

Denmark: Estoppel - what does it take?

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Increasingly, it seems that complex trademark cases are not always decided on the basis of trademark law and EUTMR alone but also on the basis of general legal principles, such as estoppel (in Danish “passivitet”), and much less often acquiescence.

We have written two blogs on the subject seen from a Danish perspective. This first blog is about the theory of estoppel and how estoppel differs from acquiescence. The second blog deals with relevant case law where estoppel is essential to the result.

What is estoppel?

The concept of estoppel differs from jurisdiction to jurisdiction. It very much depends on national law and is derived from national case law practise. In Danish law it is a general legal principle which has been incorporated into the Danish Trademark Act (hereafter TMA) Article 9.

The concept of estoppel has also been discussed on an EU level in connection with the understanding of the concept of acquiescence. In the legal opinion of Advocate General Trstenjak of 3 February 2011 in Case C-482/09 “Budvar” she explains in § 60: *“Under the laws of the Member States, a right is generally regarded as lost by estoppel if the right-holder has, over a certain period (point in time), failed to assert it (inactivity of the person entitled) and the person subject to it has acted in reliance, and was also on an objective assessment of the conduct of the right-holder entitled to act in reliance (legitimate expectation), on the right-holder not*

*asserting the right in future either. In that case the breach of good faith lies in the unfair delay in asserting the right. **What is protected is the confidence in a certain legal situation of the person who is in principle subject to the right, a confidence which the law regards as justified in view of the specific circumstances of the particular case.***

The explanation of estoppel by the Advocate General Trstenjak is in line with the Danish general principle of estoppel and Article 9 TMA where a later right to a trademark may also co-exist with an earlier right to a confusingly similar trademark if the proprietor of the earlier right has not, within a reasonable time, taken the necessary steps to prevent the use of the later trademark.

Within the area of intellectual property it takes a lot to lose one's right by estoppel. We have identified the following three key factors which are important when deciding whether or not the holder of the earlier right loses the right to prevent the use of the later mark: 1) knowledge or what the owner of the earlier right ought to know (in Danish: "viden or "burde vide") 2) time - how much time has passed from the point when the owner of the earlier right became aware of the younger right - or should have known about it - and until he/she takes action 3) justification - can the lack of action by the owner of the earlier right be justified? An example of this is e.g. if the younger mark is only used on small quantities of goods. The owner of the earlier right must set up routines internally to ensure that possible violations of trademark rights come to their knowledge within a reasonable time, cf. U 2001.166 SH NINOFLEX and the like.

It is - of course - a pre-condition that likelihood of confusion exists between the trademarks in question (or if the earlier right is reputed/well-known that a link exists).

How does estoppel differ from acquiescence?

The distinction between estoppel and acquiescence can be very difficult, as the concepts overlap to some extent.

A clear difference between estoppel and acquiescence is that acquiescence is an incorporation of Article 9 EUTMD whereas estoppel deals inter alia with unregistered trademark rights. Furthermore, to establish acquiescence the owner of the earlier right must have acquiesced for five successive years whereas estoppel is not defined by a fixed period of time but more by what appears to the

judges to be reasonable in the circumstances.