

Kluwer Trademark Blog

CREAM is that a colour? Distinctive character acquired through use

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In Denmark – as in the EU – it is possible to overcome an absolute ground for refusal based on non-distinctive character of the mark applied for if the applicant is able to provide proof that the mark applied for has acquired distinctive character through use prior to the application date, see Article 7(3) EUTMR (or the Danish equivalent, section 3(3) of the Danish Trademarks Act).

In general, a trademark is considered to have acquired distinctive character when the mark applied for is known by the relevant public as a sign of origin/business identifier for the applicant's goods/services within the relevant territory.

When the trademark consists exclusively of ordinary, descriptive words is refused, the applicant must provide proof that the descriptive words have acquired a secondary meaning through long-lasting and intensive use. The extent of use must be such that when the relevant public is confronted with the mark, the goods/services of the applicant immediately spring to mind.

In a recent decision (case number BS-1448/2016-SHR) from the Danish Maritime and Commercial High Court (the "Court"), the Court confirmed the decisions from the Danish Patent and Trademark Office (the "DKPTO") and the Danish Board of Appeal regarding the, *per se*, non-distinctive and descriptive trademark CREAM for, *inter alia*, clothing in Class 25. All instances found that CREAM could describe the colour of the clothes. The applicant tried to overcome the absolute ground for refusal by filing evidence of distinctive character acquired through use. The evidence was rejected as insufficient.

In general, to acquire distinctiveness for a trademark which is, *per se*, non-distinctive, the applicant needs to provide evidence showing that, when confronted with the mark for goods/services, the relevant public no longer perceives the mark as having only the descriptive meaning, but also as a business identifier for the applicant. In other words, the mark must be associated with the applicant and not the dictionary meaning.

The evidence of acquired distinctive character must consist of indications concerning the place, time, extent and nature of use of the trademark applied for (as is the case for evidence of reputation). For example, evidence may consist of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements and articles, and sworn or affirmed statements. In Denmark, affidavits confirming use of the mark are generally considered insufficient if the "facts" stated in the affidavit are not supported by evidence

from third parties or public facts (e.g. financial statements). In contrast, declarations from the relevant trade organisation are useful and considered trustworthy by, *inter alia*, the DKPTO.

– Nature of use

The evidence submitted must prove public use (not internal use) and may consist of both commercial and promotional activities. However, it is important to remember that evidence of promotional activities must be accompanied by a list of recipients. The evidence of acquired distinctive character must also show for which goods/services the mark is in use.

– Place of use

The place of use is Denmark (including Greenland and the Faroe Islands). The use must be widespread and not limited to only one or a few towns or cities in Denmark. Generally, evidence showing use of the mark in neighbouring countries or registration of the mark internationally will not assist in the registration of the mark.

– Time of use

The evidence must predate the application date to be considered. Consequently, evidence from the internet must be printed prior to filing the application (to be on the safe side) unless the evidence is otherwise (pre)dated.

– Extent of use (use of each of the goods mentioned in the specification of goods/use of part of them)

It has to be evaluated whether, in view of the market situation in the particular industry or trade concerned, it can be deduced from the material submitted that the relevant public associates the mark with the applicant and not with the dictionary meaning.

– Use by the owner or on its behalf

Use of the mark must be made by the applicant or with the consent of the applicant.

Unfortunately for the applicant of CREAM, the stream of bad luck continued as the owner's EU-registration No. 487637 for CREAM (registered for *clothing for women* in Class 25) was invalidated due to lack of distinctive character on the day after the Court decision cited above.

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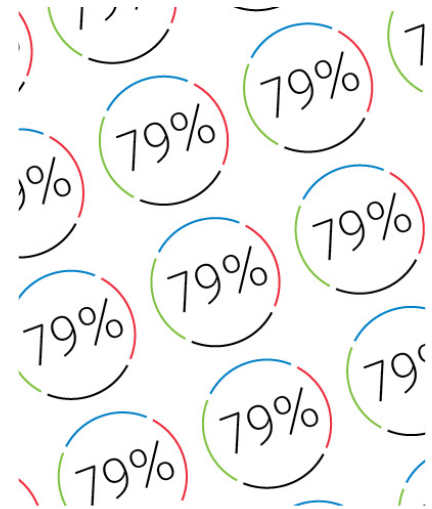
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