

Three in one: how to protect trademarks in Greece, Romania and Albania

This jurisdictional overview for Greece, Romania and Albania highlights the best options for protecting brands in the three different jurisdictions

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Greece

Local trademark registration requirements

In Greece, trademarks must be filed in person by a lawyer with a valid power of attorney. Electronic filings or electronic-only pre-filing clearance searches are not yet established practice. Depending on the type of mark to be filed (eg, word, figurative or device-only mark), certain label requirements apply (ie, colour or black and white). Labels should be of the highest possible resolution, as the mark's publication and subsequent protection will be based solely on these. This requirement is particularly significant if protection is sought for a specific colour shade (Pantone matching system) or device (Vienna classification), since trademarks are published only in black and white. Therefore, in the event of a dispute or litigation over a colour mark, the colour label held at the Greek Trademark Office is decisive. In relation to the specification of goods/services, applicants should carry out careful research and adapt and translate their application to the particular goods/services as needed (and avoid simply inserting the respective classes' synoptic titles), in order to ensure proper protection and avoid any inadvertent conflicts. Greek courts will not adopt an "inventive

approach" towards offering protection to goods/services in the same class if they are not specifically mentioned in the trademark registration certificate. Instead, the courts tend to adhere strictly to the specification actually listed. In all cases a search for any prior conflicting marks through local trademark agents who are fluent in Greek is recommended in order to avoid potential disputes in the administrative and/or civil courts.

Advantages of local over central trademark filings

Greece is a member of the Madrid Protocol for international trademarks. It is also a member of the European Union and thus covered by Community trademark (CTM) applications. Although central filings are generally preferred by industry, especially at present, it is questionable whether these are as cost effective and time efficient as is often believed. Often, national filings mature to registration well before a CTM filed at the same date would, thus expediting local protection and assertion of rights. Moreover, due to the linguistic particularities of Greek vocabulary, there are many occasions where a national as opposed to a CTM or international registration (IR) filing would be preferable. In particular, as the Greek alphabet is not Latin-based, many Latin-based word marks would be allowed in Greece as sufficiently distinctive, notwithstanding that in jurisdictions that use the Latin alphabet (and which cover the majority of the European Union/Madrid Protocol), the same marks would likely be rejected as descriptive terms, devoid of any distinctive qualities. Moreover, due to the option of including in the trademark certificate a Latin-based term in its Greek transliteration, applicants can ensure that their mark be considered as protectable in

relation to all target groups, even those not fluent in foreign languages.

Jurisdictional issues

Trademark protection is twofold in Greece: once a trademark application is accepted by the examiner, issues related to validity, cancellation and opposition fall within the jurisdiction of administrative tribunals and courts: the Administrative Trademark Committee, the Administrative Court of First Instance, the Administrative Court of Appeal and the Council of State, as the supreme administrative court. Infringement issues are adjudicated by civil courts, from first instance to appeal court all the way up to the Supreme Court. Efforts have been discussed and are currently underway to strengthen the IP courts in Greece, thus anticipating a smooth and reliable fast-track procedure as per the applicable provisions in EU law and the Agreement on Trade-Related Aspects of Intellectual Property (TRIPs), to which Greece is bound. A proactive approach is crucial with regard to trademark protection; rights holders must institute proper watching services and take action as soon as a conflict arises. The same applies for infringement proceedings that eventually become necessary if a conflicting mark is used in the market.

Dealing with local challenges

Local provisions place the burden of acting swiftly on the legitimate party seeking protection against a conflicting mark or a third party's infringing activities. As such, vigilance – in terms of both the trademark registry and market activities – is key to ensuring proper trademark protection in Greece. Effective and prompt internal communication between the local unit and the rights holder, and efficient collaboration with a local trademark attorney with regard to taking appropriate action, are also vital. Instituting systematic, locally based watching services to ensure accurate results (due to linguistic particularities and the unreliability of purely online data) in monitoring the trademark registry can also help. In terms of market vigilance, it may be worth conducting online or in-person presentations to local staff to help them identify the rights holder's marks and to instruct them on what action to take once a conflicting mark is located. These simple steps can prove cost effective if applied uniformly to all local units, with input and feedback from local trademark counsel. After all, prevention is the best cure (particularly when dealing with trademark protection).

Romania

Local trademark registration requirements

Natural or legal entities may apply to register trademarks, acting either *pro se* or through a representative. Applications must include the applicant's data, a reproduction of the trademark and specification of the goods and/or services for which protection is sought. In addition, they may contain references to colours claimed as distinctive elements of the trademark, a transliteration or translation of its verbal element(s) and information on whether it is three-dimensional. If an application is filed for the first time in another signatory to the Paris Convention or member of the World Trade Organisation, the applicant may claim that date as the date of priority for registering the same trademark in Romania, provided that the latter is filed locally within six months.

For trademark registrations, applicants may also invoke the exhibition priority established in the Paris Convention, if certain goods or services have been publicly displayed at an officially recognised international exhibition held in Romania or in another signatory state, subject to submitting the application to the State Office for Inventions and Trademarks within six months of the date of first display at the exhibition.

Advantages of local over central trademark filings

Central filings designating Romania are feasible, as Romania is a member of the Madrid Protocol and Madrid Agreement, as well as being a member of the European Union, covered by the CTM system. One advantage of registering trademarks locally is cost, with additional advantages related to simplified and flexible procedures, reduced effort and time saving, given that the national trademark registration procedure takes approximately one year. In addition, the local pre-filing clearance search services necessary for national filings help applicants to avoid potential conflicts and disputes; the same is not true for central (CTM/IR) filings, which do not carry out local trademark searches, meaning that unpleasant surprises can arise after a registration is granted. It is also recommended that verbal trademarks and those containing slogans, taking into account the message they convey in Romanian, be registered nationally; there is less point in registering such marks in other countries as they have less economic worth outside Romania.

Jurisdictional issues

Industrial property rights are defended administratively as well as through the courts, in accordance with provisions set out in civil and penal laws. The relevant administrative body in the field is the State Office for Inventions and Trademarks, which determines claims related to trademark registrations. Judicial control falls to the Bucharest Court of Law and the Bucharest Court of Appeals. Claims for cancellation of a trademark registration, termination of trademark rights and infringement are dealt with by the Bucharest Court of Law. Decisions may be challenged by way of appeal or second appeal (*in rem*).

As a signatory to TRIPs and an EU member state incorporating the relevant EU legal framework into its national laws, Romania has in place a variety of means and procedures to protect effectively rights holders throughout its territory.

Dealing with local challenges

Aside from time-consuming court procedures, there are several fast-track options available for trademark matters.

The Government Emergency Ordinance on the Protection of Industrial Property (100/2005) implements the EU IP Rights Enforcement Directive (2004/48/EC) regulating a variety of measures, procedures and remedies in the field of industrial property and providing added protection to rights holders. The ordinance provides for the possibility of securing evidence by way of injunction; it also establishes a set of legal tools for adopting urgent measures before a determination on the merits and for the better administration of evidence in favour of the claimant.

The Law on Measures for Safeguarding the Observance of Intellectual Property Rights (344/2005) transposes the EU Customs Regulation (1383/2003). The law sets out a simplified procedure regarding the retention of counterfeit or pirate goods by Customs, avoiding the need for court intervention as much as possible.

Albania

Local trademark registration requirements

Foreign entities wishing to file a trademark in Albania can do so only via an authorized local trademark agent registered with the Albanian Patent and Trademark Office (ALPTO). To date, electronic filing or pre-filing clearance searches are not available. An application must be accompanied by:

- A precise representation of the trademark, including the verbal element, if any.

- Eight labels featuring the trademark in the exact form in which it is to be registered.
- A specification of the goods/services for which protection is applied, as per the Nice Classification.

Applications may be refused because of a certain portion of the specification of goods and/or services – for this reason, merely referring to a whole class without elaborating can be a double-edged sword. Specifications that are too broad or too narrow entail the risk of either unnecessary conflicts with prior marks or lack of protection of non-specified goods and/or services in a class, depending on the circumstances. As such, care should be taken to adapt the specification accordingly, with the assistance of a local trademark agent. Another significant requirement relates to trademark licence agreements; in order for these to be opposable, they should be legalised by notarial deed and duly registered with the ALPTO.

Advantages of local over central trademark filings

Albania is not part of the CTM system, as it has not yet joined the European Union. However, as Albania is a member of the Madrid Agreement and the Madrid Protocol, central trademark filings in the form of IRs can be used by rights holders that intend to expand their business internationally without mandating their local presence in Albania.

On the other hand, although English-language terms used for IRs may be promoted in the local market, given the peculiarities of the Albanian language it is recommended that rights holders include a transliteration of their mark in order to ensure proper protection.

Jurisdictional issues

In Albania, the same court has jurisdiction over both trademark validity and infringement matters; the ALPTO only registers the latter's decisions in the register. Moreover, in the case of imported goods suspected of infringement, upon a request from the rights holder or its representative, Customs or the market supervisory authority may take provisional measures by activating customs suspension procedures or removing infringing goods from the market. If applied, both measures will remain in place for 20 working days. During this time, the interested party should file a lawsuit with the court; otherwise, such measures will be revoked.

With regard to the validity of a trademark, the court may decide to abrogate a trademark due to a lack of distinctive elements, the rights holder's failure to use it continuously for five years or the name becoming generic in the market for the goods or services for which it is registered. In infringement matters, rights holders may request the court to issue temporary or permanent injunctions and order the offender to cease any other infringing action and remove or block the disputed goods, or else order their seizure and destruction. The same court may also decide on the proper allocation of damages to the owner of an infringed trademark. Albania has made great progress in the effective protection of trademark rights in recent years. It is indicative that the Law for the Protection of Trademarks and other Industrial Property Rights (9977/2008) was implemented as recently as 7th July 2008 in order to update the national law on current international provisions and agreements for reliably and effectively protecting industrial and IP rights in Albania.

Dealing with local challenges

Due to several linguistic and other particularities in the paperwork and procedures required for the effective protection of trademarks in Albania, the law mandates that non-Albanian trademark applicants use the services of an authorised local trademark agent registered with the ALPTO. This stipulation allows Albanian trademark agents to monitor effectively the Trademark Register and market, advise on any conflicts and find practical solutions to issues as they arise, which is particularly important in light of current changes and updates in local laws and regimes in anticipation of future possible EU membership. Further, engaging the services of a local trademark agent ensures regular collaboration and liaison with the ALPTO, which is particularly important in an evolving trademark market where many marks are still available for registration by legitimate applicants and measures of relief against exploitation by infringers can be taken on the basis of the available legal framework. **iam**



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