

FINLAND



by Pamela LÖNNQVIST, Sonja HEISKALA, Elisa HUUSKO,
Irmeli NOKKANEN, Janina TAHVANAINEN

2021 Study Question Q278

Industrial Designs and the Role of Prior Art

Questions

I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

References to a "design" below are to be read as referencing the intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture, irrespective of what it is called in your jurisdiction.

Note: If your answer(s) to Q1) to Q3) below is (are) the same as your answer(s) in reply to the 2016 Designs Study Question, you may simply refer to those answer(s).

- 1) a) Does your Group's current law provide for an intellectual property right (other than copyright, trademarks or trade dress), that specifically protects the outward appearance or ornamentation of an object or article of manufacture or other? Please answer YES or NO.

YES.

- b) If YES to Q1.a), please identify that law and explain what that right is called. (e.g., registered design, industrial design, design patent, etc.).

The Finnish Registered Designs Act (221/1971, as amended), which implements the EU Directive on the legal protection of designs (98/71/EC) refers to a "design right" ("mallioikeus" in Finnish and "mönsterrätt" in Swedish).

Finland is a member of the European Union, and thus, the Community Design Regulation (EC) No 6/2002 is also applicable in Finland. The Regulation refers to a "Community design", which includes both a "registered Community design" and an "unregistered Community design". This report will primarily focus on Finnish law.

- 2) Please identify what features of the outward appearance or ornamentation are taken into consideration for a design, e.g., shape/contour, surface, texture, color, etc.

A design is defined as 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 (Section 1a of the Finnish Registered Designs Act).

- 3) a) Is prior art used to assess requirements for protection of a design prior to registration/issuance of a design, i.e., during substantive examination by an Intellectual Property ("IP") Office? Please answer YES or NO.

YES (Finland).

If you have answered YES to Q3.a), please proceed to answer Q3.b). Otherwise, please proceed to Q4).

b) Referring to 03.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely

c) Referring to 03.a) to 03.b), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

The Finnish Registered Designs Act (221/1971, as amended), the Finnish Registered Designs Decree (252/1971), the Government Proposal HE 113/1970 regarding the Registered Designs Act, and the Government Proposal HE 6/2002 amending the relevant provisions of the act.

4) a) Is prior art used to assess requirements for protection of a design when validity of the design is contested in court or other post-registration/issuance venue?

Please answer YES or NO.

YES.

If you have answered YES to Q4.a), please proceed to answer Q4.b). Otherwise, please proceed to Q5).

b) Referring to Q4.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely

c) Referring to Q4.a) to Q4.b), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

The Finnish Registered Designs Act (221/1971, as amended), the Finnish Registered Designs Decree (252/1971), the Government Proposal HE 113/1970 regarding the act, and the Government Proposal HE 6/2002 amending the relevant provisions of the act.

5) a) Is prior art used to assess requirements for protection of a design with respect to infringement proceedings or other legal situations not addressed by Q3) and Q4)? Please answer YES or NO.

NO.

If you have answered YES to Q5.a), please proceed to answer Q5.b). Otherwise, please proceed to Q6).

b) Referring to Q5.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely

c) Referring to Q5.b), please indicate in which context these requirements for protection are taken into consideration, e.g., before a judge in infringement proceedings or other legal situations not addressed by Q3) and Q4).

d) Referring to Q5.a) to Q5.c), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

6) a) Do your national/regional laws or guidelines provide different definitions of prior art or indications of what qualifies as prior art for registration/issuance, validity, infringement, or other? Please answer YES or NO.

YES.

b) If YES to Q6.a), please briefly identify the differences, if not readily apparent from your responses to Q3) to Q5).

There are additional requirements regarding novelty and individual character for a design right of a component part of a complex.

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 (Section 2 of the Finnish Registered Designs Act)

Question 7)

a) What are recognized means of disclosure, i.e., which materials/documents, etc., can constitute prior art?

The Finnish law contains no exhaustive list of materials that can constitute prior art. Any kind of public disclosure can make the design known to the public, whether in tangible or intangible form.

According to the Finnish Registered Designs Decree, Section 13, the Finnish Patent and Registration Office shall take into account everything that it is aware of in the assessment of whether the conditions for registration of a design are met. With respect to novelty, the examination carried out by the Finnish Patent and Registration Office, shall include applications for national registered designs and international registrations under the Hague Agreement designating Finland that are pending with the Finnish Patent and Registration Office and that have been received before the filing date as well as designs that have been entered in or removed from the Register of Designs. The eligibility for registration of a design in relation to Sections 4, 4a and 4b of the Finnish Registered Designs Act shall be investigated to the extent necessitated by the substance of the design and without a substantial delay in the processing of the application.

According to the Registered Designs Decree, Section 14 in the case of conflict with an earlier application for registration of a design, the registering authority may defer the processing of the later application until a decision has been made with respect to the earlier application or until the earlier application becomes available to the public or until the conflict has ceased as the result of a change in the application.

The Finnish Patent and Registration Office complies with the EUIPN common communication on publications of designs on the Internet. (CP10 Common Practice – Criteria for assessing disclosure of designs on the internet of 1 April 2020, regarding the admissibility of evidence related to publication of prior designs. https://euipo.europa.eu/tunnel-web/secure/webdav/quest/document_library/News/cp10/CP10_en.pdf)

b) Does the prior art have to be “printed” and if so, what does that mean?

NO.

c) Does the prior art have to be “published” and if so, what does that mean?

NO. The prior art must have been made available to the public before the filing (or priority) date.

Unpublished prior design applications will be examined as prior art by the Finnish Patent and Registration Office. In case of such conflicting applications, the examination will be delayed until the prior unpublished design has been published or withdrawn.

The provisions concerning publication were amended to comply with the provisions of the EU Designs Directive 98/71/EC. A design would be deemed to have become public, if (a) published in the registration procedure, (b) otherwise or exhibited, (c) is used in the course of business, or (d) otherwise become public. The former absolute novelty requirement became relative when the Registered Designs Act was amended. A design does not become public unless the disclosure could reasonably have become to the attention of those who operate in EU, in connection with their normal business operations.

d) Have there been any recent updates or clarifications of prior art in your jurisdiction focused on intangible or other non-“printed” materials? Please provide those updates.

The Communication CP10 of EUIPN clarifies the disclosure related to electronic material available on the Internet. (See above (a))

Time of disclosure

Question 8)

a) What is the relevant date of a prior art reference?

The filing date or where priority is claimed, the priority date.

b) Are design applications published, and if so, when?

Finnish design applications become public on the filing date, unless deferred publication has been requested by the applicant. If the application is withdrawn during the 6-month deferment period, the application does not become public at all.

c) When and how are issued design patents or registered designs published?

The registered designs are published each month for opposition purposes in the official Design Gazette after the registration

National registered designs and international registrations under the Hague Agreement designating Finland are recorded in the Designs Register, which is a public register. The information is available via the Design Information Service at the Finnish Patent and Registration Office.

d) Does the publication of an issued design patent or registered design effect a publication of the underlying design application if not previously published?

NO. Design applications and the related file history are public from the filing date unless deferred publication has been requested. If deferment has been requested, the publication of a registered design will happen after the deferment time has ended.

Circumstances of disclosure

Question 9) Are the circumstances of disclosure relevant, e.g. (please tick all boxes that apply):

- geographic location
- type of location (e.g., during an exhibition)
- sector/type of products
- the person disclosing the prior art (e.g., the applicant of a design, a person bound by a confidential agreement, etc.)
- the recipient of the disclosed prior art
- other, namely

Grace period. See below.

Grace period

10) Does your jurisdiction provide a grace period after a first public disclosure of a design for later filing for protection of such design? Please answer YES or NO. If answering YES, please explain the conditions

(e.g., formal request, same applicant) and identify the length of time for the grace period (e.g., 6 or 12 months).

YES. There is a 12-month grace period before the filing (or priority) date for designs, which have been made available to the public by the designer or a third person as a result of information provided or action taken by the designer; or as a consequence of an abuse in relation to the designer.

Other

11) Please indicate any other relevant criteria of prior art.

See above Q6. In addition to novelty and individual character of product and geographical limitations, there are special rules regarding complex products. 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, (a) if the component part remains visible during normal use of the product (excluding maintenance, servicing or repair work); and (b) if the visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

The use of prior art when assessing the requirements for protection of a design

12)

a) Does one single prior art reference have to disclose all features of a design in order to prevent its validity?

NO.

b) Can a prior art reference that differs only in minor details from a design prevent finding validity? If YES, please indicate what does only in minor details mean (is it, e.g., in a non-substantive way)?

YES. Designs shall be deemed to be identical, if their features differ only in immaterial details.

c) Can a prior art reference that discloses the entire design with additional features prevent finding validity?

YES.

d) Can a combination of prior art references be used to disclose the features of a design in order to prevent its validity? If YES, is there a limit to the number of prior art references that can be combined?

YES. There is no pre-defined maximum limit to the number of prior art references that can be used. All features of each prior art reference must be taken into account (Market Court Decision No. 249/16). It is not possible to choose only a part of the features from a prior art reference and combine them with the features included in another prior art reference. All prior art references are examined as a whole, taking all their individual features into account.

e) Does the assessment of validity differ where there is numerous prior art or very few prior art available?

YES.

f) Does the assessment of validity differ with respect to designs for different industry sectors (e.g., textile design vs. GUI design)?

YES.

The influence of prior art on the infringement/scope of protection of a design

13) Does the assessment of infringement/scope of protection of a design differ where there is numerous prior art or very few prior art? Please refer to earlier response(s) where applicable.

YES.

II. Policy considerations and proposals for improvements of your Group's current law

14) Could any of the following aspects of your Group's current law relating to prior art be improved? If YES, please explain.

a) defining criteria of prior art

NO.

b) the use of prior art when assessing the requirements for protection of a design

NO.

c) the influence of prior art on the infringement/scope of protection of a design.

NO.

15) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

NO.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

16) Do you believe that there should be harmonisation in relation to the definition of prior art and/or the use of prior art when assessing the requirements for protection?

If YES, please respond to the following questions without regard to your Group's current law or practice.

YES. The Finnish Group would favour the introduction of an absolute novelty criteria globally without any territorial restrictions.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

17) a) Should prior art be used to assess requirements for protection of a design prior to registration/issuance, i.e., during substantive examination by an IP Office? Please answer YES or NO.

NO. The Finnish Group considers it important that designs are examined and registered quickly and in a cost-effective manner and prefers the current process for registering RCDs at the EU level, where prior designs are not examined ex-officio by the EUIPO.

The Finnish Patent and Registration Office examines prior national registered designs and international registrations under the Hague Agreement designating Finland but does not examine RCDs which are also in force in Finland, which makes the examination incomplete and not useful for the users.

However, the Finnish Group recognizes that the technological development may open up new reliable possibilities in the future to examine prior registered designs easily and in a cost-effective manner, which could be very useful for the users.

Unregistered designs cannot be covered by the examination.

If you have answered YES to Q17.a), please proceed to answer Q17.b). Otherwise, please proceed to Q18).

b) Referring to Q17.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely

18) a) Should prior art be used to assess requirements for protection of a design during determination of validity when validity of the design is contested in court or other post-registration/issuance venue? Please answer YES or NO.

YES.

If you have answered YES to Q18.a), please proceed to answer Q18.b). Otherwise, please proceed to Q19).

b) Referring to Q18.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely

19) a) Should prior art be used to assess requirements for protection of a design with respect to infringement proceedings or other legal situations not addressed by Q17 and Q18)? Please answer YES or NO.

YES (in the assessment of the scope of protection).

If you have answered YES to Q19.a), please proceed to answer Q19.b). Otherwise, please proceed to Q20).

b) Referring to Q19.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply.

- Novelty
- Originality
- Individual character
- Non-obviousness
- Inventive step
- Aesthetic
- Ornamental
- Other, namely the scope of protection.....

c) Referring to Q19.b), please indicate in which context these requirements for protection should be taken into consideration, e.g., before a judge in infringement proceedings or other legal situations not addressed by Q17) and Q18).

Assessment of the scope of protection in all legal situations.

Criteria of prior art

20) a) What should recognized means of disclosure be, i.e., which materials/documents, etc., can constitute prior art?

Any kind of disclosures of prior designs, whether in tangible or intangible format should be recognized.

b) Should the prior art have to be “printed” and if so, what should that mean?

NO, there should be no exhaustive list of prior art or requirement of “printed publications”. Prior art, whether in tangible or intangible form should be accepted.

c) Should the prior art have to be “published” and if so, what should that mean?

Prior art should be published or have become publicly available. Unpublished designs, which do not become public, are not prior art.

Time of disclosure

21) What should the relevant date of a prior art reference be?

Filing (or priority) date.

Circumstances of disclosure

22) What, if any, circumstances of disclosure should be relevant? Please tick all boxes that apply.

- geographic location
- type of location (e.g., during an exhibition)
- sector/type of products
- the person disclosing the prior art (e.g., the applicant of a design, a person bound by a confidential agreement, etc.)
- the recipient of the disclosed prior art
- other, namely conditions of grace period

Grace period

23 a) Should there be a grace period after a public disclosure of a design for later filing for protection of such design? Please answer YES or NO.

YES.

b) If the answer to Q23.a) is YES, please identify what the length of time for the grace period should be. Also, please explain what the conditions allowing for the benefit of the grace period should be (e.g., formal request, same applicant).

12 months. Same length globally.

Other

24) Should there be any other relevant criteria of prior art?

NO.

25) Should the assessment of prior art differ for the different requirements for protection mentioned in Q17)b), Q18)b) and Q19)b)?

NO.

The use of prior art when assessing the requirements for protection of a design

26) a) Should one single prior art reference have to disclose all features of a design in order to prevent its validity?

NO.

b) Should a prior art reference that differs only in minor details from a design prevent finding validity? If YES, please indicate what should only in minor details mean (is it, e.g., in a non-substantive way)?

YES.

c) Should a prior art reference that discloses the entire design with additional features prevent finding validity?

YES.

d) Should it be possible to contest the validity of a design on the ground of a combination of prior art references disclosing the features of a design? If YES, should there be a limit to the number of prior art references that can be combined?

YES. From a practical perspective, there should not be pre-fixed maximum limit of prior art references.

e) Should the assessment of validity differ where there is numerous prior art or very few prior art available?

YES. The number of prior designs ("product density" in Finnish "tuotetiheys") should be taken into account, as it has effect on the freedom of the designer.

f) Should the assessment of validity differ with respect to designs for different industry sectors (e.g., textile design vs. GUI design)?

YES. The freedom of the designer differs between different industry sectors.

The influence of prior art on the infringement/scope of protection of a design

27) Should the assessment of infringement/scope of protection of a design differ where there is numerous prior art or very few prior art? Please refer to earlier response(s) where applicable.

YES. See above Question 26. Moreover, the freedom of the designer should be taken into account in the assessment, as it defines the scope of protection.

28) Please comment on any additional issues concerning any aspect of industrial designs and the role of prior art you consider relevant to this Study Question.

NO.

29) Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

NO.