

Denmark: What do LEGO, JENSEN and UTZON have in-common?

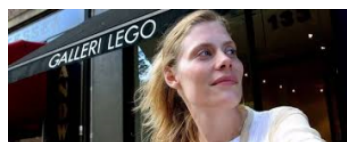
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LEGO, JENSEN and UTZON have in-common that they all are trademarks and last names at the same time.



A decade ago the reputed producer of construction toys for children LEGO tried to prohibit Louise Lego Andersen – painter and gallery owner – from e.g. signing her paintings as “L. Lego” (see ruling V 150/03). LEGO claimed reputation and a registration for *art exhibition services* in Class 41. The Supreme Court ruled against LEGO and allowed the gallery owner Louise Lego Andersen to continue using her middle name Lego when signing her paintings, naming her gallery “Galleri Lego” and using lego as an ad-word on Google.

In Denmark, as in all EU Member States, the trademark law contains an own-name-defence, i.e. a provision whereby anybody can use his or her own name provided this is in accordance with honest practices in trade.

In the years following the LEGO ruling there was a tendency to take the exception a bit far, as people seemed to think that if LEGO had to co-exist, then nobody could prohibit the use of one’s own name. However, recently we have received two rulings going in the other direction.

In 2014, we received the ruling in JENSENS FISKERESTAURANT versus JENSEN

BØFHUS used for *restaurant services* in Class 43 (see ruling H



228/2013). Both FISKERESTAURANT and BØFHUS are non-distinctive for Class 43 services as they respectively mean “fish restaurant” and “steak house”. JENSENS BØFHUS wished to prohibit the use of JENSENS alone and in combination with FISKERESTAURANT. JENSENS BØFHUS claimed reputation and JENSENS FISKERESTAURANT among other things claimed use of his own name. The rightful owner of JENSENS FISKERESTAURANT was Sæby Fiskehal ApS, which was 100% owned by the private person named Jacob Jensen. The Supreme Court concluded that taking into account that the own-name-defence is an exception to the general right granted the proprietor of a trademark to prohibit any person not having his consent from using any sign in the course of trade if the sign is similar or identical to the trademark. The Supreme Court found that the exception cannot be extended to the names of a limited liability company, shareholders, executive management and the like which is why Sæby Fiskehal ApS had no right to use JENSEN as a stand-alone trademark or together with the descriptive element FISKERESTAURANT. Thus the Supreme Court ruled in favour of JENSENS BØFHUS and prohibited further use of JENSENS used by Sæby Fiskehal ApS.

Then, on 30 November 2015, we received a ruling concerning Benedikte Utzon’s use of her own name and the trademark BENEDIKTE UTZON (see ruling V 78/14). The question was whether Benedikte Utzon’s use of her own name was violating the trademark right to BENEDIKTE UTZON for *inter alia goods made of leather* in Class 18 and *clothing* in Class 25. Prior to the conflict Benedikte Utzon went bankrupt and the trademark BENEDIKTE UTZON was purchased by Topbrand. The Court ruled that as Topbrand is the rightful owner of the trademark BENEDIKTE UTZON it must be assumed that it will not be possible for Benedikte Utzon to make commercial use of her own name as a stand-alone brand or in combination with other elements for goods and services in Classes 18, 25 and 35. This means that Benedikte Utzon can no longer use her name as follows: Designed by: “Benedikte Utzon, Designet af: Benedikte Utzon, Designer: Benedikte Utzon, Design: Benedikte Utzon, By Benedikte Utzon”. The Court allowed Benedikte Utzon to continue to have a profile on Facebook and Instagram under her own name and she is also allowed to communicate – in a loyal way – that she is the designer of her new brand MY LITTLE CURVY LOVE.

To sum up it is possible to conclude that it is unlikely that you will be entitled to use your own name as a trademark within the same line of business as the proprietor of an earlier trademark right consisting of your name. So all entrepreneurs out there: be aware! When you start up a business in your own name and later on sell it, you will - unless otherwise agreed - lose your right to use your own name again as a trademark within the same or similar line of business.