

November 14, 2018

Sune Stampe Sørensen  
Director General  
Patent- og Varemærkestyrelsen  
Helgeshøj Allé 81  
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Denmark

*Via e-mail to Sune Stampe Sørensen SSO@dkpto.dk; Cc Anne Rejnhold Jørgensen ARJ@dkpto.dk; Anne N. Johansen ajo@dkpto.dk; svar@dkpto.dk*

**Re: Comments on Danish draft Implementing Regulation**

Dear Director General Stampe Sørensen,

The International Trademark Association (INTA) appreciates the opportunity to provide input on the "*Bekendtgørelse om ansøgning og registrering mv. af varemærker*", i.e. the draft statutory instrument on application, registration, etc., of trademarks (the "Implementing Regulation")

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](http://www.inta.org).

In July 2017, INTA submitted comments on the draft amendments aiming 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"). INTA respectfully submits the following comments on the draft Implementing Regulation which aims to implement the DTA as amended by the Directive.

**1) Wording and definition of rights in Article 2 (1), (1)**

In line with the draft DTA as amended by the Directive, Article 2 (1), (1) of the Implementing Regulation refers to the terms "*individual trademark*", whereas no definition of "trademark" is

provided. As noted in our comments to the amendments to the DTA, we believe this may create confusion and uncertainty for Danish users.

INTA recommends that a definition of “trademark” be provided and that it is clarified that individual trademarks, guarantee marks, certification marks, collective marks and marks acquired through use are all subcategories of trademarks.

We understand that the expression “*individual trademark*” is used in the Directive which also does not include a definition of “trademark”. In this context, if, in order to properly follow the Directive and its implementation, the Implementing Regulation cannot be modified, we suggest that the Danish IP Office (the “IPO” or the “Office”) issues guidelines clarifying these terms.

## **2) Search reports, Article 2 (4)**

Under Article 2(4) of the Implementing Regulation, the option of receiving a search report is selected (and paid for) by default with a trademark application. In order to opt out of the search report option, the application must (1) be filed electronically and (2) include a list of goods and services using pre-approved terms.

INTA believes that this rule entails an unnecessary burden for applicants who should be free to choose whether or not they wish to receive a search report. In fact, many businesses in Denmark use their own list of goods and services and applicants relying on such lists should not be forced to select and pay for a search report. Moreover, it could make more sense that a search report is only provided where the submitted list of goods and services is acceptable.

In the context of the EU Trademark Reform, INTA opposed the mandatory search in the EUTM (at the time CTM) register which we believe has proven to be of very limited effectiveness, efficiency and added-value for users. In fact, it appears that in the great majority of cases, clients carry out availability searches before filing so that at the time of filing they are already aware of potential obstacles. Experience also shows that, even where prior availability searches are not conducted, it is only seldom that the applicant decides to withdraw or limit an application further to the notification of the mandatory search. Finally, reports to trademark owners of a potential conflicting trademark filing also seldom led to the filing of an opposition.

At the time, INTA also noted that various companies already provide for pre-filing or qualified search reports. As stated then, in our view, it is not the role of the EUIPO, which is the competent body for granting EUTM rights, to assess the relevance of hits in search reports. Indeed, providing such legal consultancy services can lead to conflicting situations when the EUIPO further takes the role of examining the EUTM applications for relative grounds, which is not acceptable.

Moreover, in that occasion, INTA recommended that should searches in the EUTM register be maintained, we believe that it would be more appropriate to clarify that: “*No search among EU*

*Trade Marks will be made unless specifically instructed by the applicant otherwise at the time of filing”.*

As stated then, we believe that it would be better for applicants if they were able to OPT IN to such searches, rather than having to expressly opt out. An opt-in system as suggested would allow applicants who wish to receive such search reports to do so.

Such position and reasoning can be applied *mutatis mutandis* to search reports issued by the Danish IPO. Therefore, we recommend that the rule under Article 2(4) of the Implementing Regulation is reversed so that a search report is only issued where the applicant so requests.

### **3) Indicating type of mark in international registrations, Article 15 (2)**

According to this provision, where international registrations designating Denmark are concerned, the Office will determine *ex officio* the type of mark applied for on behalf of the applicant.

INTA recommends that the rules regarding indication of the type of mark in international registrations designating Denmark are aligned with those applicable to national registrations (Article 3 of the Implementing Regulation). Notably, where the applicant has not indicated a type of mark or has indicated an incorrect type of mark, it should be granted with the opportunity of amending his application. This seems to be the practice followed by the Office for national registrations, which we applaud and hope will continue. We recommend that this practice is applied consistently to national and international registrations.

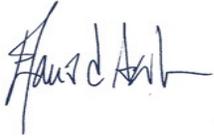
### **4) Filings and correspondence with the Office in English, Articles 7 and 46**

Article 7 and Article 46 of the draft Implementing Regulation confirm the current practice of the Danish IPO allowing applicants and foreign representatives to submit their filings and correspond with the Office in English.

INTA applauds this practice as it allows foreign applicants and trademark holders as well as Danish businesses operating in English to smoothly correspond with the Office. We welcome the recognition of this practice in the law in the interest of increased legal certainty for all users.

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  lene Nicora, Chief Representative Officer-Europe at [hnicora@inta.org](mailto:hnicora@inta.org) and Carolina Oliveira, INTA Policy Officer - Europe at [coliveira@inta.org](mailto:coliveira@inta.org).

Sincerely yours,

A handwritten signature in black ink, appearing to read "Etienne Sanz de Acedo". The signature is fluid and cursive, with the first name "Etienne" being the most prominent part.

Etienne Sanz de Acedo  
Chief Executive Officer  
International Trademark Association