

Contributing firm
Awapatent A/S



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Legal framework

In Denmark, it is possible to protect design rights by filing an application for:

- a national design right with the Danish Patent and Trademark Office (DKPTO);
- a registered Community design with the Office for Harmonisation in the Internal Market; or
- an international design registration designating the European Community via the Hague system with the World Intellectual Property Organisation.

Denmark also allows for the protection of unregistered design rights through the unregistered Community design system (discussed below).

As Denmark is an EU member state, the laws governing design protection in Denmark have largely been harmonised with and are similar to those in the rest of the European Union. Both the Design Act and the EU Community

Designs Regulation (6/2002) apply to design rights in Denmark. The rules and procedures for trademark application and prosecution are set out in the Design Act.

While the Design Act largely reflects the rules set out at EU level to harmonise IP laws within the European Union, there are a few differences – most notably that the Danish rules allow for design registration of spare parts.

Design rights are treated as a distinct IP right in Denmark, which is separate from patents, utility models, trademarks and copyright. These rules can be used in conjunction with each other and sometimes overlap, but the rules governing each right are separate.

Unregistered designs

As mentioned above, Denmark allows for the protection of unregistered Community designs. Such rights are established through use by making the design public within the European Union, typically by displaying the design on a website, in magazines or at trade fairs. It is not necessary to prove extensive use of the design, but it can be difficult to prove ownership of or entitlement to such rights if no dated

material showing the design can be produced in the event of opposition. It is therefore recommended to keep on file dated material showing the design at various intervals.

Unregistered design rights have a maximum lifespan of three years from the date of publication. They can be used to prohibit only the commercial exploitation of a similar design. Thus, it is insufficient if the allegedly infringing design gives users the same overall impression, as is the case for registered designs.

Registered designs

Both natural and legal persons can apply for registration of a national design. The applicant may choose to include information about the designer, but this is not mandatory. Nor is it required that a legal person file an assignment agreement between the designer and the applicant.

Design protection is limited to the appearance of a given product – namely, its shape, form, decoration or colour. Technical features cannot be protected through design rights, but can be protected as either utility models or patents.

Further, the so-called ‘must-fit’ rule applies in Denmark, meaning that protection cannot be obtained for the part of a design which is necessary in order for it to be fitted as a component to another product. This rule is largely intended for the spare parts industry.

In order to qualify for registration, the design in question must be visible during ordinary use. An exception to this rule is, as mentioned above, the fact that the Design Act expressly allows for design protection of spare parts, although such protection is limited to a maximum of 15 years’ validity. The ‘must-fit’ rule is intended to facilitate the protection of spare parts.

A design registration cannot include state emblems, official or international designations or designs that are contrary to public order or morality, though it is rare to see examples of such designs in Denmark.

A design must further be new and possess individual character in order to be registered in Denmark. If a design has been made public before application, it will not be considered new. This novelty requirement is global. However, a 12-month grace period is available in Denmark within which a design can still

be registered, even if it has been made public. That said, applicants should consider carefully whether to avail of this grace period, as it may hinder use of the priority period and the opportunity to obtain registration abroad.

‘Individual character’ is understood to mean that the design must differ in overall impression from all previously known designs. When evaluating whether a design is sufficiently individual, the type of product and the freedom granted to the designer will be taken into consideration.

The costs of registration depend largely on the design in question and the fee of the local agent assisting with the application. The official fees payable to the DKPTO for a design application are available at www.dkpto.dk. The main official fees are as follows:

- a Dkr1,200 application fee for the first five-year period;
- a Dkr2,200 renewal fee for each additional five-year period; and
- a Dkr700 multiple registration fee for each design beyond the first.

By registering a design, the applicant (or future assignee) is granted the exclusive right to prevent others from using the design in the course of business (eg, to manufacture, sell, import or hire products displaying the design). Commercial use of an identical design, or a design which creates the same overall impression among consumers, will be considered as infringement.

A design registration is valid for a maximum of 25 years, for one or more five-year periods from the date of filing of the application. The registration can be renewed at the earliest three months before expiry and at the latest (on payment of an additional fee) six months after the expiry of each five-year period. A design registration for spare parts is valid for a maximum of 15 years.

Procedures

An application for a national design can be filed with the DKPTO by post, fax, online or in person. The DKPTO will check the formalities, but will not conduct a search for novelty or individual character.

Anyone can file an application, although it is advisable to use a Danish representative

if the applicant is unfamiliar with the Danish language or case law.

There are no requirements that a certain form be used when applying to register a design, although it is advisable to use the form available from the DKPTO for the sake of ease.

The application must include the following:

- details about the applicant(s);
- an indication of the product and class(es) for the design;
- information about multiple designs (if applicable). Multiple designs may be included in the same application if they are all in the same class or if they are ornaments to the main design object;
- confirmation of whether the application is to be filed in colour or black and white;
- images of the design. There is no upper limit to the number of images allowed, but they must show the design clearly and preferably against a neutral background. The images can be supplied by email in jpg format. Dotted lines may be used to show parts of the product for which design protection is not sought;
- an attached model of the design (optional);
- priority information (if applicable);
- a request for deferred publication (if applicable). Publication can be deferred for up to six months from the filing date and will be granted on request;
- payment of the applicable fee(s); and
- the signature of the applicant or its representative.

If the design passes official examination, possibly after amendments following communications with the DKPTO, the DKPTO will publish the design as registered. There is no opposition period for designs in Denmark, but a design registration is still vulnerable to an administrative cancellation action or a cancellation action brought before the courts.

Anyone can request that a registered design be examined for novelty or individual character, and that the registration be cancelled if these criteria have not been met. As a Danish design application is not examined for novelty or individual character at the time of registration, it is advisable for the owner to request an administrative examination if the design is the subject of a court case. A test for

novelty and individual character at this stage will strengthen the design registration.

Unregistered design rights can be tested for novelty and individual character only during the course of a court case and not by the DKPTO.

Enforcement

There is a long tradition of enforcing IP rights in Denmark. Both registered and unregistered design rights can be enforced.

The main cause of action is commercial exploitation of an infringing design. Such matters are brought before the courts – typically the Danish Maritime and Commercial Court in Copenhagen.

In some cases, infringement may be halted by sending a cease-and-desist letter detailing the rights of the owner or licensee of the design.

If this proves insufficient as a deterrent, a court order requesting that the alleged infringer or a relevant third party provide information that can be used as evidence of the infringement or incurred damages may be granted before the infringement action as such is filed with the court. The courts may also grant an order for the seizure of documents or product samples (or copies) in order to provide the plaintiff with access to evidence for its case.

It is common in Denmark to request a preliminary injunction as part of an infringement action. A bank guarantee or similar is usually required in order to obtain a preliminary injunction. The amount of the guarantee will depend on the design in question and how harsh the preliminary injunction will be on the alleged infringer. The guarantee will be used to compensate the alleged infringer in the event that the preliminary injunction is granted, but later found to be unfounded.

The courts take approximately between one and three months to decide an interim injunction matter. *Ex parte* decisions may be handed down, but the courts normally allow the alleged infringer to comment on the interim request.

Preliminary injunctions must always be followed up by a court case, unless the infringer forfeits this right. The period between the application for a preliminary injunction and finalisation of the court case can easily span two years.

On July 1 2013 a new set of rules entered into force in Denmark, allowing for interim injunctions to arise from and run parallel to normal court actions, rather than as a separate matter before the main proceedings. It is hoped that this will shorten the timespan between commencement of proceedings and resolution of the matter; however, at the time of writing the rules have not yet been seen in use.

Successful infringement actions may result in the court ordering the infringer to:

- cease unauthorised use of the design right;
- pay a penalty in the event that the order is not met;
- pay damages; and/or
- pay for the publication of information regarding the infringement.

The court may also order the infringer and relevant third parties to provide the plaintiff with information on the production and distribution channels and pricing of the infringing goods.

Ownership changes and rights transfers

Danish law provides no formal requirements for transfers or licences regarding design rights. A transfer or licence can be established orally or in writing, but parties are advised to sign written agreements, for clarity and evidentiary purposes.

There is no requirement to register a licence or transfer with the DKPTO, but again this is advised for the sake of clarity and ease of proof of ownership or entitlement.

Related rights

Design rights may overlap with copyright and with figurative or three-dimensional trademarks, and it is not uncommon to see a single product protected by multiple registrations.

The Copyright Act explicitly stipulates that copyright may overlap with design rights for the same object. The creator of the design usually also holds the copyright. In the event of assignment of a registered design, it is prudent to include a transfer of copyright in the assignment agreement in order to avoid the separation of these two forms of exclusive right.

In order to secure copyright protection in Denmark, the object must possess a sufficient level of originality and be artistic. Both registered and unregistered designs can be

protected by copyright.

It is not possible to register copyright in Denmark; whether a given work is indeed protected by copyright is determined only once a judge has decided on the matter. The threshold for originality varies depending on the subject matter.

Design rights may also overlap with figurative or three-dimensional trademarks. In the event of different rights holders, the prior right may invalidate the later right. In this context, it is significant in Denmark that trademarks may be established not only by registration, but also through use alone.

It is also common practice to claim that an infringing design violates the Marketing Practices Act. This act protects against unfair competition, which can be claimed even if no design right – whether registered or unregistered – exists. [WTR](#)

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Ms Bender joined Awapatent in 2011 and specialises in trademark, design, domain name and marketing law. She advises on all issues related to these areas, from drafting of IP strategies and selection of trademarks and other rights to prosecution and litigation concerning IP rights and their exploitation.