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Sune Stampe Sørensen
Director General
Patent- og Varemærkestyrelsen
Helgeshøj Allé 81
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Via e-mail to Sune Stampe Sørensen SSO@dkpto.dk;
Cc Keld N. Jensen knj@dkpto.dk; Anne N. Johansen ajo@dkpto.dk;
sva@dkpto.dk

Re: Comments on the planned amendments of the Danish Trademark Act

Dear Director General Sune Stampe Sørensen,

The International Trademark Association (INTA) appreciates the opportunity to provide input on the Draft Amendment of the Danish Trademark Act, following the consultation launched by the Danish Patent and Trademark Office (“Danish PTO”).

INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. INTA’s members are more than 7,200 organizations from 191 countries, including 36 in Denmark. The Association’s member organizations represent some 31,000 trademark professionals and include brand owners from major corporations as well as small and medium-sized enterprises, law firms and nonprofits. There are also government agency members as well as individual professor and student members. Further information about our Association can be found at www.inta.org.

INTA has been engaged from the very beginning of the reform of the EU trademark system and respectfully submits the following comments on the draft amendments which aim to implement Directive (EU) 2015/2436 of 16 December 2015 (the “Directive” or “TMD”) into Danish law, i.e. into the Danish Trademark Act (“DTA”).

1) The wording and definition of rights in §1a (3) and §1a (4) (“Scope of the DTA/Definitions”)

Following the wording of Article 1 of the Directive, the DTA introduces a new term in §1a, namely "*individual mark*", which is a form of subcategory for trademarks. It makes the terminology and hierarchy between trademarks and other types of marks confusing.

INTA therefore suggests that it's made clear that guarantee marks, certification marks, collective marks and marks acquired through use are all subcategories of trademarks.

2) Trademarks acquired through use

The DTA still acknowledges trademark rights acquired through use and therefore, still acknowledges a "*first to use principle*" in Denmark, which INTA applauds.

However, the wording used, namely, "*more than local significance*" in § 3(1)(3) (establishment of trademark rights) and § 15 (3)(5 a)) and § 15 (3)(6) and § 15 (3)(8) (obstacles to registration) as well as the term "*locally defined character*" in § 10(3), introduce a previously absent criteria in the assessment of the relevant use of a sign. This change may render the reading of the law more restrictive than the current practice under case law in Denmark.

Under the current Article 3 trademark rights can be acquired through use if a mark has been continuously used in Denmark for specific goods or services. The courts have interpreted that in order to oppose a conflicting registration, the mark must be used to an extent that is of more than local importance (in Danish "*brugen har et omfang, der er mere end af lokal betydning*"). An example of a sign where trademark rights have been acquired through use is "NOMA". NOMA is local to Copenhagen but the importance and knowledge of the mark NOMA is far reaching in Denmark, going beyond Copenhagen.

With the changes to Article 3 DTA and its new paragraph 3, trademark rights may be acquired in Denmark if a sign has been used in the country, for specific goods and services, *and the use has more than local significance* (in Danish, "*mere end lokal betydning*"). INTA is concerned that the addition of such criteria, in its original formulation in Danish, may lead to a more restrictive interpretation of the law by the courts in Denmark.

For these reasons, INTA respectfully requests that the Danish PTO reconsider the wording so that the current practice of granting protection to marks in use is kept. In particular, the proposed new Article 10(3) establishes that a trademark does not entitle its owner to prevent third parties from making commercial use of earlier signs which have only a locally defined character where the earlier sign is used within the limits of the area in which it is recognized. INTA recommends that the term "*locally defined character*" in § 10(3) be replaced by "*the knowledge of the earlier sign is only local*".

In addition, Chapter 1A about "*the conferral of trademark rights*" and, in particular, the rule on protection of well-known marks in §4 (2)(3) contains no reference to rights acquired through use.

INTA respectfully requests that the Danish PTO consider amending the Article to include such rights.

3) Search reports

The draft §11 and §17, respectively on "*application for registration of a trademark*" and "*search reports*", propose that the applicant is entitled to choose between a) a stripped down model, i.e. no search reports or b) a search report similar to the one currently in practice in Denmark or c) a search report with an appraisal/evaluation.

INTA believes that search reports with an appraisal/evaluation would be very similar to an availability search, which cannot be done by only looking at the marks and the goods themselves. In fact, an assessment of whether two trademarks conflict with each other involves not only a mere comparison between the marks and the goods and/or services, but also among others, an assessment of the use of the earlier mark, which is outside the Danish PTO's competence.

Consequently, offering search reports with an appraisal/evaluation can be perceived as an offer to carry out availability searches, and thus may be misleading for businesses, particularly small and medium-sized enterprises (SMEs). Notably, an applicant that, pursuant to the appraisal/evaluation contained in the search report, is convinced that a risk of confusion with a prior mark is not that high, may later learn, during opposition proceedings, that in fact the holder does have valid and enforceable prior rights.

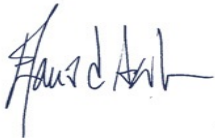
Moreover, INTA is concerned that requiring the Danish PTO to provide evaluations of risk of confusion between signs may cast doubts on its impartiality and ultimately results in legal uncertainty. INTA therefore recommends that §11(2) is deleted.

4) § 20 regarding "suspension as a result of negotiation"

INTA welcomes the introduction, in §20, of the possibility to suspend opposition proceedings where the parties so request. In that sense, we recommend that a similar rule be introduced as concerns administrative revocations.

INTA stands ready to support the Danish PTO in its efforts towards the implementation of the EU trademark reform. We hope you will find our comments useful. Should you wish to further discuss any of the points we have raised or additional issues, please contact H  l  ne Nicora, Chief Representative Officer-Europe at hnicora@inta.org and Carolina Oliveira, INTA Policy Officer - Europe at coliveira@inta.org.

Sincerely yours,

A handwritten signature in blue ink, appearing to read "Etienne Sanz de Acedo". The signature is fluid and cursive, with a long horizontal stroke at the end.

Etienne Sanz de Acedo
Chief Executive Officer
International Trademark Association