

Trademark Opposition Procedures

The Danish Trade Marks Act section 23 (1)

When the registration has been published, opposition may be filed against the validity of the registration. The opposition, which shall be reasoned, shall be filed with the Patent and Trademark Office within two months from the date of publication. A fee, the amount of which shall be fixed by the Minister of Trade and Commerce, shall accompany the opposition.

Who may file a notice of opposition?

In principle, anyone has the right to file a notice of opposition against the validity of a registered trademark. Thus the opponent is not required to document a legal interest in the case, (i.e. third party observations may be submitted).

Terms for filing a notice of opposition

In order to file a notice of opposition against the validity of a published trademark, certain requirements must be met.

A notice of opposition must be filed within two months from the publication of the particular trademark in the Danish Trademarks Gazette. This time limit cannot be extended for any reason. Hence, a notice of opposition filed outside the time limit is rejected. However, in such a case, an application for the revocation of the trademark may be filed.

Opposition must be substantiated, although the requirements for grounds are limited. Thus, in an opposition based on likelihood of confusion, it is adequate grounds that the opposition refers to the rights of a particular existing trademark and states its registration number. Hereafter, the proprietor of the published trademark may request further substantiation from the opponent.

In the case of unsubstantiated grounds, we give the opponent a time limit to clarify possible queries. However, if an opposition is obviously ungrounded, it is rejected.

Furthermore, a fee must accompany the notice of opposition.

Grounds for opposition

In most cases, the notice of opposition is filed, because the opponent holds that the published trademark infringes his rights. These rights may include a registered or applied national trademark, an international designation, an applied or registered Community Trademark, the name of a person or company, or a copyright. They may also be the infringement of a mark or sign which is used either inside or outside of Denmark.

Moreover, it is adequate grounds for opposition to claim that the published mark lacks distinctive character. A mark must have distinctive character in order to be registered, and in this connection, the linguistic meaning of the mark is examined. How-

ever, we are not always aware that a certain term has taken on generic meaning. In this case, an opposition based on lack of distinctive character becomes significant.

The validity of the registration

When a notice of opposition has been filed, the Patent and Trademark Office examines all aspects of the registration anew. Thus, the reasons for the rejection of an application may also be used to justify the subsequent complete or partial rejection of a registration.

In this way, it is possible to implicate circumstances that the opponent has not presented in the notice of opposition. Therefore, we might decide that a published mark lacks distinctive character, even though the opposition is based on infringement of an existing right.

Notice of counterstatement of use

In many cases of opposition, the opponent claims several existing trademark rights. If the opponent's trademark registrations have existed for more than five years, the proprietor of the published trademark may request documentation that the existing rights have been used in accordance with the requirement of use.

Subsequently, the opponent must document that the mark meets the requirement of use. In the treatment of an opposition, if the mark has been used only in relation to some of the goods and services for which it is registered, it will be considered as registered for these goods and services only.

Thus, the proprietor of the opposed right cannot be required to submit a claim to revoke the opponent's registration. It should be noted that a possible limitation of the opponent's mark is only applicable in this particular conflict. The mark will remain unaltered in the trademark register.

If a counterstatement concerns the use of an existing Community Trademark, the opponent must fulfil the requirement of use as stated in the Council Regulation on the Community Trademark, section 15.

Hearing procedures

The proprietor of the registered right is informed of the notice of opposition and has the right to submit a counterstatement within a certain time limit. Once received, we evaluate whether the matter can be decided on the basis of the given evidence.

In a case of opposition based on likelihood of confusion, it is usually adequate for the opponent to state the ground and the proprietor to submit a counterstatement. The case will then be sufficiently elucidated to decide the matter.

The extent of the hearing procedures will vary according to the complexity of the case. If it is a case of whether the trademark is well-known, has acquired distinctive character through use, or used inside or outside of Denmark, both sides have the right to comment each other's statements.

In any case, e.g. the opponent claiming his mark to be well-known, he is encouraged to document this claim. Equally, the Patent and Trademark Office always seeks to

shed light on all aspects of the case by encouraging both parties to submit any evidence unknown to us which might be relevant to the decision of the case.

Determination of a case

When a case is sufficiently elucidated, the office makes a decision. The decision itself consists in an introduction, a short account of the arguments of both sides, and the basis of the decision, along with a conclusion. In addition to this, a guide on how to appeal is included to the unsuccessful side.

The decision may be either that the mark is deleted from the register, that a disclaimer is added to the mark, or that the list of goods and services of the mark must be reduced so that the marks may coexist.

Possibilities of appeal

Both parties may appeal the decision to the Board of Appeal if their claims have not been fully sustained. The time limit for bringing a case before the Board of Appeal is two months from the date of the decision. The fee must also be paid with this time limit.

Cancellation

Trademarks which have been registered contrary to the provisions of the Trade Marks Act may be cancelled if, for example, the mark is confusingly similar to an earlier trademark, either a used mark or a registration. The mark may also be invalidated due to a lack of distinctive character. In these cases the request is treated in the same way as an opposition.

Requirement of use

If a trademark does not fulfil the requirement of use in Denmark, the registration may be revoked. Anyone has the right to request the invalidation or revocation of a registration. Thus a legal interest in the case is not required. However, an application for invalidation or revocation cannot be based on others' rights, unless the applicant has been granted authority to act on their behalf. For example, a parent company cannot claim the rights to a mark owned by a subsidiary company, unless the parent company is authorized to represent the subsidiary company.

An application for invalidation or revocation of a mark may be withdrawn up until the final decision is made. If so, the registration is upheld in its entirety.