

Plain Packaging Questionnaire

National Group: Denmark

Introduction

- 1) In view of the Australian plain packaging legislation and similar legislative initiatives in a number of other jurisdictions, and following the workshop “Plain Packaging – a slippery slope?” held in Seoul during the 2012 AIPPI Congress, AIPPI intends to study the legal basis for adopting plain packaging. At the present time, the issue arises in relation to tobacco products. However, there has also been public debate concerning similar packaging restrictions for other legal consumer products, such as foods deemed to be unhealthy and alcohol. In particular, AIPPI seeks to study the legal basis for restricting the use of trademarks in relation to particular classes of products, in light of public interest considerations.

- 2) In the context of tobacco products, the term “plain packaging” (sometimes referred to as “standardised packaging”) refers in general to:
 - prescribed shape, size and colour of packaging;
 - prohibition on all branding or promotional elements (such as trademarks, logos and product claims and other visual design elements); and
 - prescribed display of the brand name, including as to typeface, font size, colour and position.Prescribed health warnings and other regulatory requirements are still required to appear on packaging.

Previous work of AIPPI and other selected sources

Please refer to the following AIPPI documents:

- PUBLIC CONSULTATION ON THE POSSIBLE REVISION OF THE TOBACCO PRODUCTS DIRECTIVE 2001/37/EC by AIPPI dated December 17, 2010 (see <https://www.aippi.org/download/committees/212/Report212AIPPI+submission+Tobacco+Products+Directive+2001-37+EC+Decemeber+17++2010English.pdf>).
- Seoul Congress 2012: Workshop VI, Plain packaging – a slippery slope? https://www.aippi.org/download/seoul12/WS/Description_WS_VI.pdf ; see also [https://www.aippi.org/?sel=meetings&cf=seoul2012&view1=Workshops with slides of presentations by Tania Voon, Carla Michelotti and Young Joo Song](https://www.aippi.org/?sel=meetings&cf=seoul2012&view1=Workshops+with+slides+of+presentations+by+Tania+Voon,+Carla+Michelotti+and+Young+Joo+Song)).

Other sources:

- **Australia:** Tobacco Plain Packaging Act 2011 see: http://www.austlii.edu.au/au/legis/cth/num_act/tpa2011180/, Tobacco Plain Packaging Regulations 2011 see: http://www.austlii.edu.au/au/legis/cth/num_reg/tppr2011n263o2011372/ , Trade Marks

Amendment (Tobacco Plain Packaging) Act 2011 see: [http://www.austlii.edu.au/cgi-bin/sinodisp/au/legis/cth/num_act/tmappa2011360/s1.html?stem=0&synonyms=0&query=Trade%20Marks%20Amendment%20\(tobacco%20plain%20packaging\)%20act%202011](http://www.austlii.edu.au/cgi-bin/sinodisp/au/legis/cth/num_act/tmappa2011360/s1.html?stem=0&synonyms=0&query=Trade%20Marks%20Amendment%20(tobacco%20plain%20packaging)%20act%202011)

- The **WHO** Framework Convention on Tobacco Control (WHO FCTC) adopted by 172 States or Organisations such as UE (2003) (see in particular Articles 11 and 13) see: <http://www.who.int/fctc/en/>
- Proposal for a DIRECTIVE OF THE **EUROPEAN** PARLIAMENT AND OF THE COUNCIL on the approximation of the laws, regulations and administrative provisions of the Member States concerning the manufacture, presentation and sale of tobacco and related products, dated December 19, 2012 see http://ec.europa.eu/health/tobacco/docs/com_2012_788_en.pdf

Discussion

- 1) This questionnaire considers the conflict between rights deriving from trademark registration and/or use, and government regulation said to be in the public interest. An example is found in section 28 of the Australian Tobacco Plain Packaging Act 2011, entitled the "Effect on the Trade Marks Act 1995 on non-use of trade mark as a result of this Act". It is evident that the Australian legislature had to take a number of measures to attempt to reconcile domestic trademark rights with the prohibitions on trademark use in its plain packaging regime.
- 2) AIPPI acknowledges that there is a public interest in promoting public health measures. This questionnaire considers legal frameworks in national systems that limit or prohibit trademark use in particular product classes based on stated public interest considerations, and what rights affected trademark rights holders may have in those circumstances.
- 3) TRIPS Articles 15 to 21 relate to trademarks. Article 15 provides that signs capable of distinguishing goods or services of one undertaking from those of another undertaking shall be capable of constituting a trademark. When a sign is not inherently capable of distinguishing the relevant goods or services, registrability may be dependant on distinctiveness acquired through use. Importantly, Article 15(4) provides that the nature of goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.
- 4) Article 16 describes the rights conferred by trademark registration, and in particular the circumstances in which the owner of a registered trademark may prevent third parties from using the same or similar mark for goods or services the same or similar to the goods or services in respect of which the trademark is registered. Article 17 permits "limited exceptions" to the rights conferred by a trademark provided that the legitimate interests of the owner and third parties are taken into account. Article 18 provides that a trademark may be renewed indefinitely.
- 5) Articles 20 and 21 prohibit certain restrictions on trademark rights. Article 20 provides that the use of a trademark in the course of trade shall not be unjustifiably encumbered by special requirements. Examples of "special requirements" include use in a special form or use in a manner detrimental to its capability to distinguish the relevant goods or services. Article 21 expressly prohibits compulsory licensing of trade marks.

- 6) It is apparent from the TRIPS provisions relating to trademarks that use is a central concept. Article 15 recognises that in order to be capable of distinguishing goods or services a trademark must be used. The rights conferred under Article 16 recognise the negative effects on trademark owners' rights where the same or a similar sign is used in the course of trade by a third party. The prohibition on unjustifiable encumbrances in Article 20 is premised on use.
- 7) It is a curious feature of the Australian Tobacco Plain Packaging Act 2011 that trademark applications may be made and trademark registrations may be retained notwithstanding that most registered trademarks in respect of tobacco products may not be used for their intended purposes, that is on packaging for tobacco products or on tobacco products themselves. Notwithstanding this prohibition, an applicant for a relevant trademark is taken to intend to use the trademark in Australia for tobacco products, and failure to use a relevant trademark will not found an action for removal for non-use.
- 8) By contrast to Article 21, TRIPS expressly permits compulsory licensing in relation to patents. Article 30 (in relation to patents) corresponds to Article 17 (in relation to trademarks) in permitting "limited exceptions" to patent rights, taking into account the legitimate interests of the patent holder and third parties. However, Article 31 expressly contemplates use of the subject matter of a patent without authorisation of the patent holder, including use by governments or their authorised third parties. Thus, it appears that public interest considerations are relevant to whether the rights of a patent owner may be diminished. However, it is important to note that in those circumstances the patent holder is not denied the ability to continue to exploit their patent rights. Further, the patent holder must be paid "adequate remuneration" which takes into account the economic value of the government authorised use (Article 31(g)).
- 9) Unlike in relation to patents, TRIPS does not expressly mandate any limitation on registered trademark rights based on public interest considerations. Article 17 gives an example of a "limited exception" to trademark rights, being fair use of descriptive terms. This suggests Article 17 contemplates exceptions that relate to the balancing of interests between private parties. Similarly, the Paris Convention (which is expressly incorporated by reference in TRIPS), does not provide for restrictions on the use of trademarks that have been rightfully registered based on public interest considerations.
- 10) Thus, the questions below explore the relationship between restrictions based on stated public interest considerations and limitations on the use of trademarks, and the rights of affected trademark rights holders.

Questions

Please answer the following questions. For each of questions 1) – 10) below, please answer in relation to your country's national laws including any constitutional law.

- 1) If the general conditions of registrability are met, does the product or service in relation to which a trade mark is used or proposed to be used have any affect on the ability to:
 - (a) register the trademark; and *NO*
 - (b) use it once so registered? *Yes, e.g. it is possible to register a trademark for nuclear plant industry, however against Danish law to use said trademark for such services. In respect of tobacco products, it is prohibited to use a trademark which is primarily known for tobacco products for marketing of other types of products or services. Reversely, tobacco products cannot be marketed under a trademark which is known for other products or services.*
- 2) What rights are derived from trademark registration? *The sole user rights and the ability to prevent others from using identical or similar trade names.*
- 3) What rights exist in relation to a sign used as a trademark but not registered? What is the basis of any such right? *Denmark recognizes common law rights based on used. This type of right is codified in the Danish Trademark Law and the common law rights gives the owner the same rights as the owner of registered trademarks.*
- 4) Is it possible to:
 - (a) obtain; or
 - (b) maintain;registration for a trademark that is not:
 - (i) used; or *YES*
 - (ii) intended to be used? *YES*
- 5) If yes to 4) above, are the rights derived from such trademark registration the same or different to registered trademarks that are used? *They are the same.*
- 6) Are rights in unregistered trademarks dependent on use? Whether yes or no, please explain the basis for your answer. *Unregistered rights are fully dependable on use. At the time use is ceased the unregistered rights no longer exists and cannot or can be enforced.*
- 7) Is there any basis to restrict the use of:
 - (a) a registered trademark; or *YES*
 - (b) a sign used as a trademark? *YES*

If yes, please explain any relevant laws or precedents.

According to the Danish Trademark Law the registration of a trademark may be restricted by specific rules, and in order to protect public interests confer The Danish Trademark Act article 14.. The restriction of use is regulated in Lex Specialis i.e. food law, pharm law etc.

8) Is there any basis for the state or any state-controlled body to expropriate?

- (a) a registered trademark; *No, not explicit*
- (b) a sign used as a trademark; or *No, not explicit*
- (c) the rights deriving from either (a) or (b)? *No, not explicit*

If yes, please explain any relevant laws or precedents.

Danish laws do recognize expropriation. There is to our knowledge no precedent.

9) If yes to 7) or 8) above, do public interest considerations provide any basis for such restriction or expropriation ("Restriction/Expropriation")? If yes, please explain any applicable public interest considerations, and any relevant laws or precedents.

The Danish Constitution article 73 protects private property of both physical persons and legal entities, and accordingly expropriation may only be done by law and provided the private owner is fully compensated, and the expropriation is done for the purpose of public interests. If 25% of the parliament is voting against, the expropriation law has to await the result of a public referendum.

10) If yes to 7) or 8) above, are trademarks different from other intellectual property rights in this regard? *NO*

11) If yes to 7) or 8) above, are any treaty or other international obligations relied on to provide a basis for such Restriction/Expropriation (as applicable)? If yes, please explain the international obligations, and how those obligations are reflected in or received into your country's law. *Not as far as we are aware.*

12) Is your country a signatory to the WHO Framework Convention on Tobacco Control ("FCTC")? If yes, has your country ratified the FCTC? *Yes, but not the guidelines. The FCTC is not ratified for Greenland and the Faroe Islands.*

13) If yes to 12) above, has the FCTC been implemented in your country? *Yes, according to the Danish Government.* If yes, please explain its legal impact, if any, including by reference to the Guidelines for Implementation of Articles 11 and 13 of the FCTC. FCTC guidelines are not binding on the Parties to the FCTC and they have not been implemented in Denmark. The guidelines are mere indications of the way in which the Convention can be implemented by.

14) Is the FCTC received directly into your country's domestic law or is domestic legislation required to give it effect in your country's law? *Domestic legislation is required.*

15) If there is presently a legal basis in your country for permitting any Restriction/Expropriation, please answer the following questions in relation to both registered trademarks and unregistered trademarks (if your country recognizes/protects the latter).

The general considerations in relation to expropriation are already explained in question 9. With respect to restrictions the general principles for legislation apply. Restrictions of trademark use appear in many different laws. In relation to tobacco products the Act on Prohibition of Tobacco Advertising explicitly restricts the use of trademarks as described above in relation to question 1 (b).

(a) What are the parameters for such Restriction/Expropriation? For example, the nature of any stated public interest considerations, the proportionality of the proposed measure to the Restriction/Expropriation.

It is impossible to generalize on the parameters on restrictions, however as Denmark is member of the European Community the rule (Article 34 in TFEU) of free movement of goods and human rights such as commercial freedom to speech (Article 10 (2) European convention of Human Rights)) and the Danish constitution Article 77 on freedom of speech apply. Consequently, any restriction cannot be a violation, and restrictions may only be acceptable provided that limitations are fair and documented and in proportion with proposed measure.

(b) Is it relevant that such Restriction/Expropriation only applies in relation to a particular class of products, eg tobacco products, foods deemed to be unhealthy or alcohol?

No, the restrictions do have to account all above mentioned considerations.

(c) What are the financial consequences for the state and the trademark rights holder respectively? *It is not regulated.* For example, is a rights holder entitled to or eligible for any compensation in respect of the Restriction/Expropriation? *In relation to restrictions compensation is generally not applicable. However, it has not been tried before the courts if restrictions on use can be so burdensome that they in reality amount to expropriation and require compensation.* If yes, what type of rights holders are so entitled or eligible? If not, why is no compensation available? *The argument is that the restriction is fulfilling the basic legal requirements mentioned above in relation to question 10(a) , and that the restrictions regulates the entire market (or all players), and accordingly the restrictions are general for all involved parties.*

(d) If compensation is available, how is it calculated? *In relation to expropriation it is required that the owner is fully compensated.*

- (e) Does a trademark rights holder affected by Restriction/Expropriation have any other claims or remedies against the state? *No* If yes, please explain the basis and nature of any claims or remedies.
- (f) In the event of Restriction/Expropriation, could a trademark remain registered? *Yes, generally it can. However, the use requirement in practice means that the trademark right after 5 years of non-use is vulnerable to cancellation*
- (g) If yes, what is the consequence of any Restriction/Expropriation on a well known trademark that was registered prior to the Restriction/Expropriation? *It may be difficult in the future to keep the status of being well known, and after 5 years of non-use the trademark will be vulnerable to cancellation.* Whereby there is a high risk that even the inherent right for a trademark owner to prevent others from use of the trademark or a mark similar to the trademark disappears.
- 16) If there is presently no legal framework in your country permitting Restriction/Expropriation, please answer the following questions in relation to both registered trademarks and unregistered trademarks (if your country recognizes/protects the latter).
- (a) What legislative changes would be necessary in your country to implement a plain packaging regime for a specific class or classes of products such as those previously mentioned? For example, amendments to existing domestic trademark legislation, changes to your country's constitution, multilateral or supranational treaty obligations. *Regardless whether the law is seen as a restriction or expropriation, plain packaging may be implemented by law in Denmark.*
- (b) Could a plain packaging regime be implemented in your country without providing compensation to affected trademark rights holders? *It depends on the scope of plain packaging, and compensation (full) may very well be required if the plain packaging will be regarded as a de-facto expropriation of the trademark rights.* If no, what type of rights holders would be entitled to or eligible for compensation? *The involved trademark owner (domestic or international)* If yes, why would no compensation be payable? *As mentioned, it is uncertain if the trademark rights holder will be entitled to compensation. There does not seem to be any precedent and there is no clear legal framework that requires compensation if the restriction does not amount to expropriation, see also question 15 (c). This would indeed be a matter for the Danish courts.*
- (c) Would a trademark rights holder affected by Restriction/Expropriation have any other claims or remedies against the state? If yes, please explain the basis and nature of any claims or remedies. *The holder may try the legality of the legislation on which the expropriation or restriction is based in the Danish courts, e.g. in relation to the freedom rights, Article 34 of TFEU[] etc.*