

THE TRADEMARKS
LAW REVIEW

FIFTH EDITION

Editors

David R Eberhart and Andrew M Levad

THE LAWREVIEWS

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PREFACE

This is the fifth edition of *The Trademarks Law Review*. Although the world has changed significantly since the release of last year's edition, the key objectives of this publication remain the same: (1) providing practitioners with a snapshot capturing the current state of trademark law and its key provisions across the world; (2) analysing recent litigation for insight into trends and developments in the law; and (3) making informed forecasts of legal and legislative changes affecting trademark practice.

As with previous editions, we brought together leading trademark practitioners to prepare chapters reflecting the state of trademark law in their respective jurisdictions. We kept the general structure of each chapter consistent to facilitate comparison between each country's laws. This text does not, and is not intended to, provide a granular analysis of the world's trademark laws or the constellation of cases that have developed across these laws in the past year. Rather, we hope this text will serve as a reference tool for practitioners' real-world use, providing a working survey of the global trademark landscape and insights into some of the particularities of the covered jurisdictions.

The changes affecting our world and its citizens have naturally impacted trademark law and practice around the globe. The persistent covid-19 pandemic hampers a return to traditional in-person commerce, and natural and human-made disasters continue to disrupt communities. The sheer unpredictability of the past year has kept many of us at home, interacting with the world through computer screens and forcing many aspects of our lives into an increasingly digital space.

Yet, trade is resilient. And where there is trade, there are trademarks. Most courts and other IP tribunals around the world have switched successfully to remote proceedings, and many IP offices have been able to resume trademark examination and processing at pre-pandemic speeds (which is not to deny that significant backlogs often remain). New case law continues to blossom in the digital space that trademark practice increasingly occupies, resulting in significant developments in the fields of online advertising and e-commerce. With an explosion of online shopping came new demand for participants in global trade systems to re-examine and refine their trademark strategies, including for cross-national licensing relationships, anti-counterfeiting measures, and development and expansion of online retail businesses.

Our authors have gathered for their respective chapters the most germane examples of legal developments in our shared new world. We hope that readers will consult this new edition regularly, and that its comprehensive yet accessible presentation will provide a convenient guide to contemporary global trademark law.

David R Eberhart and Andrew M Levad

O'Melveny & Myers LLP

San Francisco

September 2021

GREECE

*Nikolaos Lyberis*¹

I OVERVIEW

The new Greek trademark registration and enforcement landscape, introduced after the enactment of the Trademarks Law No. 4679/2020, is described in this chapter. After brief reference to the legal framework for the protection of trademarks and other similar intellectual property rights, aspects of registrability, prior rights and *inter partes* proceedings such as opposition, invalidity and revocation actions are approached. Civil proceedings against infringements of trademarks, unfair competition and disputes regarding company names, trade names and domain names are presented regarding pretrial, main hearing and alternative handling of cases. Lastly, representative case law illustrates these areas of law.

II YEAR IN REVIEW

i XΩPIO-HORIO case²

In this trademark infringement case, the plaintiff, Minerva SA Edible Oils & Food Enterprises, owner of a Greek trademark series consisting of or including the word 'XΩPIO' (meaning 'village') (Class 29, 30), requested the ceasing of use of the indications XΩPIO-HORIO by the defendants, owners of the Greek trademarks 'LyraKis FAMILY mild 0.3 Cretan Village' (in English) and 'Λυραάκη ΟΙΚΟΓΕΝΕΙΑ ελαιού 0.3 Κρητικό Χωριό' (in Greek), which are used to distinguish olive oil. The court found that the olive oil under the plaintiff's trademark 'XΩPIO' has prevailed in the course of trade. The court ordered the defendant to cease using the indications XΩPIO-HORIO either alone or in combination with other indications to distinguish olive oil and any other types of oils and edible fats.

ii EVOLTRA v. EVOLVA pharmaceuticals case³

The opposing party requested the rejection of the Greek trademark application (Class 5) because of its similarity with its prior EUTM 'EVOLTRA' (word) (Class 5). The Administrative Trademarks Committee (ATC) found that the two marks are similar. The second word 'pharmaceuticals' of the contested application is descriptive and as such is lacking distinctive power and must be rejected.

1 Nikolaos Lyberis is the managing partner of Vayanos Kostopoulos IP Law Firm. The information in this chapter was accurate as at November 2020.

2 Decision No. 73/2020 of the CC of Appeal of East Crete.

3 ATC Decision No. 128/2019.

iii Medap v. medac case⁴

This opposition concerned the comparison of the Greek trademark application (Classes 5, 9, 10, 16, 35, 37, 38, 42 and 44) with the earlier EUTM (word) ‘medac’ (Classes 3, 5, 10). The two marks and the goods and services distinguished by them were found by the ATC to be confusingly similar. The figurative component of the Greek mark is insufficient to establish any sufficient differentiation between them.

iv MAMMUT v. MAMMUTH case⁵

In this invalidity case, the petitioner holder of IRs and MAMMUT (word) (Class 25), both designating Greece, filed a petition for declaration of invalidity against the Greek trademark (Class 25). According to the ATC’s decision, the compared marks are confusingly similar both with respect to their word elements as well as their figurative elements. The contested trademark was cancelled.

v Ikea v. Ikeapharm case⁶

The defendant registered and used the domain names ‘ikeapharm.gr’ and ‘ikeapharm.com’, through which he was selling pharmaceutical products and cosmetics (online pharmacy shop). The plaintiff, the holder of the famous trademark and distinctive sign IKEA, filed a civil action requesting the ceasing and desisting of the use of its famous sign and mark. The court held that the registration and use of the defendant’s domain names infringes the famous distinctive signs of the plaintiff (trademark series, company name, trade name, domain name, all consisting of or including the indication IKEA). The defendants were ordered to cease use of the contested domain names and to transfer their ownership to the plaintiffs.

vi Alibaba case decision⁷

This infringement case was about the comparison between the defendant’s domain name ‘alibaba.info’ and the prior and famous trademark, distinctive sign (as domain name, company name, trade name) ‘Alibaba’ of the plaintiff. According to the civil court, the compared signs are highly similar. The defendant was ordered to cease using the contested domain name in both Greece and the EU.

vii ΣΚΑΙ v. SKY case⁸

The plaintiff, owner of the EU trademark series ‘SKY’ has operated since 1989 and is the largest television network of the UK. The defendants have been using the mark ‘ΣΚΑΙ’/‘SKAI’ since 1989 in Greece as a distinctive sign of their radio and television station, as company name, trade name and domain name. The mark ‘ΣΚΑΙ’ is widely known by the Greek consumer public. The free of charge services provided by the plaintiff are only accessible by English consumers. The two signs, SKY and ΣΚΑΙ/ SKAI, are dissimilar so as to cause confusion to the public, both from the optical and acoustical impression that they create. The word ΣΚΑΙ/ SKAI is meaningless in Greek.

4 ATC Decision No. 150/2019.

5 ATC Decision No. 33/2019.

6 Decision No. 1801/2015 I. Instance MMCC of Athens.

7 Decision No. 4839/2014 I. Instance SMCC of Athens, Isokratis Database.

8 Decision No. 1726/2013 I. Instance SMCC of Athens (Interlocutory Injunction), Isokratis Database.

viii Olympic Games 2004 case⁹

According to Greek Law 2598/1998, terms related to the term ‘Ολυμπιακοί Αγώνες 2004’ (Olympic Games 2004), which have been *de jure* as trademarks, without any prior examination of their registrability, are protected in favour of the Organizing Committee of Olympic Games – Athens 2004.

In this infringement case, the defendant registered and was using the domain name www.olympicgames2004.gr. The court ruled that the latter infringes the committee’s rights on the above terms, according to the provisions of trademark law and unfair competition law. The defendant was ordered to cease and desist using the contested domain name as well as any other term that is linked to the Olympic Games.

III LEGAL FRAMEWORK

i Legislation

- a* Trademarks Law 4679/2020 (Official Gazette A71/20 March 2020). Reference to number of an Article is henceforth meant to be of Law 4679/2020;
- b* EU Directive 2015/2436 for the harmonisation of national trademarks law;
- c* EU Directive 2004/48 for the enforcement of IP rights;
- d* Being a member of the EU, Greece is part of the European Union trademark system (Regulation 2017/1001). The EUIPO Trademark Guidelines affect considerably the practice of the ATC and the courts;
- e* Paris Convention (1883) – Ratification Law 213/1975;
- f* TRIPS Agreement (1993) – Ratification Law 2290/1995;
- g* the Nice Agreement for Classification of Goods and Services (11th version) – Ratification Law 2505/1997; and
- h* the Unfair Competition Law 146/1994 as currently in force.

ii Authorities

- a* Article 20(3) now officially distinguishes between the different tasks undertaken by the officers of the Greek Trademarks Office (GTO), by explicitly referring to:
 - ‘controllers’, who examine whether a new trademark application fulfils the formal requirements;
 - ‘researchers’, who perform a search for earlier possibly conflicting trademarks and send relevant notifications to the holders of earlier rights;
 - ‘examiners’, who examine new trademark applications as to absolute grounds of refusal; and
 - ‘registrants’, who confirm whether formal requirements for registration are met and record the registration;
- b* the General Commercial Registry (ΓΕΜΗ) and Chambers of Commerce as one-stop-shop service providers for company names;
- c* the National Telecommunications and Post Services Commission (ΕΕΤΤ) for domain names; and
- d* the Council for the Supervision of Advertising Practices (ΣΕΕ) for illicit advertising.

⁹ Decision No. 9485/2000 I. Instance SMCC of Athens SM (Interlocutory Injunction), EpiskEmpD/2000 (1994).

iii Substantive law

- a* Law 4679/2020 for registered trademarks, including well-known marks;
- b* Law 146/1914 for unregistered marks, company names, trade names or business names;
- c* Law 146/1914 against Unfair Competition Law 4679/2020 and EU Regulations (EC) 110/2008, (EU) 1151/2012, (EU) 1308/2013, (EU) 251/2014 and Article 4 of Law 4679/2020 for geographical indications. There are also laws on specific branches of products, for example Law 2040/1992 for olive oil, PD 81/1993 for agricultural products, among others; and
- d* Decision No. 843/2/1.3.2018 of National Telecommunications and Post Services Commission (domains) (EETT) for domain names.

IV REGISTRATION OF MARKS**i Inherent registrability*****New trademark definition – practical impact on Greek trademarks and international registrations***

Graphical representation as an element of trademark definition is abolished. Also, new forms of trademarks, the ‘non-traditional marks’ (i.e., 3-D marks, position, pattern, motion, audiovisual and hologram marks) have been introduced.¹⁰

Trademarks shall be represented in the registry in any appropriate form, in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable trademark offices (TMOs), the courts and the public to determine with clarity and precision the scope of protection afforded to their proprietor.¹¹ These provisions are applicable both for Greek trademark registrations and for international petitions that are based on Greek trademark applications as well as for international trademark registrations designating Greece.¹² Nevertheless, for the time being, while the World Intellectual Property Organization (WIPO) accepts non-traditional trademarks as basic registrations, it requires that these be graphically represented in the national trademarks registry. Thus, if a Greek sound mark is represented in the form of a sound recording (MP3, MP4), then it may not be accepted by WIPO.¹³

Goods and services classification with analytical reference to goods and services

Goods and services for which protection is sought should be identified with sufficient clarity and precision to enable the competent authorities and economic operators to determine the scope of protection of a mark. Use of such general terms shall be interpreted as including, respectively, protecting all the goods or services covered only by the literal meaning of the indication or term and not as comprising a claim to goods and services, which cannot be

¹⁰ Article 2(4)(c)(d)(e)(h)(i).

¹¹ The IP Offices of the EU countries, EUIPO and the European Commission issued on 4 December 2017 a Common Communication on the representation of the new types of acceptable marks, their definitions and the accepted electronic means for sound, motion, multimedia and hologram marks. See the first update of June 2018 (<https://euipo.europa.eu/ohimportal/en/news/-/action/view/3941045>).

¹² Article 71.

¹³ See explanatory notes on the official application form ‘MM2 Application for International Registration governed exclusively by the MADRID PROTOCOL (Rule 9 of the Common Regulations)’, Item 7(55-56), https://www.wipo.int/export/sites/www/madrid/en/forms/docs/form_mm2_inf.pdf.

so understood. This applies also to marks registered prior to the new law. Nevertheless, for older marks that are registered with respect to the entire heading of a Nice Classification, no provision is foreseen that corresponds to that adopted by Article 33(8) of Regulation 2017/1001 (i.e., a declaration for protection request beyond the literal meaning of Class Heading to be filed within a term). Proprietors of these Greek trademarks are generally recommended to examine whether or not goods and services for which their mark is actually used are included in the literal meaning of said Nice Classification headings. In the negative case, it is advisable for better protection that relevant petitions specifying such goods and services be filed.

Absolute grounds for refusal

A trademark shall not be registered or, if registered, shall be liable to invalidation if it cannot constitute a trademark in the meaning of law¹⁴ or is devoid of any distinctive character¹⁵ or consists exclusively of signs designating the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of goods and services,¹⁶ or consist exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade.¹⁷ Unlike Article 4(5) of the EU Directive 2015/2436, the new Law provides that acquired distinctiveness through use must be proven to exist until the date of filing of an application and not after the filing date. This provision, though, disregards the fact that the trademark registration process is sometimes quite lengthy to be completed. Prevalence in the course of trade within the Greek territory is required.¹⁸ According to the Court of Justice of the European Union (CJEU) case law, in determining whether a mark has acquired distinctive character because of the use made of it, an overall assessment of the evidence is required concerning the trademark's function as source indicator.¹⁹ Such evidence may include market share, promotional expenses, market awareness and opinion polls.²⁰

The shape of goods may also constitute an absolute ground for refusal if a sign filed as a trademark is comprised exclusively²¹ thereof. The innovation of this provision²² is that it does not refer only to the shape but also to a possible other characteristic of the good.

An example of a trademark's 'other characteristic' might be a sound mark representing the sound of a motorbike and distinguishing motorbikes if the sound results from the nature

14 Article 4(1)(a).

15 Article 4(1)(b).

16 Article 4(1)(c).

17 Article 4(1)(d).

18 Greek Council of State Decision No. 293/2008, EEmpD, 2019,161. See also CJEU C-215/14 *Société de Produits Nestlé SA v. Cadbury UK Ltd*, pp.63 to 64.

19 CJEU T-359/12 *Louis Vuitton Malletier v. OHIM*, pp. 88 to 89.

20 *ibid.*, p. 90.

21 According to CJEU case law, the term 'exclusively' has been interpreted so as to restrict this ground for refusal to signs which consist 'exclusively' of the shape of goods that is 'necessary' to obtain a technical result. Because any shape of goods is, to a certain extent, functional and it would therefore be inappropriate to refuse to register a shape of goods as a trademark solely on the ground that it has functional characteristics. Thus, non-registrable are solely shapes of goods that incorporate a technical solution only, and whose registration as a trademark would therefore actually impede the use of that technical solution by other undertakings; CJEU C-48/09 P, *Lego*, para. 48.

22 Article 4(1)(e)(aa), (bb), (cc).

of the goods (in the sense of technical performance) or an olfactory mark of a scent for a perfume.²³ Furthermore, signs which may mislead the public, for instance as to the nature, quality or geographical origin of the goods or services, contravene public policy or accepted principles of morality as well as Article 6 *ter* of the Paris Convention, those who have great symbolic importance (especially religious symbols, representations and words) or those that have been filed in bad faith, shall also not be registered as trademarks.²⁴

Absolute grounds for refusal are also protected geographical indications (PGIs), protected designations of origin (PDOs) and plant variety rights.²⁵

At the stage of the filing of the trademark application, absolute grounds for refusal are assessed *ex officio*. After the publication of a trademark, they may be raised through an opposition.²⁶ Legal interest does not have to be proven. Furthermore, cancellation of a registered mark can be requested on absolute grounds.²⁷

ii Prior rights

Procedural aspects

The *ex officio* examination as to relative grounds of refusal is abolished with the aim to expedite the registration process.

However, the Trademark Office (TMO) would still undertake an anteriority search in order to notify the holders of earlier conflicting trademarks. This type of search would not extend to other earlier rights (such as company names, domain names, among others).

Thus, it is highly recommended that the applicants perform an availability search before filing their mark and the proprietors monitor their earlier rights against confusingly similar new trademark applications for opposition purposes.

Substantive aspects

A sign would not be registered or may be subject to invalidity when it conflicts with earlier rights. The latter may be a Greek national trademark, a European Union trademark (EUTM) or an international registration (IR) designating Greece, well-known trademarks in the sense of Article 6 *bis* of the Paris Convention as well as trademarks registered and used abroad (under certain circumstances – trademark filed in bad faith).

The earlier rights may also be to non-registered trademarks and other signs used in the course of trade (such as company names, distinctive titles, copyright or the right to personality such as an artist's name), PDOs and PGIs.²⁸

23 EUIPO Trademark Guidelines, Version: 1.0, of 1 February 2020, Part B, Section 4, Chapter 6.2 (<https://guidelines.euipo.europa.eu/1803468/1786987/trade-mark-guidelines/2-shape-or-other-characteristics-resulting-from-the-nature-of-the-goods>).

24 Article 4(1)(f), (g), (h), (i), (o).

25 EU Regulations 110/2008, 1151/2012, 1308/2013, 251/2014; see also Articles 22 and 23 of TRIPS Agreement with respect to international Agreements ratified by Greece or the EU.

26 Article 25(2).

27 Article 52(4).

28 Article 5(3)(e).

Relative grounds of refusal or invalidity constitute also the unauthorised filings by an agent or representative of the trademark owner.²⁹ Such bad faith trademark filing presupposes lack of knowledge from the part of the real trademark owner.³⁰

Prerequisites for protecting earlier rights and refusing a trademark application or declaring a registered trademark invalid

These prerequisites are the following:

- a* earlier rights predate the filing of the contested trademark application or registration; and
- b* there is a 'likelihood of confusion' (including the likelihood of association) for the part of the relevant public. This is the issue of whether the public might believe that the goods and services in question come from the same undertaking or from economically linked undertakings. In the assessment of likelihood of confusion the basic parameters of identity or the 'degree of similarity between the signs', the identity or the 'degree of similarity between the goods or services' involved and the 'distinctiveness of the earlier mark' are taken into account. Other factors, such as the 'relevant public', its 'sophistication' and the 'degree of attention' it normally displays would also affect the assessment of the likelihood of confusion.³¹

Likelihood of confusion is not a prerequisite:

- a* when a 'double identity' (identity of the compared signs and the goods or services concerned) exists; and
- b* when the earlier right refers to a 'reputed' trademark. In the latter case, protection is granted if there is an identity or similarity between the signs in question, so that a link between the later and the earlier mark is created in the mind of the relevant consuming public and 'the use of the later sign without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark (free-riding; dilution)'.³²

In connection with the concept of reputation, it is not required anymore to prove the uniqueness of the mark and the imaginative character thereof. A trademark can be reputed when it is known by a significant part of the relevant public in Greece (or the EU where a EUTM is involved).³³ Proof related to long-standing and widespread use of the mark, high market share and extensive advertising of the goods bearing the mark as well as market surveys about the degree of market awareness are important means of evidence to that effect.

29 Article 5(3).

30 Article 10 of the Law 4679/2020 implementing Article 13 of EU Directive 2015/2436.

31 Decision No. 672/2019 I. Instance MMCC of Kerkyra, NOMOS Database.

32 Decision No. 966/2019 of the Supreme Civil Court of Greece, NOMOS Database.

33 Decision No. 1030/08 of the Supreme Civil Court of Greece EEmpD 2008, 891, Decision No. 1423/13 of the Supreme Civil Court of Greece, EEmpD 2014, 215.

iii Inter partes proceedings

Relative grounds of refusal or invalidity³⁴ – procedural aspects

Relative grounds of refusal or invalidity may be raised by third parties (not *ex officio*), before registration, by means of an opposition or, after registration, either by an application for declaration of invalidity of the contested mark or by a counterclaim brought about by the defendant in an infringement action for declaring the plaintiff's mark invalid.

The opposition and the application for a declaration of invalidity are filed before the ATC.³⁵ Appeals relating to opposition proceedings are addressed to ordinary administrative courts,³⁶ whereas appeals relating to invalidity (and revocation) proceedings although filed before the ATC are now addressed to civil courts.³⁷

Opposition

- a The opposition is filed and examined before the ATC.³⁸ Legal means against the latter's decision are filed before the ordinary administrative courts.³⁹
- b The opposition is filed within three months starting from the day following the date of digital publication of the examiner's or the court's decision accepting the challenged trademark application.⁴⁰
- c Both absolute and relative grounds of refusal may be raised.⁴¹

An opposition on absolute grounds of refusal may be filed by any natural or legal person, including associations of manufacturers, producers, service providers, traders and consumers or bodies that represent such associations.

Relative grounds of refusal are only raised by earlier right holders and the duly authorised users of earlier trademarks.⁴²

Requirement as to proof of use of the earlier mark⁴³

When at the date of filing of the opposed trademark application the earlier trademark (legal basis of the opposition) has been registered for at least five years and if the applicant so requests, the opposing party has to provide proof that his or her mark has been put in genuine use in the territory where it is protected during the five-year period preceding the date of filing of the opposed application or that there are proper reasons for non-use. Failure to meet the above requirement leads to the rejection of the opposition, without being examined on the merits.

34 Article 5.

35 Articles 25 and 52 respectively.

36 Article 32.

37 Articles 52 and 50 respectively.

38 Article 25(1).

39 Article 32.

40 Article 25(1).

41 Article 25(1)(2)(3) and Article 5.

42 Article 17(4).

43 Article 28.

Amicable settlement

The new law⁴⁴ enables the parties in opposition proceedings to jointly request before the ATC a time period of at least two months to explore possible extrajudicial settlement (analogous to the cooling-off period provided by the European Trademark Regulation).

Application for a declaration of invalidity

- a* This type of application is filed before the ATC.⁴⁵ Legal means against the ATC's decision are adjudicated by the civil courts.⁴⁶
- b* The application for invalidity can be filed at any time after the registration of the mark. However, in the case where the proprietor of an earlier trademark has acquiesced, for a period of five successive years, in the use of a later registered trademark (remained inactive against the use or registration of that mark) while being aware of such use (real knowledge is required; presumed knowledge may suffice when undoubtedly proven), that proprietor shall no longer be entitled to apply for a declaration that the later trademark is invalid, unless the later trademark was filed in bad faith (acquiescence).⁴⁷
- c* An application for invalidity may be filed on both absolute and relative grounds of refusal.⁴⁸
- d* Although Article 52 does not specifically refer to the entitlement of the users of earlier trademarks to file an application for declaration of invalidity, a duly authorised user (Article 17, Paragraph 4) should also be able to file such legal means.
- e* If the other party in the proceedings so requests, the applicant for the invalidity is required to prove genuine use of his or her earlier trademark⁴⁹ or that there are proper reasons for non-use in two separate time periods (i.e., within the five-year period preceding the filing of the application for invalidity (provided that his or her mark has been registered for at least five years at that time) and within the five-year period preceding the filing of the contested trademark registration (when at that time his or her mark has been registered for more than five years)). In the absence of adequate proof of use (or of proper reasons for non-use), the application for invalidity is rejected (no examination on the merits).

Use requirements

Greek trademark law does not provide for any use or intent to use requirements for filing, registering or renewing a trademark application or registration.

Proof of use is required for pursuing the refusal or invalidity of a later trademark and prohibiting the use thereof. The earlier trademark owner, if the other party so requests, is required to prove genuine use of his or her earlier trademark in the frame of opposition and invalidity proceedings.⁵⁰

The defendant in infringement proceedings is entitled to request that the plaintiff proves that the earlier trademark has been put to genuine use or that there are proper reasons

44 Article 27(4).

45 Article 52(1).

46 Article 52(1).

47 Article 12.

48 Articles 52(4)(5) and 5.

49 Article 54.

50 Articles 28 and 54.

for non-use during the five-year period preceding the filing of the civil action⁵¹ or the petition of interlocutory injunction.⁵² Failure to comply with the above requests leads to the rejection of the legal means filed.

Non-use of a registered trademark renders it vulnerable to a revocation action (see below).

Application for revocation (Article 50) – counterclaim for revocation (Article 38 Paragraph 12 et seq.)

An application for revocation is filed before the ATC. The ATC's decision can be contested before the civil courts.

When infringement proceedings have already been initiated, revocation may be pursued through a counterclaim (a separate civil action) filed by the defendant in parallel to the infringement proceeding case (see Section III.iii, 'Use requirements').

The new law lays down the absence of genuine use and the trademark having become generic or a misleading indication as grounds for revocation. In particular:

- a* a trademark shall be liable to revocation if, within a five-year period as of its registration, it has not been put to genuine use in Greece in connection with the goods or services in respect of which it is registered or if, within a continuous five-year period, it has not been put to use, and there are no proper reasons for non-use. Real and effective use is proven through evidence concerning the place (Greece or part thereof), time (as above), extent (volume of the acts of use, duration and frequency thereof are important to that effect) and nature of use (public and external use to guarantee the origin of the goods which aims at creating an outlet for those goods would protect a trademark registration from a revocation action);
- b* a trademark shall also be liable to revocation if, after registration, it has become commonplace due to acts or inactivity of the proprietor; and
- c* as a result of the use made of, it is liable to mislead the public as to the nature, quality or geographical origin of the goods and services.

The trademark holder bears the burden of proving the use of his or her mark.

Mediation

The new law⁵³ foresees, for the first time, mediation proceedings in disputes pending before the ATC at any time after the filing of an opposition, petition for revocation or invalidation and intervention. The petition for mediation causes suspension of the deadlines.

iv Appeals

Previously, civil courts were bound by the final decisions of the ATC and the administrative courts.⁵⁴ With the new Law, there is partial transfer of authority from the administrative to the civil courts.⁵⁵

51 Article 40.

52 Article 42(1).

53 Article 31.

54 Decisions Nos. 966/2019, 575/2017, 1731/2014, 344/2013, 62/2013 of the Supreme Civil Court of Greece, NOMOS Database.

55 See Article 94(3) of the Hellenic Constitution.

In civil action proceedings for trademark infringement, the defendant may now file a counteraction for the revocation or invalidation of any mark which is the legal basis of the civil action.⁵⁶ Until now, the civil courts could examine such a case only with respect to EU trademarks for which Regulation 2017/1001 applied. The legislative goal is the avoidance of conflicting decisions on the same case.

It is also foreseen⁵⁷ that petitions for revocation or invalidation of a mark are examined at the first instance by the ATC, for their speedy resolution. However, the ATC's decision can be challenged before civil courts and not in administrative ones.⁵⁸ The ATC's decisions are examined formally and substantively by the civil courts, although the ATC is an administrative law body operating within the frame of the TMO.

The ATC has jurisdiction over the acceptance and rejection of trademark applications; over the examination of oppositions and recourses against decisions of the examiner; over petitions for revocation or invalidation, intervention and conflicts which arise between the TMO and the applicants.

However, the constitutionality of the partial transfer of competence from administrative courts to the civil ones has been put in doubt since it introduces an unjustified exception to the established principle of distinction between the competence of administrative and civil judicial bodies.⁵⁹

v Elimination of fees for change records and restriction of goods and services

Another important change is the elimination of official fees for records of change of owner's name, legal seat, address and legal form. These updates in the registry are a matter of public interest.

There is a slight increase in the trademark filing fee (€120 for the first class, up from €110) and the renewal fee (€110 for the first class, increased from €90). Nevertheless, reduced official filing fees are due (€100 for the first class) and official renewal fees (€90 for the first class) if the relevant petitions are filed electronically.

vi Guarantee or certification marks

Guarantee or certification marks⁶⁰ is a novum of the new law concerning the quality of goods.

vii Term and renewal of trademarks

The 10-year protection term for Greek trademarks begins from the filing date of the application and not on the day following the filing as was the previous law.

Renewal is possible within the last six months (not 12 months) before the expiration of a mark.

Late renewal within the six months' grace period is possible subject to a 50 per cent fine on the official fee. However, caution is required because renewal within the grace period

56 Article 38(12).

57 Article 47(4).

58 It is an opposition of Article 538 of the Code of Civil Proceedings.

59 See also Section III.v.

60 Articles 56 to 63.

does not overturn third parties' rights possibly acquired in the meantime. This new provision though seems to be legally questionable since renewal within the grace period is granted while protection against third parties within the same period is denied.

V CIVIL LITIGATION

i Forums

The competence of civil courts of first and second instance to adjudicate trademark matters is significantly broadened.⁶¹ The national courts for infringements concerning European trademarks are those of Athens and Thessaloniki (first and second instance).

ii Pre-action conduct

It is often possible to settle conflicts between earlier and later trademarks through negotiations that may lead to either withdrawal of a mark or limitation of the list of goods and services. A warning letter is also a useful alternative.

iii Causes of action

Rights conferred by a trademark

Positive powers

Registration of a mark entitles the proprietor to affix the mark on the products, their packaging, on invoices and price lists, to use the same in advertising, in social media, et al.⁶²

Negative powers

Prohibited acts constituting an infringement are indicatively enumerated in the law.⁶³ Unauthorised use of a trademark as a trade or company name or part thereof, its use on business papers and in advertising, including social media and in comparative advertising were added to the new law as infringing acts. Furthermore, enforcement of trademark rights is strengthened against infringing goods coming from third countries that are being brought in the course of trade in Greece without being released for free circulation here, regardless of any custom situation (transit, transshipment, warehousing, etc.).

The proprietor may prohibit 'preparatory acts' concerning use of packaging or other means, the 'reproduction of the trademark in dictionaries' as well as contest the registration and use of the 'trademark' when 'registered in the name of an agent or representative' of the real owner.

Consequently, the protection reserved to the registered trademark is now readily enhanced.

Limitation of the effects of a trademark

a A trademark shall not entitle the proprietor to prohibit a natural person (not a legal entity though) from using in the course of trade his or her name, which happens to be identical to the earlier mark.

61 See also Section III.iv.

62 Article 7(1). Acts amounting to use of a trademark are referred to in Article 7(2).

63 Article 7(3).

- b* A third party shall not be prohibited from using in the course of trade signs or indications which are not distinctive. The new law broadens said limitation owing to the lack of reference to criteria, such as the kind, quality, intended purpose, of goods and services. There may now be room for such limitation to be invoked against signs that, although are devoid of distinctive character, have been granted trademark registration (and they have not meanwhile acquired distinctive character through use).

The limitations under points (a) and (b), above, shall reasonably apply where a third party acts in accordance with honest practices.

- c* Intervening rights are an exception to the principle of priority. The owner of an earlier trademark shall not succeed in invalidity or infringement proceedings against a posterior registered mark, if the latter has been obtained at a time when the earlier trademark was liable to be declared invalid or be revoked (e.g., because at that time had not acquired distinctive character due to its use), or if the earlier trademark could not challenge the posterior mark because the necessary conditions were not then applicable (e.g., no enhanced distinctiveness or reputation of the earlier mark had been acquired at that time to permit protection in terms of likelihood of confusion or dilution, respectively).

In such cases, the marks in conflict are led to coexistence, since the proprietor of the later trademark would not be entitled to challenge the use of the earlier trademark.

- d* 'Preclusion of a declaration of invalidity' and 'prohibition of use of a later trademark due to acquiescence' may also be regarded as means of limitation of the effects of a trademark. The counterargument of acquiescence (the proprietor of the earlier trademark remained inactive against the use of a later registered trademark for a period of more than five years) may be put forward not only in invalidity proceedings but in infringement proceedings as well and preclude – if successful – the grant of protection to the earlier trademark against the registration and use of a later trademark.
- e* Exhaustion of the plaintiff's right on an earlier trademark.

iv Conduct of proceedings

Infringement proceedings include the initial civil action writ, the deployment of plaintiff's arguments, the defendant's arguments and any supplementary writs by both parties commenting on the opposite party's arguments and submitted evidence. Sworn declarations, public or private documents such as contracts, invoices, promotional material, ads in paper or electronic form may be presented to the court. It remains at the discretion of the court to invite one or more witnesses for oral examination if it is deemed necessary.

Taking into account the negative powers of a trademark proprietor and the limitations of trademark protection, one could summarise the main defences available according to the law, to a person or entity sued for alleged infringement as follows:

- a* non-use of the plaintiff's trademark or other sign in the course of trade; that is to say, not as a source indicator for the distinguished goods and services (e.g., in the frame of a scientific research, parody or in a cultural performance);
- b* use requirement concerning the plaintiff's prior mark or other right (see Section III.iii);
- c* claiming lack of risk of confusion including risk of association with respect to the earlier mark or lack of fame of the plaintiff's mark;

- d* use of own earlier right by the defendant (principle of priority);
- e* counterclaim for invalidity or revocation of the plaintiff's mark (Article 38, Paragraph 12 et seq.). To this end, a separate civil action in the sense of counterclaim by the defendant in parallel to the infringement action is required. It is noted that a counterclaim for invalidity or revocation may also be filed in defence against a petition for interlocutory injunction. However, the trademark would not be declared invalid or be revoked by virtue of such decision;
- f* exhaustion of plaintiff's rights;
- g* loss of plaintiff's trademark protection owing to acquiescence with respect to the defendant's posterior registered trademark;
- h* intervening rights (see Section IV.iii); and
- i* abusive exercise of trademark's negative powers according to general civil law principle (Article 281, CC).

v Remedies

Apart from withdrawal of infringing goods, removal of infringing sign and destruction of said goods, noteworthy changes are:

- a* wilful misconduct is required for the court to order a fine for moral damages. A simple misconduct (mere fault) is not sufficient;
- b* if the court issues a desist order, the maximum amount of pecuniary penalty that can be imposed is up to €100,000 in favour of the claimant (as opposed to €10,000 under the previous law) and up to one-year imprisonment of the infringer. The same remedy is available in a granted interlocutory injunction; and
- c* civil or penal court decisions regarding trademark infringement may, at the expense of the infringer, order appropriate measures for the dissemination of the information concerning the decision, including the uploading of the decision online and the entire or partial publication thereof in mass media and social media.

VI OTHER ENFORCEMENT PROCEEDINGS

In respect of goods subject to customs supervision or customs control that are suspected of infringing an intellectual property right, EU Regulations No. 1352/2013 (as amended by Regulation 2020/1209) and 608/2013 provide for customs detention of potentially infringing goods. EU Regulation No. 608/2013 has proven to be a useful tool against counterfeits, if the applicant is a holder of an EU IP right, such as an EUTM, a registered community design, a PDO or a PGI.

According to the new law,⁶⁴ owners of Greek trademarks are entitled to prevent all third parties from bringing goods in the course of trade in Greece, where such goods come from non-EU countries and bear without authorisation a trademark that is identical to a prior trademark registered in respect of such goods, or which cannot be distinguished in its essential elements from said trademark. Such right though shall not apply if the holder of goods proves that the proprietor of the registered trademark is not entitled to prohibit the placing of the goods in the Greek territory.

64 Article 7(5).

VII OUTLOOK

E-procedures before TMOs are recognised tools of service improvement. However, the prima facie reasonable limitation of trademarks' negative powers may, under some circumstances, distort competition. Furthermore, partial transfer of judicial competence from the administrative to the civil courts in regard to appeals against the ATC's decisions on revocation and invalidity petitions may be challenged in the future on grounds of unconstitutionality causing legal uncertainty, as the minority of the Full Bench of the Supreme Administrative Court held. Finally, augmented e-infringements in the digital world challenge e-commerce activities, especially in times of economic crisis or public health restrictions. Generally, the new law is considered to be a successful step towards better trademark protection. New case law though will hopefully provide any pending answers.

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