



FINNISH PATENT AND
REGISTRATION OFFICE

Int.reg. 1482770

**THE PROTOCOL RELATING TO THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

EX OFFICIO PROVISIONAL TOTAL REFUSAL

notified to the International Bureau of the World Intellectual Property Organization (WIPO) according to
Art. 5 of the Madrid Protocol

I. Office refusing protection:

**Finnish Patent and Registration Office
Trademarks
FI-00091 PRH
Telephone: +358-29-509 5000
Telefax: +358-29-509 5328**

II. Number of the international registration which is the subject of the refusal: 1482770

III. Other information concerning the international registration which is subject of the refusal: MAKE SMOKING
HISTORY
(word mark).

IV. The grounds for this refusal are the following:

The mark is not distinctive as it indicates the intended use of the goods in question in class 34. The mark is merely understood as an implication that the goods are intended for quitting smoking. The phrase is not understood as a mark indicating the commercial origin of the goods and the mark is therefore not likely to distinguish the goods of the holder from those of others.

V. Provisions of the Finnish Trademarks Act applicable on the subject (enclosed):

Art. 12

VI. Total refusal.

VII. The holder of the registration may request a review of the refusal. The request shall be received by the Finnish Patent and Registration Office no later than within 2 months from the date of the refusal. **The time limit expires 09.12.2019 (dd.mm.yyyy).**

Please use the following reference number when submitting the request: W201900843
The request can be submitted through our electronic service at <https://epalvelut.prh.fi/tmposti>.
The request is to be drawn up in Finnish or Swedish. If the holder of the international registration is not a resident of the European Economic Area, the request has to be filed through the intermediary of a

representative resident in the European Economic Area (Art. 28 paragraph 6).

If the holder of the registration has not within the time limit given above requested for the review, the registration shall not take effect in Finland for the goods/services which are affected by the refusal (Art. 92 paragraph 4).

If the holder of the international registration has failed to submit a response to the refusal by the time limit, the holder may ask for a continued processing of the registration. The request for continued processing has to be filed within two months from the time limit. Within those 2 months the holder must also pay a fee of 100 € and submit arguments for overcoming the obstacles reported in the refusal (Art. 22).

If the grounds for this refusal include EU trademarks, EU trademark applications or international registrations designating Finland or the European Union, they can remain as grounds for refusal also in cases where they are transformed into national applications or, specifically in the case of designations concerning the European Union, the designations are transformed either into designations concerning Finland or into EU trademark applications, and the said applications or designations are ultimately accepted.

Please note that if the designation is accepted subsequent to reviewal or appeal an opposition may be filed against the mark within 2 months of the publication of the mark (Art. 32).

Oppositions may be filed after the end of the 18-month period (Art. 5(2)(c)(i) of the Madrid Protocol, Rule 16(1) of the Common Regulations).

VIII. Date on which the refusal was pronounced: 09.10.2019 (dd.mm.yyyy)

IX. Signature of the Office: 09.10.2019 Finnish Patent and Registration Office

Sara Henriksson
Legal Officer
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This document has been electronically signed.

Extract from the Finnish Trademarks Act (544/2019)
(Unofficial translation)

Article 11

Signs of which a trade mark may consist

Any sign may be registered as a trade mark when:

- 1) it is capable in trade of distinguishing the goods or services of the proprietor of the trade mark from those of other parties; and
- 2) it is capable of being represented on the Register of Trademarks in a manner which enables the authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

The following shall be considered to be devoid of distinctive character:

- 1) trade marks that may describe the kind, quality, quantity, intended purpose, value or geographical origin of goods or services, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
- 2) trade marks which have become a generic name in trade for the good or service; or
- 3) trade marks which cannot in other respects be used to distinguish the goods or services of the proprietor of the trade mark from those of another party.

Exclusive rights also to a sign other than referred to in paragraph 1 may be obtained through establishment.

Even on the basis of establishment, a trade mark may not consist of a sign which consists exclusively of a shape or another characteristic that:

- 1) results from the nature of the good or service;
- 2) is necessary to obtain a technical result; or
- 3) gives substantial value to the good or service.

Article 12

Absolute grounds for refusal and invalidity

A trade mark shall not be registered or, if registered, shall be invalidated if:

- 1) trade marks which are not capable of being represented on the Register of Trademarks in the manner laid down in article 11, paragraph 1, item 2;
- 2) trade marks which cannot constitute a trade mark under article 11, paragraph 4;
- 3) trade marks which are devoid of any distinctive character as provided in article 11, paragraph 1, item 1, and article 11, paragraph 2;
- 4) trade marks which are contrary to law, public policy or accepted principles of morality;
- 5) trade marks which are of such a nature as to deceive the public;
- 6) trade marks which, without proper consent, include a state escutcheon, state flag or other state emblem, the escutcheon of a Finnish municipality, or the flag, escutcheon or other badge or emblem of an international intergovernmental organisation, or some other protected badge based on an international treaty that is binding on Finland;
- 7) trade marks which, without the proper consent, include an official certification or guarantee mark, or official sign or hallmark, for goods for which the mark is to be registered or for goods similar to them;
- 8) trade marks which, without the proper consent, include something, the inclusion of which in the mark may cause a risk of the public confusing the trade mark with the sign, flag, escutcheon, badge, emblem or hallmark referred to in items 6 or 7;
- 9) trade marks which are excluded from registration in Finland or in the European Union pursuant to a provision concerning protection of designations of origin and geographical indications, traditional terms for wine, or traditional specialities guaranteed;
- 10) trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination protected in Finland or in the European Union, and the goods or services covered by the trade mark application or trade mark registration are of the same or closely related species with the plant variety;
- 11) trade marks for which an earlier collective mark application or collective mark registration concerning the identical sign already exists in the Register of Trademarks for identical goods or services;
- 12) trade marks for which an earlier certification mark application or certification mark registration concerning the identical sign already exists in the Register of Trademarks for identical goods or services or such a certification mark registration, the validity of which has expired due to lack of renewal, has existed in the Register of Trademarks.

A trade mark shall also be invalidated when the application for registration of the trade mark was filed in bad faith by the proprietor of the trade mark.

The registration of a trade mark may not be foregone pursuant to paragraph 1, item 3 when the trade mark, prior to the date of filing, has acquired a distinctive character in use among its relevant class of persons as the sign of the goods or services of the applicant for the trade mark. A trade mark may not be invalidated pursuant to paragraph 1, item 3 when the trade mark, prior to the date of filing of an application or action for invalidation, has acquired a distinctive character in use in a corresponding manner.

Article 13

Relative grounds for refusal and invalidation

A trade mark may not be registered or, if registered, shall be invalidated if:

- 1) the trade mark is identical with an earlier trade mark that has been registered or become established for identical goods or services;
- 2) the trade mark causes a likelihood of confusion on the part of the public because of its identity with, or similarity to, the earlier trade mark that has been registered or become established for identical or similar goods or services;
- 3) the trade mark is identical with or similar to an earlier trade mark that has a reputation in Finland or in the European Union regardless of whether used for identical or similar goods or services if:
 - a) the use of the trade mark without due cause would take unfair advantage of the distinctive character or the repute of the trade mark that has a reputation; or
 - b) the use of the trade mark without due cause would be detrimental to the distinctive character or the repute of the trade mark that has a reputation;
- 4) the trade mark creates a likelihood of confusion on the part of the public with an earlier protected company name, auxiliary company name, translation of company name or secondary symbol of another trader:
 - a) whose line of business is identical with or similar to the goods or services included in the list of goods or services;
 - b) who is very well established and well-known, and the use of a similar trade mark would constitute improper exploitation of the goodwill associated with the company name; or
 - c) who is established and, relative to the particular nature of the activities, the use of a similar trade mark would be liable to diminish the goodwill associated with the company name;
- 5) the use of the trademark would infringe an earlier copyright as referred to in article 1 of the Copyright Act (404/1961) or an earlier right to control a photographic picture as referred to in article 49a of the Copyright Act;
- 6) the use of the trade mark would infringe the earlier design right of another;
- 7) the trade mark is likely to give the impression that it is the name or likeness of another person, unless the name or likeness is evidently that of someone deceased a long time ago;
- 8) the agent of the proprietor of the trade mark applies for registration of the trade mark in its own name without the consent of the proprietor, unless there is a proper reason for the registration;
- 9) an application for a designation of origin or a geographical indication under the legislation of Finland or the European Union has been submitted prior to the date of filing or the date of priority of the trade mark, provided that the said designation or indication is subsequently registered and the registration confers the right to prohibit the use of the later trade mark.

A trade mark shall also not be registered when the trade mark is liable to be confused with an earlier trade mark protected abroad, provided that the application for registration was submitted in bad faith by the applicant.

Earlier trade mark within the meaning of paragraph 1, items 1–2 means:

- 1) a national trade mark or application for a trade mark with an earlier date of filing or otherwise with an earlier priority;
- 2) a trade mark that has become established at the date of filing or date of priority;
- 3) an EU trade mark or application for an EU trade mark with an earlier date of filing or otherwise with an earlier priority;
- 4) an EU trade mark that has the seniority provided in Article 39 or 40 of the EU Trade Mark Regulation over a national trademark or over an international registration designating Finland; or
- 5) an international registration designating Finland or the European Union with a prior date of registration or date of filing of extension request or otherwise with an earlier priority.

Notwithstanding the provisions of paragraph 1, items 1–8 and paragraph 2, a trade mark may be registered with the consent of the person whose right is concerned. A trade mark shall not be invalidated pursuant to paragraph 1, items 1–9 when the person whose right is concerned has given consent.

Article 22

Continued processing of an application

If an applicant within the time period imposed for remedying a deficiency, submitting a statement and providing information fails to submit a statement, provide the information or remedy the deficiency, the processing of the application shall nonetheless be continued when the applicant, within two months of the expiry of the time period imposed:

- 1) requests continued processing of the application;
- 2) in the context of the request submits the statement, provides the information or remedies the deficiencies; and
- 3) in the context of the request pays the fee imposed for continued processing of application.

Article 28 paragraph 6

Agents

The proprietor of an international registration who is not domiciled in the European Economic Area who wishes to submit a statement to the Finnish Patent and Registration Office shall use for this purpose an agent who is domiciled in the European Economic Area.

Article 32**Filing of opposition**

Opposition shall be filed within two months of the publication of the registration by notifying the Finnish Patent and Registration Office in writing of the identification information of the opponent, details of the registration and the goods or services covered by the registration against which the opposition is directed, and the grounds for the opposition, and by paying the opposition fee.

Opposition may be directed at all or some of the goods or services for which the trade mark has been registered. When the opposition is based on a prior right, the opponent shall be the proprietor of that right.

Article 92 paragraph 4**Examination of an international registration**

If the proprietor of the international registration fails to submit a response within the deadline imposed, the international registration shall not take effect in Finland in respect of the parts pointed out in the notification.