

## **Unofficial translation**

# **REGISTERED DESIGNS ACT 12.3.1971/221**

## **Chapter I. General Provisions**

### **Section 1**

Anyone who has created a design or his or her successor in title may through registration obtain the exclusive right to the design (the right to a design) in accordance with this Act.

#### **Section 1 a**

In this Act:

- (1) 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation;
- (2) 'product' means any industrial or handicraft item, including parts intended to be assembled into a complex product, and packaging, get-up, graphic symbols and typographic typefaces;
- (3) 'complex product' means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

Computer programs are not considered to be products within the meaning of subsection 1(2) above.

### **Section 2**

A design shall be protected by a design right if it is new and has individual character.

A design shall be considered new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available before the date of filing of the application for registration or, if priority is claimed, the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

The design of a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

- (1) if the component part remains visible during normal use of the product; and
- (2) if the visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

‘Normal use’ within the meaning of subsection 4(1) above shall not include maintenance, servicing or repair work.

### **Section 3**

A design shall be deemed to have been made available to the public:

- (1) if it has been published in the registration procedure or otherwise; or
- (2) if it has been exhibited or used in trade or it has otherwise become known.

A design has not, however, become available to the public if the events referred to in subsection 1 could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union, before the date of filing of the application for registration or, if priority is claimed, the date of priority.

The design shall not, however, be deemed to have become available to the public for the sole reason that it has been disclosed to a third person under conditions of confidentiality.

### **Section 3 a**

A design shall not be deemed to have become available to the public in the manner referred to in section 2 if the design for which protection is claimed has during the 12-month period before the date of filing the registration application or, if priority is claimed, the date of priority, been made available to the public:

- (1) by the designer or a third person as a result of information provided or action taken by the designer; or
- (2) as a consequence of an abuse in relation to the designer.

The provisions of subsection 1 relating to the creator of a design shall also apply to his or her successor in title.

### **Section 4**

A design shall not be registered:

- (1) if it is contrary to public policy or to accepted principles of morality; or
- (2) if it is identical with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority and which is protected from a date prior to the said date by a design registered for Finland or by an application for such right.

### **Section 4 a**

A design shall not be registered, if it without the proper permission includes:

- (1) the coat of arms, flag or other emblem or the designation or abbreviation of the designation of a state, municipality or an international intergovernmental organization, or a figure, designation or abbreviation of a designation that may be confused with such emblem, sign, designation or abbreviation of a designation;
- (2) an official mark or stamp of inspection or guarantee for the same or similar articles as those for which the design is intended;
- (3) anything that may be understood to be another person's trade name or a trade symbol or trademark established for another in Finland or the surname, pseudonym or similar name or the portrait of another, unless the name or portrait manifestly refers to a person long since deceased;
- (4) anything that may be interpreted as the title of another person's protected literary or artistic work, provided such title is distinctive, or anything which infringes another's copyright to such a work or right to a photographic illustration;
- (5) anything that does not substantially differ from a design or utility model registered in Finland in the name of another person;

#### **Section 4 b**

A design right shall not subsist in features of appearance of a product

- (1) which are solely dictated by its technical function; or
- (2) which must be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

Notwithstanding subsection 1(2), a design right shall subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

#### **Section 5**

The scope of the protection conferred by a design shall include any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing the design shall be taken into consideration.

#### **Section 5 a**

Subject to the exceptions stated below, the right to a design shall imply that no person other than the design right owner is entitled to use the design without his or her consent. The uses shall cover, among other things, the making, offering, putting on the market, using, importing, exporting or stocking for these purposes of a product which matches the design or in which the design is incorporated.

#### **Section 5 b**

The rights conferred by a design right do not cover:

- (1) private use of the design for non-commercial purposes;
- (2) use of the design for experimental purposes; nor
- (3) acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

Neither do the rights conferred by a design right cover the equipment on ships and aircraft registered in another country when these temporarily enter into the country, the importation into the country of spare parts and accessories for the purpose of repairing such craft, nor the execution of repairs on such craft.

### **Section 5 c**

A design right does not give its owner the right to deny the use of a product protected by the design right if the product has been put on the market within the European Economic Area by the design right owner or with his or her consent.

### **Section 6**

Any person who, at the time the application for registration is made, has in the course of trade been using a design in this country, may notwithstanding another's right to the design continue such use while retaining its general character, provided that such use did not entail a manifest abuse with respect to the applicant for registration or to his or her predecessor in title. Under similar conditions, any person who has taken substantial steps to use the design in the course of trade in this country shall have the same right of use.

The right defined in subsection 1 can only be transferred to other parties together with the business in which it has arisen or in which the design was to be used.

### **Section 7**

Section 7 has been repealed by Act 12.7.2002/596.

### **Section 8**

Any application filed in Finland shall be deemed, for the purposes of section 2 and 6, to have been filed at the same time as the application in another country, if the design has been the subject of an application for registration of a design or for protection as a utility model which has been filed in a country party to the Paris Convention for the Protection of Industrial Property (Finnish Treaty Series 43/1975) or the Treaty Establishing the World Trade Organization (Finnish Treaty Series 5/1995).

Registration in Finland shall be applied for within a period of six months from the date of filing of the application for registration in the Contracting State referred to in subsection 1.

The provisions of subsections 1 and 2 shall also apply to an application which has been filed elsewhere and in respect of which the registering authority finds special reasons to equate it with an application filed in a Contracting State.

In order to enjoy priority in accordance with the provisions of subsection 1, the applicant shall request it in an application filed in this country, stating where and when the application referred to was made; the applicant must also state, as soon as possible, the number of the application referred to.

#### **Section 8 a**

The registering authority may in an office action order the applicant to substantiate the priority referred to in section 8. In order to enjoy priority the applicant must within a certain period file a certificate from the authority that received the basic application referred to, attesting to the filing date of the application and the applicant's name, and a copy (certified by the said authority) of the application document and of a representation or representations of the design accompanying the application.

The period referred to in subsection 1 may not expire earlier than three months from the date on which the application is filed in Finland.

If the applicant does not comply with the order in accordance with subsection 1, priority may not be enjoyed.

#### **Section 8 b**

Priority may be based only upon the first application of which the design was the subject.

If the person making the first application, or his or her successor in title, has filed with the same authority a later application relating to the same design, the later application may be invoked as the basis of priority provided that, at the time of filing, the earlier application has been withdrawn, dismissed or rejected, and the documents filed in the case have not become available to the public, and has not left outstanding any right based upon it and has not served as a basis for priority. Where priority is accepted on the basis of the later application, the earlier application may no longer be invoked as grounds for priority.

#### **Section 8 c**

Where an application is filed for multiple registration in accordance with section 11, priority may be obtained for one or more of the designs.

Where such an application is filed, priority may be invoked on the basis of more than one application, even if they have been filed in different countries.

## **Chapter II. The Application for Registration and Processing Thereof**

### **Section 9**

The registering authority shall be the Finnish Patent and Registration Office.

**Section 10**

Applications for registration of designs shall be made in writing to the registering authority.

The application shall mention the creator of the design. Where the applicant is not the creator, the applicant must confirm in the application that the design right has been transferred to the applicant. In addition, the application shall specify the product or products to which the application relates.

The application shall be accompanied by a representation or representations of the design. Where the applicant, before the registration is published in accordance with section 18, also deposits a specimen, the specimen shall be deemed to disclose the design.

**Section 10 a**

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

Further provisions on payment of additional fees relating to the application shall be given by government decree.

**Section 11**

An application may include more than one design where the products stated in the registration application according to the classification established by the Locarno Agreement Establishing an International Classification for Industrial Designs (Finnish Treaty Series 22/1972) fall in the same class.

**Section 12**

An applicant who is not domiciled in Finland shall have an agent resident in the European Economic Area who is authorised to represent the applicant in matters concerning the application.

**Section 13**

An application must not be amended in a manner that does not retain the essential features of the overall impression of the design.

**Section 14**

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

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

However, the application shall be reinstated if, within two months from the expiration of the prescribed period, the applicant so requests and makes a reply to the office action or takes steps to remedy the defect and within the same period pays the prescribed reinstatement fee. Reinstatement may not be granted more than once.

### **Section 15**

If there is still any objection to acceptance after the applicant's answer, and provided that the applicant has had an opportunity to answer the objection, the application shall be rejected in so far as there is an objection to acceptance, unless there are grounds for delivering a further office action to the applicant.

### **Section 16**

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

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

### **Section 17**

Where anyone proves to the registering authority that he or she has a better right to the design than the applicant, the authority shall transfer the application to them if they so request. The transferee shall pay a new application fee.

Where transfer is requested, the application must not be amended, dismissed, rejected or accepted until the request for transfer has been finally decided.

### **Section 18**

Where the application documents are in the prescribed form and no objection has been found to acceptance, the registering authority shall register the design and publish the registration.

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

### **Section 18 a**

Opposition shall be made in writing to the registering authority within two months from the date of publication of the registration in the Design Gazette.

If registration has been applied for by a person not entitled to it under subsection 1, opposition may be lodged by anyone who considers him or herself to be entitled to the design.

If a design without proper permission includes a symbol or mark referred to in section 4 a (1) and (2), opposition may be lodged by the person whose right is infringed by the registration.

If a design is in conflict with section 4(1)(2) or section 4 a (3-5), the opposition may be lodged by the applicant for or the holder of the conflicting right.

In cases other than those stated in subsections 2 to 4, the opposition may be lodged by anyone.

### **Section 19**

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

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

### **Section 20**

After the expiration of the period for lodging an opposition prescribed in section 18 a (1), the oppositions filed against the design registration shall be examined. sections 14 to 17 shall be observed, where appropriate, in such examination. Where the opponent withdraws the opposition, the case may nevertheless be considered if there are special reasons for doing so.

In the case of opposition the registration holder shall be informed thereof. Where the opposition is not manifestly unjustified, the holder shall also be given an opportunity to answer the opposition.

After the opposition has been examined, the registering authority shall revoke the registration to the extent there is an obstacle to registration. Once a decision to revoke a registration has become final, the decision shall be published.

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

### **Section 21**

An applicant may appeal against a final decision taken by the registering authority on an application for registration if the decision is not in his or her favour. 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.

An applicant may appeal against the rejection of a request for reinstatement, provided for in section 14(3), and against the acceptance of a request for transfer, provided for in section 17. The person making a request for transfer may appeal against the rejection of his or her request.

**Section 22**

Appeals from decisions taken by the registering authority under this Act must be lodged with the Market Court, as provided in the Act on the Finnish Patent and Registration Office (575/1992).

The provisions of the Act on the Judicial Proceedings at the Market Court (100/2013) apply to the hearing of appeals, referred to in subsection 1, by the Market Court.

**Section 22 a**

If the registering authority receives notice of an international registration from the International Bureau referred to in section 44 a, 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 design begins and the designs covered by the international registration are partly or wholly the same as in the Finnish design registration, the registering authority shall revoke its decision concerning the Finnish registration and take a new decision on the matter.

**Section 23**

Section 23 has been repealed by Act 3.12.2010/1058.

**Section 23 a**

When the registering authority enters a design in the Register of Designs, the design shall be given a registration number. In the case of multiple registration, all the designs to be registered shall be given a common registration number. The design right owner shall be provided with a certificate of registration.

The register shall contain:

- (1) the serial number of the application and the registration number of the design;
- (2) the name, domicile and address of the design right owner and, where the owner is represented by an agent, the agent's name, domicile and address;
- (3) the name and address of the creator of the design;
- (4) indication of the articles for which the design is registered and of the classes to which the design has been assigned;
- (5) indication of the date
  - (a) on which the application for registration is deemed to have been filed in accordance with section 10 a;
  - (b) on which the application documents became available to the public;
  - (c) on which the design was registered;

- (d) on which the registration was published;
- (6) information as to priority requested, stating where the application giving rise to priority was filed and the date and serial number of that application;
- (7) a representation or representations of the design;
- (8) information as to whether a specimen has been submitted;
- (9) information as to whether the design has been amended under section 25 a;
- (10) information on partial cancellation of the design under section 31.

### **Section 23 b**

An entry referred to in section 27 shall state the name, domicile and address of the owner of the right, and the date of the transfer of the design right or of a license or mortgage. If a request is made to this effect with respect to a license, a note shall be made as to whether the right of the design right owner to grant a further license is restricted.

If a question concerning a note cannot immediately be settled, it shall nevertheless be noted in the register that a note has been requested.

Subsection 1 shall apply correspondingly to a note concerning a compulsory license and the right defined in section 32(2).

On notification that the right to a design is the subject of attachment, this shall be noted in the Register of Designs.

Notification of an amendment regarding an agent shall also be noted in the register.

### **Section 23 c**

Where the design right owner gives notice, in accordance with section 33(1), that he or she renounces the right to a design and where a license is noted in the register, the licensee shall be informed and allowed sufficient time to safeguard his or her interests in the matter, before the design is removed from the register.

## **Chapter III. Period of Validity of Registration of a Design and Amendment of a Registered Design**

### **Section 24**

Registration of a design shall be valid for five years, dating from the day on which the application for registration was made. Registration may, on request, be renewed for four further periods of five years, each such period running from the expiration of the preceding period.

The maximum term of protection shall nevertheless be 15 years, if the design is a component part of a complex product and is used to restore the original appearance of the complex product.

**Section 25**

A registration may be renewed at the earliest one year before and at the latest within six months from the expiration of any current period of registration.

Applications shall be made in writing to the registering authority, if the applicant wishes to have an amendment made to the register entries. Otherwise a registration shall be deemed to have been renewed once the renewal fee has been paid.

Renewal of a registration shall be published.

**Section 25 a**

A registered design may be amended at the written request of the holder, if the design has been registered contrary to provisions of section 1, 1a, 2, 3, 3a, 4, 4a or 4b. In the amended form the design shall, however, comply with the requirements prescribed in this Act for registration, and the essential features of the overall impression of the design must not be changed. A fee for amendment of a design is payable in respect of the application.

Any amendment to a registration shall be published.

**Chapter IV. Assignments, Licenses, Compulsory Licenses****Section 26**

The right to a design may be transferred.

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

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

**Section 27**

In the case of the transfer of the right to a design or a license, a note to that effect shall – on request and in return for a prescribed fee – be entered in the Register of Designs. The same shall apply to a mortgage on the right to a design. If it is proved that a license or mortgage that has been entered in the register has ceased to be valid, the entry shall be removed.

Subsection 1 shall correspondingly apply to a compulsory license and to the right referred to in section 32(2).

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

In legal proceedings or other cases regarding the right to a design, the person whose name has last been entered in the Register of Designs as design right owner shall be deemed to be the owner thereof.

Any person requesting entry in the register of an assignment of the right to a design or a license or a mortgage relating to such right shall, provided that he or she was acting in good faith at the time of such request, be unaffected by an earlier assignment of the right to a design or right relating thereto which had not previously been the object of a request for entry.

## **Section 28**

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

## **Section 29**

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

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

## **Section 30**

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

## **Chapter V. Termination of Right to a Design**

### **Section 31**

Where a design has been registered contrary to section 1, 1 a, 2, 3, 3 a, 4, 4 a or 4 b and an obstacle to registration still remains, the Court shall, if an action is brought to that end, cancel the registration in whole or in part. However, registration may not be cancelled on the ground that the person in whose name the registration was made is only a part-owner of the design right.

Where registration has been granted to a person who is not the rightful owner of the design as defined in section 1, an action to cancel the registration may be brought by the person who claims to be entitled to the design.

Where registration has been granted contrary to provisions of section 4 a (1) or (2), an action to cancel the registration may be brought by the person whose right is infringed by the registration.

Where registration has been granted contrary to provisions of section 4(2) or section 4 a (3 to 5), an action to cancel the registration may be brought by the applicant for or the holder of the conflicting right.

An action for cancellation of registration may also be brought by the Public Prosecutor if the action is based on a provision of section 4(1) or section 4 a (1) or (2).

In cases other than those stated in subsections 2 to 5, an action may be brought by anyone who sustains damage as a result of the registration.

### **Section 31 a**

In a case referred to in section 31(2), an action must be brought within one year after the plaintiff has had knowledge of the registration and of the other circumstances on which the action is based.

Where the design right owner acted in good faith when the design was registered or when the right to the design was transferred to him or her, the action may not be instituted later than three years after the registration.

### **Section 31 b**

The registration of a design may be cancelled in part only if the design after the cancellation still complies with the requirements for registration prescribed in this Act and the essential features of the overall impression of the design do not change.

Subsection 2 has been repealed by Act 31.1.2013/109.

### **Section 31 c**

The registration of a design may be declared invalid even after it has lapsed or has been surrendered.

### **Section 32**

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

Where a person who has been refused registration of a design has begun in good faith to use the design in the course of trade in this country or has taken substantial steps for that purpose, he or she may, on payment of reasonable compensation and on the fulfillment of other reasonable terms, continue such use or start the intended use, keeping its general character. In similar circumstances, the holder of a license entered in the register shall have the same right.

The right defined in subsection 2 may be transferred only together with the business in which the design is or was intended to be used.

**Section 33**

Where the design right owner declares in a written statement that he or she renounces the right to a design, the registering authority shall remove the design from the register.

Where the right to a design is the subject of attachment or a mortgage relating thereto has been recorded in the register or where a dispute concerning transfer of registration is pending before a court, the design may not be removed from the register at the request of the design right owner so long as the attachment or mortgage continues or the dispute has not been finally settled.

**Chapter V a. Community Design****Section 33 a**

*Community design* means an unregistered design in accordance with Council Regulation (EC) No 6/2002 on Community designs, and a design registered under the Council Regulation 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 and Design Office*.

**Section 33 b**

An application for the registration of a Community design may be filed with the Finnish Patent and Registration Office, which forwards it to the Community Trade Mark and Design Office, as provided in the Council Regulation on Community designs.

A forwarding fee is payable to the Finnish Patent and Registration Office on filing an application for a Community design.

**Chapter VI. Obligation to Provide Information****Section 34**

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

Any person who by direct representation to another person, in an advertisement or by an inscription or label on an article or its packaging or otherwise, states that registration of a design has been applied for or granted, without at the same time giving information about the number of the application or of the registration, shall, if so requested, give such information without delay. Where it is not expressly stated that registration has been applied for or granted, but the circumstances are such as to bring about the belief that this is the case, the person concerned shall, if requested, without delay inform whether registration has been applied for or granted.

**Chapter VII. Responsibility and Obligation to Provide Compensation****Section 35**

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

Where the infringement of a design was intentional, he or she shall, unless the act is punishable as a crime against an industrial property right under Chapter 49, section 2, of the Criminal Code of Finland, be liable to a fine for violation of the right to a design.

Prosecution for the violation of the right to a design may be instituted by the Public Prosecutor only if the aggrieved person brings a legal action based on the violation.

### **Section 35 a**

When hearing an action referred to in section 35(1) the court may at the design right owner's request prohibit the keeper of a transmitter, server or other similar device or other provider of a service acting as a transmitter, under penalty of a fine, from continuing the use alleged to infringe the registered design (injunction order) unless it can be considered disproportionate in view of the rights of the alleged infringer, or in view of the rights of the intermediary and the design right owner.

Before the bringing of an action referred to in section 35(1), the court may, at the design right owner's request, issue an injunction if the preconditions for it set out in subsection 1 exist and if it is obvious that the design right owner'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 the design 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 subsection 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 order 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 35(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 subsection 35(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 or her action or failed to arrive to the court. The same applies if the injunction is withdrawn under subsection 3 or lapses under subsection 4. When an action is brought for compensation for damage and costs, the provisions of Chapter 7, section 12, of the Code of Judicial Procedure apply.

### **Section 36**

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

Anyone who infringes the right to a design without intention or negligence shall pay compensation for the use of the design, in so far as such compensation may be found reasonable.

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

### **Section 36 a**

In a dispute that concerns an infringement of a design right the court may, at the plaintiff's demand, order that the defendant must compensate the plaintiff for the cost occurred to him or her for publishing, by suitable measures, information concerning the final decision in which the defendant is found to have infringed the design 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.

### **Section 37**

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

The goods referred to in subsection 1 above may be seized if it appears that an offense under Chapter 49, section 2, of the Criminal Code of Finland or section 35 of this Act has been committed. In such case, the provisions on seizure in the Coercive Measures Act (806/2011) shall be complied with.

Notwithstanding the provisions of subsection 1, the Court may, where special reasons exist and if so requested, make an order giving the owner of the goods referred to in subsection 1 the right of disposal over the goods during the remainder of the period of protection or during part thereof in return for reasonable compensation and under other reasonable terms.

### **Section 38**

If anyone contrary to the provisions of section 5 a uses a design that is the subject of an application for registration after the application documents have become available to the public, the provisions of this Act with respect to infringement of the right to a design shall apply correspondingly in so far as the application leads to registration. However, no penalty may be inflicted.

Compensation for damage caused by use made before the application has been published in accordance with section 18 shall in this case be determined in accordance with section 36(2).

The provisions of section 36(3) shall not apply where the proceedings for compensation are instituted within one year after the registration of the design.

### **Section 39**

Where registration of a design has been cancelled as the result of a judgment having become final, the penalties, compensation or protective measures provided for in Chapter 49, section 2, of the Criminal Code of Finland or sections 35 to 38 of this Act shall not be ordered.

Subsection 2 has been repealed by Act 31.1.2013/109.

### **Section 40**

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

A fine shall be imposed on anyone who, in any case referred to in section 34, gives wrong information, if punishment for the act is not provided for in the Criminal Code of Finland.

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

Proceedings based on the offense defined in this section may be instituted by the Public Prosecutor only if the aggrieved person brings a legal action based on the offense.

## **Chapter VIII. Rules Concerning Legal Proceedings**

### **Section 41**

The design right owner, or any person who may use the design by virtue of a license or a compulsory license, may bring an action to determine whether he or she is protected by the registration against another person, where there is, to his or her detriment, any uncertainty as to the relationship.

Under the same conditions, any person who carries on or intends to carry on a business activity may bring an action against the design right owner to determine whether any obstacle to the activity is presented by the particular registration.

Subsection 3 has been repealed by Act 31.1.2013/109.

**Section 42**

Section 42 has been repealed by Act 31.1.2013/109.

**Section 43**

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

The Market Court shall serve as the court having jurisdiction in matters concerning Community designs, as provided for in the Council Regulation referred to in section 33 a above.

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

**Section 43 a**

Charges of an intellectual property offence, as referred to in Chapter 49, section 2, of the Criminal Code of Finland, which infringes a right to a design; and charges of violation of a right to a design, as referred to in section 35(2) of this Act, and of an offence referred to in section 40 of this Act, are heard by the Helsinki District Court.

Claims for compensation under section 36 and section 40(3) or claims under section 37, 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 43.

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 b**

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 a above, to request a statement from the registering authority.

**Section 43 c**

When hearing a case referred to in section 43 a, 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 a above, to notify the registering authority of a decision.

## **Chapter VIII a. International Registration of Designs**

### **Section 44 a**

International design registration means the registration of a design effected by the International Bureau of the World Intellectual Property Organization (hereinafter referred to as ‘the International Bureau’) in accordance with the Geneva Act of July 2, 1999, relating to the Hague Agreement Concerning the International Registration of Industrial Designs.

The Finnish Patent and Registration Office shall be the registering authority responsible in Finland for all action relating to international registrations, and shall keep a record of international registrations in force in Finland.

### **Section 44 b**

A Finnish citizen or any person domiciled, resident or having a real and effective industrial or commercial establishment in Finland can file an application for international registration with the International Bureau or the registering authority.

An application filed with the registering authority shall be sent to the International Bureau without delay. The applicant shall pay a transmittal fee to the registering authority on filing an application.

### **Section 44 c**

An international application shall be filed in writing in accordance with the Geneva Act.

The states or intergovernmental organisations in which protection is sought shall be designated in the application. When filing the application, the applicant shall pay the fees given in the Geneva Act to the International Bureau.

### **Section 44 d**

An international design right registration designating Finland shall have the same effect as a national application under this Act, as from the registration date accorded by the International Bureau. Provisions laid down in and under this Act shall apply *mutatis mutandis* to the international registration.

An international registration may be renewed by filing an application with the International Bureau.

### **Section 44 e**

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

If the registering authority finds that the international registration does not comply with the conditions of registration laid down in this Act, it shall notify the International Bureau in a justified notification of refusal that the international registration has no effect in Finland. The notification of refusal shall be filed with the International Bureau within 12 months from the date of publication of the international registration.

After the notification of refusal, the holder of an international registration has the right to make a statement within a period prescribed by the registering authority or cancel the international registration in respect of Finland. If the statement issued by the registration holder commenting on the notification of refusal does not present any grounds on which the design would comply with the conditions of registration laid down in this Act, the registering authority shall decide that the international registration has no or only a partial effect in Finland. Once a decision to partially or totally refuse a registration has become final, the decision shall be published in the Design Gazette.

#### **Section 44 f**

If an opposition has been filed against an international registration within a period laid down in section 18 a, the registering authority shall send a notification of the matter, together with a statement of the grounds, to the International Bureau within a period given in section 44 e (2).

The registration holder shall be given an opportunity to submit a statement regarding the opposition within a prescribed period, after which the registering authority shall examine the opposition. If the registering authority finds that the registration does not comply with the conditions of registration laid down in this Act, it shall decide that the international registration has no or only a partial effect in Finland. The registering authority shall reject the opposition if no obstacle to international registration in respect of Finland is found.

If the registering authority decides, on account of an opposition, that the international registration has no or only a partial effect in Finland, the authority shall make an entry about it in its list. Once a decision to partially or totally refuse a registration has become final, the decision shall be published in the Design Gazette.

#### **Section 44 g**

The registering authority shall notify the International Bureau of any changes in the international registrations designating Finland.

If a design is partially or totally removed from the International Register, the registering authority shall, when necessary, remove it from its list. Changes concerning the validity of an international registration in Finland shall be published in the Design Gazette.

#### **Section 44 h**

If a holder of an international registration who is not domiciled in Finland wishes to submit a statement to the registering authority, the holder shall appoint an agent resident in the European Economic Area.

### **Chapter IX. Special Provisions**

**Section 45**

A design right owner who is not domiciled in Finland shall have an agent resident in the European Economic Area who is authorised to receive summons or other documents on behalf of the owner in matters concerning the design right, except for summons in criminal matters or orders to a party to appear in person before a court. The agent shall be reported for registration in the Register of Designs.

**Section 46**

The Government may, provided that reciprocity exists, decree that the rules set out in Section 12 or 45 shall not be applicable with respect to an applicant or a design right owner who is resident in a foreign country or who has in that country an agent entered in the Finnish register having the powers referred to in those sections.

**Section 46 a**

If the registering authority has failed to notify the applicant, the opponent or the design right owner of its decision at the address he or she has given to the registering authority, the decision may be notified by publishing it in the Design Gazette published by the Finnish Patent and Registration Office.

**Section 47**

In connection with an application for registration of a design, renewal of a registration, amendment of a design or the filing of a Community design application or an application for international registration, the applicant shall pay an application fee, a renewal fee, a fee for amendment of the design, a forwarding fee for the Community design application or a transmittal fee for the application for international registration and, where applicable, the following additional fees: a class fee for each class of articles beyond the first, a multiple registration fee for each design beyond the first, a storage fee for the storage of a specimen, and a publication fee for each representation beyond the first, and a separate fee for other entries in the Register of Designs. An increased renewal fee shall be payable if the fee is paid after the expiration of a current period of registration.

The Government shall determine the fees payable under this Act.

**Section 48**

Further provisions on applications for registration, the division of an application, the processing of applications for registration, the publication of registration, the Register of Designs, 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, matters concerning registered designs, the Register of Designs, publication in matters concerning design right, and other similar technical matters.

**Section 49**

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

**Entry into force and application of amendments:****10.5.1991/802:**

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

**26.6.1992/578:**

The Act enters into force on 1 September 1992.

**13.11.1992/1035:**

The Act enters into force on 1 March 1993.

**18.12.1992/1411:**

The Act will enter into force on a date to be defined by decree. (Act 1411/92 entered into force on 1 January 1994 in accordance with Decree 1342/93.)

**21.4.1995/718:**

The Act enters into force on 1 September 1995.

**12.7.2002/596:**

The Act enters into force on 1 August 2002.

This Act also applies to designs registered before its entry into force and to designs to be registered on the basis of an application filed before the entry into force of this Act. The provisions of law in force at the time of the entry into force of this Act will however apply to the cancellation of a design registered on the basis of an application for registration filed before the entry into force of this Act.

An application for registration filed before the entry into force of this Act will be processed and decided on in accordance with the provisions of law in force at the time of the entry into force of this Act.

If anyone at the time of the entry into force of this Act uses a design in this country in a manner that according to the provisions of law in force at the time of the entry into force of this Act does not require the consent of the design right owner, he or she may continue the use of the design, even if the consent is required under this Act. The same right is enjoyed by anyone who has taken substantial steps to use the design.

**20.12.2002/1215:**

The Act enters into force on 1 January 2003.

**21.7.2006/685:**

The Act enters into force on 1 September 2006.

Section 35 a of this Act also applies to disputes that have been pending before the entry into force of this Act.

The provisions of law in force at the time of the entry into force of this Act apply to disputes that have been pending before the entry into force of this Act, instead of section 36 a in this Act.

**3.12.2010/1058:**

Provisions regarding the entry into force of this Act shall be issued by government decree.

The provisions of this Act apply to applications for registration of a design pending at the time of the entry into force of this Act. Applications for registration already published by the registering authority in accordance with section 18 will however be processed and decided on in accordance with the provisions of law in force at the time of the entry into force of this Act.

Measures necessary for the implementation of this Act may be undertaken before the Act's entry into force.

**14.4.2011/356:**

The Decree enters into force on 1 May 2011.

**22.7.2011/862:**

The Act enters into force on 1 January 2014.

**31.1.2013/109:**

The Act enters into force on 1 September 2013.

Appeals from decisions taken by the registering authority before the entry into force of this Act, are lodged in accordance with the provisions of law in force at the time of the entry into force of this Act.

Disputes or application or criminal cases which have been brought before a District Court before the entry into force of this Act, are heard in accordance with the provisions of law in force at the time of the entry into force of this Act.

Measures necessary for the implementation of this Act may be undertaken before the Act's entry into force.