

Greece

Contributing firm

Karatzas & Partners Law Firm

Author

George Minoudis

Partner

1. Legal framework

The most important pieces of legislation governing trademarks in Greece are as follows:

- the Trademarks Law (2239/1994), which sets out the main legislative framework for Greek registered trademarks and implements the First Trademarks Directive (89/104/EEC);
- the Unfair Competition Law (146/1914), which includes provisions for the protection of unregistered marks;
- the EU Community Trademark Regulation;
- Chapter C of Law 2943/2001, which establishes Greek Community trademark courts;
- Law 213/1975, which ratifies the Paris Convention for the Protection of Industrial Property;
- Law 2505/1997, which ratifies the Nice Agreement on the Classification of Goods and Services;
- Law 2290/1995, which ratifies the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs);
- Law 2783/2000, which ratifies the Madrid Protocol on the International Registration of Marks; and
- Decision K4-307/2001, which implements the Madrid Protocol.

2. Unregistered marks

Unregistered marks are protected by Articles 13 to 15 of the Unfair Competition Law. An unregistered trademark will be protected if:

- it has distinctive character; and
- it has been established in transactions as a trademark.

The first criterion is much the same as in the case of registered marks. Distinctive character may exist in the mark itself or may be acquired through use.

Establishment in transactions requires that a significant part of the relevant sector of the public is aware that the mark serves to distinguish goods or services. This must be the case at the time that protection is sought; for example, it is not sufficient that this were true at some point in the past. Essentially, a significant part of the public must know the mark and must connect it to specific goods or services. It is not easy to quantify the amount of use needed to cross this threshold; this may differ depending on the nature of the goods or services and the prominence accorded to the mark.

Protection will be provided geographically only in relation to the territory in which the mark has been established.

3. Registered marks

Ownership

The aim of a registered trademark is to distinguish the goods or services of one undertaking from those of others. Some thus contend that, in theory, trademark applicants should be the owners/managers of an undertaking or should intend to be the owners/managers of an undertaking. However, others suggest that this criterion need not be satisfied, since the current legal regime applicable in Greece (as well as in the other EU member states) has largely severed the ties between the mark and the undertaking to which it relates (eg, a mark is freely transferable). In any event, in practice this criterion is not checked by the Greek authorities responsible for trademark registration; even if it were, it could lead to a refusal of registration only in extreme or special cases.

Foreigners may obtain trademark registration on the basis of reciprocity (ie, if the trademarks of Greek nationals are protected in the applicant's

home state). This will be the case in most instances, given the extensive matrix of international agreements on IP protection.

It can thus be stated that, save for very limited exceptions, any natural person or legal entity can be the owner of a trademark, without further qualification.

Scope of protection

Protected: The first precondition for registration is that the mark is capable of being represented graphically. So, for example, sounds can in principle be registered, since they can be graphically represented as notes; the same applies for three-dimensional trademarks, including the shape of a product or its packaging. In order for a mark to be unregistrable, it would have to be impossible to represent it graphically – examples could include smells, although even these can be represented graphically to some extent.

A sign must also be distinctive – that is, it must be capable of distinguishing the goods and services of one undertaking from those of others. So, for example, a single letter, a single colour or a single number may lack distinctiveness. However, a sign that inherently lacks distinctiveness may acquire this through use.

Not protected: The Trademarks Law contains the following list of specific cases in which a trademark cannot be registered due to lack of distinctiveness:

- The mark consists exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or provision of the services, or other characteristics of the goods or services;
- The mark consists exclusively of signs or indications that have become customary in

the current language or in the good-faith and established practices of the trade; or

- The mark consists exclusively of:
 - a shape which results from the nature of the goods themselves;
 - a shape of the goods which is necessary to obtain a technical result; or
 - a shape which gives substantial value to the goods.

However, in all these cases a mark will be accepted for registration if, by the time of registration, it has acquired distinctiveness through use.

In addition, the following will not be registered as trademarks:

- marks that are contrary to public policy or accepted principles of morality;
- marks that are of such a nature as to deceive the public, especially as to the nature, quality or geographical origin of the goods or services;
- marks that are to be refused pursuant to Article 6ter of the Paris Convention, as well as signs of great symbolic importance, especially religious symbols, representations and words; and
- marks which were applied for in contravention of good faith or in bad faith.

The above constitute absolute grounds for refusal of registration. The relative grounds for refusal of registration are as follows:

- The mark is identical to an earlier trademark and the goods or services for which registration is sought are identical to those for which the earlier trademark is registered; or
- The mark is identical or similar to an earlier trademark registered for identical or similar goods or services, and there is thus a likelihood of confusion, including the likelihood of association with the earlier trademark, on the part of the public.

'Earlier trademarks' include:

- earlier registered national trademarks;
- earlier registered Community trademarks (taking into account priority claims);
- earlier applications for the above, subject to registration;
- marks which, on the date of filing or priority, are well known in the sense of Article 6bis of the Paris Convention; and
- Community marks in relation to which a valid seniority claim is being made *vis-à-vis* Greece.

A trademark will also be refused registration where:

- it conflicts with an unregistered trademark or another sign used in the course of trade which entitles its owner to prohibit the use of a later trademark, as long as such rights were acquired before the date of filing or priority; or
- it conflicts with an earlier right to personality or an earlier copyright or industrial property right.

In such cases the owner of the earlier trademark may consent in writing to registration of the newer one, as long as:

- the two marks are not identical; or
- the consent is not, in the opinion of the Administrative Marks Tribunal, contrary to public interest or likely to deceive the public.

Trademark registration does not entitle the owner to prohibit a third party from using the following in the course of trade – provided it uses them in accordance with honest commercial or industrial practices, and in any case not as marks:

- its own name or address;
- indications as to the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or provision of the services, or other characteristics of the goods or services; or
- the registered trademark, where it is necessary to indicate the intended purpose of

goods or services, in particular as accessories or spare parts.

4. Procedures

Examination

The authority responsible for accepting trademark applications and managing Greek trademarks in general is a directorate of the Ministry of Development. Trademark registration is granted by the Administrative Marks Tribunal, following a hearing. The hearing is oral in theory only, as in practice all arguments are presented in writing. The hearing usually takes place within six months of filing. The tribunal will examine on its own accord whether there are absolute or relative grounds for refusal of registration; a third party with a legitimate interest may also intervene at this point to support the acceptance or refusal of the mark. Decisions are usually issued between one and five months after the hearing.

The decision – like all decisions of the tribunal – may be appealed before the First Instance Administrative Court, whose decision can in turn be appealed before the Administrative Court of Appeal and ultimately before the Council of the State (Supreme Administrative Court).

The Trademarks Law requires that a summary of the decision accepting the trademark application be published in the *Government Gazette IP Bulletin* within one month of its issue. In reality, this timeframe is not observed and publication may actually occur up to three or four months after the decision.

Opposition

Any party with a legitimate interest may oppose the decision before the Administrative Marks Tribunal. The opposition must be filed within a four-month period, commencing on the 16th

day of the month following that in which the decision was published.

Registration

The trademark will be registered if no oppositions are filed during the opposition period, or if any oppositions are successfully and finally overcome.

Cancellation/surrender

The trademark owner can surrender the mark at any time in respect of some or all of the relevant goods or services.

Invalidation

A mark is generally invalidated upon the application of a party with a legitimate interest.

A trademark registration may be invalidated if:

- the mark has not been put to genuine use in connection with the goods or services for which it is registered within five years of registration, or the mark is not used for a continuous five-year period; or
- the undertaking ceases to operate, or the goods or services for which the mark is registered cease to be traded, for five years.

In both cases the mark will not be invalidated if the owner can prove that there was reasonable cause for the non-use or cessation of operations. Commencement or resumption of genuine use is also a valid defence, except where this occurs in the three months before the invalidation application is filed and after the owner became aware that a third party might file an invalidation application.

Trademark use includes use on the goods and their packaging, in letterheads, invoices, price lists, advertisements and other printed matter, and in electronic media. It also includes:

- use of a different version of the mark which does not alter its distinctive character;
- use on products intended solely for export; and

- use by an authorized third party (this must be done pursuant to a licence which is approved by the Administrative Marks Tribunal and recorded in the Registry of Marks; otherwise it is not lawful).

A trademark is also vulnerable to invalidation if:

- as a result of the trademark owner's actions or inactivity, the trademark becomes customary in the current language or the common name in the trade for a product or service in respect of which it is registered, where at least 20 years have elapsed since registration;
- as a result of its use by the trademark owner or an authorized third party, the trademark is liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services for which it is registered; or
- there were relative or absolute grounds for refusal when the trademark was registered, where less than five years have elapsed since registration.

A trademark will not be invalidated where the earlier mark owned by the party seeking invalidation may itself be invalidated for non-use or cessation of operations, unless the later mark was registered in bad faith.

Neither will the mark be invalidated if the owner of the earlier mark or right knowingly tolerated the use of the offending mark for five continuous years, unless the later mark was registered in bad faith.

Invalidation becomes effective when the tribunal's decision becomes final and binding.

The directorate will cancel a trademark on its own initiative if the registration is not renewed within six months of the expiry of the 10-year period of protection, or if the owner is a company, which is dissolved and liquidated.

5. Enforcement

Complexity

The rights to registered and unregistered trademarks are enforced by the civil courts in cases of actual or threatened infringement. In the case of a registered mark, the civil courts cannot examine the validity of the registration and are obliged to grant the mark protection, whether properly registered or not. In contrast, the courts will examine whether an unregistered mark is eligible for protection.

The principal concern is to safeguard the owner's exclusive right to use the mark.

Protection will be granted where a third party:

- uses an identical mark for identical goods or services;
- uses a similar or identical mark for similar or identical goods or services; or
- in the case of well-known marks, uses an identical or similar mark for unrelated goods or services, where such use would give that party an unfair advantage derived from the distinctiveness of the trademark without reasonable cause, or would tarnish the distinctiveness or repute of the trademark.

Registered mark: The principal remedies available in case of infringement of a registered trademark are as follows:

- a court order aimed at reversing the effects of the infringement – for example, where the marks are identical, ordering the destruction of the goods bearing the infringing mark (if proportionate to the offence), or where the marks are similar, ordering the removal of the infringing mark from the goods and its subsequent destruction, or if this is not possible, the destruction of the goods;
- a court injunction prohibiting the third party from using the infringing mark in the future. Where there is imminent danger of

infringement, an injunction will be granted even if no infringing acts have taken place;

- a claim for damages. This remedy is not very useful in practice, as it is difficult for the petitioner to prove and quantify the loss. In addition, there must be fault on the part of the defendant (negligence or intent);
- a preliminary injunction, usually in the form of an order to seize infringing goods and a prohibition against the production or circulation of such goods until the first instance or appellate decision; or
- a provisional order, usually with the same content as a preliminary injunction.

The first two remedies above become statute-barred 20 years after the creation of the infringing mark. The third becomes statute-barred three years after the end of the year in which the infringement occurred.

A preliminary injunction will be granted only where the trademark owner can prove, in addition to infringement, that there is an imminent threat that must be averted or that the matter is urgent. In practice, and given the protracted timeframes of ordinary hearings, the preliminary injunction is probably the most important remedy available to trademark owners. In light of the significant damage that infringing goods can cause in a short time to a lawful trademark owner, imminent danger is not difficult to prove in most cases.

A provisional order is even more urgent than a preliminary injunction, and may be requested and granted upon submission of a petition for a preliminary injunction. The order is granted following an *ad hoc* hearing by a judge. The judge may decide to grant the order *ex parte*, although this is rarely the case. It is difficult to obtain a provisional order, and very solid evidence of the unlawfulness of the defendant's acts and the gravity of the danger facing the petitioner are required.

In order to ease the burden of proof, the Trademarks Law provides that where the infringing mark is identical to the petitioner's mark, infringement may be proved simply by presenting to the court the excerpt from the Trademarks Register concerning the petitioner's mark.

Unregistered mark: The principal remedies available in case of infringement of an unregistered trademark are as follows:

- a court order aimed at reversing the effects of the infringement – for example, ordering the removal of the infringing mark or – if this is not possible and the defendant knew or ought to have known that it was using a third party's sign or mark – the destruction of the infringing mark;
- a court injunction prohibiting the third party from using the infringing mark in the future. Where there is an imminent threat of infringement, an injunction will be granted even if no infringing acts have taken place;
- a claim for damages. This remedy is not very useful in practice, as it is difficult for the petitioner to prove and quantify the loss. In addition, there must be fault on the part of the defendant (negligence or intent);
- a preliminary injunction, usually in the form of an order to seize infringing goods and a prohibition against the production or circulation of such goods until the first instance or appellate decision; or
- a provisional order, usually with the same content as a preliminary injunction.

The first three remedies above become statute-barred six months after the petitioner became aware of the infringement and the infringing party, and in any event three years after the infringing act. The periods within which to claim damages begin to run only once loss has occurred.

Preliminary injunctions and provisional orders may be sought in the same way as in case of infringement of a registered trademark.

Timeframe

A provisional order will be granted immediately or within one or two days of filing a petition for a preliminary injunction, following a hearing by a single judge.

Where a preliminary injunction is sought, a hearing will usually take place within two or three months of filing the petition, with the decision issued one to two months after the hearing.

Other remedies are granted after a full hearing by the first instance court, which will take place within one to two years of filing the petition, depending on the court's location and the procedure followed. The judgment will be issued between six months and a year after the hearing. The judgment will not generally be enforceable until any appeal has been decided or the right to appeal has expired. However, the court may extend an existing preliminary injunction or grant a new preliminary injunction in the interim. In any event, the defendant will often cease its infringement after a preliminary injunction has been granted, as it may not be commercially worthwhile to pursue this course any further.

At second instance, the hearing will generally take place six to seven months after the appeal, and the judgment will be issued between six and seven months thereafter. If the appeal is rejected, the first instance judgment becomes enforceable.

If the case is ultimately appealed to the Supreme Court (*Areios Pagos*) on a point of law, it will be heard within six or seven months, and the Supreme Court will issue judgment between six and seven months thereafter.

Although the procedural system is slow, a trademark owner can nonetheless obtain a high

degree of protection. Moreover, wilful infringement of a trademark will generally result in criminal liability of the defendant. The criminal court may order the removal of infringing marks from goods or the destruction of marks or goods, under the same terms as above, even where the defendant is acquitted. Such an order will be granted at the court's discretion in the case of an unregistered trademark, or where there is a risk of confusion in the case of a registered trademark.

6. Ownership changes – legalization requirements

Documents from other jurisdictions that are required to prove a change of ownership must be apostilled according to the Hague Convention. Such documents must also be translated into Greek (a Greek lawyer is entitled to do this).

7. Areas of overlap with related rights

There is a degree of overlap between trademark rights and other rights. In certain cases registered marks can obtain supplemental protection under the Unfair Competition Law, and in others from the provisions on unregistered trademarks. In addition, device marks that exhibit the requisite degree of creativity will be protected under copyright provisions. Finally, certain marks could in theory be protected by legislation on designs.

8. Online issues

Trademark registration also entitles the owner to use the mark electronically, including on the Internet, and online use is thus protected.

Protection is also extended to the owners of unregistered trademarks. However, such protection does not automatically entitle the trademark owner to use the mark as a domain name.

Where a domain name in the '.gr' top-level domain conflicts with a trademark, the trademark owner must seek an order prohibiting the use of the offending domain name through a preliminary injunction, and ultimately through a full hearing. The following issues must be determined:

- whether there is an actual conflict between the two, given the nature and function of a trademark and those of a domain name; and
- if there is a conflict, which of the two rights was acquired first. This right will have priority.

The Hellenic Telecommunications and Post Commission, which is ultimately responsible for '.gr' domain names, will invalidate a domain name pursuant to a final judicial or arbitral judgment acknowledging another's prior rights to the domain name (or part thereof), and will temporarily suspend its use pursuant to a judicial or arbitral judgment to that effect.

In certain circumstances, recent case law has acknowledged a right to transfer a domain name to the petitioner; however, this outcome is by no means guaranteed, as Greek case law is persuasive, but not binding.