

Denmark: Trademark right established through use

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In the EU there are jurisdictions (like Spain, France, Benelux) that do not recognise any unregistered trademarks beyond those that are notoriously known. There are others where the acquisition of unregistered trademark rights is possible but subject to use and recognition of the mark surpassing a certain qualitative threshold – with varying requirements. Then of course in the UK and Ireland you have passing-off. From all we know, Denmark is the one EU country where it is easiest to acquire trademark rights without registration.

In Denmark it is possible to establish a trademark right either through registration or through use. The reasoning behind this dual principle is that it should not be possible to seize control of a trademark already used by another undertaking by being the first to file an application for registration of the same trademark.

To establish a trademark right through use in Denmark you are only required to show limited use of your trademark. The minimum requirements for establishing a trademark right through use were laid down by the Supreme Court in U.2000.1351H which concerned the trademark ELYSIUM used for funeral services.

The court found that it is possible to establish a trademark right through use exercised during one single day. In the ELYSIUM-case the owner issued a press release describing the new services to be launched under the ELYSIUM trademark. This resulted in the owner getting free publicity both in a message from the news agency Ritzau as well as in articles in 15 newspapers with a total circulation of

approximately 200,000 copies. This press coverage was found by the court to be sufficient for creating a trademark right based on use.

In order to prove that you have acquired a trademark right through use you need to provide the Courts or the Danish Patent and Trademark Office with evidence showing use of the mark in the relevant territory for the relevant goods/services. As a general rule it is preferable to show actual sales under the mark, but as demonstrated by the ELYSIUM-case it is possible to establish a right to a trademark without any actual sales under the mark. It follows that it is important to distinguish between the evidence needed to show continued use of a trademark on the one hand and the evidence needed to establish a user-based trademark right on the other. In the latter case the requirements are less strict.

To be able to enforce a user-based trademark right it is a condition that the trademark is still being used. It remains to be determined in practice how long a user-based trademark can be out of use before the rights in the mark cease to exist. With the amendment of the Danish Trademark Act (TMA) in 1991 it became compulsory to use a registered trademark within five years from the date of registration, cf. Section 25 TMA. However, it is not possible to apply Section 25 TMA by analogy when it comes to trademark rights based on use alone. The assumption is that you lose the right to the trademark established through use sooner than the five-year grace period granted to registered rights, but it all depends on the distinctive character of the trademark and how intensely the mark has been put to use.

It can be time consuming and expensive to file proof of a trademark right established through use, but this dual principle of establishing a trademark right through use should also be seen as a very handy tool when the owner of a registered trademark has used the trademark in a form which differs from the form in which it is registered, and it is also possible to avoid the EUIPO torpedo if you base your right on the prior - even if only limited - use exercised in Denmark to be able to proceed with your conflict case at administrative or Court level.