

Zacco

Acting together to extend protection in Norway

Well-known trademarks in Norway are protected under the Trademarks Act and, to some degree, the Marketing Act, which requires traders to follow good business practice in their transactions with each other

Exclusive trademark rights may be obtained either through registration of the mark or through use in such a way that the mark becomes well known. A 'well-known' mark is one that has become established as a company's specific sign through use. This implies that a mark which is basically descriptive may acquire through use the distinctiveness necessary to obtain legal protection as a trademark.

In practice, a mark's reputation can be used as a legal basis to: register a trademark which lacks the necessary distinctiveness; file an opposition against a third party's trademark application or registration; or deny a third party's use of signs (trademarks, domain names or company names) that either are confusingly similar to the well-known mark or exploit or damage the well-known mark's power of attraction, reputation or prestige. In addition, reputation has implications for the duration and termination of the legal protection granted to the well-known mark.

The legal basis for the abovementioned use of a well-known trademark is found in the Trademarks Act and the Marketing Act. Norway is not a member of the European Union; however, due to the European Economic Area agreement, Norway is bound by the same trademark rules as EU member states. Accordingly, the Trademarks Act must be interpreted in accordance with EU trademark law, including the EU Trademark Directive and case law from the European Court of Justice (ECJ) and the European Court of First Instance. In practice, this means that both EU and Norwegian case law are considered relevant when interpreting the Trademarks Act in applications or oppositions before the Norwegian Industrial Property Office (NIPO) and in litigation before the Norwegian courts.

The legal requirements for proving that

a trademark is well known are strict and few trademarks have been registered in Norway on the basis of having well-known status. In Case 7272/2004 (SAFE) the NIPO Board of Appeal stated that a descriptive mark can be registered only when it has gained a new primary meaning. There is no clear line as to when a mark is considered well known; the outcome will depend on an overall assessment of the relevant facts.

General requirements

It must be proven that the trademark is well known. The documentation must show use of the mark as a trademark and not as a descriptive term or type of goods. Thus, descriptive word marks should always be used with, for example, an initial letter in capital, medium-bold types and/or marked with the trademark symbol (™). Furthermore, a distinction must be made between use of the name as a trademark and as a secondary company name – only use as a trademark is relevant.

In line with ECJ case law, the documentation need no longer show the mark only as it is registered; use in connection with other elements is also relevant. However, trademark protection can be obtained only for the goods or services for which the mark has been used. Therefore, the documentation must show use of all the applicable goods and services.

A mark must be proven to be well known on both the application and registration date, and this must be evident from the submitted documentation. Documentation of use after filing will not be considered, except market surveys (and possibly declarations) from shortly after the filing date which show knowledge of the mark on or before the date of filing.

As regards intensity and duration, intense use of the mark may result in

more rapid results and vice versa. However, large investments of time and money in branding the mark are no proof of reputation in themselves, as it is the results of these efforts that must be shown.

The documentation must prove that the mark is well known in Norway. Documentation of use outside Norway may also be used to prove that the mark is well known in the country, as in NIPO Board of Appeal Decision 7628/2007 (RED BULL). Although the RED BULL energy drink was not sold in Norway until May 2009, it was proven that the RED BULL trademark was already well known to Norwegian consumers from 2003 based solely on Red Bull's foreign marketing.

The protection granted to a trademark considered well known in only a local circle of trade may not constitute the basis for trademark registration, as national reputation is required. However, a trademark that is well known locally may constitute a legal basis to prevent a third party from registering a trademark, company name or domain name that is confusingly similar to the well-known mark, or that exploits or damages the well-known mark's power of attraction, reputation or prestige.

This must be remembered when choosing a new trademark, company name or domain name, since a mark that is well known locally may prevent the new name from being registered and may lead to considerable litigation or marketing costs.

Proving that a trademark has become well known

Branding and sales of a trademark can usually be proven through documents such as sales figures, market shares, marketing costs and commercial budgets. However, in order to be relevant, such figures must be

compared against the total market figures for the relevant goods or services.

In order to show how and for which goods or services a mark is used, media coverage, marketing material, brochures, advertisements and publications can be presented.

The documentation must be dated and specify the media in which the document was published and how often this occurred. Regarding material published online, it is important to have dated print-outs in order to prove the exact date. The value of internet documentation increases when it is supported by the number of hits by the relevant circle of trade in the relevant time period.

Market surveys may serve as good evidence. However, it is particularly important that the questions be asked in a neutral manner. NIPO has rejected results from market surveys for using leading questions or failing to show whether the name/mark was perceived as a trademark, a secondary company name or a description for gaming (NIPO Board of Appeal Decision 7720/2008 (TIPPINGA)).

Declarations and witness statements are sometimes submitted as proof; however, these are rarely given any evidentiary weight by NIPO.

Some examples of registrations with NIPO based on establishment through use include HERBAL ESSENCES for shampoo; ITUNES for online music library; FILMWEB for website with film information and booking facilities; COMFORT HOTEL for hotel services; INTERNET EXPLORER for web browser; HOT N'SWEET for liquor; SPORTSLÅVEN ('sports barn') for sports shop; FJELLDUKEN ('mountain cloth') for wind-resistant cloth; and HANDYCAM for video camera.

Duration of legal protection

A registered trademark is granted protection for a period of 10 years from the date of registration; this may be renewed for subsequent 10-year periods (Section 23a of the Trademarks Act). It is a prerequisite for protection that the mark is actually used as a trademark – if a trademark has not been used within five years of the date of registration, it may be deleted from the Trademark Register if a court so rules.

An unregistered trademark can be granted protection provided that it is considered to be well known. However, in Norwegian case law and jurisprudence there has been discussion as to whether the obligation to use a mark within five years also applies to well-known trademarks in order for them to maintain their legal protection. The Supreme Court so ruled in *Lundetangen* (November 16 1999);



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however, the Appeal Court disagreed in its more recent *Saga* judgment (March 25 2008). The court of first instance judgment in *Nordlandsposten* (June 26 2009) upheld the Supreme Court's *Lundetangen* judgment. In the authors' opinion, this is incorrect and the legal protection granted to well-known trademarks should remain as long as the trademark owner can prove that the mark is still well known in the relevant circle of trade. This opinion is in line with the proposed new Trademarks Act.

Legal protection under marketing law

The protection granted to well-known trademarks under the Trademarks Act is supplemented and to some degree extended by the Marketing Act, which deals with the control of marketing, commercial practices and contract terms and conditions in consumer relations, and requires traders to follow good business practice in their transactions with each another.

The Supreme Court has established that the provisions in the Trademarks Act may be supplemented by the protection provided in the Marketing Act. Accordingly, in disputes concerning well-known marks it is usually claimed that the challenged mark infringes either the Trademarks Act or the Marketing Act. The two most important provisions in the Marketing Act with regard to well-known marks are Sections 25 and 30.

Section 25 provides that: "No act shall be performed in the course of trade which conflicts with good business practice among traders."

Section 30 provides that: "It shall be prohibited in the course of trade to use copies of distinguishing marks, products, catalogues, advertising materials or other produced items in such a manner and under such circumstances that the use must be considered an unfair exploitation of the efforts or results of another person, and to present a risk of confusion."

With reference to these provisions, a trademark owner's investments in time and money in order to make a mark well known may be protected from other parties' attempts to take unfair advantage of those investments and the mark's reputation. This means that the protection granted to well-known trademarks in Norway is already in line with the EC's judgment in *L'Oréal SA* (Case C-487/07 June 18 2009, ref Section 50). [WTR](#)