



News Greece (finally!) introduces its new Trademark Law implementing the EU Directive

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### Introduction.

Even though the necessary modifications introduced by EU Directive 2015/2436 were due to be transposed into national law by January 19, 2019, and notwithstanding the fact that the public consultation on a related draft law was finalized that month, the long-anticipated new trademark law was only enacted in Greece on March 20, 2020, in the midst of the Covid-19 lockdown. Law 4679/2020 finally transposed Directive (EU) 2015/2436 in Greece and efficiently approximates the treatment of the national trade mark to that of the EU trademark, as regulated by the EU Regulation 2017/1001.

The new law introduces very important changes, which, however, have been mostly tested at the EU level. It reinforces competition mainly by fostering innovation whilst confining the scope of trademark protection, as it does so by streamlining it, putting more emphasis on the issue of trademark use rather than on the typical aspect of its registration.

The main modifications introduced by the new law include the following:

### Removal of the graphic representation requirement-Introduction of new types of trademarks.

The new trademark law abolished the requirement for trademarks to be represented graphically.

Following this, in order for a sign to constitute a trademark, apart from being able to distinguish the goods or services of one undertaking from those of others.

It is sufficient that same is represented in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection offered to its proprietor. In this respect, the representation of the trademark may be submitted in any appropriate form using generally available technology, as long as is 'clear, precise, easily accessible, intelligible, durable, self-contained and objective'.

The graphic representation requirement has often been considered as a "serious restriction" to the registration of "non-traditional" or "non-conventional" types of trademarks and, due to this change, which is in line with the Directive and the EUTMR, a wider variety of signs is now available for registration, such as pattern marks, motion marks, position marks, hologram marks and audiovisual marks.

Obviously, a prerequisite for the actual filing of some of these marks is the introduction of the necessary technical equipment and infrastructure at the Greek Trademark Office, which has yet to materialize.

The abolishment of the graphic representation requirement is indeed a significant development in Greek trade mark law, rendering the legal system more adaptable to further technological development and new marketing strategies. On the other hand, since the criteria for proper representation remain strict (e.g. a description or a specimen are not considered appropriate representation), certain non-visual non-traditional signs, still remain unavailable for registration.

Nevertheless, rapid technological developments may give rise to more opportunities for the creation of suitable representations of non-conventional trademarks, making the registration of such signs possible without any need to amend the trademark legislation itself.

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### **Abandonment of the ex officio examination of relative grounds for refusal.**

The ex officio examination of relative grounds by the Greek Trademark Office, a long-established practice which has been repeatedly criticized as creating unnecessary barriers to the registration of trademarks, has finally been abolished. The Examiner now only checks applications with respect to absolute grounds of refusal, hence employees of the Trademark Office ("Trademark Office Researchers") will only identify prior rights, whose owners will receive notification of the publication of the later mark so that they may file opposition before the Administrative Trademark Committee.

### **Specification of goods and services.**

Under the new law, the use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services **clearly** covered by **the literal meaning** of the indication or term. Consequently, in case a trademark applicant uses the entire heading of one class, said application will only be protected for goods and services specifically mentioned and not for all of the goods or services of said class.

According to the explanatory memorandum of the law, said provision apply not only to applications filed after the entry to force of the new law but also to already existing trademarks.

The issue that arises in this respect concerns the trademarks filed for the heading of one or more classes prior to 19.6.2002, i.e. prior to the IP-Translator case, when, according to the Greek practice of that time, the use of all general indications listed in the class heading of a particular class was considered as constituting a claim to all goods or services falling within this particular class.

It is worth noting that the law does not provide (as in the case of Regulation (EU) 2015/2424) for a grace period within which the owners of the national marks may file a declaration and clarify, in a clear, precise and specific manner, one by one from the alphabetical list for that class of the Nice classification, all the products (other than those clearly covered by the literal meaning of the indications of the class heading) that they intended to protect.

It does not appear that the Trademark office is willing to grant such a grace period so, in our view, the only solution for owners of earlier marks wishing to avoid negative consequences, would be, as Professor Chrissanthis recommends, to proceed to a limitation of the goods in their marks as soon as possible in order for same to reflect the goods for which they are actually used.

### **Change of the role of the civil courts in trademark cases.**

Prior to the new law, there was a clear-cut distinction between the competence of the administrative and that of the civil courts, resulting to a "dual system": Issues regarding the registration process (relative and absolute grounds, oppositions, revocation or invalidity actions) were examined by the Administrative Trademark Committee and the Administrative Courts while the Civil Courts were only competent for trademark infringement cases and were not competent for cases for which the Administrative Trademark Committee and the Administrative Courts were competent. Moreover, the Civil courts were not permitted to challenge in any way the validity of a registered mark. The new law changes this radically: while the Trademark Committee remains competent for both opposition and invalidity/revocation cases, appeals relating to oppositions remain in the realm of the Administrative Courts, whereas appeals relating to invalidity/revocation actions are transferred to the civil courts.

Furthermore, civil courts are now allowed to deal with counterclaims for revocation or invalidity of national marks, as it has already been possible with respect of EUTMs, in accordance with the EUTM Regulation. More specifically: if an infringement action has already been filed, the respondent can only challenge the validity of the mark by way of a counterclaim before the civil courts. On the other hand, in case a revocation or invalidity action has been filed before the Administrative Trademark Committee prior to the lawsuit, the Civil Court may suspend the infringement proceedings and order preliminary measures.

Furthermore, the right to request proof of use which, under the previous law existed only in the opposition and invalidity proceedings, has now also been introduced in the context of infringement proceedings, meaning that the use and not the registration of the mark is protected. Accordingly, the respondent may claim non-use as a defense in infringement proceedings, requesting that the plaintiff/owner of the trademark should prove that, during the five-year period preceding the date of bringing the action, the trade mark has been put to genuine use in connection with the goods or services in respect of which it is registered or that there are proper reasons for

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non-use, provided of course that the trademark was not registered for less than five years at the date of the bringing of the action.

It is also worth noting that the respondent may not only raise non-use as a defense in the preliminary injunctions but also file a counter-claim for the temporary invalidity or revocation of the mark in this context, even though, the court's decision in this respect cannot result in the permanent revocation or invalidation of the mark.

#### **Acquiescence.**

Acquiescence is now available as a defense to the respondent not only in the context of infringement proceedings but also in invalidity proceedings. Furthermore, the law also made use of the discretion provided by the Directive, while said defense also applies against holders of other prior rights, provided for in article 5 paragraph 3a and 3b of the law.

#### **Intervening rights.**

As per the recitals of the Directive, for the sake of ensuring legal certainty and safeguarding legitimately acquired trade mark rights, it is appropriate and necessary to provide that proprietors of earlier trademarks should not be entitled to obtain refusal or invalidation or to oppose the use of a later trade mark if the later trade mark was acquired at a time when the earlier trade mark was susceptible to being declared invalid or revoked or if the earlier trade mark could not be enforced against the later trade mark because the necessary conditions were not applicable.

Article 48 of the law provides for the intervening rights defense in the context of infringement and art. 53 in the context of invalidity proceedings.

The circumstances in which this defense may apply vary depending on whether the later mark is an EU trade mark or a national mark.

In accordance with article 48, the proprietor of an earlier registered national mark could not prohibit the use of a later registered national mark when the posterior mark would not be declared invalid where the proprietor of the earlier mark had acquiesced in the use of the posterior mark (article 12), or where it was applied at a time when the earlier mark was lacking of distinctive power or had not obtained the necessary degree of distinctiveness or of reputation (article 53), or where the prior mark had not been put to genuine use at the relevant point of time (article 54). Moreover, pursuant to the same article, the owner of an earlier registered national mark could not prohibit the use of a posterior EUTM, where the later EUTM could not be declared invalid on the basis of relative grounds of invalidity as per art. 60(1), (3) or 1(4) of the Regulation (EU) 2017/1001, in case of acquiescence within the meaning of art. 61(1) or (2), or in situations of previous non-use of the prior mark, as per art. 64(2) of the Regulation.

#### **Mediation.**

In an effort to promote alternative dispute resolution procedures, the new law provides for the possibility of mediation in the proceedings before the Administrative Trademark Committee. The process (as opposed to mediation in case of trademark infringement actions before civil courts) is **optional** and the filing of a joint request by both parties is a prerequisite.

#### **Renewal.**

The renewal of a trademark registration can take place within the period of six months (:no longer one year) preceding the expiry of the registration. Under the new law, the office shall inform the owner of the trademark of the expiry of the registration, however, it cannot be held liable if it fails to do so. The law also provides for late renewal during the six months following the expiry date ("grace period"), however, late renewal does not overturn the rights that third parties may have acquired during this period.

#### **Certification marks.**

The new Trademark law introduced the notion of guarantee or certification marks for the first time in Greece. These are marks which have been designated as certification marks by the applicant at the moment of their filing and serve to guarantee the consumer that the goods or services under the mark comply with certain quality requirements which are controlled by the proprietor of said mark in respect of the characteristics of the marks, with the exception of geographical origin. Thus, the law has not implemented the related option offered by the Directive, according to which signs or indications which may serve in trade to designate the geographic origin of

the goods or services may constitute certification marks thus supporting the autonomy of the sui generis protection system of geographical indications.

#### **Changes in the official fees.**

Interestingly, there are no longer official fees for the recordal of changes of name, legal form and address and for the recordal of limitation/restriction of goods. Slightly lower fees are offered for the electronic filing and renewal of trademarks as compared with those in paper format.

#### **Other noteworthy changes include:**

Extension of the absolute prohibition for signs consisting exclusively of the shape which results from the nature of the goods; or is necessary to achieve a technical result, or which gives substantial value to the goods, to apply not only to shapes, but also to signs which consist exclusively of any other characteristic (e.g. colour).

The right of the trademark owner to require a publisher of a dictionary, encyclopaedia or similar reference work to indicate that the term in question is a registered trademark in case the reproduction of the mark in the reference work gives the impression that the name is generic in relation to the registered goods or services.

The right of the trademark owner, in the case of a mark registered in the name of his agent or representative, without the proprietor's consent, to oppose use of said mark and/or to demand its assignment in his favour.

Trade mark owners may also stop preparatory acts of infringement where there is a risk that packaging, labels, tags, security or authenticity features will be used in relation to infringing goods or services. In addition, trademark owners may prevent third parties from bringing goods coming from third countries, into the Greek territory, also when same are not released for free circulation in Greece and placed in all customs situations such as transit, transshipment, warehousing, free zones, temporary storage, inward processing or temporary admission, even if such goods are not destined for circulation in the Greek market. This entitlement of trade mark owners applies to infringing marks that are identical to or which cannot be distinguished in its essential aspects from the registered mark and it will lapse if the holder of the goods, involved in the relevant customs proceedings, provides evidence that the trade mark owner is not entitled to prohibit the use of the trade mark in the country of final destination. This obviously facilitates the seizure of counterfeit goods stated to be in transit, putting the onus on the holder of the goods to prove the goods are not infringing.

Possibility of the publication of a decision not only in the press but also on social media.

The monetary penalty cautioned for violation of a court decision ordering a trademark infringer to desist from further infringing acts was increased from 10.000 Euros to 100.000 Euros.

In order for compensation and moral damages to be awarded, intentional misconduct or gross negligence is required (ordinary/simple negligence not being sufficient).

Following the enactment of the above law, Greece is finally fully compliant with the Directive. Nevertheless, concerns have been expressed over some of its provisions, such as those related to renewal and to the "dual" jurisdiction between the administrative authorities/courts and civil courts and it remains to be seen how successfully and smoothly its provisions will be applied by the judiciary.



