

**NB: Unofficial translation
FINLAND**

Act on Utility Model Rights

(800/1991; amendments up to 1696/1995 included)

Chapter 1 - General provisions

Section 1

Anyone who has made an invention, or his successor in title, shall be entitled, on application, to a utility model right to his invention, and thereby to the exclusive right to exploit the invention commercially, in accordance with the provisions of this Act.

For the purposes of this Act, "invention" shall mean a technical solution that is commercially exploitable.

The following, as such, shall not be regarded as inventions:

- (1) discoveries, scientific theories and mathematical methods;
- (2) aesthetic creations;
- (3) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers; and
- (4) presentations of information.

Utility model rights shall not be granted for:

- (1) inventions the exploitation of which would be contrary to morality or public policy;
- (2) plant or animal varieties; or
- (3) processes.

Section 2

An invention must be new in relation to what was known before the filing date of the utility model right application and must differ distinctly therefrom.

The prior art shall be held to comprise everything made available to the public by means of a written or oral description, by use or in any other way. Additionally, the content of utility model right, patent and design applications as filed in this country prior to the above-mentioned filing date shall be regarded as comprised in the prior art if such applications are made available to the public under section 18 of this Act, section 22 of the Patents Act or section 19 of the Registered Designs Act. The requirement set out in the first paragraph, that the invention must differ distinctly from the prior art known before the filing date of the application for a utility model right, shall not apply, however, in such cases.

Applications referred to in Chapter 8a shall, for the purposes of the second paragraph, have the same legal effect as applications for utility model right filed in this country, pursuant to provisions laid down in sections 45b and 45f.

A utility model may nevertheless be registered for inventions made available to the public within the six months preceding the filing date of the application if disclosure was the result of:

- (1) an evident abuse in relation to the applicant or his predecessor in title; or
- (2) the fact that the applicant or his predecessor in title had displayed the invention at an official or officially recognized international exhibition falling within the terms of the Convention on International Exhibitions (Finnish Treaty Series 36/37).

For the purposes of the second paragraph, publication according to Article 93 of the European Patent Convention (Finnish Treaty Series 8/96) shall be equated with the making available to the public of application documents according to section 22 of the Patents Act. What is said above, also applies to publication according to Article 158(1) of the European Patent Convention where the European Patent Office equates such publication with publication according to Article 93.

Section 3

The exclusive right conferred by registration of a utility model shall imply, subject to the exceptions stated below, that no one may exploit an invention without the consent of the proprietor of the utility model right by making, offering, putting on the market or using a product protected by the utility model right, or by importing or possessing such product for these purposes.

The exclusive right shall also confer on its proprietor the exclusive right to prevent any person not having his consent from supplying or offering to supply any person not entitled to exploit the invention with the means of working the invention in this country in relation to an essential element of the invention where such other person knows, or on the basis of the circumstances should have known, that the means are suitable and intended for working the invention. This provision shall not apply where the means are staple commercial products, except where such other person attempts to induce the receiver to commit any act infringing the exclusive right referred to in the first paragraph of this section. For the purposes of this subsection, any person using the invention in a manner referred to in subsection 3(1) or (3) shall not be regarded as entitled to exploit the invention.

The exclusive right shall not apply to:

- (1) use which is not commercial;
- (2) use of a product protected by registration of a utility model right that has been put on the market within the European Economic Area by or with the consent of the proprietor of the utility model right; or
- (3) use in experiments relating to the invention as such.

Section 4

The provisions of sections 4 and 5 of the Patents Act regarding commercial use or exploitation of an invention on foreign vessels, aircraft or other means of transport for their needs shall apply *mutatis mutandis* on an invention for the purposes of this Act.

Section 5

An application for registration of a utility model right relating to an invention disclosed not earlier than 12 months before the date of filing in an application for a patent or for registration of a utility model filed in Finland, or in an application for a patent, an inventor's certificate or utility model protection filed in another country party to the Paris Convention for the Protection of Industrial Property (Finnish Treaty Series 36/70 and 43/75) or the Agreement Establishing the World Trade Organization (Finnish Treaty Series 5/95), shall be deemed, for the purposes of section 2(1-2), and section 4, to have been filed at the same time as the earlier application if the applicant so requests. Such priority may also be enjoyed under an earlier application for protection filed in a country not party to the above-mentioned conventions if the corresponding priority deriving from a Finnish application is granted in such country and if the laws of such country substantially conform to those conventions.

The Government, or a Registering Authority appointed by the Government, shall lay down the manner in which priority claims shall be filed and the documents to be submitted in support of claims.

Chapter 2 - **Applications for utility model rights and their processing**

Section 6

Applications for utility model rights, hereinafter referred to as "utility model applications", shall be filed in writing with the National Board of Patents and Registration, acting as Registering Authority. In the cases referred to in Chapter 8a applications may also be filed with the patent authority of another country or with an international organisation.

The application shall contain a description of the invention, accompanied by drawings where necessary, and a precise statement of the subject matter for which utility model right protection is sought (a claim). More specific provisions regarding drawings accompanying the application shall be laid down by decree. The description shall be sufficiently clear to enable a person skilled in the art to carry out the invention with the guidance thereof. Where the invention relates to a product of a microbiological process, section 8a and section 22(6)(8) of the Patents Act shall apply *mutatis mutandis*.

The inventor's name shall be stated in the application. If a utility model right is applied for by a person other than the inventor, the applicant shall be required to prove his title to the invention.

Section 7

The description and claim shall be written in Finnish or Swedish in compliance with the language laws in force. If the claim is written in one only of the two national languages, the Registering Authority shall have the claim translated into the other national language before the utility model is registered. The applicant shall pay the prescribed translation fee. Where the applicant is a foreigner, the description shall be written in Finnish and the claim in Finnish and Swedish. However, all applicants shall be entitled to write the description of the invention and the claim in both Finnish and Swedish.

The applicant shall pay the prescribed registration fee. The application shall be deemed not to have been filed until the fee has been paid.

Section 8

A utility model application may also result from conversion of a pending patent application relating to the same invention into an application for a utility model right, which shall be deemed to have been made on the filing date of the patent application. However, conversion shall not be allowed after expiry of ten years from the day the patent application is deemed to have been filed. In other respects, the provisions relating to applications for utility models shall also apply in the case of such utility model applications.

A patent application shall remain pending even if it is converted into a utility model application unless the applicant specifically withdraws the patent application.

Section 8a

If a European patent application under the European Patent Convention is to be deemed withdrawn because it has not in due time been received by the European Patent Office from the national Registering Authority of the Contracting State of the European Patent Convention with which the application was filed, it shall, at the applicant's request, be converted into a utility model application, provided that:

- (1) the request is submitted to the national Registering Authority of the Contracting State of the European Patent Convention within three months of the date the European Patent Office notified the applicant that the application is deemed withdrawn;
- (2) the request is received by the Registering Authority within 20 months of the filing date of the application or, where priority is claimed, from the date of priority; and
- (3) the applicant pays the prescribed application fee and submits the translation pursuant to section 7 of the utility model application within the prescribed time limit.

If a European patent application is to be deemed withdrawn because no translation in its language of proceedings has been submitted to the European Patent Office within the prescribed time limit, it may, at the request of the applicant, be converted into a national utility model application in compliance with the provisions of Articles 135 and 136 of the European Patent Convention. The applicant shall additionally pay

the Registering Authority the prescribed application fee and submit a translation pursuant to section 7 of the utility model application within the prescribed time limit.

If a utility model application within the meaning of subsections 1 and 2 satisfies the requirements as to form of the European Patent Convention and its Implementing Regulations, it shall be accepted in these respects.

Section 9

A utility model right may not be applied for in respect of two or more mutually independent inventions in the same application.

At the applicant's request, a utility model application may be divided, in which case the new application shall be deemed to be filed at the same time as the original application.

Section 10

An applicant for and a proprietor of a utility model right not domiciled in Finland shall be required to appoint a representative domiciled in the country to represent him in all matters concerning the application and the registered utility model.

Section 11

A utility model application may not be amended in such a way that a utility model right is claimed for matter not disclosed in the original application.

Section 12

The Registering Authority shall check that the application complies with section 1(2-3) and sections 6 to 11.

The Registering Authority shall classify the application.

The applicant or, after the utility model has been entered into the Register or been made available to the public under section 18, anyone may submit a request in writing for an examination to assess whether an invention for which utility model registration has been granted or a utility model application filed satisfies the requirements laid down in section 2(1). The prescribed fee is payable for the examination.

Section 13

If the applicant fails to satisfy the requirements for the application, or if the authority finds other obstacles to the registration of the utility model, the applicant shall be notified thereof by official action and be invited to file his comments or the necessary corrections within the specified period of time.

If the applicant fails to file his comments or to take steps to remove, within the specified period of time, the obstacles, the application shall be dismissed. The

official action issued pursuant to the first paragraph shall include a notice to that effect.

A dismissed application may be reinstated if, within two months of the expiration of the time limit laid down in the official action, the applicant so requests and files comments or takes steps to correct the application and, within the same period of time, pays the prescribed reinstatement fee. An application may be reinstated only once.

Section 14

If, after the applicant has filed his comments, there still remains an obstacle to the registration of the utility model which the applicant has had an opportunity to comment on, the application shall be rejected, unless there is reason to issue a further official action to the applicant.

Section 15

If a person other than the applicant claims title to the invention before the Registering Authority, and if the circumstances are held to be uncertain, the Registering Authority may invite such other person to institute legal proceedings before a court of law within a specified period of time, failing which the claim will not be taken into consideration.

If proceedings for title to an invention in respect of which utility model protection has been applied for are pending before a court, the processing of the utility model application may be suspended until a final decision has been given in such proceedings.

Section 16

If a person proves to the Registering Authority that he has title to the invention and not the applicant, the Registering Authority shall, if such person so requests, transfer the application to him. At the same time, he shall pay a new application fee.

The application shall not be dismissed, rejected, granted or withdrawn until a final decision has been taken on the request.

Section 17

If the application satisfies the requirements of section 1(2-3) and of sections 6 to 11, the utility model shall be recorded in the Utility Model Register. Public notice shall be given of the registration and a certificate of registration shall be issued to the applicant.

Section 18

The application file shall be available to the public as from the date of registration or no later than when 15 months have elapsed since the date the application was filed or is deemed to have been filed, or, where priority is claimed, from the priority date.

At the request of the applicant, registration may be postponed for a period of no more than 15 months from the date the applications was filed or is deemed to have been filed, or, where priority has been claimed, from the priority date. If the application has been dismissed or rejected, the file shall become available to the public only if the applicant requests for reinstatement of the application or appeals against the decision by which the application was rejected. A prescribed fee is payable for the postponement of the registration.

At the applicant's request, the application file may be made available to the public earlier than provided for in the first paragraph.

Chapter 3 - **Opportunity to require that the registration be declared invalid**

Section 19

If an invention for which a utility model right has been registered or an application for a utility model right does not satisfy the requirements laid down in section 1(2-4), section 2, section 6(2), or sections 8 or 11, any person may request that the registration of the utility model be declared invalid in whole or in part.

The request shall be made to the Registering Authority in writing and state the facts on which it is based. The person making the request shall pay the prescribed fee. If the payment is not made, the request will not be considered.

A request that a registration be declared invalid shall not be considered if proceedings concerning transfer of the registration are pending.

Section 20

The Registering Authority shall notify the proprietor of the utility model right of any request made under section 19 and give him an opportunity to file comments on the request within a specified period of time. If a partial invalidation of the registration is concerned, the proprietor shall submit a reworded claim to the Registering Authority within the same specified period of time. If he does not oppose the request within the specified period of time, the registration shall be declared invalid in whole.

If the proprietor of the utility model right opposes the request, it shall be examined by the Registering Authority.

Section 21

If the Registering Authority ascertains, as a result of the request, that the invention to which the utility model right relates, or the application for a utility model does not fulfil

the requirements of section 1(2-4), section 6(2), or of sections 8, 9 or 11 of the Act, the registration of the utility model shall be declared invalid in whole or in part.

If a registration has been declared invalid, the decision shall be published once it becomes final.

Chapter 4 - **Appeals**

Section 22

A utility model right applicant or proprietor may seek appeal of a final decision concerning registration or declaration of invalidation of the utility model right, if the decision is not in his favour. The person requesting a declaration of invalidation of a utility model may seek appeal if his request is rejected by the decision.

Appeal of a decision rejecting a request for reinstatement under section 13(3) or a decision granting a request for transfer of an application under section 16 may be sought by the applicant. Appeal of a decision rejecting a request for transfer of an application may be sought by the person making the request.

Section 23

An appeal from a decision taken by the Registering Authority under the present Act shall be brought by filing an appeal with the Board of Appeal of the National Board of Patents and Registration. Separate provisions shall apply to the appeal procedure and the proceedings before the Board of Appeal.

Chapter 5 - **Scope and term of protection**

Section 24

The scope of protection conferred by a utility model right shall be determined by the claim. The description and illustrations may be used to interpret the claim.

Section 25

The term of protection of a utility model registration shall be four years from the filing date of the application and may, on request, be renewed twice, first for a period of four years and then for a period of two years.

Section 26

Renewal of a registration shall be requested in writing from the Registering Authority not earlier than one year before and not later than six months after the registration term expires. Within the same period of time the proprietor of the utility model shall pay the prescribed renewal fee. After the expiration of the running registration term the renewal fee shall be paid raised by a prescribed amount.

The renewal of a registration shall be announced.

Chapter 6 - Assignment, licences and compulsory licences

Section 27

A utility model right may be transferred.

If another person has obtained the right to exploit the invention commercially (licence), such person may transfer his right to a further person only if such has been agreed.

However, if the licence has been granted to an enterprise, it may be transferred together with the enterprise, unless otherwise agreed. In such case the assignor shall remain liable for compliance with the licence agreement.

Section 28

The transfer of a utility model right or the grant of a licence shall be recorded in the Utility Model Register on request and on payment of the prescribed fee. This shall also apply to the pledging of a utility model right. On proof that a licence or a pledge recorded in the Register is no longer in force, the entry shall be deleted from the Register.

The first paragraph of this Section shall apply *mutatis mutandis* to compulsory licences and to the right referred to in the first paragraph of section 32.

The person last recorded in the Utility Model Register as the proprietor of the utility model right shall be deemed the proprietor for the purposes of legal proceedings and for other matters concerning the utility model.

Section 29

If a person acting in good faith has requested the Registering Authority to record in the Register that a utility model right has been transferred to him or that he has obtained a licence to a utility model or a pledge in a utility model, an earlier transfer of the utility model right or of rights therein shall not be enforceable against him, if the other party has not previously requested registration of his acquisition in the Utility Model Register.

Section 30

Where two years have elapsed since the registration of the utility model and the invention has not been worked or brought into use to a reasonable extent in Finland, any person who wishes to work the invention in the country may obtain a compulsory licence to do so unless there are legitimate grounds for the failure to work.

The provisions of sections 46 to 50 of the Patent Law relating to compulsory licences to exploit inventions protected by patents shall apply *mutatis mutandis* with respect to utility model rights.

Chapter 7

Termination of utility model right and obligation to furnish information

Section 31

Where a utility model has been registered in the name of a person other than the person entitled under section 1 and where an action is brought by the person having the right to the utility model, the court shall transfer the utility model to the entitled person.

Such actions shall be brought within one year of the plaintiff's gaining knowledge of the registration and of any other circumstances on which the action is founded. Such action may not be brought more than three years after registration of the utility model if the proprietor of the utility model acted in good faith at the time the utility model was registered or was transferred to him.

Section 32

Where a person dispossessed of a registration in accordance with section 31 had, in good faith, begun commercial exploitation of the invention in this country or had made substantial preparations therefor, he shall be entitled, against reasonable remuneration and on other reasonable terms, to continue the exploitation or to commence the intended exploitation, provided that its general nature is maintained. A licensee recorded in the Utility Model Register shall have the same right subject to equivalent conditions.

The right referred to in the first subsection of this section may only be transferred to others together with the enterprise in which it is exploited or intended to be exploited.

Section 33

Where the proprietor of a utility model right notifies in writing that he relinquishes his registration, the Registering Authority shall delete the utility model from the Register.

Where a utility model is seized for debt or is subject to a pledge that has been recorded in the Register or if an action for transfer of the registration is pending, the utility model may not be deleted from the Register at the proprietor's request as long as the seizure or pledge is in force or until a final decision has been given in the action.

Section 34

Where a utility model registration has been transferred by final decision of a court, the Registering Authority shall publish a notice to that effect.

Section 35

The provisions of section 56 of the Patents Act concerning the obligation to furnish information in respect of a patent shall apply *mutatis mutandis* to a utility model right.

Chapter 8 - **Liability, payment of compensation and court proceedings**

Section 36

The court may forbid any person who infringes the exclusive right conferred by a utility model right from continuing or repeating the act.

Section 37

Any person who intentionally or negligently infringes a utility model right shall be liable to pay reasonable compensation for the exploitation of the invention, as also compensation for other damages caused by the infringement. If there is only slight negligence, the compensation may be adjusted accordingly.

A person found guilty of utility model right infringement that is neither intentional nor negligent shall pay compensation for the exploitation of the invention if and to the extent held reasonable.

An action for compensation for utility model right infringement may only be brought with respect to damages suffered during the five years preceding the institution of the action. If an action is not instituted within that period, the right to compensation shall be forfeited.

Section 38

The provisions of section 59 of the Patents Act concerning measures to prevent further infringement shall apply *mutatis mutandis* to utility model rights.

Section 39

Any person who infringes an exclusive right in a utility model right intentionally, shall, unless the act is punishable as an industrial property right offence under section 2 of Chapter 49 of the Penal Code, be liable to a fine for *violation of a utility model right*.

Indictment for an offence referred to in the first paragraph may be brought by the Public Prosecutor only if so requested by the injured party.

Section 40

Any person who intentionally or by negligence, other than slight negligence, fails to comply with an obligation under section 35, shall be liable to a fine for *failure to comply with the obligation to furnish information relating to a utility model*.

Any person who provides false information in a case referred to in the said section shall also be liable to the same penalty, unless the act is punishable under the Penal Code.

Indictment for an offence referred to in the present section may be brought by the Public Prosecutor only if so requested by the injured party.

Section 41

Where a utility model registration has been declared invalid by a final decision, no penalty, payment of compensation or other sanction may be ordered under section 2 of Chapter 49 of the Penal Code or sections 36 to 39 of this Act.

Where the plaintiff in an action for infringement of a utility model right claims that the registration does not comply with this Act, the court may, at the defendant's request, stay proceedings or the decision until a final decision has been taken on the invalidity claim. Where no request for invalidation has been filed with the Registering Authority, the court shall order the defendant, in connection with the stay of proceedings, to file such request within the period of time it shall determine.

Section 42

Any person who wishes to bring an action for transfer of a utility model right or for grant of a compulsory licence shall give the Registering Authority notice thereof and shall notify all persons recorded in the Utility Model Register as licensees under the utility model right or as proprietors of a pledge therein. If a licensee wishes to bring an action for utility model infringement he shall notify the proprietor of the right thereof.

The requirement to notify pursuant to the first paragraph shall be deemed satisfied when notification by registered letter has been sent to the addresses recorded in the Utility Model Register.

If the plaintiff cannot prove, at the time the action is brought, that he has given notice pursuant to the first paragraph, he shall be given a sufficient period of time to do so. If he does not avail himself of that period of time, the action shall be dismissed.

Section 43

The District Court of Helsinki shall be the competent court to hear proceedings in respect of:

- (1) proper title to an invention for which a utility model right has been sought;
- (2) transfer of a utility model right;
- (3) grant of compulsory licences, amendment of conditions for compulsory licences or revocation of a right referred to in the first paragraph of section 32;
- (4) infringement of a utility model right or non-compliance with the obligation to furnish information relating to a utility model; or
- (5) assessment of the compensation due under section 37.

Section 44

The provisions of sections 66 and 67 of the Patents Act shall apply *mutatis mutandis* to the proceedings referred to in section 43.

Section 45

The court shall communicate to the Registering Authority a copy of decisions given in the proceedings referred to in section 43 together with a statement as to whether the decision is final.

Chapter 8a - **International applications**

Section 45a

In this Act "an international application" shall mean an application relating to a utility model filed under the Patent Cooperation Treaty (Finnish Treaty Series 58/80).

International applications shall be filed with a registering authority or an international organisation (receiving office) authorized under the Patent Cooperation Treaty and its Regulations to receive such applications. The receiving office in Finland shall be the National Board of Patents and Registration, as laid down by Government decree. Applicants filing an international utility model application in Finland shall pay the prescribed fees.

Unless otherwise provided in sections 45b to 45f, the provisions Chapter 3 of the Patents Act in respect of the processing of international patent applications shall *mutatis mutandis* apply to the processing of international utility model applications designating Finland.

Section 45b

An international utility model application to which a receiving office has assigned an international filing date shall have the same effect in this country as a Finnish utility model application filed on the same date. The second sentence in section 2(2) shall only apply to an international application that has been pursued under section 45d.

Section 45c

An international utility model application shall be deemed withdrawn as far as the designation of Finland is concerned in the cases referred to in Article 24(1)(i) and (ii) of the Patent Cooperation Treaty.

Section 45d

If an applicant wishes to pursue an international utility model application in Finland, he shall file with the Patent Authority a translation in Finnish or Swedish of the international application within 20 months of the international filing date or, where priority is claimed, of the priority date, or a copy of the application where it is written

in Finnish or Swedish. The applicant shall pay the prescribed registration fee to the Registering Authority within the same period.

If an applicant has requested that the international utility model application be the subject of an international preliminary examination, and if within 19 months of the date referred to in the first paragraph of this Section he had stated his intention under the Patent Cooperation Treaty and its Regulations to use the results of the international preliminary examination in applying for a utility model right for Finland, he shall comply with the requirements of the first paragraph within 30 months of that date.

If the applicant has paid the prescribed registration fee within the time limit laid down in the first or second paragraph, the required translation or a copy of the application may be filed within a further period of two months, provided the prescribed additional fee is paid within that same period.

If the application, in cases referred to in the first and second paragraphs of this Section, does not satisfy the requirements of this Act, the applicant may within a period of two months from the time limits referred to in the first and second paragraphs render the application to comply with the requirements as to form and content of the Implementing Regulations of the Patent Cooperation Treaty. If the applicant does not satisfy the requirements of this Section, the application shall be deemed withdrawn as far as Finland is concerned.

Section 45e

Where an applicant withdraws his request for international preliminary examination or his statement of his intention to use the results of such examination in applying for a utility model right for Finland, the international utility model application shall be deemed withdrawn as far as Finland is concerned. The application shall not be deemed withdrawn, however, if withdrawal is made prior to the expiration of the time limit laid down in section 45d(1) and if the applicant also pursues the application within the time limit laid down in the first, third or fourth subsection of section 45d.

Section 45f

Where an international application has been pursued under section 45d, provisions of Chapters 2 and 5 shall apply in respect of the application and examination, unless otherwise provided in this section or in sections 34 to 38 of the Patents Act. However, the application may be taken up for examination prior to expiration of the period laid down in section 45d(1-2) only if so requested by the applicant.

The obligation under section 10 of the applicant to have a representative domiciled in the country does not begin until the date when the application may be taken up for examination.

When 18 months have elapsed since the date of filing of the application or, if priority is claimed, from the priority date, and the applicant has satisfied his obligation under section 45d to submit a translation or, where the application has

been written in Finnish or Swedish, the applicant has submitted a copy of the application to the Registering Authority, the application documents shall be made available to the public even before the applicant has pursued the application.

Chapter 9 - **Special provisions**

Section 46

Separate provisions shall apply to the amounts of fees to be paid under the present Act.

Section 47

More detailed provisions to regulate utility model applications, the Utility Model Register and also the Registering Authority will be issued by Government decree. Detailed regulations concerning utility model applications and their processing may be issued by the Registering Authority.

Section 48

The provisions of section 75 of the Patents Act concerning the obligation to surrender rights in an invention in certain cases and the compensation to be paid therefor shall apply *mutatis mutandis* to utility model rights.

Separate provisions shall apply in respect of inventions of importance to the defence of the country.

Chapter 10 - **Entry into force and transitional provisions**

Section 49

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

Applications filed prior to the entry into force of this Act may not serve as a basis for a priority claim under section 5.

Patent applications filed or deemed to have been filed prior to the entry into force of this Act may not be converted into applications for utility models under section 8.