

Contributing firm
Roschier Brands, Attorneys Ltd



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Legal framework

Finnish design registrations are regulated by the Registered Designs Act (221/1971), as amended. The act is based on the EU Design Directive (98/71/EC).

Designs are examined by the National Board of Patents and Registrations. The Design Rights Unit is organised under the Trademarks and Designs Line of the board. The Patents and Innovations Line examines utility models and patents, but not designs. Thus, Finnish design protection is referred to as 'designs' – not 'design patents', as in some jurisdictions.

According to the act, a 'design' is an industrial property right which protects the appearance of a product or part thereof. The object of protection extends only to the appearance of a product. Technical inventions may, instead, obtain patent or utility model protection.

Unregistered designs

There are no provisions in the act regarding

unregistered designs. Therefore, obtaining a design right under national law requires that the design be registered.

Protection for unregistered designs is based solely on the EU Community Design Regulation, which came into effect on March 6 2002. Designs which were disclosed for the first time on or after this date will be protected. Protection is not afforded to designs disclosed before this date.

There is no use requirement under the Community Design Regulation. If the holder of an unregistered design wants to rely on this regulation, it should be able to provide proof:

- of when the design was disclosed;
- that the disclosed design is the claimed design;
- that the interested circles in Finland were aware of the disclosure; and
- that the design is in fact a copy of the earlier disclosed design.

The scope of protection for unregistered designs is narrow, protecting them against copying only for three years from the date of disclosure.

Registered designs

Any natural person or legal entity, either separately or jointly, may apply for the registration of a design. If there are multiple applicants, there should be an indication as to whom all correspondence should be sent to. Legal entities must indicate their official name and domicile.

Utility articles, such as chairs or individual parts thereof (eg, a chair leg), graphic symbols or even the shop front of a store, can be protected. However, the object of protection must always be a concrete article; thus, ideas or moving elements cannot be protected. On the other hand, graphic symbols, such as icons, can be protected.

Design rights do not cover...

Private use of a design is permitted for non-commercial purposes. An example of private use is preparing a design for a family member free of charge. However, selling the design even to limited circles is no longer considered private use.

Design rights do not cover the use of a design for experimental purposes. For example, a scientist may use and quote a design in his or her publications or lectures, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that the source of the design is referenced.

Designs of interconnections

Protection is not granted to features of appearance of a product which must be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated, or to which it is applied, to be mechanically connected to or placed in, around or against another product so that either product may perform its function. These so-called 'designs of interconnection' are thus refused protection. The purpose behind this is to prevent monopoly of the spare parts business.

Modular designs

Design rights can be granted to designs which allow multiple assembly or connection of mutually interchangeable products within a modular system. Bookcases are a good example of modular systems in which multiple assembly is possible, and thus protection is possible.

Technical function

Design rights cannot be granted to designs which are solely dictated by their technical function. This refers to such features which, for technical reasons, cannot be implemented in any other way.

Fees

The official application fee is €185. The fee for each additional class is €50; the fee for multiple registration for each additional design is €100; and the publication fee for each additional filed representation is €45. The application will be considered as filed only after the application fee has been paid. The fees are non-refundable, even if design protection is refused.

Procedures

Applications cannot be filed electronically. Domestic applicants may use Finnish or Swedish, in accordance with Finland's language legislation. Foreign applicants must file the application form, including all enclosures, in Finnish.

Representations

It is recommended to submit the design using line drawings, provided that they give the best and most precise information on the design. Photographs and three-dimensional drawings are acceptable, provided that they are essential for the comprehension of the design. In principle, technical drawings are not acceptable.

The drawings must not exceed A4 size and all drawings must be filed in triplicate. The representations can be in either black and white or colour. However, a colour design is limited to cover a design in that specific colour.

If protection is sought for only part of a product, the part can be drawn in solid lines and the rest of the design can be drawn in dotted lines.

The design can be represented in different positions. For instance, a laptop can be represented in open and closed positions. An enlargement of the claimed part of the design can be filed. However, this also requires that a picture of the entire design be submitted.

Number of designs

It is advisable to use several different views in the representation of a design in order to give a complete picture of the design. The number

of views is not limited by the regulation, but normally the application should not exceed 20 drawings per design, unless it is justified under the circumstances. Shaded versions of drawings are not forbidden as such, but are likely to encounter objection if considered as a sketch.

The number of designs per application is not limited, provided that the designs fall within the same Locarno class.

Specimens

The applicant may want to enclose a specimen of the design in the application, but there are no requirements to do so. The specimen must not exceed 40 centimetres in any dimension or weigh more than four kilograms. Even if a specimen of the design is filed, representations must always be filed after the application.

Formalities

The Design Rights Unit first examines formalities – namely, whether the drawings, power of attorney, assignment and payment requirements have been met. If deficiencies are found, the applicant is notified of an official action where it is invited to correct the deficiencies within a two-month period. If no reply to the official action is received by the deadline, the application will be considered as abandoned. An application may be reinstated only if the applicant pays the reinstatement fee and corrects all deficiencies.

Examination

The examination covers all valid pending registration applications in Finland that have been filed before the filing date of the application, as well as the designs currently valid in the designs register and those removed from it. The examination does not cover registered Community designs or utility patents filed in Finland.

If no obstacles to registration are found in the examination and the design is not trivial, it will be published in the *Design Gazette*, published by the board. The applicant will not be notified of publication. If an obstacle is found, the applicant will be notified of an official action and given a period of two months to reply.

Deferred publication

The applicant may request that the application

be kept secret for a maximum period of six months from the filing date or the priority date (if claimed). The claim for secrecy must be made at the time of filing the application; a subsequent claim will be rejected.

Oppositions

There is a post-registration opposition procedure. The notice of opposition must be filed with the board within two months of the date of publication of the registration. A statement of grounds and representation of the design claimed as basis for the opposition must be submitted during the prescribed time period.

The entitlement to file oppositions is restricted to parties which consider themselves entitled to the design. Additionally, oppositions can be filed by those whose right is violated by the registration. However, these cases are restricted to designs that include, for example, a national flag, official stamp or stamp of inspection or guarantee. Also, opposition may be lodged by the applicant or owner of a conflicting right if the design includes, for example, a trademark.

Anyone has the right to file an opposition if the design is not new or does not have individual character, or if it is contrary to law and good policy. Anyone has the right to file an opposition if protection is sought for so-called technically determined parts and designs of interconnection.

If an opposition is filed against the design, the proprietor will be notified and given a period of two months to file its counterarguments. There is only one round of observations, after which the Design Rights Unit will rule on the basis of the evidence before it.

If a third party claims that it has a better right to the design, and if the matter is unclear, the Design Rights Unit may then invite the third party to initiate proceedings before the court at the risk of not taking the opposition into account during examination.

Appeals

If the application is rejected, the applicant may file a notice of appeal before the Market Court. The same applies to opposition proceedings, where the right to file an appeal rests with the party that is unsuccessful in the proceedings. Decisions of the Market Court may be appealed

to the Supreme Court, provided that it grants leave to appeal.

Registration

The design will be published and registered, provided that there are no obstacles to registration. There is no separate registration fee and the board will issue a registration certificate.

Renewals

Registration of a design is valid for five years from the filing date and may be renewed for four further five-year periods. Thus, the maximum term of protection is 25 years. If the design is a component part of a complex product and is used to restore the original appearance of the complex product, the maximum term of protection is nevertheless 15 years.

Renewal of design registration is possible without submitting a written application by paying the renewal fee into the board's bank account. The payment must indicate the name of the proprietor of the design registration and the registration number. The payer must also pay all bank costs, ensuring that the board receives the renewal fee in total.

On the other hand, if the registration details (eg, the proprietor's name) have changed, the renewal must be made by filing a written application. If the renewal application is filed by a representative, power of attorney must be filed.

The renewal fees can be paid one year before the expiration of a current period of registration. There is a grace period of six months after the expiry date within which the design registration can still be renewed, provided that an additional €50 fee is paid.

Removal from register

Withdrawal of the application is possible at any stage of the application procedure; there is no official fee for this. The proprietor may request the removal of the design from the register at any time, free of charge.

The court may also declare the design invalid, even though it is expired or renounced.

Enforcement

Significant reforms in the Finnish IP arena recently came into force. The Market Court – newly designated as the centralised forum for

all civil IP matters – is the first-instance court for design litigation. Decisions of the Market Court can be appealed to the Supreme Court, if the latter grants leave to appeal.

The proceedings commence by filing a written application for summons in which the applicant states its grounds, claims and evidence. The court will notify the defendant accordingly and invite it to file a response within a given deadline. It is up to the court to decide whether further observations will be granted to the parties.

In the next step, the court sets a date for a preliminary hearing, in which the parties present their claims, evidence and witnesses. The parties will be requested to settle the case; if this is not possible, the court will set a main hearing date.

In the main hearing, both parties have the opportunity to provide details of their written evidence and witnesses are heard. Both parties will also present their closing statement, including legal arguments and conclusions. The timetable for delivering decisions is not known at the time of writing.

Preliminary injunctions

If the infringement is evident, a preliminary injunction is granted. The court will not grant the preliminary injunction if it has any doubts or concerns regarding the application. It is a simple written procedure and the decision will remain in force until the main case has been decided or until the court revokes it. Preliminary injunctions are granted promptly, and in some exceptional cases even without hearing the respondent.

Remedies

Design infringements are usually decided as a civil dispute. In such cases, it is often difficult to prove the scope of damages and the court will have to estimate compensation that is justified according to the circumstances. Normally, the estimation is based on theoretical royalty fees and, in any case, it is up to the plaintiff to claim and prove reasonable compensation.

In criminal actions, the court will impose a fine or a prison sentence of up to two years, provided that the infringement was intentional and clear.

Ownership changes and rights transfers

A request for change of ownership or representative can be filed either together with the renewal request or separately at any time. There is an official fee for the request; only a change of address is free of charge. However, a change of domicile is liable to a charge.

An application for the recordal of licence, assignment or pledge will be recorded as long as the request meets the formal requirements. The licence may be exclusive or non-exclusive. If the application cannot be decided immediately, the board must note in the register that such a request has been received.

Related rights

There is an overlap between different IP rights, such as trademarks, copyright, patents and utility models.

The government appoints the Copyright Council for three years at a time to assist in copyright matters and to issue opinions on the application of the Copyright Act. The council is composed of representatives of major rights holders and users of protected works. Anyone can request an opinion from the council, regardless of whether it has personal interests at stake.

Three-dimensional trademarks protect the overall appearance of a product or its packaging. Therefore, the final product may contain parts that are covered by:

- a design registration (eg, the handle of a cup);
- a trademark registration (eg, the overall appearance of the cup); and
- copyright (eg, a decorative pattern that adorns the cup).

Thus, in many cases the final product is protected by several IP rights. [WTR](#)

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Asta Uhlbäck is a design and trademark attorney at Roschier Brands, Attorneys Ltd, acting as a coordinator of design protection matters.

Ms Uhlbäck specialises in intellectual property, with a particular focus on design protection. She advises clients and prepares opinions regarding the scope of protection and design validity to help them with their business decisions. These clients hail from a wide variety of industrial sectors, including large companies with a global reach.

Ms Uhlbäck previously worked as an examiner at the Office for Harmonisation in the Internal Market and as a member of the Opposition and Cancellation Division.