

Denmark: To be or not to be.... reputed

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For some time, the Danish Patent and Trademark Office (DKPTO) has taken the approach that when an opposition is based on the reputation associated with earlier EU rights, then those earlier EU rights need to be reputed also in Denmark to enjoy the enhanced protection provided by reputation in oppositions against national Danish trademark applications.

This approach has meant, among other things, that the moose of Abercrombie & Fitch was found not to be sufficiently reputed (in Denmark) despite the brand being backed by a flagship store located in the main shopping street of Strøget in Copenhagen (opposition against VR 2011 02903).

In the recent case, Philip Morris Brands Sàrl (Philip Morris) opposed the application



(SUPER ROLL) in Class 34 for, i.a., *tobacco products* as filed by Scandinavian Tobacco Group Assens A/S (Scandinavian Tobacco). Philip Morris based its opposition on the indisputably reputed EU trademark registration



(ROOF TOP) for identical or highly similar goods. It is easy to see why Philip Morris needed to rely on the reputation of the earlier mark, as no

likelihood of confusion exists between the purely figurative mark of Philip Morris and the mark applied for.

Philip Morris argued that the earlier mark was identically reproduced in the mark applied for – just as a mirror image – and that the word elements SUPER ROLL were weak/non-distinctive for *tobacco for rolling your own cigarettes*. Furthermore, Philip Morris emphasised that the ROOF TOP logo has been used together with the main brand Marlboro for 60 years and, additionally, filed evidence of reputation consisting primarily of brand ratings associated with Marlboro.

Both the DKPTO and the Danish Board of Appeal (DKBoA) found the evidence of reputation insufficient to establish that the earlier right was reputed in Denmark. Arguments regarding the unitary character of the EU trademark and reputation in other member states in the EU were lost on the DKPTO and the DKBoA. They stated: ‘It is insignificant that the trademark is reputed in other Member States ... it must be proved that the trademark is reputed in Denmark’ (translated).

In the decision by DKBoA the DKBoA more or less repeated the arguments put forward by the DKPTO and referred to case C-487/07, *L’Oréal v. Bellure*. Thus, the DKBoA recognised the ROOF TOP logo as reputed in the EU, but not in Denmark.

Extensive further evidence of reputation was submitted by Philip Morris before the Maritime and Commercial High Court (the Court), including a market survey for Marlboro’s market share in Denmark in the period of January 2007 to July 2012. In this period, Marlboro’s market share accounted for between 1.4% and 3.1%. Philip Morris argued that this (low) market share was sufficient to position the earlier right in a highly competitive market, dominated by the brands of Scandinavian Tobacco, with Denmark being traditionally the home market of the Scandinavian Tobacco products.

The Court case was delayed, as answers to the preliminary questions in case C-125/14 *Iron & Smith*, were pending – answers which Philip Morris argued would be relevant to the present case. In *Iron & Smith*, para. 34, the Court of Justice of the European Union (CJEU) clarified how the earlier right may benefit from ‘...*reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trademark may benefit from the protection introduced by Article*

¶4(3) of Directive 2008/95 where **it is shown that a commercially significant part of that public is familiar with that mark** (my emphasis), makes a connection between it and the later national mark...'

With this clarification from the CJEU, the Court rightly came to the conclusion that the ROOF TOP logo needed not be reputed in Denmark to benefit in Denmark from its reputation in other parts of the EU. It was enough that a sufficiently large part of the relevant public in Denmark made a connection between the ROOF TOP logo and the SUPER ROLL logo.

Hopefully, this way of applying the concept of reputation in Denmark of an EU trademark is not a unique example but will become common practice in the future – also at the administrative level.