

# CHANGES TO TRADEMARK PROCEEDINGS

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Where a party involved in trademark oppositions or nullifications requests an extension of time to complete negotiations and where a mutual agreement is deemed possible, the Danish Patent and Trademarks Office (DKPTO) will no longer obtain consent from the other party. Instead, if the other party disagrees that negotiations are pending, it must object.

The duration of an extension has also been increased from two months to six months. Where agreement is reached prior to the end of the extended deadline, the parties involved must give the DKPTO notice to resume prosecution of the case based on the terms of the agreement. If the DKPTO is not notified within six months and one of the parties confirms that negotiations are still pending, a further six-month extension of term will be granted.

The change to the procedure acknowledges that communications between parties in disputes of this nature can rarely be completed within two months, especially if the parties are from different countries or must follow time-consuming internal communication routes in order to mutually accept the terms of an agreement.

The DKPTO has also changed the assessment principles it uses with regard to evidence provided in cases involving oppositions and nullifications. The aim of this change is to facilitate implementation of the DKPTO's procedures and allow it to reach decisions faster.

In most cases, the DKPTO will no longer make initial assessments of the quality of evidence provided by a party and invite the party to provide further material if the evidence is considered inadequate to prove the case. Instead, the evidence provided will be assessed as part of the decision-making process. Exceptions to this new strategy may be made if the DKPTO deems these necessary due to legislation or considers it expedient.

Pending oppositions and nullifications will be treated according to the new guidelines.

## Geographical origins

Previously, an application for a trademark in Denmark could be refused if the trademark included an indication of a geographical location and some of the claimed goods were commonly known to originate from said location. In such cases and if the applicant was from a country other than the country of the geographical location indicated, the DKPTO would deem the trademark misleading with respect to the origin of the goods. But from now on, the DKPTO will not consider the applicant's address as decisive when assessing whether the nature and geographical origin of the claimed goods and services are misleading.

In other words, an application for a trademark that includes a geographical location may be refused if the actual origin of any of the claimed goods is different to the geographical origin of the goods or services as specified in the application.

To help applicants understand these new rules, the DKPTO has provided the following example.

A Danish applicant can legitimately register a trademark that includes the text '*Produit de France*' for cheese, as long as the trademark is only used for cheese made in France, as this will not mislead the customer.

If, however, *Produit de France* is to be applied to Swiss, French and Dutch cheese, the trademark would be partly refused, because it would be misleading with regard to the Swiss and Dutch cheese. If the phrase was used in relation to Swiss cheese solely, the trademark would be refused in its entirety.

In February 2009, the Board of Appeal confirmed a decision by the DKPTO to partly reject the word mark 'Jurakalk'. One of the main reasons contributing to the rejection was that Jurakalk was considered descriptive of limestone from the Jura or the Jurassic period. Thus, the trademark was rejected for part of the goods, which included a variety of lime-based building materials, being descriptive of the indicated geographical origin of the Jura.

The word Jurakalk was also considered misleading in relation to asphalt and tar products. In line with the new guidelines, Jurakalk was maintained for goods in Class 37 not closely related to limestone, asphalt and tar. Both the DKPTO and the Board of Appeal considered the argument that Jurakalk was a well-known trademark, but both found the evidence in support of this insufficient to allow registration.

The applicant has now lodged an appeal at the Maritime and Commercial Court in a last attempt to register Jurakalk as a word mark.

## Classification of software

In line with the intentions of the WIPO, the DKPTO will no longer require the specification of software in Class 9. The DKPTO stills deems unclear the description of software in the goods category "not-downloadable software"; however, the description of software in the service category "placing software to online disposal", or similar designation, is acceptable.

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