

Government Bill for a New Finnish Trademarks Act

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The Finnish Ministry of Economic Affairs and Employment appointed a working group two years ago with the intention of completely revising the Finnish Trademarks Act. The working group submitted its report to the Ministry on 19 March 2018. Now, on 18 October 2018, a Government bill was finally submitted to the Parliament. The new Trademark Act is intended to enter into force 1 January 2019.

The Government bill proposes to implement the revised EU Trademark Directive, to enforce the Singapore Treaty on the Law of Trademarks and to bring the present trademark regulation up to date. In addition, the Government bill includes amendments to related legislation such as the Finnish Company Names Act, the Criminal Code and relevant procedural acts. The new Trademarks Act will also result in the annulment of the current Finnish Act on Collective Marks since the provisions concerning collective marks and control marks will be included in the new Act.

Key amendments

Among the key amendments, an administrative procedure for the revocation and declaration of invalidity in addition to the current civil proceedings, will be introduced. This administrative procedure will largely correspond to the current opposition procedure. In order to avoid parallel administrative and civil proceedings the Government bill proposes that if a court proceeding concerning the same trademark is initiated between the same parties, proceedings at the Patent and Registration Office will be terminated.

The Government bill further proposes corresponding administrative procedures to deal with partial or total revocation of company names and auxiliary trade names in addition to the current court proceedings; however, such alternative administrative procedures would be limited to cases of non-use. Finnish companies with a broad (partly undefined) field of business frequently constitute a relative ground for refusal for national trademark registration despite operating in a totally different field since the Patent and Registration Office examines relative grounds for refusal *ex officio*. The presumably more efficient administrative procedures and possibility for partial revocation should at least partly help trademark owners to more easily overcome such hurdles relating to the cross protection between trademarks and trade names.

Further, trademark owners could henceforward invoke the five-year partial or total non-use of a claimant's trademark or trade name as a defence in opposition, revocation, or invalidation proceedings.

Other key amendments are the waiver of the graphical representation requirement, new classification rules, the introduction of an exclusive right of a Finnish trademark owner in situations where counterfeit goods are caught in transit (not put up for sale on the Finnish market, but caught while passing through) as well as the introduction of a clear provision criminalising infringement of EU trademarks (typically counterfeits); and also clear provisions criminalising infringement of EU designs.

Schedule for adaptation of the new classification provisions

Under the Government bill, owners of registrations filed before 1 October 2012, using the Nice class headings (or only class number if filed before 1996) shall specify their list of goods and services to ensure that they follow the new classification provisions by the renewal of the respective trademark registrations. (If the last date for renewal of a trademark is within six months after the law enters into force, such specification may be submitted by 1 July 2019). After said due date, class headings would, unless specified, embrace only those goods and services covered by the literal interpretation of said class headings. Trademark owners of registrations filed between 1 October 2012 and 31 December 2013 using class headings and a reference to the alphabetical list of the Nice classification may within the same time specify the goods and/or services on the alphabetical list. The main aim with this proposal is to make the trademark register clearer and more uniform.

The governmental bill can be found in Finnish [here](#). The new Trademarks Act and related legislation is intended to take effect on 1 January 2019.

Borenius' lawyers are available to assist in addressing any questions you may have regarding this legal alert. Please feel free to contact any of the Borenius' attorneys listed in this alert or those with whom you usually work.

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Åsa serves as a Vice President of the Finnish Association for Industrial Property Rights and she has been actively involved in the INTA Anti-Counterfeiting Committee and the Finnish Franchising Association. She has contributed to national and international publications in the field of intellectual property, advertising law, franchising and commercial contracts.

Åsa is regarded in various international publications as one of the leading legal experts in Finland in the field of intellectual property, trademarks, anti-counterfeiting, commercial contracts and franchising.

Åsa served as a member of a working group appointed by the Finnish Ministry of Economic Affairs and Employment to prepare the full revision of the Finnish Trademarks Act. The working group submitted its draft government proposal for a new Finnish Trademarks Act and for the partial revision of the Finnish Trade Names Act on 19 March 2018.