



# Trademarks

in 42 jurisdictions worldwide

Contributing editors: Joseph Nicholson and Stuart Sinder

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# Denmark

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## 1 Ownership of marks

Who may apply?

As an introductory remark, it must be noted that all matters relating to Danish trademarks are regulated by the Danish Act on Trademarks (the Trademarks Act). No references are made here to the European Community Trademark Regulation.

According to the Trademarks Act, private persons and legal entities may apply for a trademark in Denmark. The Trademarks Act contains no requirements regarding the activities of such trademark-holders, hereunder whether the trademark-holder is engaged in commercial activities.

An application form may be downloaded from the Danish Patent and Trademark Office's website ([www.dkpto.dk](http://www.dkpto.dk)) and may be submitted in the Danish, English, Swedish and Norwegian languages. However the list of goods and services must be submitted or translated into Danish.

A trademark application must contain the following information for recognition at the Danish Patent and Trademark Office:

- the applicant's name and postal address;
- the name and address of any representative (representation is not required);
- representation of the mark; and
- a list of goods and services divided into classes (see question 4).

If these formal requirements are met an application number will be granted.

Please note that the Trademarks Act does not apply to collective marks – that is, trademarks that are meant to be used by particulars other than the trademark-holder, for example, members of an organisation. Instead the Danish Act on Collective Marks applies. The Collective Marks Act is not subject to this article. It is worth noting however, that the Act on Collective Marks makes reference to a waste majority of the Trademark Acts provisions, hereunder to the administrative rules regarding applications.

## 2 Scope of trademark

What may and may not be protected and registered as a trademark?

According to the Trademarks Act the definition of a trademark is 'particular characteristics for goods and services, which are used or meant to be used in a business'.

All types of signs are eligible for protection under the scope of the Trademarks Act, including but not limited to words, word combinations, slogans, letters, numbers, personal names, company names, building names, figures, representations, pictures, illustrations, shapes of goods, gear, wrappings, holograms, sounds, smells and colours.

To be decided is whether the sign is or will be used for commercial purposes and whether the sign is distinctive.

The scope of 'commercial purposes' is very broad. This means, for example, that non-profit organisations might also be considered as engaged in activities having a 'commercial purpose'.

A sign is considered distinctive if the sign is suitable for distinguishing one party's goods and services from the goods and services of another party.

A sign lacks distinctiveness if the sign is descriptive, for example, if the sign consists purely of elements that serve as common terms for the species, characteristics, amount, quality, condition, value, geographical orientation or other characteristics of the goods or services that the sign is meant to be used for, or if the sign, in common vocabulary or marketing practices, serves as the common term for the goods or services at hand.

A sign lacking distinctiveness may acquire such in relation to particular goods or services, or both, through intensive and persistent use as a sign for such goods and services.

## 3 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration?

Following the Danish Patent and Trademark Office's receipt of the application fee (currently 2,350 kroner covering three classes and 600 kroner per class exceeding three), the Office examines whether the sign:

- lacks distinctiveness;
- is misleading;
- is in breach of public order, law and decency;
- contains official or public symbols;
- is identical or confusingly similar to registered trademarks;
- is identical or contains names of registered companies;
- is identical or contains protected family names; or
- is breaching the copyrights of a third party.

In the event of breach of public order, law or decency, if the mark is misleading or contains signs, symbols, escutcheons or flags in the public domain, or if the mark lacks distinctiveness, the Danish Patent and Trademark Office informs the applicant of such barriers and encourages the applicant to alter the mark or show acquired distinctiveness, as the case may be. If the applicant should choose not to do so within a specific deadline, the application is denied by the Danish Patent and Trademark Office.

In all other circumstances, the applicant is notified of the examination results and granted a preliminary trademark right, which is published in the Danish Trademark Bulletin. No publication or registration fee is charged.

The application process and length varies depending on – among other things – the caseload of the Danish Patent and Trademark Office, the recognition of the formal requirements (see question 1), encouragements made by the Patent and Trademark Office and potential third-party oppositions.

If the formal requirements are met and the Danish Patent and Trademark Office does not request further documentation, a preliminary registration is most likely to be granted within two months following the filing date.

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#### 4 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed?

The Nice Classification System is used in Denmark; it undergoes continuous changes and alterations of the goods and services being included.

The latest (ninth) version of the Nice Classification System may be found on the World Intellectual Property Organization (WIPO) website ([www.wipo.int](http://www.wipo.int)).

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#### 5 Conflicts with other trademarks

Are applications examined for potential conflicts with other trademarks? What is the procedure followed by the Trademark Office?

The Danish Patent and Trademark Office examines whether identical or confusingly similar trademarks exist and provides the result to the applicant in a search report.

The examination is performed based on available databases, for example, the database of the Danish Patent and Trademark Office ([www.dkpto.dk](http://www.dkpto.dk)), Statistics Denmark ([www.dst.dk](http://www.dst.dk)), the Central Business register ([www.cvr.dk](http://www.cvr.dk)), dictionaries, etc.

However the examination is for information purposes only.

The search report does not influence the decision of the Danish Patent and Trademark Office. Instead it is for the applicant to decide whether to withdraw the application or request a preliminary registration of the trademark. If the applicant decides to request a preliminary registration, third parties have a two-month period following the publication date of the preliminary registration to oppose the registration.

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#### 6 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a challenge on grounds of non-use?

No use and proof of use of a mark is required prior to registration in Denmark.

The trademark-holder is obliged to initiate use of the mark within five years following the registration date in order to avoid revocation or co-existence claimed by a third party.

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#### 7 Appealing a denied application

Is there an appeal process if the application is denied?

An application is denied, if the sign:

- is in breach of law, public order or decency;
- is misleading;
- contains signs, symbols, flags or escutcheons in the public domain; or
- lacks distinctiveness and the applicant has been unable to correct such barriers to registration.

An applicant may appeal such a decision to the Danish Patent and Trademark Appeal Board within two months following the date on which the applicant was informed of the decision.

An appeal writ must contain information regarding the decision made by the Danish Patent and Trademark Office, the claims of the claimant and documentation substantiating the appeal. A fee (currently 4,000 kroner) must follow the appeal writ.

An applicant may not initiate court proceedings prior to the Appeal Board delivering its decision.

The Appeal Board decision may subsequently be brought before the Maritime and Commercial Court within two months following the delivery of the decision.

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#### 8 Third-party opposition

May a third party oppose registration, or seek cancellation of a trademark or service mark? What are the primary bases of such challenges, and what are the procedures?

If the basic requirements in the Trademarks Act are met, the applicant is granted a preliminary registration.

During the following two-month period a third party has the right to oppose the registration upon payment of a fee (currently 2,500 kroner). The opposition must be submitted to the Danish Patent and Trademark Office, which informs the trademark-holder of such initiated proceedings and encourages the trademark-holder to submit comments and relevant additional documentation prior to the Danish Patent and Trademark Office delivering its final decision.

Primary bases of such third-party oppositions are the applicant trademark being:

- identical or confusingly similar to already existing trademarks;
- identical or containing names of registered companies;
- identical or containing protected family names; or
- breaches the copyrights of a third party.

A decision delivered by the Danish Patent and Trademark Office on the grounds of a third-party opposition may be appealed to the Danish Patent and Trademark Appeal Board within two months from the delivery of such decision. The appeal writ must contain information regarding the decision delivered by the Danish Patent and Trademark Office, the claims of the opponent, as well as documentation substantiating the appeal. A fee (currently 4,000 kroner) must follow the appeal writ.

Court proceedings may not be initiated prior to the Appeal Board delivering its decision. In a period of two months following the Appeal Board's decision, the parties to the procedure may appeal the decision to the Maritime and Commercial Court.

If no third party opposes the preliminary registration of a trademark within two months following the publication of the preliminary registration, this preliminary registration is converted into a final registration. In the event of a final trademark registration, a third party may request a cancellation of the trademark to the Danish Patent and Trademark Office or initiate cancellation proceedings with the Maritime and Commercial Court or the local city courts. There are no time bars for initiating such cancellation proceedings.

Primary grounds for such cancellation proceedings are:

- identical or confusingly similar prior trademarks, registered companies, protected family names;
- breach of the copyrights of a third party;
- lack of distinctiveness; or
- lack of use in a five-year period.

The Danish Patent and Trademark Office must refrain from initiating cancellation proceedings in the event cancellation proceedings have already been initiated with the Maritime and Commercial Court or the local city court.

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#### 9 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration?

A trademark registration in Denmark is indefinite upon payment of renewal fees every tenth year (currently 2,350 kroner covering three classes and 600 kroner for each class exceeding three).

The Danish Patent and Trademark Office notifies the trademark-holder prior to the lapse of a 10-year period.

**10 The benefits of registration**

What are the benefits of registration?

A trademark right is established in Denmark by either registration or use. The substantive rules in Danish trademark law do not distinguish between these two reasons of establishment, which means equal rights for trademark-holders regardless of registration or use grounds.

However a difference is made in regard to burden of proof and documentation needs.

A presumption is thus made from the information available in the Danish Patent and Trademark Office's registration database ([www.dkpto.dk](http://www.dkpto.dk)) in regard to the existence of a trademark right for particular goods and services, priority date, the validity and the rightholder. Such presumption cannot be made in regard to trademarks based on use. And a trademark-holder of a trademark established by use is thus to prove his or her right by delivering and submitting substantiating material and documentation, if the said trademark right is contested by a potential infringing third party (see question 18).

**11 Assignment**

What can be assigned?

An assignment of a trademark is considered an agreement between two independent parties, which, due to the Danish legal principles on contractual freedom, gives the parties the right to freely agree on, for example, a partial assignment with regard to specific goods or services, geographical areas, goodwill, other intellectual property assets, etc.

**12 Assignment documentation**

What documents are required for assignment and what form must they take?

The assignment is a bilateral agreement and does not need to meet any formal requirements, content, notarisation, etc.

However, due to the burden of proof, it is recommended to draft and sign an agreement containing information regarding the parties, the trademark at hand (including registration number), a representation of the trademark, classification, geographical areas and goods and services, in order to establish the scope of the assignment.

A template regarding assignment is found on the Danish Patent and Trademark Office's website ([www.dkpto.dk](http://www.dkpto.dk)).

**13 Validity of assignment**

Must the assignment be recorded for purposes of its validity?

An assignment becomes valid when agreed by the trademark-holder and the assignee regardless of form. If the trademark right has been registered in the Danish Patent and Trademark Office's database ([www.dkpto.dk](http://www.dkpto.dk)), the parties need, however, to notify the Danish Patent and Trademark Office of the assignment in order for the Danish Patent and Trademark Office to change the registered information regarding the rightholder.

A template regarding assignment may be found on the Danish Patent and Trademark Office's website ([www.dkpto.dk](http://www.dkpto.dk)).

**14 Security interests**

Are security interests recognised and what form must they take?

Security interests are recognised in Danish trademark law with regard to registered trademarks.

It is a condition to secure the interest of the mortgagee that the Danish Patent and Trademark Office and the Danish Register of Chattel Mortgages are notified of and register such security interest.

**15 Markings**

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

It is not a requirement in Denmark to use specific words or symbols as an indication of trademark use or registration such as '®', 'registered trademark', 'TM', etc. However, due to the risk of dilution (for example, with regard to trademarks being available in encyclopaedias and dictionaries), it is recommended to add relevant symbols in connection with the use of the trademark. Furthermore, the addition of such symbols may influence the evaluation of a third party's possible wilful or negligent misconduct when determining the liability obligation, including the obligation to pay damages owing to unlawful use of a trademark.

**16 Trademark enforcement proceedings**

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

The following types of actions are available to a trademark-holder if a third party is believed to infringe the exclusive right of a trademark-holder or if it is anticipated that such third party will infringe the trademark rights of a proprietor:

- border enforcement – administered by the local tax authorities (see question 20);
- seizure of goods – administered by the local bailiff's courts and local tax authorities (see questions 20 and 21);
- discovery – administered by the local bailiff's court (see question 21);
- preliminary injunctions – administered by the local bailiff's courts (see question 17); and
- infringement proceedings – administered by the local city courts or the Maritime and Commercial Court (see question 17).

In addition, the following falls under public prosecution:

- trademark infringements, if the activities are particularly abusive, for example, in the event of piracy with respect to valuable products or substantial profits (see question 19).

The local city and bailiff's courts do not have any particular – if any – experience with trademark matters, whereas the Maritime and Commercial Court may be seen as a de facto specialised court. Thus it is recommended to initiate the proceedings at the Maritime and Commercial Court in the event of freedom to choose, unless substantial reasons regarding, for example, the trademark-holder, suggest the opposite.

**17 Procedural format and timing**

What is the format of the infringement proceeding?

The format and strategy regarding a third party's alleged unlawful activities must be decided – among others – on the necessity of a fast process and decision, the sums allocated by the trademark-holder and documentation in the hands of the trademark-holder.

If it is probable that a third party has or will infringe the rights of a trademark-holder, and if it is probable that proof of such unlawful activities are to be found in particular locations, the local bailiff's court may decide on a discovery and later seizure of the goods, which are to be used in later infringement proceedings (see question 21).

If the proprietor has an immediate interest that cannot await a decision by the local city court or the Maritime and Commercial Court in an ordinary infringement proceeding, the trademark-holder may initiate

preliminary injunction proceedings at the local bailiff's court (see question 26). Preliminary injunction proceedings are typically concluded with an oral hearing (as in an ordinary infringement proceeding) and the decision is often delivered by a junior judge with no particular knowledge in trademark matters. However, the process is faster and a decision can thus be delivered within hours if strictly necessary.

With a few minor exceptions, the same procedural rules apply to preliminary injunction proceedings as to main trademark infringement proceedings. Thus the parties are allowed to be heard, call witnesses, and submit documentation substantiating their claims, expert opinions, etc.

The procedural rules regarding preliminary injunction proceedings do, however, differ from the procedural rules regarding main infringement proceedings in the following important aspects:

- an extended right to submit expert opinions, which have been collected unilaterally, is given; and
- a less strict burden of proof on the trademark-holder applies. The trademark-holder thus only needs to show probability of a trademark infringement.

Due to this less strict burden of proof, the trademark-holder is obliged to initiate court proceedings at the local city court or the Maritime and Commercial Court claiming confirmation of the issued preliminary injunction within two weeks of the bailiff's court's decision.

Preliminary injunction proceedings are thus in fact a two-step procedural process, which require – among other things – allocation of substantial resources from the proprietor, but on the other hand gives a possibility for fast and effective enforcement of the trademark-holder's rights.

If a preliminary injunction is unlikely to be granted (for example, owing to the legal requirements of balance-of-interest and immediate interest) or if a trademark-holder is uninterested or unable to allocate the necessary and required economic resources to a two-step procedural process, a trademark-holder may choose to initiate ordinary trademark infringement proceedings at the local city court or the Maritime and Commercial Court.

In aggravated and exacerbated circumstances, the public prosecutor may, following the request of a proprietor, initiate criminal proceedings against the alleged infringing party.

#### 18 Burden of proof

What is the burden of proof to establish infringement or dilution?

The burden of proof lies on the trademark-holder. It is thus for the trademark-holder to prove that a third party is involved in unlawful activities infringing the trademark-holder's right. During preliminary injunction proceedings, it suffices that the trademark-holder shows probability.

The burden of proof shifts in the event of pleaded dilution of the trademark. It is thus for the potential infringing third party to establish such dilution.

#### 19 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

A trademark-holder – or if agreed between the trademark-holder and the licensee, a licensee – is entitled to claim damages and compensation owing to wilful or negligent misconduct of a third party in proceedings following an issued preliminary injunction, in infringement proceedings or in a separate lawsuit following an infringement proceeding.

Damages claims include, among other things, lost profit, market disturbance and unjust profit caused by the infringing activities of the third party, whereas compensation includes additional harm and non-economic losses.

#### Update and trends

Trademark-holders need to take careful consideration prior to seeking a preliminary injunction as to whether the trademark-holder will be able to provide a security in the event the local bailiff's court should decide to require such a security prior to issuing a preliminary injunction (which they normally do). It is thus established in two recent decisions made by the Danish Supreme Court and the Western High Court in Denmark that as the proprietors were unable or unwilling (or both) to provide the required security, preliminary injunctions were not issued with the effect that the proprietors had to recover the estimated costs of the defendants.

In aggravated and exacerbated circumstances, the public prosecutor may – following the request of a trademark-holder (or licensee) – initiate criminal proceedings against the alleged trademark infringing party.

Please see question 26.

#### 20 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

Activities taking place outside Denmark do not influence the evaluation of an alleged infringing activity within the borders of Denmark.

However it should be noted that a trademark-holder, according to the European Community Regulation No. 1383/2003, may request the assistance of the tax authorities to seize imported goods believed to infringe the trademark-holders' exclusive rights.

#### 21 Discovery

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

A trademark-holder is entitled to request the assistance of the local bailiff's court in initiating and organising a discovery at the alleged infringing party's business or private address. It is a requirement that the trademark-holder submits a request to the bailiff's court substantiating the probability of a trademark infringement taking place or expected to take place, and establishing that there are reasons to believe that documentation or proof of this alleged infringement may be found at the alleged infringing party's address.

Discovery is not decided by the bailiff's court in the event of imbalance of interest, for example, the right to privacy, trade secrets, etc. If discovery is decided, the trademark-holder is obliged to initiate court proceedings regarding the alleged infringing activities within four weeks from the bailiff's court's notification of the discovery's finalisation.

During the course of discovery the bailiff's court may decide to seize effects such as products and documents, found to be necessary in serving as documentation and proof of the infringing activities.

In addition, a trademark-holder is entitled during the course of infringement proceedings to request a court order claiming an obligation on the potential infringing third party to provide specific information concerning manufacturers, distributors, retailers, products, amounts, prices, etc. Such requests must contain an outline of the information needed and reasons relating thereto.

#### 22 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

All proceedings vary in length depending on the pressure and workload of the courts, the complexity of the facts and legal questions raised, the

documentation needed, procedural difficulties, appeal, etc.

However, preliminary injunction proceedings are typically decided within three to nine months, whereas infringement and dilution proceedings are decided within 18 to 24 months.

Appeal proceedings roughly last as long as first-instance proceedings.

### 23 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The litigation costs vary and depend, among other things, on the documentation needed, witness statements and expert opinions required, translation costs, marketing reports, market surveys, formal difficulties raised and decided in separated proceedings, etc, and whether the proprietor seeks discovery, seizure or preliminary injunction, or a combination of the above, prior to initiating infringement proceedings.

However, a trademark-holder must expect costs of not less than 100,000 kroner for a straightforward first-instance trademark infringement case. The costs in relation to possible appeal proceedings will be roughly within the same range.

The courts impose costs on the losing party. Costs are decided as an estimate based on the value of the case, time spent, the number of court days, and expenditure regarding expert opinions, witnesses, etc. However the tendency in case law shows an unlikely success to recover all costs upheld in connection with preparation and participation in proceedings.

### 24 Appeals

What avenues of appeal are available?

Decisions delivered by the local bailiff's courts and the local city courts may be appealed to the High Court. A decision delivered by the High Court may be appealed to the Danish Supreme Court but only upon prior approval of the Appeals Permission Board. Such approval is rare and requires reasons of fundamental legal importance.

Decisions delivered by the Maritime and Commercial Court may be appealed to the Danish Supreme Court.

### 25 Defences

What defences are available to a charge of infringement or dilution, or any related action?

The following main defences are available in infringement or dilution proceedings:

- invalidity;
- non-infringement;

- co-existence;
- lack of use;
- dilution; and
- non-action.

### 26 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

A trademark-holder (or licensee) is entitled to damages for lost profits, market disturbance, unjust profits and any additional harm caused by the infringing activities of a third party. The amount awarded is based on information obtained, for example, in a discovery action, publicly available annual reports, lost licence fees, lost sales, etc.

In addition a trademark-holder may request compensation for non-economic loss, for example, owing to loss of goodwill, and request the seizure and destruction of the infringing goods (see question 21).

Injunctive relief (preliminary) is available as an important sanction in trademark infringement matters (see question 17) and may be issued if the following basic requirements are met:

- the proprietor proves or makes it probable that a third party is infringing the proprietor's trademark;
- the infringing use of the trademark is pending or preparations for such use have been initiated; and
- it is considered necessary in order to efficiently enforce the claimed trademark, which cannot await the outcome of an ordinary court proceeding.

Criminal remedies also exist. Thus an infringing party may be sentenced to a maximum of six years imprisonment if the party wilfully and under aggravated or exacerbated circumstances infringes a trademark-holder's right.

### 27 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Alternative dispute resolution techniques, such as mediation and court-based mediation, are not expressly mentioned in the Trademarks Act. The techniques are, however, available under the Laws of Denmark. This means the use of ADR is conditioned on the parties agreeing to do so. ADR techniques have – until now – rarely been used in relation to trademark disputes.

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