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# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2019

**8th Edition**

A practical cross-border insight into trade mark work

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# Sweden

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The trade mark authority in Sweden is the Swedish Patent and Registration Office (Sw: PRV).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The trade mark legislation in Sweden is the Swedish Trade Marks Act (2010:1877).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any signs, particularly words, including personal names, figurative elements, letters, numerals, and the shape of goods or of their packaging, provided that the signs are distinctive, can be registered as a trade mark. The signs must be capable of being clearly represented in the Trade Marks Register.

### 2.2 What cannot be registered as a trade mark?

A sign which is not distinctive may not be registered as a trade mark, nor may a sign which is subject to absolute (see question 3.1) or relative grounds (see question 4.1) for refusal.

### 2.3 What information is needed to register a trade mark?

The following information must be included in an application for trade mark registration:

- the name and residence concerning the applicant and/or any representative;
- a representation of the trade mark;
- a list of goods and services for which the trade mark is intended; and
- the type of classes to which the mark belongs.

### 2.4 What is the general procedure for trade mark registration?

The first step is to submit an application with the PRV together with the required fees. The PRV then makes an assessment of the application. If no ground of refusal is found, the PRV will register and publish the trade mark. However, if any grounds for refusal apply, then the applicant will be notified and receive an opportunity to rebut the refusal.

### 2.5 How is a trade mark adequately represented?

A sign may take different forms (see question 2.1). The sign must be distinctive and clearly capable of being represented in the Trade Marks Register.

### 2.6 How are goods and services described?

Goods and services shall be described as precisely as possible. The Nice Classification system classifies the goods and services for the particular trade mark in question.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Swedish national trade marks cover Sweden only.

### 2.8 Who can own a trade mark in your jurisdiction?

Any natural person or a legal entity can own a trade mark.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire distinctive character through use.

### 2.10 How long on average does registration take?

Average processing times can vary from one to three months depending on the workload of the PRV.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The costs are as follows:

- Online applications: SEK 2,000.
- Physical applications: SEK 2,700.

These fees cover one class and each additional class costs SEK 1,000.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Registration of a trade mark can be obtained from the PRV. It can also be obtained internationally through a registration via the Madrid Protocol designating Sweden. Moreover, a European Union trade mark is valid in Sweden.

### 2.13 Is a Power of Attorney needed?

No, a Power of Attorney (PoA) is not needed.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, but if a PoA is to be submitted, only the original signed document will be accepted.

### 2.15 How is priority claimed?

An applicant that wishes to claim priority shall make a request before the trade mark has been registered. The applicant shall indicate who filed the earlier application, where and when the earlier application was filed and the number of the earlier application.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, collective and certification marks are recognised in Sweden.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

For a trade mark to be registered, the sign in question must be capable of distinguishing the goods and/or services.

A sign is usually not covered by the exclusive rights granted by the trade mark if it:

- results from the nature of the goods;
- is necessary in order to obtain a technical result; and/or
- is a shape that gives substantial value to the goods.

Furthermore, a trade mark cannot be registered if it:

- is contrary to law or regulations or goes against principles of morality or public policy;
- is of such nature that it deceives the public about the nature, quality, geographical origin, or any other circumstance related to the goods or services;

- includes, without permission, a state or international emblem, or such a municipal coat of arms, or other emblem which, under law or regulations, may not be used, if unauthorised, as a trade mark, or something that can easily be confused with such an emblem or such a municipal coat of arms;
- if the mark contains or consists of any sign which is liable to be conceived as a geographical indication for wines or spirits and relates to wines or spirits of a different origin; or
- if the mark contains or, in essential parts, reproduces an earlier plant variety designation that refers to a plant variety of the same or related plant species, to the extent that the plant variety is protected according to the Swedish Plant Varieties Act (SFS 1997:306), or EU law.

### 3.2 What are the ways to overcome an absolute grounds objection?

The applicant must demonstrate that the mark does not fall under any of the absolute grounds. This can be done by raising objections to the PRV. In particular, the applicant can submit that the mark in question has obtained distinctiveness through use.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A party receiving a decision of refusal has the right to appeal that decision.

### 3.4 What is the route of appeal?

The PRV's decisions can be appealed to the Patents and Market Court (PMD). The appeal must be submitted within two months from the date of the decision. Decisions taken by the PMD can be appealed to the Patents and Market Court of Appeal (PMÖD), subject to the condition that a leave for appeal has been granted. The PMÖD's decisions can also be appealed to the Swedish Supreme Court (in limited instances), also subject to the condition that a leave for appeal has been granted.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Unless a use of a trade mark has not been approved by the relevant holder, the trade mark may not be registered, if it is:

- identical to an earlier trade symbol for identical goods or services;
- identical or similar to an earlier trade symbol for identical or similar goods or services, if there exists a likelihood of confusion, including the likelihood of association between the user of the trade mark and the proprietor of the trade symbol as a result of the trade mark use;
- identical or similar to an earlier trade symbol which is known by a significant part of the relevant public, and the use of the trade mark would take unfair advantage of or without due cause be detrimental to the distinctive character or repute of the trade symbol; or
- can be confused with a symbol which, at the time of the application, was being used by a third party in this country or abroad and is still in use, if the applicant was acting in bad faith at the time of the application.

Furthermore, a trade mark may not be registered if it contains or consists of:

- an element which is liable to be conceived as another party's registered company name;
- an element which is liable to be conceived as another person's characteristic surname, generally known artistic name or similar name, if the use of the trade mark would be to the disadvantage of the bearer of the name, and if the name obviously does not relate to a person who is long deceased;
- a picture of another person that obviously does not relate to a person who is long deceased; or
- an element which infringes another party's copyright in a literary or artistic work or another party's rights in a photographic picture or in a design.

#### 4.2 Are there ways to overcome a relative grounds objection?

Yes, this can either be done through:

- submitting evidence that there are no conflicts with any prior rights;
- limiting the list of goods and services; or
- securing consent from the proprietor of the earlier right.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

All decisions of refusal of registration can be appealed.

#### 4.4 What is the route of appeal?

See question 3.4 above.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on absolute and relative grounds.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone can oppose the registration of a trade mark.

However, if opposition is based on relative grounds for refusal and the trade mark holder makes a request, then that opponent must show a legitimate interest in that opposition.

#### 5.3 What is the procedure for opposition?

Upon the PRV's publication of the contested mark in question, one has three months from the publication date to file the opposition. The proprietor of the contested trade mark will subsequently be informed of the opposition and receive an opportunity to make a statement regarding the opposition. The PRV will, based on the arguments and evidence submitted by the parties, either reject the opposition, or cancel the contested trade mark.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

The trade mark registration is published by the PRV. Moreover, the proprietor will also receive a "receipt" certifying successful trade mark registration.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights commence on the date of application, if the trade mark is successfully registered.

#### 6.3 What is the term of a trade mark?

The trade mark is valid for 10 years from the date of registration. It is also possible to renew the trade mark for 10-year periods. There is no limit to how many times a trade mark registration can be renewed.

#### 6.4 How is a trade mark renewed?

A trade mark is renewed by filing an application or paying the renewal fee. Renewal is possible at the earliest six months before the expiration, and at the latest, six months after the expiration. The renewal fee is higher if the application is submitted after the expiration. The PRV will publish the renewal in the Trade Marks Registry.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes, through a written application to the PRV.

#### 7.2 Are there different types of assignment?

Yes, an assignment of a trade mark can either be made fully or partially for certain goods or services.

#### 7.3 Can an individual register the licensing of a trade mark?

Yes, an individual has the option of registering the licence of a trade mark. A written application and the licensing agreement is submitted to the PRV.

#### 7.4 Are there different types of licence?

Yes, exclusive and non-exclusive licences are available.

#### 7.5 Can a trade mark licensee sue for infringement?

Yes, the court may, for instance, issue an injunction upon a petition by a party in possession of a trade mark, or a licensee/licensor. The

injunction may be aimed at any party that commits or contributes to a trade mark infringement.

#### 7.6 Are quality control clauses necessary in a licence?

No, quality control clauses are not necessary in a licence.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes, both an application for registration of a trade mark and a registered trade mark can be pledged. A written pledge agreement can be registered at the PRV.

#### 7.8 Are there different types of security interest?

No, there are not.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark registration may be revoked if the:

- the trade mark has been registered in violation of the Swedish Trade Mark Act;
- registration is still in violation of the Swedish Trade Mark Act;
- rights in the mark may not persist anyhow; or
- the trade mark has not been put to use within five years following the registration of the mark.

Furthermore, a registration can also be revoked if the trade mark:

- in consequence of acts or inactivity of the proprietor, has become a common name in the trade for goods or services in respect of which it has been registered;
- has come to conflict with law or regulations or principles of morality or public policy; or
- in consequence of the use made of it by the proprietor or with the proprietor's consent in respect of the goods or services for which it is registered, has become liable to deceive the public concerning the nature, quality, geographical origin or any other circumstance related to the goods or services.

In addition, registration of a trade mark may be revoked if the proprietor has not, within five years from the final decision on the registration matter, or within a consecutive period of five years, made genuine use of the mark in Sweden in respect of the goods or services for which it has been registered.

### 8.2 What is the procedure for revocation of a trade mark?

The procedure is either initiated by an application for administrative cancellation to the PRV or through action brought to the PMD.

### 8.3 Who can commence revocation proceedings?

Anyone can apply for an administrative cancellation or bring an action for revocation. However, revocation on the basis of relative grounds for refusal may only be instigated by a party that can show a legitimate interest.

### 8.4 What grounds of defence can be raised to a revocation action?

Decisions concerning administrative cancellation may be appealed to the PMD within three weeks of the date of the decision. Decisions by the PMD can be appealed to the PMÖD, subject to the condition that a leave of appeal has been granted by the PMÖD.

### 8.5 What is the route of appeal from a decision of revocation?

Decisions concerning revocation are appealed to the PMD within three weeks from the date of the decision. The PMD's decision can be appealed to the PMÖD if a leave of appeal has been granted.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

See question 8.1.

### 9.2 What is the procedure for invalidation of a trade mark?

See question 8.2.

### 9.3 Who can commence invalidation proceedings?

See question 8.3.

### 9.4 What grounds of defence can be raised to an invalidation action?

See question 8.4.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trade mark can be enforced by filing an application for a summons with the PMD.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The pre-trial procedure is typically instigated through an application for a summons with the PMD. The PMD subsequently issues a writ of summons. Following the issuing of a writ of summons, the defendant hands in a statement of defence. The parties then have the option to submit further evidence and claims in support of their actions. The PMD then holds a preparatory meeting with a judge

where the parties have the option to respond to each other's statements. The former may also be accompanied with additional questions submitted by the PMD. The parties then have an option to submit further evidence and arguments. Following this exchange, the PMD can hold a main hearing. It takes approximately nine months for pre-trial proceedings to reach a main hearing, but naturally, this varies depending on the complexity of the case.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

- i) The PMD may issue an injunction, under penalty of a fine, for the time until the case has been finally adjudicated or otherwise is decided if the plaintiff shows a probable cause of an act that may amount to trade mark infringement – or contribution to an infringement – is taking place. Furthermore, it must be reasonably expected that the defendant – through the continuation of that act – diminishes the value of the exclusive right in the trade symbol. Before an injunction is issued, the defendant is given an opportunity to respond, unless a delay would entail a risk for damage (*ex parte* decisions, however, are very rare in Sweden). A preliminary injunction may – as a general rule – be rendered only if the plaintiff posts a security (usually a bank guarantee) with the PMD for the damage that may be caused to the respondent.
- ii) A final injunction may be issued under penalty of a fine, against a party that commits, or contributes to, a trade mark infringement, against the continuation of that act.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party can be compelled to provide disclosure of relevant documents if an applicant can demonstrate probable cause that a third party has committed a trade mark infringement. The PMD may order, under penalty of a fine, that the infringing party, or a party contributing to or benefitting from the infringement, shall provide information to the applicant concerning the origin and distribution networks in relation to the goods or services in question. Anyone who has been ordered to provide information also has a right to reasonable compensation for the costs and inconvenience caused. The compensation is paid by the party that has applied for the order to provide information.

Furthermore, if reasonably assumed that someone has committed, or contributed to, an infringement, the PMD may – for purposes of preserving evidence – order an investigation to search for objects or documents that are assumed to be of importance for the inquiry into the infringement. An order for an infringement investigation can only be issued by the PMD where the applicant deposits a security with the court for the damage which may be caused to the opposite party.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

All evidence must be filed prior to the preparatory phase of the proceedings of the trial being closed by the court (unless there are legitimate reasons for introducing such evidence later). At the main hearing, all arguments and evidence must be presented orally; it is possible to make reference to written materials that are filed. Witnesses and experts are questioned during the main hearing and there will be an opportunity for cross-examination.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, but there must, generally speaking, be very compelling reasons for the Court to do so.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The right to compensation may be subject to a statute of limitations of five years from the time that the damage was caused.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, these can either be committed by intent or gross negligence. If convicted, a defendant may be ordered to pay fines and/or imprisonment for up to two years.

### 10.9 If so, who can pursue a criminal prosecution?

A public prosecutor may pursue criminal prosecution. However, this is subject to the condition that the injured party calls for a prosecution, and that prosecution is called for in the public interest.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

These could be considered unfair marketing practices under the Marketing Act (2008:486).

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Grounds that could be invoked include the following:

- that the use was not conducted in the course of trade;
- that the use has not adversely affected any function of the earlier registered trade mark; and
- that there is no likelihood of confusion with the earlier mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The most typical grounds invoked include, but are not limited to, the following:

- counter-claim of invalidity (i.e. cancellation of a trade mark);
- exhaustion of rights;
- revocation due to non-use; and
- that the mark is used in accordance with good business practice for a firm name.



## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Remedies available for trade mark infringement include:

- monetary compensation (damages); and
- preliminary and final injunctions.

In addition to the foregoing, the PMD can order:

- the infringing party to recall the products from the channels of commerce;
- alteration, destruction, or seizure of the infringing goods in cases of criminal offences; and
- the party that has committed or contributed (to the infringement) to pay pecuniary compensation for appropriate measures to disseminate information about the judgment in the case at hand.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The main rule is that the losing party compensates the costs of the prevailing party. The Swedish Code of Judicial Procedure sets out what costs are recoverable. This includes – but is not limited to – pre-trial costs arising from the main procedures (i.e. counsel fees and compensation to witnesses). Furthermore, the losing party must also compensate any costs relating to the prevailing party's own work and loss of time deriving from the main hearing.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The PMÖD hears appeal cases. Leave to appeal is required in order for the PMÖD to hear the case.

There are three grounds for granting an appeal; namely, if:

- there is reason to doubt the accuracy of the first instance decision;
- it is not possible to assess the accuracy of the first instance decision without granting leave to appeal; or
- the case has precedential value.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

As a general principle, new evidence cannot be submitted in the course of appeal proceedings. There are, however, exceptions in the Swedish Code of Judicial Procedure; for instance, in situations where the evidence did not exist or if the evidence was initially not available in the first instance proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Sweden has transposed EU Regulation 608/2013 concerning customs enforcement of intellectual property rights. This regulation provides the rightsholder with a possibility to file an application for action with the customs authorities. Following such action, the customs authorities may – upon identifying goods suspected of infringing an intellectual property right – suspend the release of the goods or detain them. The suspected infringer and the rightsholder are subsequently informed about the suspension within one working day. Unless the parties agree to the destruction of the infringing goods, the rightsholder must initiate court proceedings within 10 working days to determine whether an intellectual property right has been infringed (or, in the case of perishable goods, three non-extendable working days). The deadline can also be extended by an additional 10 working days. If no judicial proceeding is initiated within the timeframe, the customs authorities will grant the release of the goods or put an end to their circulation.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

If established through use, unregistered rights are fully enforceable in Sweden. A sign is deemed to be established if a significant part of the relevant public recognises the mark in question as an indication of source regarding the covered products or services. In the event that a mark is partially established on the market, then such unregistered mark will confer geographically limited exclusive rights.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names enjoy protection under the Swedish Company Names Act (2018:1653). This sets out that a company name can either be protected through registration with the Swedish Companies Registration Office, or as an unregistered trade name if it, through use, has become established in the market (either in a substantial part of Sweden or in a local part). Protection for company names is similar to that of trade marks, i.e. protection against identical trade symbols, confusingly similar trade symbols, or if the trade name is reputed, trade symbols that are identical or similar, and the use takes unfair advantage of, or without due cause is detrimental to, the company name's distinctive character or repute.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The aforementioned titles might be protected by copyright. The condition is that the use therein is related to the artistic work concerned. Furthermore, characteristic surnames confer protection against any use which may serve as an indicator of origin. However, for such protection to enter into force, that use would have to entail a disadvantage for the bearer of such surname.

## 16 Domain Names

### 16.1 Who can own a domain name?

Either a natural person or a legal entity can own a domain name.

### 16.2 How is a domain name registered?

A domain name can be registered through a registrar. This can be a reseller authorised by the Swedish Internet Foundation for the top-level domain “.se”.

### 16.3 What protection does a domain name afford *per se*?

A domain name does not confer any particular type of protection, except the right for a proprietor to use the domain name as an address for a website, or an email.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

On 1 January 2019, new and updated provisions in the Trade Marks Act entered into force. These changes were made in light of the transposition of EU Directive 2015/2436 to approximate the laws of the Member States relating to trade marks. Following these changes, it is now possible to register new types of trade marks, such as for example, animated marks.

Another change brought with the amendment is that it is now possible for customs to intervene against goods suspected of infringement, including in the event that the goods are not necessarily targeting the Swedish market.

At the same time, the previous Trade Names Act has also been replaced by a new Act on Company Names. This Act has now been modernised and the concept of “trade name” (Sw: “*firma*”) has been replaced by the concept of “company name” (Sw: “*företagsnamn*”).

Finally, a new Act on the Protection of Designations of Agricultural Products and Foodstuffs has also entered into force as of 1 January 2019.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

- PMT 7235-17 – In a case concerning a company’s use of the trade mark “CRISP ROLLS” on packaging for crusts/biscuits

(Sw: “*skorpa*”), the Patents and Market Court of Appeal considered whether the former infringed the earlier trade mark “KRISPROLLS”. The Court established that the trade mark “KRISPROLLS” has a fairly weak distinctive character for crusts/biscuits, and that the holder of that trade mark could not prove that the trade mark acquired, by way of use, any enhanced distinctiveness for the goods in question.

- PMT 3491-16 – The Patent and Market Court of Appeal decided to request a preliminary ruling by the Court of Justice of the European Union (CJEU) on the interpretation of the concept of “shape, or another characteristic, which gives substantial value to the goods” as per Article 7(1)(e)(iii) of Regulation 2017/1001. The CJEU will hand down its preliminary ruling on 14 March 2019.
- PMÖÄ 5438-17 – In a case concerning trade mark registration of alcoholic beverages, the Patents and Market Court of Appeal found that the mark “MAXIMUS VODKA MAXIMUS VITAE EST MAXIMUS VITAE EST EXPORT VODKA SUPER PURE” was confusingly similar to the earlier trade mark “MAXIMUS”.

### 17.3 Are there any significant developments expected in the next year?

The Swedish Government has – by way of a governmental inquiry (SOU 2018:6) – suggested the introduction of two new criminal denominations: copyright criminal offences; and trade mark criminal offences. In both denominations, the government also proposed that the offences should be considered “gross” if regarded as being particularly serious.

Furthermore, the Government also proposed the maximum sentence carried with the suggested criminal denominations to be increased from two years’ to six years’ imprisonment, and that all property – not just tangible objects – may be subject to seizure by the authorities. This means, for example, that domain names used for copyright and/or trade mark infringement could also be seized to ensure subsequent confiscation. The amendments are proposed to enter into force on 1 July 2019.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The possibility of securing preliminary injunctions expeditiously has significantly improved and the handling times at the specialised courts from commencement of the proceedings to a main hearing have been reduced.

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## HANNES SNELLMAN

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