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John Filias

IP Consultants

Patents - Designs - Trademarks
Antitrust & Competition Law
Domain names - Internet Law
Copyright

Patent & Trademark attorneys
European Patent attorneys



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1. Legal framework

The following national and international laws govern trademarks in Greece:

- the Trademark Law (2239/1994);
- the Unfair Competition Law (146/1914);
- Law 213/1975, which ratifies the Paris Convention for the Protection of Industrial Property;
- the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights, implemented on January 1 1996 by Law 2290/1995;
- Law 2505/1997, which ratifies the Nice Agreement on the Classification of Goods and Services (Ninth Edition applicable);
- Law 2783/2000, which ratifies the Madrid Protocol (Greece has issued a declaration that the limit to notify refusal of protection shall be 18 months);
- Ministerial Decision K4-307/2001, implementing the Madrid Protocol; and
- Chapter C of Law 2943/2001, establishing Greek Community trademark courts.

2. Unregistered marks

Protection

Although unregistered rights cannot be recorded in Greece, in practice they can be protected where, as per the relevant provisions of the Unfair Competition Law, the use of the unregistered mark has been so extensive that it has become a 'distinguishing feature of origin' of the party using the unregistered mark.

Use requirements

No particular time period for use is set by statute or case law. The issue of whether an unregistered mark has become a distinguishing feature of origin is examined on a case-by-case basis, in light of, among other things:

- the surrounding circumstances;
- any other conflicting marks (whether registered or unregistered); and
- any use overseas.

In general, the guiding principle is that use should be systematic, continuous and for a number of years.

3. Registered marks

Ownership

There are no specific limitations as to who may apply for a trademark – therefore, in Greece, individuals, legal entities or group organizations may equally apply to register a trademark.

Power of attorney

An attorney should be appointed to file the trademark application and a power of attorney is required before filing. Although the power of attorney need not be legalized by apostille, it should be signed and stamped with the company seal. The same power of attorney can be used for subsequent applications by the applicant within five years of the date of signing the original power of attorney form.

Scope of protection

According to Article 1(1) of the Trademark Law, a 'trademark' is any sign capable of being represented graphically and of distinguishing the goods or services of one undertaking from those of other undertakings. In particular, a trademark may consist of words, names of natural or legal persons, pseudonyms, representations, designs, letters, numerals, sounds (including musical phrases) or the shape of goods or of their packaging. The title of a newspaper or magazine may be deemed a trademark.

Articles 3(1) and following of the Trademark Law provide that, among other things, the following cannot be protected as trademarks:

- signs that are devoid of any distinctive character;
- signs that are descriptive, commonly used or functional;
- signs that are deceptive as to their geographical origin;
- signs that are against public policy or morality;
- signs that were filed in bad faith; and
- signs that conflict with prior rights to the point of giving rise to confusion to the public.

4. Procedures

Examination

Following the filing of a trademark application, a hearing is scheduled to take place before the

Trademark Committee and an *ex officio* examination takes place if there are any reasons to refuse the trademark application (aside from formalities and absolute and, to an extent, relative grounds for refusal). In case of objections, the applicant is given a deadline for the submission of written arguments in support of the trademark application. Moreover, any third party with a legitimate interest may file an intervention at the examination hearing.

Opposition

Any party with a legitimate interest may oppose the published trademark application in the *Official Bulletin* once it has been initially accepted by the Trademark Committee. Ideally, the interested party would have filed an intervention against acceptance of the trademark application at the examination hearing if the trademark application came to its attention earlier.

Registration

If there are no objections or oppositions, registration takes place automatically following publication of the trademark in the *Official Bulletin* and lapse of the opposition deadline.

Removal from register

According to Article 17 of the Trademark Law, a trademark can be cancelled, either in whole or in part, by decision of the Trademark Committee or the administrative courts with proper jurisdiction, in the following circumstances:

- The trademark has not been put to genuine use by its owner for a continuous five-year period following the date of registration of the trademark, or there has been no genuine use of the trademark by its owner within the five-year period immediately following the registration date of the trademark. Although the law calls for genuine use of the trademark by its owner, it is clear from a combination of other provisions and pertinent case law that if the genuine use of the trademark is carried out by a licensee of the trademark and the relevant licence agreement is recorded with the Greek Trademark Office, the trademark use by the licensee will be seen as use by the trademark owner.
- The trademark has been registered in the name of an undertaking that has been inactive for a period of five years. The term 'inactive' is not further defined by the law and this ground is rarely used for cancellation of a trademark. The burden of proof regarding inactivity lies with the third party seeking to cancel the trademark, presumably with a legitimate interest to do so (eg. registering the trademark itself).
- The trademark has become a commonly used term due to the activity or inactivity of the owner. This provision places the onus on the trademark owner to take any proactive steps necessary to ensure that the trademark does not lose its distinctiveness due to extensive use by others in a context that would render it a generic term. There is often a fine line between proving extensive use, as it may serve as an evidence of distinctiveness, while avoiding a finding of common usage.
- The trademark is likely to mislead the public and, particularly due to the use of the trademark by its owner, is likely to cause confusion with regard to the nature, quality or geographical origin of the goods and/or services which it covers. The objective of this provision is to prevent any bad-faith use after registration of a trademark that does not affect registrability itself, but rather the nature of the use.
- The trademark should have not been registered to begin with because it is in violation of Article 3 or 4 of the Trademark Law. This is an all-inclusive provision – if there are grounds to assert that a trademark has been erroneously registered – and as, once registered, there are no longer refusal or opposition procedures available against a particular trademark, this provision allows a party with a legitimate interest to pursue this course of action (ie, cancellation of a trademark on what would have been opposition grounds) within five years of the date of registration, unless the mark was filed in bad faith. However, the interested party is likely to be asked why it was not proactive and did not take appropriate action against the trademark during examination or opposition stage.

In order to substantiate cancellation grounds, interested parties are encouraged to conduct trademark searches in order to determine the availability of identical or similar marks in the Trademark Register. In use-based cancellations they should conduct investigations to determine the use and extent of a particular trademark and the activity or inactivity of the trademark owner.

5. Enforcement

Two distinct court systems are applicable to trademark rights. The administrative courts have jurisdiction on any issues relating to the registrability and validity of a registered trademark, subsequent to decisions issued by the Trademark Committee (eg, regarding examination, opposition or cancellation of a trademark). This jurisdiction is based on the Trademark Law, pursuant to which there are no prescription deadlines – although the actions taken depend on the applicable recourse or appeal deadlines.

Alternatively, the civil courts have jurisdiction over issues relating to the infringement of registered and unregistered trademarks and related rights. Aside from the provisions of the Trademark Law, unregistered rights are protected in the civil courts on the basis of the Unfair Competition Law (146/1914) if the unregistered rights can be claimed to have been established due to long and extensive use. However, the Unfair Competition Law provides a strict deadline for action of six months from the date on which the petitioner became aware of the infringing activities, with a maximum of three years from the date when the infringement commenced.

Administrative actions

A case moves to the administrative courts after adjudication by the Trademark Committee at first instance (ie, acceptance or rejection of a trademark). The case then progresses to:

- the Administrative Court of First Instance (for appeals against Trademark Committee decisions);
- the Administrative Court of Appeals (for appeals against first-instance court decisions); and

- the Council of State (for reconsidering the legal issues and remanding the matter to the Administrative Court of Appeals if errors in law are found in the earlier decision).

These proceedings are essentially an action against the decision of a Greek administrative authority (ie, the Trademark Committee), hence the administrative courts have jurisdiction and the Ministry of Commerce is involved in all such actions and proceedings (as the ministry to which the Trademark Committee belongs).

Civil actions

The civil courts handle infringement matters in a different manner. The party whose registered or unregistered trademark rights have been violated may bring a legal action before the civil courts, in particular in the relevant IP court. The IP courts were set up some years ago. This type of proactive proceeding involves no administrative or other authority and depends solely on the proactiveness of the party seeking to enforce its rights.

The following types of action are available.

Temporary restraining order: This is available in cases of extreme urgency – that is, where the trademark owner requests a temporary restraining order as soon as the infringing activities have begun in order to enjoin the allegedly infringing activities until adjudication by the court. This is an informal proceeding which may take place *ex parte*, although in almost all cases the courts invite the respondents to appear. The hearing usually takes place within two to three days of filing the temporary restraining order petition. During the brief oral proceeding, the primary aim is to convince the judge of the urgency of the matter and the irreparable harm that will be caused to the petitioner if the order is not granted. If the order is granted, it remains valid until the injunction petition hearing takes place (and at times may remain in force until the injunction decision is issued). The order can be requested only if an injunction petition is filed simultaneously. Although not subject to appeal, a petition to revoke it may be filed.

Injunction: A petition for injunction also requires urgency and is usually heard within one to two months of filing. The decision is then issued in approximately one to three months from the hearing date. The procedure is more formal than that for a temporary restraining order, as an actual hearing takes place, with witnesses for each side and the optional submission of sworn affidavits, as well as relevant pleadings and exhibits. The court also examines the merits of the case in more detail to the extent of determining that, at the very least, it is more likely than not that an infringement has occurred. Due to changes to the Code of Civil Procedure, a main infringement action must be filed no more than 30 days after the injunction decision is issued. Nevertheless, in order to demonstrate the seriousness of the matter for the court's assessment of the case, it is recommended that the injunction petition be filed concurrently with the main infringement action or shortly thereafter. As the injunction decision is always immediately enforceable, a petition to revoke its immediate enforceability may be filed.

Infringement action: An infringement action is a regular proceeding in which the matter is examined in detail by the IP court, and includes the most extensive pleadings. In terms of the relevant timeframes, in cases where the Unfair Competition Law is used as an auxiliary legal basis, hearings take place within six months of the date of filing and the decision is issued within six months of the date of the hearing (in order to comply with the six-month limit discussed above and found in the Unfair Competition Law). If the circumstances preclude the application of the Unfair Competition Law (due to prescription issues), the proceedings are longer – around one year for the hearing and one year for the decision to be rendered. All applicable timeframes naturally depend on the caseload of the court at the particular time.

Damages

The civil court proceedings described above primarily deal with infringement; thus, the aim is to stop the infringement. Damages are mostly awarded through a separate compensatory action, calculated on the basis

of a formula applied by the courts after liability has been irrevocably proven.

Criminal actions

Although criminal penalties are available by law, they are seldom pursued due to the cost and time involved, and because the main aim of trademark owners is the prevention of infringement through the civil courts.

6. Ownership changes and right transfers

In order for assignments, changes of address, changes to the legal form of an undertaking and licences to have legal effect in the Greek jurisdiction, they must be duly recorded against the particular trademark with the Trademark Office. Documents from other jurisdictions proving changes must be legalized by apostille, according to the Hague Convention. In addition, power of attorney forms are required – these need only be signed and stamped with the company's seal, if available. In order to ensure that trademark changes are properly handled and the proper forms are used, it is advisable to consult a lawyer who can review the available documents and observe the proper formalities required by the Greek Trademark Office. As mentioned above, the licensee's use of a trademark inures to the benefit of the trademark owner, and thus effectively offers a defence against a potential non-use cancellation action, provided that it is first recorded with the Trademark Office. Legalization by apostille of the licensor's signature is required.

7. Related rights

Often under Greek law, particularly in regard to unregistered device marks, the provisions of the Copyright Law (2121/1993) apply to protect such device marks, provided that the device has a degree of originality and has potential artistic merit. The majority of copyright matters that involve device marks are slightly more difficult to prove, given the broad availability of device marks over the Internet and with the fact that copyright is not registrable under Greek law.

However, it is always helpful to resort to the Copyright Law whenever feasible, since the prescription deadlines are more generous to the petitioner or plaintiff in contrast to, for example, the Unfair Competition Law.

8. Online issues

Under Greek law, domain names are regulated by administrative regulation, primarily in relation to their administration and proper registration. These regulations allow the adjudication of alleged bad-faith registration of a domain name via the Alternative Domain Name Dispute Resolution Policy (ADRP), which is similar to the Uniform Domain Name Dispute Resolution Policy provided for by the Internet Corporation for Assigned Names and Numbers. This procedure is the most time-efficient and cost-effective means to retrieve a domain name that has been registered in bad faith. In order to prove bad faith, the domain name must usually correspond to an identical or very similar registered mark, or to an unregistered mark if the use of that mark in Greece has been so extensive that the unregistered mark is easily discernible and recognized by the public and qualifies as a distinguishing feature of origin of the party initiating the ADRP.

The firm would like to thank Eleni Lappa, who is no longer with Dr Helen G Papaconstantinou, John V Filias and Associates, for her work on the chapter.

Unregistered rights	
Protection for unregistered rights?	✓
Specific/increased protection for well-known marks?	✓
Examination/registration	
Representative requires a power of attorney when filing? Legalized/notarized?	✓ / ✓
Examination for relative grounds for refusal based on earlier rights?	✓
Registrable unconventional marks	3-D, aspects of packaging, colours, olfactory, sounds ✓
Opposition	
Opposition procedure available? Term from publication?	3 months ✓
Removal from register	
Can a registration be removed for non-use? Term and start date?	5 years' non-use from registration date ✓
Are proceedings available to remove a mark that has become generic?	✓
Are proceedings available to remove a mark that was incorrectly registered?	✓
Enforcement	
Specialist IP/trademark court?	✓
Punitive damages available?	✗
Interim injunctions available? Time limit?	in cases of urgency ✓
Ownership changes	
Is registration mandatory for assignment/licensing documents?	but recommended ✗ / ✗
Online issues	
National anti-cybersquatting provisions?	actions may be available ✗
National alternative dispute resolution policy (DRP) for local ccTLD available?	ADRP ✓