

## **DECREE ON UTILITY MODEL RIGHTS, 5.12.1991/1419**

### **Utility Model Applications and Record of Applications**

**Section 1** A utility model application consists of an application document and accompanying documents.

Unless otherwise provided, the provisions in this Decree concerning utility model applications shall only apply to:

- (1) Finnish utility model applications;
- (2) international utility model applications pursued in Finland under section 45d of the Act on Utility Model Rights or accepted for examination under section 38 of the Patents Act (No 550/67); and
- (3) European patent applications which have been converted into national utility model applications in accordance with section 8 or 8 a of the Act on Utility Model Rights (800/1991).

**Section 2** The application document must be signed by the applicant or their representative, and it must comprise:

- 1) the name, domicile and address of the applicant and, if the applicant has appointed a representative, the name, domicile and address of the representative;
- 2) the name and address of the inventor;
- 3) a concise and factual title for the invention to which the utility model application relates;
- 4) information as to whether priority in accordance with section 5 of the Act on Utility Model Rights is claimed;
- 5) if several persons jointly apply for registration of a utility model, a statement as to which of them is entitled or, if the applicants have appointed a representative, whom they have jointly authorised to receive communications from the Registering Authority on behalf of them all;
- 6) a statement as to whether the applicant requests for an examination under section 12 of the Act on Utility Model Rights;
- 7) Paragraph 7 has been repealed by Decree 6.11.2008/701.
- 8) where the application includes the deposit of biological material, a statement corresponding to the statement referred to in section 17 b of the Patents Decree (669/1980); and
- 9) a list of the documents accompanying the application document.

**Section 3** The following documents shall accompany the application document:

- 1) a description of the invention together with a picture or pictures to illustrate the invention, and one or more claims;
- 2) if the applicant has appointed a representative, a proof of authorisation;
- 3) if the invention has been made by someone else than the applicant, a statement justifying the applicant's right to the invention; and
- 4) Paragraph 3 has been repealed by Decree 6.11.2008/701.
- 5) where an examination under section 12 of the Act on Utility Model Rights has been requested, a receipt for the payment of the examination fee.

**Section 4** If the document is not written in one of the languages laid down by the first paragraph of section 7 of the Act on Utility Model Rights, the applicant must also submit to

the Registering Authority a translation of the document into Finnish or Swedish. For a document other than a description or claim, the Registering Authority may waive the requirement for a translation or may accept a translation into a language other than Finnish or Swedish.

**Section 5** Where a utility model application is made in accordance with section 8 of the Act on Utility Model Rights by converting from a patent application or a European patent application, the applicant must in connection with the application state the date when the patent application or the European patent application forming the basis of the application was made or is deemed to have been made, and the number of the application. Copies of documents required, excluding copies of the description, claims, and pictures, are transferred ex officio from the patent application to a utility model application of this kind. When a European patent application is converted into a utility model application, the applicant must submit all documents relating to the application.

A request for the postponement of registration under section 18 of the Act on Utility Model Rights shall be filed in connection with the filing of the utility model application, or within two months from the filing date.

**Section 5a** The provisions of sections 52 r and 52 s of the Patents Decree shall apply mutatis mutandis to the conversion of a European patent application into a national utility model application under section 8 a of the Act on Utility Model Rights. The provisions of section 7(2) of the Act on Utility Model Rights shall apply to the application fee.

**Section 6** The Registering Authority shall enter the application number and the filing date on the utility model application.

#### **Section 7**

Section 7 has been repealed by Decree 27.10.2011/1099.

**Section 8** Where notice is given to the Registering Authority that an invention for which a utility model right has been sought has been assigned to another person, the latter person shall be recorded as the applicant in the record of applications only if proof of the assignment is furnished.

#### **Priority**

**Section 9** To enjoy priority under section 5 of the Act on Utility Model Rights, the applicant must claim priority in the application filed in Finland and therein state where and when the application given as a basis for the priority was filed and, as soon as possible, its serial number. If the application is made through conversion under section 8 or 8 a of the Act on Utility Model Rights, the priority claim shall apply without a separate request also to the new application resulting from conversion.

**Section 10** The Registering Authority may through an office action request the applicant to prove the claimed priority by submitting, within the prescribed time limit, a certificate issued by the authority which received the application forming the basis for the priority, stating the filing date of the application and the applicant's name, as well as a copy of the application

certified by that authority. The copy must be filed in the form prescribed by the Registering Authority.

**Section 11** Priority may only be based on the first application in which the invention was disclosed.

If the person who filed the first application or his successor in title has filed a subsequent application with the same authority, relating to the same invention, the subsequent application may be cited as a basis for priority, provided that at the time of filing of the later application the earlier application was withdrawn, dismissed, or rejected without having become available to the public and without there being any rights subsisting, and had not served as a basis for priority. Where priority has been obtained on the basis of the subsequent application, the prior application may no longer serve as a basis for claiming priority.

**Section 12** An application may claim priority deriving from several earlier applications even where they have been filed in different countries.

## **Claim**

**Section 13** The claim must contain:

- 1) the title of the invention;
- 2) a statement identifying the art in relation to which the invention is new (prior art), where necessary; and
- 3) a statement of the new and characteristic features of the invention.

A utility model application may incorporate more than one claim. If an application includes more than one claim, they shall be arranged and numbered consecutively.

Each claim may relate to one invention only.

Where a utility model application contains several inventions, they shall be interdependent. In this case there shall be a technical connection between all of the inventions in that they have, in whole or in part, the same or similar special technical characteristic. The term special technical characteristic shall mean the technical feature contributed by each single invention going, in considering the invention as a whole, beyond the state of the art.

The question whether the inventions share a technical characteristic shall be determined irrespective of whether they are stated in separate patent claims or as alternatives in a single claim.

A claim may not contain any matter irrelevant to the invention disclosed therein or irrelevant to the exclusive right claimed by the applicant.

## **Description**

**Section 14** The description may contain only subject matter that assists in understanding the invention. Where a newly-coined word or a technical term that is not generally accepted has to be used, such term shall be explained. The designations and units of measurement may not depart from those in general use in Finland.

If the invention relates to biological material or involves the use of biological material when being carried out, and a sample of the biological material must be deposited under section 6(2) of the Act on Utility Model Rights, the applicant must in the application documents give all relevant information that are available to them regarding the characteristics of the material. The Registering Authority must be notified of the deposit. The provisions of section 17 a, section 17b(3) and (4), section 17 c and sections 25 a, 25 c and 25 d of the Patents Decree concerning the deposit of biological material, shall apply mutatis mutandis to the deposit of biological material relating to a utility model application.

## **Pictures**

**Section 15** By a picture is meant a drawing, a photograph or similar. The pictures must be so accurate as to clearly disclose the object for which protection is sought. The pictures must be in black and white and reproducible. They may not exceed the size of an A4 sheet.

## **Amendments to utility model applications**

**Section 16** Claims may not be amended to include subject matter not disclosed in the original utility model application. Where a claim is amended to add new features, the applicant must at the same time state where those new features are to be found in the basic document.

If more than one invention has been disclosed in the basic documents, the applicant may divide the application into more than one application. A new application resulting from division may not encompass subject matter that was not disclosed in the original application.

Where an application is divided because it contains more than one mutually independent invention and there is no technical connection between the inventions, the new application shall only be considered to have been filed at the same date as the original application if the new application has been filed no later than two months after the reduction of the original application.

## **Utility Model Register**

**Section 17** A utility model is recorded in the Utility Model Register if it meets the requirements set out in section 1 (2–4) and sections 6–12 of the Act on Utility Model Rights.

The following details shall be recorded in the register:

- 1) the serial number in the record of applications of the application, the registration number of the utility model and the classes according to the International Patent Classification to which the utility model is assigned;
- 2) the name, domicile and address of the proprietor of the utility model;
- 3) where the proprietor of the utility model has appointed a representative, the name, domicile and address of the representative;
- 4) the name and address of the inventor;
- 5) the following dates:
  - a) the filing date of the application;
  - b) if the utility model application results from conversion of a patent application in accordance with section 8 of the Act on Utility Model Rights, the filing date of the patent

application;

c) if the application is an international application, the international filing date and the date when the application was pursued in accordance with section 45 d of the Act on Utility Model Rights, or the date when the application was filed under section 38 of the Patents Act, and the international application number;

d) if the application has been converted from a European patent application into a national application under section 8 or 8 a of the Act on Utility Model Rights, the filing date in accordance with the European Patent Convention and the date when the application was filed with the Registering Authority for conversion, and the serial number of the European patent application;

e) the date on which the application documents have been made available to the public;

f) the date of registration of the utility model;

6) priority, where claimed, together with an indication of the country where the application given as the basis for priority was filed, the filing date of that application and its serial number;

7) if the application results from division, the serial number of the parent application;

8) a statement as to whether the application has been the subject of an examination under section 12 of the Act on Utility Model Rights;

9) if the invention relates to biological material or involves the use of biological material when being carried out, a statement as to whether a sample of the biological material has been deposited; and

10) the title and picture of the invention.

**Section 17 a** When a utility model has become public, the Registration Authority shall publish a claim publication under section 17(2) of the Act on Utility Model Rights.

The claim publication includes the first claim, and a picture, if any. It also includes the following details:

1) the application's serial number in the record of applications, the registration number and the classes;

2) the name and address of the proprietor of the utility model;

3) the name, domicile (registered office) and address of the representative, if any;

4) the name of the inventor;

5) the title of the invention;

6) the date of receipt and the date of filing of the application;

7) if the application is made by converting from a patent application in accordance with section 8 of the Act on Utility Model Rights, the filing date of such application;

8) if the application is made by converting from a European patent application in accordance with section 8 and 8 a of the Act on Utility Model Rights, the filing date in accordance with the European Patent Convention and the date when the application was filed with the

Registering Authority for conversion, and the serial number of the European patent application;

9) if the application is an international application, the international filing date and the date when the application was pursued in accordance with section 45 d of the Act on Utility Model Rights, or the date when the application was filed under section 38 of the Patents Act, and the international application number;

10) the date when the application documents have been made available to the public;

11) the date of registration of the utility model;

12) claimed priority together with an indication of the country where the application given as the basis for priority was filed, the filing date of that application and its serial number;

13) if the application results from division, the serial number of the parent application;

14) a statement as to whether the application has been the subject of an examination under section 12 of the Act on Utility Model Rights; and

15) if the application involves deposit of biological material, an indication of the institution where the deposit is placed, as well as the number given to the deposit by the institution.

The claim publication referred to in section 21(2) of the Act on Utility Model Rights must include, besides the details mentioned in subsection 2, the date when the Registering Authority has taken a final decision on partial invalidation.

**Section 18** The public notice under section 17 of the Act on Utility Model Rights concerning the registration of a utility model must give the serial number and the classification according to the International Patent Classification of the utility model, the title and picture or pictures of the invention, where necessary, the name of the proprietor of the utility model and the serial number of the application, and a statement as to whether the application has been the subject of an examination under section 12 of the said Act.

**Section 19** Any claim made to the Registering Authority to have the registration of a utility model declared invalid or any notification made to the Registering Authority that a person has taken legal action to have a utility model right transferred or to obtain a compulsory license shall be recorded in the Utility Model Register.

When a copy of the decision in a matter has been sent to the Registering Authority in accordance with Chapter 4, section 23, of the Act on the Judicial Proceedings at the Market Court (100/2013) or section 44 c of the Act on Utility Model Rights, or when the Registering Authority has taken a decision in a case referred to in subsection 1 concerning a claim to have a registration declared invalid, this fact shall be recorded in the Utility Model Register. Once the decision has become final, an entry shall be made in the Register in such a way that the main content of the decision is apparent.

**Section 20** Entries under section 28 and 29 of the Act on Utility Model Rights shall include the name, domicile and address of the proprietor of the right and the date of the transfer or

grant of the license or pledging. In the case of a license, it shall be stated, on request, whether the right of the proprietor of the utility model right to grant additional licenses has been limited.

Where it is not possible to take an immediate decision on the question of recording, an entry shall nevertheless be made in the register that a request has been made.

The provisions of the preceding paragraph 1 shall correspondingly apply to the recording of a compulsory license and a right under section 1 of the Act on Utility Model Rights.

**Section 21** Seizure of a utility model right to cover a debt shall be recorded in the register when reported.

Any change reported in respect of a representative shall also be recorded in the register.

**Section 22** If the proprietor of a utility model right, in accordance with the first paragraph of section 33 of the Act on Utility Model Rights, states that he waives the registration of his utility model and if a license on this model is recorded in the register, the holder of the license shall be notified thereof and a reasonable period of time shall be reserved for him to assert his right in the case before the utility model is deleted from the register.

**Section 23** The renewal of a registration shall be recorded in the Utility Model Register.

A public notice regarding a renewal shall state the serial number of the utility model, the date on which the renewed term of protection begins and the name and address of the proprietor of the utility model right.

**Section 24** Once a registration has lapsed, the Registering Authority shall remove the utility model from the register.

Once the utility model has been removed from the register or the utility model right by a final court decision has been assigned to another person, the Registering Authority shall give a public notice thereof.

### **Examination by the Registering Authority**

**Section 24a** In examining an invention in accordance with the third paragraph of section 12 of the Act on Utility Model Rights, the Registering Authority shall consider all facts that come to its attention. The examination at the Registering Authority shall be carried out on the basis of publicly available utility model or industrial design applications from Finland and of patent specifications, published specifications and publicly available international applications from Finland, Norway, Sweden, Denmark, the United States of America, the United Kingdom, France, Germany, and the European Patent Office. Other available publications may also be examined if found necessary. The Registering Authority shall notify of the result of the examination and issue a statement thereof where such statement specifically has been requested for.

## **Receiving Office for International Applications**

**Section 24b** The Finnish Patent and Registration Office shall be the receiving Office for international patent applications where the applicant or one of the applicants is a national of Finland, a natural person domiciled in Finland, a legal entity constituted according to Finnish law or anyone who carries on business in Finland.

The provisions of sections 46 to 51 and 51a of the Patents Decree shall apply mutatis mutandis to the receiving of international utility model applications at the Authority. The provisions of sections 52 and 52a to 52c shall mutatis mutandis apply to the pursuing of international utility model applications designating Finland.

## **Miscellaneous provisions**

**Section 25** A utility model application shall be classified according to the International Patent Classification system.

**Section 26** Public notices in respect of utility models shall be given in a publication issued by the Registering Authority.

## **Entry into Force**

**Section 27** This Decree shall enter into force on January 1, 1992.