

Denmark: Currently forum shopping is the only way forward

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The discrepancy between the case law using geographical origin as a reason for rejection of a trademark in the EU and at the DKPTO, respectively, is becoming increasingly noticeable; most recently with the judgement from the General Court in T-122/17 DEVIN on the registrability of the geographical name DEVIN. The discrepancy concerns the issue when a geographical name is considered a geographical origin in the EU and when a geographical name is a ground for objection at the DKPTO.

In practice, it is next to impossible to obtain a trademark registration for any geographical name in Denmark – even if the name is historical, like HAFNIA (historical name for Copenhagen), for a specific address in Denmark, or if the geographical scope under the geographical name is diffuse.

The very strict practice at the DKPTO on geographical names is reasoned by the fact that (previously) Danish businesses used the geographical names to distinguish themselves from other businesses within the same line of business, e.g. a hairdresser in Copenhagen and a hairdresser in Aarhus. This historical use of geographical names in combination with the name of the business has resulted in a(n extremely) strict practice for Danish geographical names, meaning that it is not possible to obtain trademark registration for a geographical name in Denmark unless it is **impossible** to perform the particular kind of business from that geographical location. An example of this is the geographical name RINGSTED (a

middle-sized non-coastal town in the middle of Zealand) for *Shipbuilding* in Class 37, meaning that RINGSTED would be considered acceptable for *Shipbuilding* by the DKPTO.

Recently, the DKPTO has *inter alia* rejected the following marks as they consider the signs to be of geographical origin and thus descriptive:

- NYHAVN 17 for *inter alia tattooing services* in Class 44 (a specific address in Copenhagen). Is that sign not be considered registrable for the number '17' alone? And is there indeed a need to keep this sign free for third parties to use as it is possible for one single undertaking only to be located at that address? EUIPO accepted the sign for the same services without the blink of an eye.
- SLAGTER VOLSTED for Classes 29 and 30 (SLAGTER means 'butcher' in English and VOLSTED can be seen as the geographical name of a small town with 148 inhabitants). Should this sign not be considered registrable as 'SLAGTER' is, in the sign, used like 'Mr.' and VOLSTED is also a last name in Danish, thus VOLSTED is used as a last name and not as an indication of geographical origin?
- GREATER COPENHAGEN in Classes 9, 16, 35, 36, 39, 41, 42, 43 and 45 (a diffuse area including Copenhagen and the urban areas around). Should this sign not be considered registrable as its geographical scope is diffuse?

Even though traditionally, Denmark and Sweden have similar case law due to the Nordic IP-law collaboration, Sweden is much more lenient than Denmark when it comes to accepting (Swedish) geographical names as trademarks.

Lately, the General Court has outlined the reasons for using geographical origin as a ground for rejection in T-122/17 DEVIN. The judgement concerns the request for a declaration of invalidity of DEVIN for *inter alia mineral water* in Class 32. The Haskovo Chamber of Commerce and Industry (HCCI, Bulgaria) filed the request for a declaration of invalidity of DEVIN and intervened in the case before the General Court.

The General Court outlined the following criteria for using geographical origin as a ground for rejection:

- descriptive signs may be freely used by all traders offering such goods or services;

- geographical names must remain available as they may be an indication of the quality and other characteristics of the categories of goods or services concerned, and may also, in various ways, influence consumer preferences by, for instance, associating the goods or services with a place that may evoke positive feelings;
- the registration of geographical names as trademarks where they designate specified geographical locations which are already **famous**, or are **known** for the category of goods or services concerned, and which are therefore associated with that category in the mind of the relevant class of persons, is excluded;
- geographical names which are **liable to be used** by undertakings and must remain available to such undertakings as indications of the geographical origin of the category of goods or services concerned.

The General Court decided to annul the decision of the Board of Appeal as they concluded that DEVIN had required distinctive character in Bulgaria (on the home market) and is, to a vast majority of the relevant public outside Bulgaria, unknown, and thus DEVIN is not considered a geographical origin by the General Court.

In view of, the DKPTO is taking the criterion **liable to be used** too far when considering diffuse, historical and geographical names used as a last name to be a geographical origin. Hopefully, the Danish case law will soon be in line with the case law from the General Court. Until then, it may be advisable to apply for registration through the EUIPO for Danish geographical names.