

Zacco

Denmark

In principle, any sign that is distinctive and can be represented graphically may be registered as a trademark in Denmark, but these requirements often prove to be insurmountable hurdles for non-traditional marks

Over the past decade, marketing specialists have begun considering non-traditional trademarks as necessary and useful supplements to traditional marks. When branding a company or promoting its products and services, the use of signs such as colours, shapes, sounds, smells, tastes, holograms and moving images has become popular and is sometimes considered to be a stronger marketing tool than a traditional mark.

For instance, well-known Danish marketing guru Martin Lindstrom discusses non-traditional trademarks in his latest book, *Buy-ology – Truth and Lies About Why We Buy*, in which he notes that visual indicators such as logos are far more effective and memorable when combined with other elements that appeal to other senses.

Using non-traditional marks results in a need for exclusive rights to the signs in question. In Denmark, the Trademarks Act, the Designs Act, the Copyright Act and the Marketing Practices Act provide possible protection. However, this article focuses on trademark registration.

Legal framework

Denmark is a member of the European Union and the European Economic Area. The current Trademarks Act is based on the EU First Trademarks Directive (89/104/EEC), which harmonizes the trademark laws of the EU member states.

In principle, a trademark can consist of all types of sign that fulfil the requirements of graphical representation and distinctiveness. The Trademarks Act does not specify what would constitute graphical representation or distinctiveness with regard to non-traditional marks. However, the Patent and Trademark Office (PTO) recently published online guidelines that provide comprehensive and clear information (in Danish) on its practice concerning some types of non-traditional mark.

Even clearer guidelines may be expected in the near future, as a result of the implementation of the Singapore Treaty on the Law of Trademarks. The Singapore Treaty entered into force in Denmark on March 16 2009 and Danish practice in respect of non-traditional marks will therefore have to adhere to the standards adopted by the treaty's Assembly of Contracting Parties.

The current requirements concerning the registration of non-traditional marks according to Danish practice are further discussed below. It appears that three-dimensional marks are the most commonly registered non-traditional marks; a small number of sound marks and moving images have been registered; whereas no colour, olfactory, taste or touch mark has yet been registered.

Three-dimensional marks

Three-dimensional signs will be regarded as trademarks provided that they are capable of being represented graphically and of distinguishing the goods or services of one undertaking from those of another.

In the past few years, the PTO has received a large number of applications for three-dimensional marks. Typically, three-dimensional marks consist of the shape of the goods themselves or their packaging/containers.

Unlike other non-traditional marks, the main practical hurdle for three-dimensional marks is not the requirement of graphical representation, but rather the requirement of distinctiveness. The requirement of graphical representation is fulfilled by any kind of depiction of the mark, such as perspective drawings or photos.

Whether a three-dimensional mark fulfils the distinctiveness requirement depends on:

- whether the shape is a common shape for the goods in question (the shape must depart from the shape which is expected by the consumer);
- whether the shape is necessary to achieve a technical result (the shape must not be merely functional);
- whether the shape is an ordinary geometric shape (basic geometric shapes

are non-distinctive); and

- whether elements of the shape can be characterized as decoration rather than as guarantees of origin (aesthetic originality does not make a shape distinctive).

In line with the Office for Harmonization in the Internal Market (OHIM) guidelines, the PTO's test is whether the shape is so materially different from basic, common or expected shapes that it can enable consumers to identify the goods by shape alone.

The Danish courts have assessed the distinctiveness of three-dimensional marks twice:

- On August 28 2003 the Supreme Court ruled in a case involving a cylindrical cardboard tube for sweets (Case HD 159-2001). The court found that the shape was non-distinctive since it was a basic geometric shape.
- On June 4 2003 the Danish Maritime and Commercial Court considered the shapes of coffee plungers (Case V-25-97). The court held that the shapes were not capable of performing the function of trademarks.

A relatively large number of three-dimensional marks (eg, for perfume flacons, bottles and containers) have been registered in Denmark.

Sound marks

A sound mark (eg, a jingle or musical piece) can be registered as a trademark if it fulfils the requirements of graphical representation and distinctiveness.

With regard to the requirement of graphical representation, the PTO refers to the European Court of Justice (ECJ) decision in *Shield Mark* (Case C-283/01), in which the ECJ held that the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Musical notations with indication of timing and pitch will meet this requirement. In this respect, the PTO no longer requires that music notations be accompanied by information about the specific instruments on which the sound must be performed.

Moreover, sonograms and oscillograms are accepted for registration if they are accompanied by a description of the sound and thereby provide an unambiguous graphical impression of the mark.

With regard to the requirement of distinctiveness, a single tone will not be considered distinctive. Similarly, a sound mark consisting of a longer musical piece or a conversation between two or more people will not be considered sufficiently distinctive.

So far, the PTO has granted registration to only three sound marks:

- the Intel jingle (VR 1998 00524);
- the sound of an animated troll saying “*Hvaaa, hvor ska’ vi hen du?*” (Danish for “Hey you, where are we going?”) (VR 1999 04561); and
- the sound of an ice cream van bell (VR 2003 02355).

Motion marks

Trademarks consisting of moving images – typically, animations in the form of a sequence of device marks – will meet the requirement of graphical representation. The mark must be represented by a series of key depictions, numbered in the order they are viewed in the sequence.

With regard to the distinctiveness requirement, very lengthy animation sequences or actual movies will most likely not be considered distinctive.

Danish registrations of moving marks include one for “feet moving in a bed” (VR 2002 02967) and “a screaming monster” (VR 2003 02487).

Colour marks

In principle, colours *per se* can be registered as trademarks.

Besides a graphical representation of the mark, the PTO requires a colour designation by use of an internationally recognized identification code. This is in line with the ECJ’s recommendation in its preliminary ruling in *Libertel* (Case C-104/01) concerning an application to register the colour orange.

With regard to enforcement, a recent judgment of the Eastern High Court (ØLK, May 28 2008) supports the need for an exact description of a colour mark by use of colour code. In that case, the court rejected a request by Deutsche Telekom – the owner of a Community trademark (CTM) registration for the colour magenta – for a preliminary injunction against TeliaSonera’s use of magenta as part of its visual identity in Denmark. The court found that there could be doubt as to which colour was protected by Deutsche Telekom’s CTM registration, since no colour code was provided in the



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original application. The court questioned the validity of the later addition of a specific colour code to the registration.

The examination of a colour mark for distinctiveness must include consideration of the public interest in not unduly restricting the availability of colours for other traders which market goods or services of the same type as those in respect of which registration is sought (see *Libertel*). Hence, in compliance with OHIM practice, the PTO does not consider colour marks distinctive, except in special circumstances.

As with any other non-distinctive sign, a colour mark may be considered registrable if it has acquired distinctiveness. In two recent cases (V-161-04, May 20 2008 and V-78-05, November 22 2006), the Danish Maritime and Commercial Court concluded that evidence of acquired distinctiveness had not been submitted with regard to Ferrari’s red colour and, therefore, an exclusive right to this colour could not be claimed.

Olfactory marks

Until a widely accepted method of unambiguous graphical representation for smells exists, olfactory marks will not be registered as trademarks in Denmark. In this respect, the PTO guidelines refer to the *Sieckmann Case* (C-273/00), in which the ECJ stated that the representation of a smell must be clear, precise, objective, intelligible, durable and easily accessible. These requirements will not be met by:

- a chemical formula, since this is not intelligible;
- a verbal description, since this is not sufficiently clear, precise and objective; or
- a sample, since this is not durable.

A combination of these methods will not meet the requirement either.

The PTO has not accepted any olfactory marks for registration, contrary to other EU national offices and OHIM itself. In fact, the PTO has considered only two applications for registration of such marks – a certain smell for bubble bath soap (VA 1997 05710) and a certain smell for perfume (VA 1997 05711). The PTO rejected both applications on the grounds that the graphical representations consisted of unclear gas chromatograms.

Other marks

So far, the PTO has provided no guidelines with respect to taste, touch and hologram marks. At the time of writing, no application had been filed for such marks. In any case, the PTO would presumably find such marks incapable of fulfilling the requirement of graphical representation. [WTR](#)