**Questions**

**I. Current law and practice**

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

1) a) May a descriptive use of a third party’s trade mark act as a defence to an allegation of trade mark infringement by that third party? Please answer YES or NO.

 YES

b) Are there specific statutory provisions in your law governing this defence? Please answer YES or NO.

 YES

c) If the answer to Q1)b) is YES, what does/do the statutory provision(s) state?

According to Section 8 of the Finnish Trademarks Act (544/2019), “[t]he sole right in a trademark shall not prevent another from using in the course of trade according to good business practices

2) a mark which describes the nature, quality, quantity, purpose of use, value or geographical origin, the manufacturing date of the goods, the date of performance of the services or another characteristic of the goods or services;

3) a mark which otherwise is devoid of distinctive character; …”

In case the complainant's legal ground is based on an EU trademark registration, the provisions of Article 14 of the EU Trademark Regulation (2017/1001) [the contents of the said article are in para 13 of these study guidelines] shall apply instead of the provisions above of the Finnish Trademarks Act.

*If you have answered NO to Q1)a), please skip Q2)-Q6) and proceed to Q7); If you have answered YES to Q1)a), please proceed to Q2).*

2) Is this defence only available as a defence in respect of word trade marks?

No. Article 14 of the EU Trademark Directive (2015/2436), which was implemented in Finnish law by the aforementioned Section 8 of the Finnish Trade Marks Act (544/2019), does not rule out any types of signs or indications.

3) Under what conditions may a descriptive use of a third party’s trade mark act as a defence to an allegation of trade mark infringement by that third party?

According to the Finnish Trade Mark Law, Section 8, exclusive right on a trade mark does not prevent third parties from using in business, according to the fair business practices, among others, marks that are descriptive in respect of the nature, quality, quantity, purpose of use, value or geographical origin, time of manufacture of goods, time of execution of services or other characteristics of goods or services (Section 8 (2)); or marks that are not otherwise distinctive (Section 8 (3)).

4) a) In order for the defence to succeed, must the use be "honest", "fair" or an equivalent thereof? Please answer YES or NO.

 YES

b) If the answer to Q4)a) is YES, what factors are taken into account when assessing this requirement? Please tick the boxes as applicable.

X the reputation of the invoked trade mark, however, this is not a stand-alone basis, but to be accounted together with other factors in the over-all assessment of the case

X the use affects the value of the invoked trade mark by taking unfair advantage of its distinctive character or reputation

X the use gives the impression that there is a commercial connection with the trade mark owner

X the use discredits or denigrates the invoked trade mark

X the product is presented as an imitation or replica of the product bearing the invoked trade mark

X the way the sign is used, namely whether the justified interests of the trade mark owner have been taken into account in a loyal manner

□ the party invoking the defence was aware of the invoked trade mark

□ other, namely ………………

5) What kind of evidence may be accepted to support the defence?

There is no general rule what kind of evidence may be accepted to support the defence. However, to successfully invoke the defence, the defendant may submit evidence on the use of the mark to demonstrate descriptive use of the mark that is subject to infringement claim. This may consist of the material that shows how the mark has been used, such as advertisements or other documents. To support the claim that the mark has been used in a descriptive way, the defendant also may submit evidence on use of the mark by third parties to demonstrate that similar use is considered descriptive use, and also others are referring to a said trademark in the same way. Such evidence can be for instance advertisements and other commercial documents, or news articles and other publications, blog postings and discussion threads. The evidence is taken into consideration as a whole by the court and is subject to a case-by-case analysis to determine whether the use has occurred in a descriptive manner.

6) In what types of proceedings concerning trade mark infringement can the defence be invoked? Please tick the boxes as applicable.

X court proceedings (civil)

□ court proceedings (administrative)

X court proceedings (criminal)

□ IP office

□ other, namely ………………

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

7) Could any of the following aspects of your Group's current law or practice relating to the descriptive use defence against an allegation of trade mark infringement be improved? If YES, please explain.

 NO.

a) whether a descriptive use of a third party’s trade mark can act as a defence to an allegation of trade mark infringement by that third party and if so, whether this applies only to word trade marks

b) under what conditions a descriptive use of a third party’s trade mark may act as a defence to an allegation of trade mark infringement by that third party

c) whether, in order for the defence to succeed, the use must be "honest", "fair" or an equivalent thereof

d) the kind of evidence that may be accepted to support the defence

e) the types of proceedings concerning trade mark infringement in which the defence can be invoked

8) 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?

Yes. It would be good for the trade mark owners to have some kind of possibilities to take actions / correct the use of their trade marks by third parties outside the course of trade (e.g. newspapers, blogs and similar). Such third party use may well affect the way in which descriptive use of the trade mark by competitors in the course of trade is ultimately assessed, but at the moment trade mark owners have only limited possibilities to take actions against use that does not take place in the course of trade. Of course, freedom of speech must be taken into account when policing trade marks outside the course of trade.

**III. Proposals for harmonization**

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

9) Do you believe that there should be harmonization in relation to the descriptive use defence against an allegation of trade mark infringement?

YES.

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

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

10) Should a descriptive use of a third party’s trade mark act as a defence to an allegation of trade mark infringement by that third party? Please answer YES or NO.

 YES.

11) Should this defence only be available as a defence in respect of word trade marks?

 NO. It should be available as a defence in respect of all kinds of marks.

12) Under what conditions should a descriptive use of a third party’s trade mark act as a defence to an allegation of trade mark infringement by that third party?

The use must be according to the fair business practices. In addition, marks that are descriptive in respect of the nature, quality, quantity, purpose of use, value or geographical origin, time of manufacture of goods, time of execution of services or other characteristics of goods or services; or marks that are not otherwise distinctive. The conditions should be assessed on a case-by-case basis.

13) a) In order for the defence to succeed, should the use be "honest", "fair" or an equivalent thereof? Please answer YES or NO.

 YES.

b) If the answer to Q13)a) is YES, what factors should be taken into account when assessing this requirement? Please tick the boxes as applicable.

X the reputation of the invoked trade mark, however, not a stand-alone basis, but to be accounted together with other factors in the over-all assessment of the case

X the use affects the value of the invoked trade mark by taking unfair advantage of its distinctive character or reputation

X the use gives the impression that there is a commercial connection with the trade mark owner

X the use discredits or denigrates the invoked trade mark

X the product is presented as an imitation or replica of the product bearing the invoked trade mark

□ the way the sign is used, namely, whether the justified interests of the trade mark owner have been taken into account in a loyal manner

□ the party invoking the defence was aware of the invoked trade mark

□ other, namely ……………… 8

14) What kind of evidence should be accepted to support the defence?

Any kind of evidence should be accepted to support the defence, and which the court deems acceptable. There should not be any pre-defined restrictions to submit legally obtained evidence.

15) In what types of proceedings concerning trade mark infringement should it be possible to invoke the defence? Please tick the boxes as applicable.

X court proceedings (civil)

□ court proceedings (administrative)

X court proceedings (criminal)

□ IP office

□ other, namely ………………