

7. ECTA Articles



THE MYSTERY OF ART. 8 (4) EU TRADE MARK REGULATION – A GUIDE THROUGH MEMBER STATES

Non-Registered Rights under Article 8 (4): Lessons from Finnish Case Law



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NON-REGISTERED TRADE MARKS

Among the rights based on Finnish law that may be invoked under Art. 8 (4) EUTMR, non-registered trade marks are most commonly relied upon. According to Section 4 of the Finnish Trade Marks Act (544/2019), exclusive rights to a trade mark may be acquired without registration if the trade mark has become established. Establishment requires that the trade mark is generally recognised in Finland by the relevant public as the sign of the proprietor's goods or services. In

practice, however, establishing a trade mark can take years, even decades, and proving establishment is not easy. The evidentiary threshold is high, as illustrated by the following cases.

In its decision MAO 280/2024, the Market Court held that the OSHEE word mark, figurative mark **OSHEE**, and the appearance of the product packaging had not become established in Finland. Although Oshee Polska submitted extensive evidence of use (including sales figures, advertising, collaborations, and market surveys), a substantial part of the evidence related to a period after the competing ONSE marks had entered the market and therefore did not cover the relevant time period. Furthermore, some of the material did not specifically concern Finland nor did demonstrate the actual visibility of the advertising to the Finnish target public. As regards the figurative marks, the Court emphasized that their use in Finland had been limited in volume, for a relatively short duration, and in part had already ceased before the relevant point in time. With respect to both the word mark and the figurative marks, the evidence did not show that a significant proportion of Finnish average consumers had come to perceive the mark as an indication of commercial origin. Concerning the product packaging, the threshold for establishment was particularly high, and consumers were not found to perceive the bottle's shape and appearance as an indicator of origin.

FINNISH LEGISLATION ALLOWS INVOCATION OF NON-REGISTERED TRADE MARKS AND COMPANY NAMES IN CONJUNCTION WITH ART. 8 (4) EUTMR. HOWEVER, RELYING SOLELY ON NON-REGISTERED TRADE MARKS OR COMPANY NAMES IS A RISKY STRATEGY.

7. ECTA Articles



Therefore, the submitted evidence was insufficient to demonstrate that exclusive rights to the trade marks were established at the relevant time.

In MAO 211/2023, the Market Court assessed whether Kesko Oyj, one of the largest grocery sector operators in Finland, had acquired exclusive rights to the K word mark through establishment for retail services for daily consumer goods and consumer products in class 35. Although Kesko submitted extensive evidence relating to the letter K, the Court found that the K mark had been used in connection with other Kesko trade marks (such as K-Market, K-Rauta and K-Citymarket). As the evidence did not show that the letter K was recognised independently as a trade mark for the services, the Court held that the mark had not become established as a trade mark for retail services for daily consumer goods and consumer products.

In MAO 1/22, it was found that while the DRACULA marks had been used in Finland for confectionery for a long time and on a wide scale, the evidence did not show that the relevant target public would associate the trade marks specifically with the relevant companies in a manner enabling the marks to distinguish their goods from those of others. For this reason, the marks were not considered to have become established

within the meaning of the Trade Marks Act. Therefore, there not only has to be extensive evidence of the use of the mark, but the evidence must relate to a relevant period of time and must also demonstrate that the recognition of the mark is linked to the proprietor. While Finnish law does allow for the acquisition of exclusive rights to a trade mark through establishment, it is clear that the bar is high.

COMPANY NAMES

Finnish law also allows company names to be invoked under Art. 8 (4) EUTMR. According to Section 13(4) of the Trade Marks Act, a trade mark may not be registered if it creates a likelihood of confusion on the part of the public with an earlier company name. Exclusive rights to a company name may be obtained either through registration in the Trade Register or establishment. Establishment requires the use of a certain name for a long period of time and to such an extent that it is commonly associated with a certain business.

For a likelihood of confusion to arise between a trade mark application and an earlier company name, the line of business of the owner of the registered company name must be similar to the goods or services covered by the later mark. When relying on a non-registered company name, for demonstrating

a likelihood of confusion, the name must be well-established and well-known, and the use of a similar trade mark must constitute an inappropriate exploitation or dilution of the goodwill of the company name.

In opposition No. B 2564535 against EU trade mark No. 14403976 *talentum*, the opposition succeeded based on an earlier EU trade mark No. 2341535 TALENTUM and a prior Finnish company name TALENTUM. The opponent submitted evidence, such as annual reports, press materials, and invoices that provided sufficient information concerning the commercial volume of use of the prior company name, particularly due to the opponent's market share in the Finnish publishing sector.

CONCLUSION

While Finnish law allows invocation of non-registered trade marks and company names, the evidentiary threshold is high. Case law shows that long-term use and market presence alone are insufficient unless supported by evidence that the mark is recognised as an indicator of origin for the proprietor's goods or services during the relevant period. Relying solely on non-registered rights is therefore risky, and companies without registered rights should ensure they can provide robust, objective evidence to support their claims.

