Cyprus

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Legal framework

Trademarks in Cyprus are governed by:

- the Paris Convention for the Protection of Industrial Property;
- the World Intellectual Property Organisation Convention;
- the Madrid Protocol;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- EU directives and regulations;
- the Trademarks Law (Cap 268); and
- case law.

Unregistered marks

Protection

Owners of unregistered marks have no right to file an infringement action: in practice, nobody can institute proceedings to prevent or recover damages for the infringement of an unregistered trademark. However, the owners of unregistered marks are free to bring a passing off action against any party which passes off its goods as those of the mark owner, and to seek remedies in respect thereof.

Unregistered marks may be assigned, alongside registered marks, to the same person and in respect of the same goods.

Use requirements

There are no specific minimum use requirements for establishing unregistered rights. However, the Trademarks Law defines 'use' as use of the mark:

- on or in physical proximity to the goods;
- in an advertising circular or other advertisement issued to the public; or
- for export purposes.

In order to assign an unregistered mark, at the time of the assignment or transfer the unregistered mark must be:

- used in the same business as the registered trademark; and
- assigned or transferred at the same time and to the same person as the registered trademark, and in respect of the same goods or services as the registered trademark.

Registered marks

Ownership

Any legal or natural person is entitled to own a mark, provided that it uses or intends to use the mark. A mark may be owned jointly if such owners are listed at the time of application.

Power of attorney

A representative must obtain Form TM1 – a power of attorney – before filing in order to act as an agent in applying for a trademark. No examination will be carried out upon filing an application or opposition until the original form has been filed with the Cyprus Trademark Registry. Nevertheless, the power of attorney need not be notarised or legalised, and can be filed at a later stage.

Under Cyprus law, only advocates may be appointed as agents for the purpose of filing a trademark application.

Scope of protection

Protected: The Trademarks Law defines a 'mark' as including a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.

Colour may contribute to distinctiveness, and is always relevant in determining resemblance and the likelihood of confusion and eventual infringement. If a trademark is registered without colour limitation, it is considered to be registered for all colours. Colour itself is registrable only if distinctiveness is proved; to date, the registry has not accepted any such applications. The same applies to shapes and three-dimensional representations.

A trademark must be registered in respect of particular goods or services or classes of goods or services. Any uncertainty regarding the class in which goods or services fall will be determined by the registrar of trademarks.

Not protected: According to the Trademarks Law, a trademark cannot be registered if:

- it is likely to deceive or cause confusion;
- it is contrary to public law or morality;
- it contains any scandalous design; or
- it would otherwise not be entitled to protection in a court of justice.

Further, a trademark will not be registered if:

- it is identical to another party's earlier registered trademark and registration is sought for identical or similar goods or services; or
- it so closely resembles another party's earlier registered trademark as to be likely to deceive or cause confusion.

Similarly, a trademark cannot be registered in respect of any services if it is identical or deceptively similar to another party's trademark that is registered – or for which registration is pending – in respect of identical services or goods that are closely related to such services.

According to case law, in instances of honest concurrent use, the court or registrar may permit the registration of trademarks that are identical or similar to each other in respect of the same goods or services by more than one owner, subject to such conditions and limitations as it may see fit to impose.

Procedures

Examination

A trademark application may be filed only through a lawyer licensed to practise in Cyprus. Form TM1 (a signed and stamped power of attorney) and Form TM2 must be submitted, along with various copies of the trademark. Form TM2 is available and accepted in English. Copies are not acceptable.

An application covering multiple classes of goods or services will be rejected. Each application for protection in a different class is treated as a separate application. A general power of attorney will generally suffice for all filings, but if the trademark application is specific, separate powers of attorney should be submitted for each class.

Searches may be carried out of both registered marks and pending applications; they may be conducted by an appointed attorney or the applicant.

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There is a specific application through which the registrar can be requested to conduct a search based on similar/identical trademarks before the applicant proceeds and files an application to register. This saves the applicant time and money. This decision of the registrar is binding. Searches for trade names and company names are also available.

Once the application has been filed, the registrar will examine it for compliance with the legal requirements. The mark must:

- be distinctive;
- not deceive; and
- not resemble any mark that has already been registered or for which registration is pending.

Each of these is a separate ground for refusal by the registrar.

The registrar can:

- grant registration of the mark as applied for;
- grant conditional registration;
- request amendments to the application; or
- refuse registration.

Where a trademark contains a word in a language other than English, the registrar will usually request an exact translation and an indication of the language to which it belongs. If Latin script is not used, a transliteration and translation must also be provided.

Upon receipt of a trademark application, the registrar will conduct a search of all registered and pending trademarks in order to determine whether any earlier marks for the same goods are identical or confusingly similar to the applicant’s mark.

If the registrar objects to the registration, the applicant is notified accordingly and given a three-month period in which to apply for a hearing or submit a written response to these objections. If it fails to do so, the application is deemed to have been withdrawn.

The registrar’s decisions are subject to appeal before the Supreme Court.

Opposition

Once the application has been accepted, it is published in the *Official Gazette*.

Any party which wishes to object to the registration of the mark can do by so giving notice to the registrar through Form TM5 within two months of the publication date. Registration of a trademark may be opposed on the grounds that the mark lacks distinctiveness, is deceptive or is confusingly similar to an earlier registered trademark. All reasons for the objection must be included in Form TM5.

Within two months of receipt of the notice of opposition, the applicant must submit Form TM6 to the registrar, responding to the opposition and setting out grounds in support of its application. Upon receipt of the response, the opponent has two months to submit evidence in support of its opposition to the registrar; the applicant must also be provided with a copy of this evidence. This helps the registrar to monitor the procedure, as well as any deadlines.

If the opponent files no evidence, the opposition will be considered abandoned. Otherwise, the applicant must file its own evidence with the registrar in the same manner and provide the opponent with a copy as submitted. The opponent has a further opportunity to respond to the applicant’s evidence within one month. The registrar will then set a date for the hearing and inform the parties accordingly.

Registration

Upon registration, the registrar will issue the applicant with a registration certificate bearing a

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copy of the trademark and the class description.

The trademark is registered as of the date of filing. For the purposes of the Trademark Law, this date is deemed to be the date of registration, unless the applicant claims a priority date in accordance with Article 4 of the Paris Convention. Such prior registration must be specified on the application form, and an original or certified copy of the certificate issued by the registrar of trademarks in the priority country must be provided.

Trademarks are initially registered for seven years and may be renewed for further 14-year periods. An application to renew must be filed in the three months before the registration expires. However, if the applicant fails to pay the renewal fees or applies late, the registrar may, after giving the relevant notice, remove the trademark from the Trademarks Register. The trademark may be restored by paying the renewal fee and a restoration fee.

Removal from register

Cancellation/surrender: At the trademark owner's request, the registrar may cancel the entry of a trademark in the Trademarks Register.

Revocation: Any interested party may apply to the court or the registrar to have a registered trademark removed from the register if:

- the trademark was registered with no good-faith intention on the part of the applicant that it be used in relation to the relevant goods or services, and there has been no good-faith use of the trademark in relation to those goods or services up to one month before the date of the application; or
- there has been no good-faith use of the trademark for a continuous period of five years or more.

Unless the applicant for revocation has been allowed to register an identical or similar trademark in respect of the relevant goods or services, or the court or registrar is of the opinion that it might be permitted to do so, the court or registrar may refuse an application for revocation in relation to any goods or services if it is shown that there was good-faith use of the trademark in respect of the goods or services for which the mark is registered before the relevant date or during the relevant period.

If there is substantial use of the trademark after the initial five-year period has expired, but before the application for revocation, the registration will not be cancelled unless the use takes place in the three months before filing of the revocation and after the owner becomes aware that a revocation application may be filed.

If the owner of a registered trademark has not substantially used the mark for a period of five years, it may not use the mark as a basis for cancellation or opposition to the registration of a later trademark.

For the purposes of proving use, the use of a trademark that varies from the mark as registered is acceptable, provided that this variation does not substantially affect the character of the trademark. The use of a trademark solely for export purposes is also acceptable.

Invalidation: Anyone aggrieved by the omission of an entry from the register, or by an unjustified or erroneous entry in the register, may apply to the court or the registrar for an order for recordation, expungement

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or amendment of the entry as it sees fit. In doing so, the court or registrar may decide any question that may be necessary or expedient in connection with the rectification of the register.

In case of fraudulent registration, assignment or transmission of a registered trademark, the registrar himself or herself may apply to the court under these provisions.

Any court order to rectify the register must specify that notice of the rectification be served in the prescribed manner on the registrar; upon receipt, the registrar will amend the register accordingly.

Upon application by an aggrieved party, the court or registrar may issue an order for recordation, expungement or amendment of an entry as it sees fit on the grounds of any contravention or non-observance of a condition entered on the register in relation to the mark.

Enforcement

Complexity

Owners of registered trademarks can commence court actions for both infringement and passing off (as defined by the Civil Wrongs Law). In contrast, owners of unregistered trademarks may enforce their rights through actions for passing off only.

Under the Trademarks Law, the owner of a registered trademark has the exclusive right to use the mark in relation to the goods for which it is registered. This right is infringed where an unauthorised third party uses a mark that is identical to the registered mark – or that so closely resembles it as to be likely to deceive or cause confusion – in the course of trade in relation to any goods for which it is registered (or in relation to dissimilar goods, if the registered trademark is famous) and in such manner as is likely to be regarded either:

- as use as a trademark; or
- where the mark is used on or in physical proximity to the goods, or in a public advertisement, as purporting to refer to either the owner or authorised user of the mark, or goods with which such person is connected in the course of trade.

An infringement action must be filed before the district courts. The owner of the registered trademark bears the burden of proving that the resemblance is deceptive.

The owner of an unregistered mark may take action only for passing off and not for infringement. ‘Passing off’ is defined as follows: “Anyone who, by imitating the name, description, sign, label or otherwise, causes or attempts to cause any goods to be mistaken for the goods of another person, so as to be likely to lead an ordinary purchaser to believe that he is purchasing the goods of such other person, shall commit a civil wrong against such other person:... [However,] no-one will commit a civil wrong by reason only that he uses his own name in connection with the sale of any goods.”

In a passing-off action, the owner of a registered or unregistered mark must prove goodwill and provide evidence showing an association between the trademark and the goods on which it is used, entitling it to use the mark to the exclusion of other manufacturers or traders. The association may be proved by various means, including advertising campaigns, the extent and length of use, and the reactions of the purchasing public.

The owner must also prove that:

- its trademark has been imitated or copied;
- there is a likelihood of confusion on the part of the ordinary purchaser arising from such imitation;

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- the infringing mark deceived the public by taking advantage of the fame gained by the owner in the course of the business; and
- it has suffered damage due to the infringement.

The relief usually available to the owner of a violated trademark is:

- an injunction restraining further use of the infringing mark; and
- damages, if these are proved in court.

In case of a passing off action that is decided in favour of the owner, the court may order the goods to be seized and destroyed.

It is also possible to obtain an interim order at the start of the court case to prohibit use of the infringing mark until the matter has been finally decided. In order to obtain an interim order, the applicant must prove that:

- there is a serious matter for the court to try;
- the claim has a strong chance of success; and
- it would be difficult or impossible for justice to be done at a later stage if the order were not issued.

It is possible to obtain an interim order *ex parte* if the applicant can prove the urgency of the matter and files the application as soon as it is notified of the infringement.

There is no time limit for pursuing an interim order; however, an interim order should be filed as soon as possible, since any delay in filing the interim order may harm the application and result in the court rejecting the application.

Border measures

A trademark owner may register its trademark with Customs using Form DPI 1. Registration informs Customs of the trademark rights so that it can intervene if counterfeit products are imported into Cyprus. As soon as Customs spots suspected counterfeit goods, it will retain them and contact the trademark owner, providing it with a sample of the goods for examination. If the trademark owner confirms that the goods are counterfeit, they will be seized. The trademark owner must then apply to the court for an order to destroy the counterfeit goods. The application is submitted together with copies of the trademark certificates and photographic material or any other material that will assist Customs in separating counterfeit goods from originals.

Timeframe

There is no substantial difference in the timeframes for the enforcement of registered and unregistered rights. However, actions taken on the basis of trademark infringement are easier to prove, since the evidentiary burden on the owner is lighter than in a passing off action and the case can thus progress more swiftly.

Ownership changes and rights transfers

The owner of a registered trademark has the right to assign the right to use a trademark to an assignee. The assignee may file an application to the registrar, provided that it supplies the registrar with the assignment agreement, including all details and terms.

Copies of a deed of assignment and a licence agreement may be filed, but they must be certified as true copies of the original by a certifying officer. A power of attorney must be filed by both parties.

The same requirements apply to granting a licence for use of a registered trademark. In addition, the owner must supply the details of

any consideration received for granting the licence.

Related rights

It may be possible to seek protection for a device mark that has artistic merit under the copyright legislation, but as Cyprus has no procedure for the copyright registration of artistic works, additional evidence is required in case of infringement of the device mark. An action based on infringement or passing off provides wider protection than an action under copyright law. Further, trademark rights may be renewed indefinitely, unlike copyright, which expires within a specified term.

Online issues

The advertisement or sale of goods or services online is recognised as use for the purposes of the Trademarks Law. The same trademark issues that arise in relation to traditional trading also arise in the online sphere. Therefore, infringement or passing off actions may be brought in case of use of a registered mark on the Internet, either as a trademark or as a domain name. WTR

Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?	**Examination for relative grounds for refusal based on earlier rights?**	**Non-traditional marks registrable?**
Yes/No ✓ / ✗	Yes ✓	3D; colours. ✓

Unregistered rights	
Protection for unregistered rights?	**Specific/increased protection for well-known marks?**
Yes ✓	Yes ✓

Opposition
Can a registration be removed for non-use? Term and start date?
Yes: two months. ✓

Removal from register		
Can a registration be removed for non-use? Term and start date?	**Are proceedings available to remove a mark that has become generic?**	**Are proceedings available to remove a mark that was incorrectly registered?**
Yes: five years' non-use. ✓	Yes ✓	Yes ✓

Enforcement		
Specialist IP/trademark court?	**Punitive damages available?**	**Interim injunctions available? Time limit?**
No ✗	No ✗	Yes ✓

Ownership changes
Mandatory registration for assignment/licensing documents?
Yes/Yes ✓ / ✓

Online issues	
National anti-cybersquatting provisions?	**National alternative dispute resolution policy (DRP) for local ccTLD available?**
No ✗	No: UDRP applies directly. ✗

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