of an international registration from the International Bureau referred to in section 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 registering 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 section 57 notice of an application for a Community trade mark or of an application within the meaning of section 57a for the registration of a trademark in Finland.



If the registering 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 registering authority may revoke its incorrect decision and take a new decision on the matter.

## **Chapter X International Registration of Trademarks**

### **Section 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 Finnish Patent and Registration Office shall be responsible in Finland for all action relating to international registrations, and shall keep a record of international registrations in force in Finland.

### **Section 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 Finnish Patent and Registration Office.

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.

### **Section 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.

### **Section 56**

The registering 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 registering 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 registering 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.

#### Section 56a

When the registering 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.

#### Section 56b

If the registering 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 registering 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 section 56a.

If the statement issued by the proprietor of an international registration commenting on the notification by the registering 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 registering 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 registering 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.

#### Section 56c

If no obstacle to registration is found, the registering authority shall give public notice of the International Bureau notification referred to in section 56a as laid down in the first paragraph of section 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 registering authority within two months of the date of the public notice.

#### Section 56d

The Finnish Patent and Registration Office sends a notification of an opposition referred to in section 56c, and grounds of it, to the International Bureau referred to in section 53. Regardless of whether the proprietor of the international registration has given a statement due to the notification, the Finnish Patent and Registration Office must examine the opposition.

Due to the opposition, the Finnish Patent and Registration Office must make a decision that the international registration has no effect in Finland, if the registration does not meet the conditions of registration under this act. If the registration meets the conditions of registration

under this act only in part, the Finnish Patent and Registration Office must make a decision that the registration has effect only in part. The Finnish Patent and Registration Office must reject the opposition, if there is no obstacle to the international registration in Finland.

If the Finnish Patent and Registration Office decides that the international registration has no effect in Finland or has effect only in part, it makes an entry of this in the record referred to in section 53(2) and gives public notice of the decision once it has become final.

#### Section 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 section 56c. Provisions laid down in and under this Act shall apply mutatis mutandis to the international registration.

#### Section 56f

If the proprietor of an international registration who is not domiciled in Finland wishes to submit a statement to the Finnish Patent and Registration Office, the proprietor must appoint a representative resident in the European Economic Area. A corporate body domiciled in the European Economic Area may also act as a representative.

#### Section 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 registering 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.

#### Section 56h

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

#### Section 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 section 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 section 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 registering 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.

#### Section 56j

If an international registration valid in Finland ceases to have effect because a party to the Protocol referred to in section 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 section 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 registering 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.

#### Section 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.

#### Section 56l

An appeal against a decision by the registering 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 declaring an international registration effective in Finland, despite an opposition filed, may be lodged by the person who filed the opposition.

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

### **Chapter Xa Community Trade Mark**

#### Section 57

*Community trade mark* means a trademark registered by the Office for Harmonization in the Internal Market (trademarks and designs) operating in the internal market of the European Union, hereinafter referred to as *Community Trade Mark Office*, under Council Regulation (EC) No 207/2009 on the Community Trade Mark.

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

#### Section 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**

#### Section 58

Further provisions on applications for registration, the Trademark Register and its maintenance, public notices, and the tasks of the registering authority shall be given by government decree.

Further technical regulations may be drawn up by the registering authority regarding applications for registration and their processing, registered trademarks, the Trademark Register, public notices, and other similar technical matters.

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

#### Section 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, section 13, of the Criminal Code of Finland; section 2 of the Decree of December 21, 1885, granting greater freedom to the iron industry.

#### Section 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 section 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.

#### Section 61

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

#### Section 62

The provisions of section 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 section began before the date of entry into force of this Act, it shall be counted as having begun on that date.

#### Section 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.

#### Section 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.