

HOLD ON TIGHT Denmark: The importance of obtaining a word mark registration for weak trademarks

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Two sports companies, Sports Group Denmark A/S (“Sports Group”) and WaterNlife ApS (“WaterNlife”) conflicted over the use of ENDURANCE as a trademark for *sports clothing*.

Sports Group had registered the device trademark



However, the trademark was not used as registered. Mostly, Sports Group used the mark in a much simpler and minimalistic version that looked like this:

ENDURANCE

Based on the use of this simple and minimalistic trademark, Sports Group claimed having obtained a trademark right to the word element “ENDURANCE”. In a previous blog post entitled [Denmark: Trademark right established through use](#) it was described that Denmark is most likely the country in Europe where it is easiest

to obtain a trademark right based on use alone.

It is a condition that the trademark right established through use is considered distinctive. Thus, it is not possible to establish a trademark right to purely descriptive or misleading words. This is possible only if, through intensive use of a non-distinctive word, the word has acquired a secondary meaning to the dictionary definitions, and if the general public, when confronted with the trademark, considers it a badge of origin.

Sports Group alleged having obtained a trademark right based on use of the word "ENDURANCE" by the time of WaterNlife's first use in 2016. Thus, in 2019 Sports Group had to prove that, when confronted with ENDURANCE back in 2016, the general public recognised it as a badge of origin for Sports Group. Needless to say, it is very difficult to prove the recognition of a word by the general public three years back.

Sports Group wanted to prevent WaterNlife's use of

DANISH 
ENDURANCE

or similar for *sports clothing and gear*.

After Sports Group's filing of a claim for a preliminary injunction with the Danish Maritime and Commercial High Court (the "Court"), WaterNlife filed a trademark application for the word ENDURANCE for *sports clothing* in Class 25 with the Danish Patent and Trademark Office (the "DKPTO"). The application was rejected as the DKPTO found the mark descriptive for *sports clothing*.

To substantiate Sports Group's claim to have acquired distinctive character through use of ENDURANCE, they submitted turnover figures (app. DKK 330.000.000 over seven years), marketing material, proof of participation in fashion fairs and the like. Additionally, Sports Group submitted a market survey and a statement from the trade organisation for sport (Sports Group is a member of the trade organisation, and WaterNlife is not ...). The market survey concluded, *inter alia*, that only 11% of the general public when confronted with "ENDURANCE" (in capital letters) recognised it as a trademark for *sports clothing*, whereas 22% of the general public recognised the dictionary meaning of "endurance" as physical

stamina or the ability to withstand wear and tear.

The Court dismissed Sports Group's claim for WaterNlife to stop using DANISH ENDURANCE / ENDURANCE for, *inter alia*, *sports clothing and gear*. Furthermore, WaterNlife did not have to recall all products labelled DANISH ENDURANCE / ENDURANCE from the market. The Court dismissed Sports Group's claim, finding that Sports Group had failed to prove that, at the time of WaterNlife's first use of DANISH ENDURANCE / ENDURANCE in 2016, Sports Group had established a trademark right to the word "endurance" for *sports clothing and gear*. Sports Group were ordered to pay costs of DKK 30,000 to WaterNlife.

If, prior to instituting legal proceedings, Sports Group had done their "homework" by timely filing an application with the DKPTO for trademark registration of ENDURANCE (word) by claiming acquired distinctive character through use, the outcome of the proceedings might have been different - or no proceedings might have been required at all.