

Denmark

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1. Legal framework

National

National legal protection is primarily regulated by the Trademarks Act 2001, based on the EU First Trademark Directive (89/104/EEC). The Trademarks Act was amended in December 2005 to implement Directive 2004/48/EC on the civil enforcement of IP rights. The other domestic laws regulating trademark protection are:

- the Marketing Practices Act, amended December 2005;
- the Designs Act 2000, amended December 2005;
- the Anti-counterfeiting Act (implementing EU Council Regulation 1383/2003 on Customs measures);
- the Companies Act 2004;
- the Personal Names Act of 1981, as subsequently amended; and
- Chapters 57 and 57a of the Administration of Justice Act, amended 2005.

International

By virtue of Denmark's membership of the European Union, the EU Community Trademark Regulation (40/94) and the First Trademark Directive apply in Denmark.

In addition, Denmark has ratified the following international treaties:

- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Paris Convention for the Protection of Industrial Property Rights;
- the Nice Agreement; and
- the Madrid Protocol on the International Registration of Marks.

2. Unregistered marks

Protection

Trademark rights can arise from practical use in

Denmark or from registration. The owner of an unregistered trademark enjoys the same legal protection as the owner of a registered mark, as long as the unregistered mark meets the requirements for distinctiveness.

Use requirements

Unregistered marks are protected by the Trademarks Act and the Marketing Practices Act. Neither requires a specific scope or intensity of use, but the use must be constant and the public must have gained knowledge of the mark through the owner's marketing activity. The precise extent of use and acquired distinctiveness required for a trademark to obtain protection is decided on a case-by-case basis.

3. Registered marks

Ownership

The legal basis for registration and ownership of trademarks is regulated by the Trademarks Act. Any natural person or legal entity can apply for and own a trademark, but the mark has to be used commercially. The mark owner has the exclusive right to use or to give others permission to use the trademark. Examination and registration of the trademark application are carried out by the Danish Patent and Trademarks Office (PTO).

Scope of protection

Protected: Pursuant to the Trademarks Act, a trademark may consist of any type of sign that is:

- capable of distinguishing the goods or services to which it applies from those of others; and
- capable of being represented graphically.

Hence, common words and symbols are not protectable.

A registrable trademark falls under one of the following categories:

- words and/or word combinations, including slogans, personal names, company names or names of real property;
- letters and numerals;
- pictures and designs; and
- the shape, equipment or packaging of the goods.

These categories are not exhaustive – others may exist as long as the mark can be presented graphically.

Not protected: A trademark right cannot be acquired for signs that consist exclusively of a shape which is dictated by the goods themselves, a shape of goods which is necessary to obtain a certain technical result or a shape which adds substantial value to the goods.

The PTO can refuse registration of the following:

- trademarks that do not possess sufficient distinctiveness. These include marks that consist of signs or indications that designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or provision of the services, or other characteristics of the goods or services;
- trademarks that consist exclusively of signs or indications of everyday language or established practices of the trade. This also applies to descriptive marks;
- trademarks that are contrary to Danish law, public order or morality;
- trademarks that are liable to mislead the public, for instance in connection with the nature, quality or geographical origin of the goods or services;
- trademarks that have not been approved by the competent authorities and therefore are contrary to Article 6ter of the Paris Convention;
- trademarks that include badges, emblems and escutcheons that are of public interest, unless the registration has been allowed by the appropriate authorities;
- trademarks that, without permission, consist of or contain an element which can be construed as a personal or company name to which another party has a legal title, or as a portrait – unless allusion is made to persons long dead – or which, without permission, contain a distinctive name or a picture of the real property of another party;
- trademarks that, without permission, consist of or contain an element which can be construed as a distinctive title of the protected literary or artistic work of another party, or which infringe the copyright in such works or the right to a photograph of another party or the industrial rights of another party; and
- trademarks that are considered confusingly similar to earlier trademarks, including registrations and applications for national trademarks, Community trademarks and trademarks registered under international agreements and effective in Denmark.

Conflicts with prior rights may be raised in opposition or court proceedings.

4. Procedures

Examination

Upon receipt of the application, the PTO ensures that the registration formalities are observed, including that the list of goods or services corresponds to the Nice Classification. The PTO also ensures that there are no absolute grounds to reject the application (eg, where the mark lacks distinctive character or is misleading or contrary to law, order or morality). The PTO will also conduct a search for prior registered rights in its database, which contains information on 160,000 registered Danish marks, as well as pending national applications, international registrations designating Denmark and Community trademarks. The PTO produces a

search report that contains a qualified list of identical marks, as well as company names or rare surnames that may constitute a hindrance to registration. The search report contains relative grounds for rejection, which means that the applicant must assess whether the mark is to be registered despite any prior rights.

Opposition

Anyone can file an opposition to a registration within two months of its publication by the PTO. The opposition must be reasoned and accompanied by a fee of €335. The PTO will examine the opposition and notify the mark owner and invite it to submit its observations. If the registration is maintained, the mark owner and the opponent will be notified.

The registration may be revoked at any time after the registration if it subsequently emerges that the trademark was registered contrary to the provisions of the Trademarks Act.

Registration

The registration fee is €315 for the first three classes and €80 for every additional class. If the application has been accepted by the PTO, it will be registered and published. Publication opens a two-month opposition period. The average registration timeframe is two to three months and renewals take one to two months. The renewal fee is €15 for the first three classes and €80 for every additional class. Registrations can be renewed from six months prior to their expiration and until six months after the expiration date.

A Danish trademark registration is valid for 10 years and may be renewed for further periods of 10 years. The validity period runs from the date of registration.

The use requirement starts five years after the mark's registration was confirmed following the end of the opposition period or resolution of any

opposition. Interested parties may request that the owner file evidence of use of the mark. If the owner cannot prove that the mark has been used for the goods and /or services registered, the mark may be partially or completely revoked. The PTO does not monitor whether the requirement of use is fulfilled, and use is not a condition for renewal.

Removal from register

Revocation: A registered trademark can be revoked if:

- the trademark is not registered in accordance with the provisions of the Trademarks Act;
- the trademark lacks the required distinctiveness;
- the trademark has not been put to effective use within five years of completion of the registration procedure or has not been used for a period of five consecutive years – unless there is a reasonable reason for non-use;
- the trademark has become a common designation in the trade for the products or services in respect of which it is registered due to the owner's activity or passivity; or
- use by the owner is misleading as to the nature, quality or geographical origin of the goods or services.

Anyone can request an administrative revocation before the PTO on the basis of any of the grounds outlined above, accompanied by a fee of €335. The trademark can also be revoked by a court decision.

Invalidation: If a registration of a trademark, a renewal of a registration or a change in the register has occurred due to an obvious handling error, the PTO may cancel the registration, the renewal or the change within three months of the registration date.

Deletion: A trademark will be deleted from the Trademarks Register at the owner's request or if the registration is not renewed. The trademark

can also be deleted from the register if the registration is declared void following an opposition or if the trademark has been revoked by a court decision.

Searches

The PTO provides facilities for accessing information and documents concerning national trademark registrations and applications, as well as Community trademarks and international marks designating Denmark on its website at www.dkpto.dk. In addition the PTO can perform the following:

- trademark search at €320 for the first three classes and €67 per additional 10 classes;
- trademark screening at €67 for the first class and €27 per additional class. Screening costs approximately €400 for all 45 classes; and
- logo scan at €280 for up to 25 references and €67 for each additional 25 references.

5. Enforcement

Complexity

Opposition and revocation proceedings:

Opposition and revocation actions should be relatively simple ways of enforcing registered trademark rights. However, these procedures tend to be lengthy and have no direct effect on the products and /or services being manufactured, imported, exported, advertised or offered for sale. Also, they often require the involvement of lawyers and the procedures themselves are often similar to that of a court, for an overall cost equivalent to that of court proceedings.

Civil proceedings: The most efficient and fastest way of enforcing trademark rights in Denmark is by using the civil procedure found in Chapters 57 and 57a of the Administration of Justice Act. Under that procedure, a court bailiff may raid, without prior warning, any location deemed to contain evidence of IP right infringement.

Everything – from goods to documents, machines and computers – can be seized. A preliminary ban is also issued. Such action can normally be carried out within 14 days of the request to the court. The bailiff does not give his opinion on damages – any claim as to damages must be settled with the infringer or by decision of the Maritime and Commercial Court in Copenhagen.

Damages: The PTO has the power to refuse the renewal of registered trademarks, but not the power to prevent actual use of infringing trademarks. To prevent actual use or to obtain damages for historical use, trademark owners can file an action with the Danish Maritime and Commercial Court. In assessing the claim for damages, the court shall – according to the amendments to the Trademarks Act that incorporate Directive 2004/48/EC – take into account all appropriate aspects, including lost profits, that the injured party has suffered and any unfair profits made by the infringer when estimating the damages. This means that it is now possible to obtain an amount in damages exceeding the actual loss of the injured party due to the fact that the court is taking the infringer's unfair profit into account when calculating damages. This may result in higher damages awards than previously seen in Denmark.

Criminal proceedings: Intentional or negligent violation of a trademark right that has been established by registration or use can be punished by a fine. Under particular aggravating circumstances, especially where the aim is unlawful profit, the punishment can be up to one year's imprisonment. The police also assist with seizures.

Customs control: Pursuant to Customs Regulation 1383/2003, mark owners may request Customs to seize goods suspected of infringing IP rights upon arrival at the Danish borders. The request can be made on a general basis (general application), but it must follow the guidelines stipulated in the regulation. When Customs

seizes infringing goods, it must inform the mark owner or the mark owner's attorney. The owner then has three days to request the suspension of the goods. Upon receipt of the suspension request, Customs will send the name and address of the consignee to the mark owner or its attorney. This gives the owner another 10 days to decide whether the seized products are to be released or destroyed. Negotiations with the infringer are normally carried out during that period, resulting in the destruction of the seized goods and the payment of damages. Cases that are not settled during that period are submitted to the Maritime and Commercial Court. Most cases are then settled during the preparation of the action before the court.

Timeframe

The timeframe for enforcement depends on the choice of action and can be between 14 days and several years. It is largely identical for registered and unregistered trademarks; however, court proceedings with regards to unregistered marks can be longer since the scope of use and distinctiveness can be harder to prove.

6. Ownership changes – legalization requirements

Full transfer: A trademark right may be assigned in connection with the transfer of a company itself or on its own. If the parties have not agreed otherwise, the trademark right will be transferred along with all other company assets in case of an acquisition. A trademark assignment will be entered in the Trademarks Register upon request. The registration is not required for the owner to maintain the right against a good-faith third party seeking to register an identical trademark afterwards and hence has no influence on the material right. The original declaration of assignment or a certified copy thereof, signed on behalf of the registered

owner, is to be sent to the PTO. The standard form is available on the PTO's website at www.dkpto.dk.

Partial assignment: Instead of full assignment, the owner can decide to assign a part of the right as a licence. Under the Trademarks Act, the owner can issue a licence to a trademark right for all or a part of the goods or services for which it is registered. The licence will be entered in the Trademarks Register upon request. The registration is not required for the owner to maintain the material right.

Mortgage: The trademark right may be mortgaged in accordance with the rules on chattel mortgages and must be registered by the PTO.

7. Areas of overlap with related rights

The Copyrights Act, the Marketing Practices Act and the Designs Act somewhat overlap with the Trademarks Act. In some situations, trademark owners may enjoy the cumulative protection of trademark law, copyright law and design law.

Trademarks may enjoy copyright protection under the Copyrights Act if the mark is an artistic work. In addition, the work must satisfy requirements for originality that are not identical to the distinctiveness requirement provided in the Trademarks Act. If a trademark has been created as a device mark, it will be protected not by the Copyrights Act, but only by the Trademarks Act. Applied art is also protected by copyright law given that the applied art is artistic and meets the requirements for originality.

Designs can also enjoy the protection of the Trademarks Act if the requirements for registration under the Designs Act are met.

Distinctive business marks are protected by the Marketing Practices Act, which stipulates that companies shall not make use of others' distinctive business marks or use their own marks in a way that causes confusion with the marks of others.

8. Online issues

As a general guideline, the rules that govern trademarks in conventional commerce also govern trademarks that are used online. It is not stipulated in the Trademarks Act that the use must be through a specific channel. This means that if use of a trademark on the Internet can be defined as use within the meaning of the Trademarks Act, the trademark is protected by the trademark regulations. However, the owner must keep in mind that the mark has to have been used commercially in Denmark in order to enjoy protection. Physical addresses linked to a homepage may be investigated through a civil seizure.

