Greece

Trademark law finally falls into line with European IP legislation

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On April 11 2012 the government passed the long-awaited Trademark Law (4072/2012), which abolishes its outdated predecessor (2239/1994). The new law intends to change the trademark registration procedure radically and align Greek legislation with the EU IP Rights Enforcement Directive (2004/48/EC). In order to allow the Trademark Office and interested parties to prepare for the major changes introduced, the law came into force on October 11 2012.

The new law's main goals are to accelerate and modernise the trademark registration procedure and to streamline the work of the Administrative Trademark Committee. Furthermore, the new law aims to achieve faster prosecution and more effective protection of trademarks in Greece, and lower official fees in an attempt to attract more trademark filings and better support for businesses.

Filing, registration and opposition procedures

The first major change towards modernisation relates to the fact that when filing a hard copy of the application for registering a new trademark, applicants must also file applications in electronic form (eg, on a CD or an equivalent means of electronic storage). In this way, the Trademark Office will be in a position to create a reliable electronic trademarks database, thus facilitating the process of conducting searches.

Additionally, the new law introduces the possibility of e-filing; however, the appropriate infrastructure and the actual procedure have not been determined as yet and will be fully set out by later decisions. Once the electronic register is launched and operating, applicants, trademark owners and interested third parties will be able to monitor the status of trademarks online and attain all relevant information regarding trademark ownership and renewals.

Moreover, the new procedure abolishes the requirement for trademark applications to be filed by lawyers. According to the new law, appointing a lawyer for filing a new trademark application is now optional, therefore reducing costs and making trademark filing more appealing.

Another major change introduced by the new law is the upgraded role of the Trademark Office examiner. Under the previous regime, all applications were examined by the three-member Administrative Trademark Committee at a later hearing date, in a procedure that lasted up to between eight and 10 months. The new law expedites this procedure. Once an application is filed, the Trademark Office examines the typical requirements and, if any of them are missing, the applicant is invited to correct or supplement the application within one month. Once the requirements are met, the newly introduced examiner – who has replaced the committee in this role – examines the application in a procedure similar to that in place for Community trademark applications. The examiner has the power to examine trademark applications and rule on both absolute and relative grounds. Where grounds for refusal exist, the examiner contacts the applicant and offers it the following options, to be carried out within one month:

- to revoke the application or limit the range of protection to a level that would make it acceptable; or
- to submit written observations.

If the applicant either limits the range of the trademark protection as requested, or the observations submitted are accepted by the examiner within one month, the application must be accepted and published on the Trademark Office website, thus limiting the required time for filing and registering a trademark to a maximum of three months.

As a result of the introduction of the examiner into the application process, the committee has evolved into an appellate body, ruling on oppositions, invalidity actions and petitions for revocation. In a further attempt to accelerate procedures, the deadline for filing an opposition has been reduced from four and a half months to three months, commencing from the publication of the examiner's acceptance decision on the Trademark Office website.

Moreover, the new trademark law introduces 'proof of use' as a new defence in opposition proceedings, essentially adopting the provisions of Article 43(2) of Council Regulation 40/1994 on the Community trademark. The party filing an opposition on the grounds of being the owner of a prior mark will have to provide evidence of genuine use of its prior rights or sufficient reasoning for not using such rights in the last five years. Failure to provide proof of use will immediately result in the rejection of the opposition, without any further examination of its grounds. This important development is expected to deter trademark owners which do not use their marks from filing oppositions based on prior rights.

Another important change which will make the procedure less complicated and less costly relates to the appeal process in front of the administrative court. Under the previous regime, filling an appeal against a committee decision did not have a suspensive effect, and an application for suspension had to be filed separately; under the new law, filling an appeal suspends the committee decision until the administrative court issues a decision on the appeal. Also, the appealing party must now notify its action to all parties involved in the committee decision which are entitled to intervene in the appeal proceedings – a provision that further simplifies and brings more certainty to the process.

Finally, the newly introduced 'return to the previous condition' provision has generated much interest. According to this provision, if, despite having exercised due care, trademark applicants or owners miss a deadline at any stage of the procedures in front of the Trademark Office or the committee as a result of *force majeure*, for reasons outside their scope of responsibility, they have the right to ask to 'return to the previous condition' and re-establish their rights, if such have been lost.

Civil and criminal trademark protection

The new trademark law also adopts the provisions of the IP Rights Enforcement Directive regarding the enforcement of IP rights, in line with the Community lawmaker's intention to provide robust and effective protection for IP rights, irrespective of different legal regimes among member states. The new law thus introduces novel regulations and procedures to the Greek judicial system (eg, the claim against infringers for admitting the infringement and committing to abstain from it in the future).

Infringed trademark owners must ask in their petition for the withdrawal of the infringing goods from the market and for their destruction, whereas under the previous regime it was the court that ruled *ex officio* on the withdrawal and destruction of infringing goods.

Furthermore, the right to compensation is comprehensively elaborated in the new law, in terms of calculation methods. The court should take into consideration, among other things:

- the amount that would have been payable to the rightful trademark owner by the infringer in cases where the latter would have asked for a licence to use the infringed trademark;
- the profits which the infringer benefited from unlawfully using the infringed trademark; and
- the loss of profits which the rightful trademark owner suffered from the unlawful use of its trademark.

The new trademark law also provides stricter criminal penalties against infringers, in line with the civil law protection provisions, and also introduces criminal penalties against infringers of famous trademarks. Penalties have thus been increased to a minimum of €6,000 and six months' imprisonment. In cases of infringement of identical marks on a widespread commercial scale resulting in either great profits for the infringer or great losses for the infringed trademark owner, penalties may rise up to €30,000, combined with a minimum two years' imprisonment.

Resignation – forfeiture of trademark rights

As under the previous Trademark Law, trademark owners have the right to resign from all or part of the goods and/or services for which their trademark has been registered.

Furthermore, the new law expressly distinguishes trademark cancellation into two categories:

- revocation; and
- declaration of invalidity.

Accordingly, a trademark may be revoked where it has not been used for five years after its registration, or if the trademark owner has suspended the mark's use for five consecutive years, unless the owner can prove that the mark's non-use was justified. Also, a trademark can be revoked in cases where its use is likely to mislead the general public as to the nature, quality or geographical origin of the goods and/or services for which the mark has been registered.

Additionally, a trademark may be declared as invalid, and therefore be partially or entirely cancelled, in cases where it is proven that it did not fulfill the registration requirements, despite the fact that the examiner approved it for registration. In order for a trademark to be cancelled as a result of revocation or declaration of invalidity, an application must be filed in front of the committee by any party with a legitimate interest.

Costs, collective marks and codification

In addition to the introduction of the optional use of a lawyer for filling trademark applications, costs have been reduced for trademark owners by a decrease in Trademark Office fees. This measure is contrary to virtually all other state fees, which are on the up due to the current state's lack of funds.

The new Trademark Law also updates the provisions regarding collective marks, in accordance with the EU Community Trademark Directive (207/2009/EC). The new provisions widen the area of applicability of collective marks, which distinguish goods now not only in relation to their origin from a specific group of manufacturers, producers, service providers or traders, but also in relation to their geographical origin. With regard to collective marks with a geographical distinction, in cases where several producers' goods originate from the same geographical area and meet the relevant requirements, producers have the right to join or become a member of the legal body which owns the collective mark and is able to use such a mark. This provision is important for Greek producers, since an increasing number have their products awarded a certified designation of origin.

The new law also incorporates the implementation of the provision of the Madrid Protocol, which was ratified by Law 2783/2000, but was neither codified nor included in the trademark legislation. In addition, the new law also includes for the first time in a single legislative body the provisions regarding Community trademarks.

Hellenic trademark

In accordance with the collective trademarks provisions of the new trademark law regarding geographical origin, a new trademark – the 'Hellenic' mark – is introduced. This trademark – both word and figurative – will be registered at the World Intellectual Property Organisation as the official trademark of Greece, and interested parties will be able to use it, provided that they fulfil the specific conditions stated by the new law. By introducing the Hellenic trademark, the state intends to limit incidents of consumers being misled by products unlawfully labelled as Greek, and protect producers from counterfeiting and unfair competition. In order to achieve this objective, the state has introduced the National Committee of the Hellenic Trademark, which will have the authority and responsibility (following public consultation) of determining the categories of product and service to which the Hellenic trademark will be awarded, and designating the appropriate bodies for the award of the Hellenic trademark along with their specifications.

Moving in the right direction

The new trademark law seems to be heading in the right direction in terms of modernisation and making trademark-related procedures more secure, faster, less costly, in line with international trends and generally more attractive for existing and prospective trademark owners alike.

However, in order for the changes to be implemented in an effective manner, it is imperative for the Trademark Office to upgrade its infrastructure and for its officers, together with IP practitioners, to embrace such changes and be educated accordingly, otherwise potential stagnation coud result in a *de facto* cancellation of the new law. iam

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