



Marking the
NORDIC COOL

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**ELLA MIKKOLA PROVIDES A SUMMARY OF THE TRADE MARK
CLIMATE IN EUROPE'S NORTHERNMOST REACHES**

Known and admired for its innovation, economic competitiveness and distinctive Scandinavian design – not to mention giant global brands like LEGO, Nokia, IKEA, Spotify and Angry Birds – it is evident that it's not only the weather that's cool in the Nordics.

The Nordic region is also an interesting market for trade mark owners all over the world, so we've compiled a summary of the registration basics.

General background

The Nordic region consists of five countries: Denmark, Finland, Iceland, Norway and Sweden, including their autonomous regions, the Åland Islands, Faroe Islands and Greenland. The Nordic countries have much in common both culturally and economically, and those similarities have been strengthened by the Nordic cooperation that also applies to trade mark law.

Originally founded in German law, the trade mark laws of the Nordic countries are a result of joint negotiations in the 1960s. Since then, these laws have gone through several amendments as a result of, for example, new international agreements.

Denmark, Finland and Sweden are members of the European Union, and, as members of the European Economic Area (EEA), Iceland and Norway have also been obliged to harmonise their trade mark laws with the European Trade Marks Directive.

During recent years, Norway and Sweden have enacted new trade mark laws, while Iceland has also revised its laws. In Finland, the revision of the Trademarks Act is still in progress, and the current provisions of the Finnish Trademarks Act are to be interpreted in accordance with the Trade Marks Directive.

In trade mark offices of the Nordic countries, the trade mark application is examined under both absolute grounds and certain relative grounds

Trade mark protection

Trade mark protection may be established either by use or by registration. Protection by use may be acquired if the mark has sufficient public recognition.

Trade marks can be registered in Nordic countries either by filing an application at each national trade mark office or by designating the desired countries in the Madrid Protocol application.

Furthermore, Community Trade Marks (CTMs) registered in the European Union are in force in Denmark (but not Greenland or the Faroe Islands), Finland and Sweden.

Protectable signs

All distinctive and graphically representable signs are registrable as trade marks. A trade mark may consist, *inter alia*, of words and word combinations (including personal names and slogans), figures, pictures, letters, numerals, or the shape of goods or their packaging.

However, the requirement that a mark be capable of being represented graphically is expected to be replaced in the Nordic region by more flexible criteria in the future, as the EU Trade Marks Directive and EU Trade Marks Regulation are to be recast and revised.

Preliminary search reports

In Denmark, Finland, Norway and Sweden, it is possible to request preliminary search reports from trade mark offices prior to filing, subject to a fee. Unlike trade mark application documents, these reports are not public.

The coverage of the reports varies from country to country. For example, in Denmark there is no assessment in the report as to whether the identified and reported registrations would form a barrier to the Applicant's trade mark.

The reports are delivered in five to seven days. In Sweden, it is possible to order an express pre-file search, which is delivered within 24 hours.

These reports are not legally binding on the trade mark office during the examination. However, they may serve as a useful tool for an applicant.

Examination

In trade mark offices of the Nordic countries, the trade mark application is examined under both absolute grounds and certain relative grounds. With the exception of Denmark, applications are also refused *ex officio* on the basis of earlier rights.

This means that the trade mark offices examine (prior to the publication of the trade mark registration) whether identical or confusingly similar prior trade mark registrations or applications could be a barrier to the registration of an application mark.

In Finland and Sweden, unregistered rights established through use also enable the office to refuse an application, if that use is known to the trade mark office.

Most EU countries have abolished *ex officio* relative grounds examination, as Community Trade Marks (CTM) are registered by the Office for Harmonization in the Internal Market (OHIM) without the possibility of such refusal on



TRADE MARK TERM (ALL COUNTRIES)























TRADE MARK DURATION/RENEWAL (+10)

- ICELAND** Term determined from date of registration. Renewal within six months before expiry; at the latest six months after expiry
- NORWAY** Term determined from date of application. Renewal within one year before expiry; at the latest six months after expiry
- FINLAND** Term determined from date of registration. Renewal within one year before expiry; at the latest six months after expiry
- SWEDEN** Term determined from date of registration. Renewal within one year before expiry; at the latest six months after expiry
- DENMARK** Term determined from date of registration. Renewal within six months before expiry; at the latest six months after expiry

REGISTRATION COSTS

(GBP CONVERSIONS APPROXIMATE, FOR COMPARISON ONLY)

	APPEAL AVENUES	No OF CLASSES	TYPE	APPLICATION FEE	ADDITIONAL CLASS (EACH)
	The decision of the Danish Patent and Trademark Office (DKPTO) may be brought before the Board of Appeal for Patents and Trademarks.	UP TO 3	 ONLINE/ PAPER	 DKK 2,350 (£226)	 DKK 600 (£58)
	The decision of the Patent and Registration Office (PRH) may be appealed to the Market Court.	1	 ONLINE/ PAPER	 EUR 215 (£155)/ EUR 250 (£180)	 EUR 80 (£59)
	The decision of the Iceland Patent Office (IPO) may be referred to the Appeals Committee for Intellectual Property Rights in the Field of Industry and/or the case may be referred to a Court of Law.	1	 PAPER	 ISK 28,000 (£136)	 ISK 6,000 (£29)
	The decision of the Norwegian Industrial Property Office (NIPO) may be appealed to the Norwegian Board of Appeal for Industrial Property Rights.	UP TO 3	 ONLINE/ PAPER	 NOK 2,900 (£248)	 NOK 750 (£64)
	The decision of the Patent and Registration Office (PRV) may be appealed to the Court of Patent Appeals.	1	 ONLINE/ PAPER	 SEK 1,800 (£139)/ SEK 2,300 (£178)	 SEK 900 (£69)

TOP BRANDS IN THE NORDICS - SOME KEY NAMES

DENMARK



MAERSK



ARLA



LEGO



DANSKE BANK



TDC

FINLAND



NOKIA



FORTUM



KONE



VALIO



UPM

ICELAND



66° NORTH



BLUE LAGOON

NORWAY



TELENOR



DNB



STOREBRAND



STATOIL/
STATOIL
FUEL &
RETAIL

SWEDEN



IKEA



NORDEA



H&M



ERICSSON



TELIA-
SONERA

PROSECUTION

REGISTRATION TIMELINE

REPRESENTATIVE REQUIRED?

(for foreign applicants)

LANGUAGE

POA REQUIRED?

REGISTRATION COMPLETION (AVERAGE)

OPPOSITION PERIOD



GENERALLY NO. If a representative is used, his/her place of residence has to be in the European Economic Area (EEA)



DANISH OR ENGLISH*



GENERALLY YES, a non-legalised POA is sufficient**



2-4 MONTHS



2 MONTHS



YES, in the EEA



FINNISH OR SWEDISH



YES, a non-legalised POA is sufficient



3-4 MONTHS



2 MONTHS



YES, in the EEA



ICELANDIC



YES, a non-legalised POA is sufficient



2-4 MONTHS



2 MONTHS



NO



NORWEGIAN



YES, a non-legalised POA is sufficient



3-6 MONTHS



3 MONTHS



NO



SWEDISH



NO



3-5 MONTHS



3 MONTHS

* List of goods and services have to be translated into Danish for publication purposes
** A POA is not required when the representative is a lawyer. The same applies for IPR adviser when they fulfil certain demands.



relative grounds. In OHIM, the owner of the existing registration must oppose the CTM in order for it to be refused registration.

This approach has also been discussed in the Nordic countries, but Finland, Iceland, Norway and Sweden have thus far decided not to abolish *ex officio* relative grounds examination. Such a broad examination process is seen as a benefit for companies, in particular SMEs.

Cancellation

If a trade mark remains unused for five years, the registration may be revoked. Trade marks may also be revoked if they have lost their distinguishing power and have become a common name, or if they have become liable to mislead the public.

It is also possible to institute invalidation proceedings in court. In Denmark, Iceland, Norway and Sweden, it is possible to apply for administrative revocation by the trade mark office. Introducing the administrative revocation procedure in Finland has also been under discussion, especially in connection with revocations on the basis of non-use.

In Sweden, the PRV (Swedish Patent and Registration Office) only permits administrative revocation on the basis of non-use if the proprietor of the registered trade mark agrees to such cancellation. If the proprietor of the registration objects, the matter is transferred to court.

The administrative procedure for revocation is generally seen as a faster and more cost-effective procedure as compared to the courts.

The registration may also be cancelled in part if the grounds for revocation concern only some of the goods or services for which the trade mark has been registered.

If a trade mark has remained unused for a period of five years but no application for its revocation has been entered, the trade mark holder may restore the protection

MARKS WITH A REPUTATION – FINLAND FOCUS

Well-known trade marks are protected in the Nordic countries against the use of identical or similar marks, even in respect of goods or services that are not similar to those for which the earlier trade mark is well known. The requirement is that use of the later trade mark could lead to a likelihood of association between the marks, and use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

In 2007, the Finnish Patent and Registration Office (PRH) established a list of trade marks with a reputation. A trade mark can be entered into the list by an application that is subject to payment of a fee. Currently, more than 70 trade marks, for both national and global brands, have been admitted to the list. The list of trade marks with a reputation is independent from the Finnish Trade Mark Register and does not have any official legal status. However, it may serve as evidence of the reputation of a mark and may facilitate the enforcement of trade mark protection. The list benefits commerce and industry, and is also helpful, for example, when conducting preliminary examinations.

The owner of an earlier trade mark with a reputation is notified if the PRH, while processing a trade mark application, finds a confusingly similar mark in the list. However, the list is not taken into consideration as a relative obstacle in the registration process by the PRH.

The Applicant is required to submit proof of the mark's reputation in order for it to be accepted into the list. The proof may consist of, *inter alia*, documentation indicating market share, advertising and marketing material, as well as market and reputation surveys.

of the trade mark by resuming its proper use.

Towards specialised IP courts?

Finland is the first country in the Nordic region to have established a centralised IP court, although Sweden is expected to have its own IP court in operation by 1 September 2016. Denmark is developing its court system as well.

In Finland, the new Court, officially called the 'Market Court', was established in September 2013. Following the reform, the Market Court now has exclusive jurisdiction to hear all IP cases as the first instance Court (with the exception of IP cases

that involve criminal proceedings, which will remain within the remit of the District Courts).

During its first year and a half of operation, the Finnish IP Court received more than 300 trade mark cases. Approximately 90 per cent were appeals concerning trade mark applications decided by the Patent and Registration Office (PRH). The rest were litigations, such as trade mark-related infringement and compensation suits.

As appeals related to the administrative decisions of the PRH (such as trade mark registration applications) are now decided in the Market Court, the Court will likely have a steady flow of trade mark cases in the future as well.



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