

Denmark

Contributing firm

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1. Legal framework

National

The most important national legislation governing trademarks in Denmark is the Trademarks Act. This legislation was first enacted in 1880 and has since been amended several times. The most recent significant changes were made in 1991 in order to harmonize the regime with EU law.

The Trademarks Act is available in English on the website of the Danish Patent and Trademarks Office (PTO) at www.dkpto.dk.

A few other Danish laws are also relevant. For instance, the Marketing Practices Act protects traders against unauthorized use of their distinctive business marks. The Companies Act and the Names Act respectively protect companies against unauthorized use of their business names and individuals against unauthorized use of their surnames.

International

As Denmark is a member state of the European Union, the following EU trademark laws also apply in Denmark:

- the Community Trademark Regulation (40/90); and
- the First Trademark Directive (89/104/EEC).

The international treaties that Denmark has ratified include:

- the Paris Convention for the Protection of Industrial Property;
- the Agreement on Trade-Related Aspects of Intellectual Property Right;
- the World Intellectual Property Organization Trademark Law Treaty;
- the Nice Agreement; and
- the Madrid Protocol.

2. Unregistered marks

Protection

The owners of unregistered marks enjoy the same rights as the owners of registered marks. However, registration makes it easier to prove ownership of a trademark right.

Use requirements

Under Section 3(1)(ii) of the Trademarks Act, an unregistered mark is established upon “the commencement of continuous use of the mark in Denmark for specific goods or services”.

This provision is interpreted to mean that a right through use may be established in just one day if the relevant goods or services are actually marketed in shops and/or in the press. It is assumed that the mere intention to use a trademark – even if supported by evidence – is not sufficient to establish an unregistered right.

An unregistered right will be lost if the unregistered mark is not used for a long period of time and such non-use is not just temporary or coincidental.

It is recommended that dated proof of use be kept on file for the purpose of demonstrating trademark rights that have been established through use.

3. Registered marks

Ownership

Any person or company can apply for and own a mark.

Scope of protection

Protected: Under Section 2(1) of the Trademarks Act, a trademark may consist of any sign that is capable of distinguishing the goods or services of

one enterprise from those of others and capable of graphical representation – in particular:

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

Not protected: According to Section 2(2) of the Trademarks Act, signs comprised exclusively of a shape which is dictated by the goods themselves, which is necessary to obtain a technical result or which gives substantial value to the goods cannot be registered as trademarks.

Sections 13 to 15 of the act list further grounds for refusal of registration. The most significant of these are as follows:

- Under Section 13, marks that lack distinctiveness may not be registered. These include marks comprised exclusively of signs or indications that may serve in trade to 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 comprised exclusively of signs or indications that are customarily used to designate the goods or services in the current language or in the established practices of the trade are also excluded from registration.

The word ‘exclusively’ is important, as it confirms that a mark comprised of more than one word may be registrable if one or more words are distinctive. A trademark may also be registered if it has acquired distinctive character through use.

- Section 14 is based on Article 6*bis* of the Paris Convention and Articles 3 and 4 of the First Trademark Directive. The marks it excludes from registration include those which are contrary to law, public order or

morality, and those which are misleading (eg, as to the nature, quality or geographical origin of the goods or services).

- Section 15 excludes from registration marks that are considered confusingly similar to existing trademarks. ‘Existing trademarks’ include registrations and applications for national trademarks, Community trademarks and trademarks registered under international agreements with effect in Denmark.

Section 15(5) expressly states that a trademark will not be excluded from registration pursuant to the provisions of Section 15 where the owner of the earlier trademark or other earlier rights consents to the registration.

4. Procedures

Examination

The PTO commences its examination upon receipt of the trademark application and the registration fee of Dkr2,350 (approximately \$415/€320) (for registration in three classes under the Nice Agreement).

The PTO will investigate whether the mark in question is registrable. To this end, the PTO will search its database, which contains all trademarks and Community trademarks in force in Denmark, as well as Danish trademark applications and Community trademark applications. The PTO will also search the Company Register and databases of unusual last names, and will then examine the meanings of the mark in certain languages and within relevant technical areas.

If there are any absolute grounds for refusal (ie, if the trademark lacks distinctive character, is contrary to law, public order or morality, or is misleading), registration will be refused. If there are relative grounds for refusal (possible conflicting

rights), the PTO will inform the applicant accordingly. The applicant can then decide whether to proceed with or modify the application.

According to Section 22, the trademark will be registered if the application is accepted by the PTO and registration will be published in the *Trademark Gazette*.

Opposition

Section 23 of the Trademarks Act provides that anyone may file an opposition to the registration within two months of its publication in the *Trademark Gazette*. The opposition must be reasoned and accompanied by a fee of Dkr2,500 (approximately \$440/€340).

The trademark owner will be notified of the opposition and invited to submit its observations. If the registration is not withdrawn, the opponent and the trademark owner will be notified accordingly. The parties will then usually be allowed to exchange briefs before the PTO decides the matter.

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

Registration

The application is registered if accepted by the PTO (ie, prior to publication and any opposition), and the registration is published in the *Trademark Gazette*.

Cancellation/surrender

Under Section 33 of the Trademarks Act, a trademark will be deleted from the Trademark Register at the owner's request. A trademark will also be deleted if:

- the registration is not renewed;
- the registration is declared void pursuant to Section 23 (opposition); or

- a decision is made or a judgment issued to revoke the trademark pursuant to Sections 29, 30 or 31.

Revocation

A trademark can be revoked either through a court decision (Section 29) or through an administrative revocation procedure before the PTO (Section 30).

The grounds for revocation are as follows:

- non-use;
- registration in contravention of the Trademarks Act; and
- loss of distinctiveness.

Under Section 25(1), if the trademark owner does not put its mark to genuine use in Denmark in connection with the goods or services for which it is registered within five years of the date of completion of the registration procedure, or if such use is suspended for an uninterrupted period of five years, the registration may be revoked unless there are legitimate reasons for such non-use.

Using the trademark in a form that does not significantly differ from the form in which it was registered, and affixing the trademark to goods or their packaging solely for export purposes, expressly constitute genuine use.

Danish case law shows that very little use is required to constitute 'genuine use', as long as there is no indication that the actual use is merely token. In the leading ruling on the matter, several sales of products with a total value of approximately \$2,000/€1,500 were sufficient to constitute genuine use.

Invalidation

If a trademark registration or renewal, or an amendment to the Trademark Register, has been made in obvious error, the PTO may cancel the registration, renewal or amendment within three months of its entry in the register (Section 34).

5. Enforcement

Complexity

There are a number of ways to protect registered and unregistered trademark rights.

The owners of registered trademarks can protect their rights through opposition and revocation proceedings, discussed above.

In addition, the following options are available to the owners of both registered and unregistered rights:

- file a request for seizure of the infringing products. As part of this procedure, documentation or other proof of the infringement may also be copied or seized. A successful seizure must be followed by a confirmatory civil suit;
- file a request for an immediate injunction against the infringing products. A successful request for an immediate injunction must be followed by a confirmatory civil suit;
- file a civil suit. Damages can be awarded only by the court in a civil suit. Likewise, costs can be claimed only in court proceedings – but the costs awarded will rarely cover the actual costs incurred by the trademark owner;
- report the infringement to the police, where the infringement is intentional;
- where the dispute concerns a domain name (under the top-level domain ‘.dk’), file a civil suit or submit a complaint to the Domain Names Complaint Board; or
- file a request for customs action under Council Regulation (EC) 1383/2003 on customs action against goods suspected of infringing certain IP rights and the measures to be taken against goods found to have infringed such rights.

Timeframe

The timeframe for opposition and revocation procedures is generally between one and two

years. In both cases, as the parties are allowed to exchange briefs before the PTO decides the matter, the actual duration of the proceedings depends largely on the parties. The PTO will usually issue its decision about eight weeks after the last brief has been exchanged.

A request for the seizure of infringing products is normally issued within one or two months, while an immediate injunction can similarly be obtained in between one and three months.

A civil suit usually takes between one and two years at each instance.

The Domain Names Complaint Board will generally resolve disputes involving domain names within three to six months.

A request for customs action will generally be handled within 30 days.

6. Ownership changes – legalization requirements

Although it is not legally required to register a transfer of ownership with the PTO, this is recommended for practical reasons.

Under Section 39 of the Trademarks Act, the transfer of the rights to a registered trademark will be entered in the Trademarks Register upon request. For this purpose, the PTO requires the submission of an original agreement documenting the unconditional transfer of one or more clearly identified marks. The agreement must be signed by the trademark owner and clearly identify the new owner. Generally, if the PTO can read the language in which the agreement is written (Danish, Swedish, Norwegian, German or English), it will not request legalization of the documents.

Although this is not required, it is recommended to use the Danish/English standard form for trademark transfers, available at www.dkpto.dk/blanketter/varemaerke/5_6_v_overdragelse.pdf. If this form is correctly filled in and submitted with an original signature to the PTO, the PTO will not request further information or documentation.

7. Areas of overlap with related rights

It is debatable whether copyright can be used to protect device marks that have artistic merit.

The general understanding seems to be that device marks which have been created for use as device marks (and not works of art) will be protected only under the Trademarks Act, and not the Copyright Act.

However, works of art that were originally created as such will continue to be protected by the Copyright Act even if they are subsequently used as trademarks with the consent of the copyright holder. For example, the statue of the Little Mermaid, created by Edvard Eriksen in 1911, would not be deprived of its copyright protection if used as a trademark.

Designs may also be protected as trademarks. There is nothing to prevent a protected design from being registered as a trademark, provided that the requirements for registration under the Design Act have been met.

8. Online issues

The same rules and principles governing registered and unregistered marks apply when such marks are used online.

However, a trademark used on the Internet will only be considered to be used in Denmark if such use has a commercial effect in Denmark. For this purpose, the following factors would indicate that a website has commercial effect in Denmark:

- Customers residing in Denmark are serviced via the website;
- The website is available in Danish;
- The website offers goods or services in Danish currency and accepts payment in this currency;
- Guarantees and services are offered to customers residing in Denmark; and
- The website is registered under the top-level domain '.dk'.