

Yearbook

2017/2018

A global guide for practitioners

Greece

Dr Helen G Papaconstantinou and Partners

Fotini Kardiopoulis, Miranda Theodoridou and Dimitra Nassimpian

**World
Trademark
Review**

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Legal framework

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

- the Trademark Law (4072/2012, Part 3), as amended by Law 4155/2013;
- the Unfair Competition Law (146/1914), as amended by Law 3784/2009;
- relevant EU legislation, including the EU Community Trademark Regulation (40/94), as codified by EU Regulation 207/2009;
- Chapter C of Law 2943/2001, which establishes the Greek Community trademark courts;
- Law 213/1975 ratifying the Paris Convention for the Protection of Industrial Property;
- Law 2505/1997 ratifying the Nice Agreement on the Classification of Goods and Services;
- Law 2290/1995 ratifying the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- Law 2783/2000 ratifying the Madrid Protocol on the International Registration of Marks.

Unregistered marks

Protection

Unregistered signs can constitute relative grounds for refusal and are protected under Articles 13 to 15 of the Law on Unfair Competition. In particular, protection is offered to signs that are deemed to have become a distinguishing feature of the goods or services that they cover.

Use requirements

In order to obtain protection, an unregistered sign must have distinctive character and must have been used in commerce. No specific statutory conditions outline the extent and type of use that will satisfy these criteria; hence, courts rule on a case-by-case basis. The guiding principle is that use should be systematic, continuous, substantial and for a number of years.

Registered marks

Ownership

Any individual or legal entity may file for the registration of trademarks, while clubs and associations may apply for the registration of

collective trademarks. In case of more than one applicant, a common representative must be appointed.

Electronic filing and e-filing

In addition to the submission of a printed trademark application form, applicants must submit the completed form and an imprint of the mark electronically (on a CD or USB).

As of November 3 2014, and following Ministerial Decision K4-14913/16.10.2014, the Greek Trademark Office has implemented e-filing for trademarks, using an electronic signature. The new e-filing system allows trademark applications to be filed 24 hours a day, seven days a week.

Electronic services of the Greek Trademark Office include renewal and recordal of changes pertaining to the owner's details. The office is expected to implement further e-services, including recordal of changes of ownership and filing of oppositions, cancellations and invalidation actions.

Transliteration requirement

In the case of marks which are not written in Latin or Greek characters, the application must include a transliteration into Greek or Latin characters.

Power of attorney

The trademark application must be signed by the applicant or its authorised attorney, whose appointment is optional. However, applicants must designate an addressee for the service of documents. If a lawyer is appointed, a simply signed power of attorney is required, which is valid for five years and may be used for further applications.

Scope of protection

The graphical representation requirement still applies. According to Article 121 of the Trademark Law, a trademark is any sign that is capable of being represented graphically and of distinguishing the goods or services of one undertaking from those of another. In particular, a trademark may consist, among other things, of words, names of natural or legal persons, pseudonyms, acronyms, slogans, designs, letters, numerals, colours, sounds (including musical phrases) or the shape of goods or their packaging.

Absolute grounds for refusal

Article 123 of the Trademark Law provides that the following cannot be protected as trademarks:

- signs that are devoid of distinctive character;
- signs that are descriptive, commonly used, customary or functional. Distinctive character may be acquired through use, except in the case of signs that consist exclusively of the shape of the goods or a shape which is necessary to obtain a technical result or gives the goods substantial value. Distinctive character will be assessed at the time of filing;
- signs which may deceive the public as to, among other things, the nature, quality or geographical origin of the goods or services intended to be covered;
- signs that are against public policy or morality; and
- signs that consist of the flags, emblems, symbols, escutcheons, signs or hallmarks of the Greek state or any other state covered by Article 6*ter* of the Paris Convention, and signs of great symbolic value and special interest – particularly religious symbols, representations and words.

Signs consisting of or comprising geographical indications for wine and alcoholic beverages, and geographical indications or appellations of origin for agricultural products, are expressly exempt from trademark protection.

Finally, a trademark shall not be registered if it has been filed in bad faith.

Relative grounds for refusal

A sign may not be adopted as a trademark if it infringes prior rights, such as:

- earlier registered marks, including EU and international trademarks effective in Greece;
- trademark applications, as above, subject to their final registration;
- well-known marks within the meaning of Article 6*bis* of the Paris Convention;
- unregistered marks or other distinctive signs or indications used in trade where the owner is entitled to prohibit use of the later mark; and



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- personality rights, copyright or other rights not covered by trademark law.

Letters of consent to the registration and use of a later mark have binding effect and can be submitted at any time during the registration procedure and at any point during the examination of a mark. Rights holders may also issue a disclaimer and limit the originally designated products or services at any time.

The law allows for the division of a trademark application or registration into two or more applications or registrations.

Procedures Examination

After a trademark application has been filed, the examiner checks each filing with respect to both absolute and relative grounds for refusal. If no grounds for refusal exist, the application is accepted. If grounds for refusal exist, the applicant is notified and may revoke the application, limit the trademark to the extent that it becomes acceptable or submit its observations within one month of notification.

If the applicant fails to reply or comply within the set term, the application is rejected. All decisions are published on the website of the General Secretariat of Commerce.

The examiner's decision to reject an application can be challenged before the Administrative Trademark Committee within 60 days (90 days in the case of foreign entities) of publication of the decision. The committee's decision is subject to further recourse before the Administrative Court of First Instance.

Opposition

Any party with a legitimate interest can oppose a trademark application. The term for filing an opposition is three months from the date of publication of the decision on the website of the General Secretariat of Commerce.

Proof of use is provided as a defence during opposition proceedings. If the trademark on which the opposition is based has been registered for more than five years, the applicant can call on the opponent to submit evidence of use of the mark in respect of the relevant goods or services on which the opposition is based in the five years preceding the date of publication of the opposed application, or to prove that there are proper reasons for non-use. Failure to meet these requirements will result in rejection of the opposition for procedural reasons.

Trademark Committee decisions are subject to recourse before the Administrative Court of First Instance within 60 days (90 days in the case of foreign entities) of notification of the decision.

Registration

A trademark is registered when it is accepted by a decision of the examiner or the Trademark Committee, subject to no further legal remedies or by a final decision of the administrative courts. A registered mark is granted protection for 10 years as of the date of filing of the application, and is indefinitely renewable every 10 years. If renewal is not requested within the specified period, the trademark can still be renewed up to six months later on payment of a fine.



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Fotini Kardiopoulis graduated with first-class honours from the University of Athens with a law degree, and holds an LLM from the London School of Economics and Political Science. She has been a member of the Athens Bar since 1985 and is admitted to practise before the Supreme Court and the Council of State.

Ms Kardiopoulis has dealt with a broad range of IP matters since 1998, with an emphasis on trademarks and alternative dispute resolution. She heads the anti-counterfeiting/anti-piracy department of the firm, and has particular experience in devising and implementing anti-counterfeiting programmes, filing and administering customs actions, monitoring and enforcing IP rights online and advising on domain name disputes. She writes frequently on IP issues.



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Miranda Theodoridou graduated from the University of Athens with a law degree and is admitted to practise before the Supreme Court and the Council of State.

Ms Theodoridou has more than 30 years' extensive experience in handling a broad spectrum of IP issues, including consultation for and legal representation of major multinational companies in administrative proceedings and courts. She has handled numerous cases, mostly focusing on trademark and domain name matters, and has made several contributions to professional publications in this area.

Ms Theodoridou is a European patent attorney and a member of numerous professional organisations, including the International Association for the Protection of Intellectual Property, the Institute of Professional Representatives before the European Patent Office and the European Communities Trademark Association.

Removal from register

Revocation: A trademark can be revoked, either in whole or in part, if:

- it has not been put to genuine use by its owner for a continuous five-year period following registration in connection with the goods or services in respect of which it is registered, or if such use has been suspended for an uninterrupted period of five years;
- in consequence of acts or inactivity on the

part of the rights holder, the trademark has become commonly used or the common name in the trade for the goods or services in respect of which it is registered; or

- by reason of the use made of a mark by the owner or with its consent in connection with the goods or services for which it has been registered, it is likely to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.



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Dimitra Nassimpian graduated from Edinburgh University with an LLB (honours), and then carried out doctoral studies there while lecturing in EU and international law. She was subsequently appointed as a full-time lecturer at Exeter University School of Law (2004 to 2008), teaching extensively in EU and UK public law at undergraduate and master's level. She has published on EU and UK administrative law and trademark litigation, and is a member of the UK Society of Legal Scholars and a visiting research fellow at Exeter University. She is currently consulting at Dr Helen G Papaconstantinou and Partners on contentious trademark and domain name matters and aspects of EU litigation.

Invalidity: A trademark is declared invalid if it should not have been registered in the first place because it was registered in breach of the provisions regarding absolute or relative grounds for refusal. The proof of use requirement also applies in invalidity proceedings.

A trademark will not be declared invalid, even if it was devoid of distinctive character, descriptive or generic at the time of its filing, if such grounds no longer exist at the time

of the petition for a declaration of invalidity because the trademark has since acquired distinctive character through its use.

Decisions ordering the revocation of a mark or a declaration of invalidity take effect as soon as they become final.

Surrender: The owner may surrender the trademark for all or part of the goods or services for which it is registered at any time. If the mark is subject to a licence, the owner must prove that the licensee has been duly informed of its intentions to surrender the mark.

Enforcement

A registered trademark confers exclusive rights on its owner, which is entitled to prevent all third parties from using in transactions without its consent any sign which:

- is identical to the mark in question in relation to identical goods or services;
- is identical or similar to the mark in relation to identical or similar goods or services, provided that a likelihood of confusion exists, including a likelihood of association; or
- is identical or similar to a trademark which has acquired reputation and whose use would take unfair advantage of the reputation of the mark without due cause or would cause detriment to the distinctive character or reputation of the famous mark, irrespective of whether the sign will cover goods or services which are similar to those of the earlier mark.

The owner of a prior trademark cannot oppose the use of a later mark if it has acquiesced to the use of the later mark for five successive years while being aware of such use, unless registration of the later mark was obtained in bad faith.

The revised trademark legislation expressly provides that the trademark holder is entitled, among other things, to prevent the transit of counterfeit goods through Greece or the import of counterfeit goods into Greece with the intention to re-export them. Special divisions have been established for EU trademarks in the civil first and second-



Criminal penalties have always been available in trademark infringement cases, but under the new law, they have become more severe. Professional and commercial-scale infringement can be considered as aggravating circumstances

instance courts of Athens and Thessaloniki. These divisions also hear national trademark cases, where they have jurisdiction.

Civil court actions

In cases of trademark infringement, the following actions may be pursued in the civil courts.

Temporary restraining order: This is available only in cases of extreme urgency where the rights holder seeks a temporary court order as soon as the infringing activities have come to its attention in order to enjoin such activities until adjudication at the injunctive stage. The judge may invite the respondents to appear at the hearing, although proceedings may also take place *ex parte*. Restraining orders may be requested only if an injunction petition has also been filed simultaneously.

Injunction: A petition for injunction also requires that the situation be urgent. The procedure is more formal than that for a temporary restraining order, as the hearing involves the examination of witnesses from each side and the optional submission of sworn affidavits, as well as relevant pleadings and exhibits. The court will also examine the merits of the case in some detail and decide on the likelihood of an infringement having occurred.

The trademark owner may require the disclosure of information under the suspected infringer's control.

In case of commercial-scale infringement, the court may order *ex parte* the provisional seizure of the infringer's assets, the freezing

of its bank accounts and the disclosure of its bank, financial or commercial documents or due access to this information. In this respect, the trademark owner must prove that there are circumstances that may jeopardise actual payment of the indemnification. The filing of a related main infringement action is a prerequisite.

Main infringement action: An infringement action forms part of ordinary proceedings, in which the issue at hand is examined in detail by the competent IP courts on the basis of extensive pleadings. In view of the Code of Civil Procedure rules that were recently revised by Law 4335/2015 (which came into force on January 1 2016), the adjudication process will hopefully be expedited: for actions filed after January 1 2016, parties must file their pleadings, including evidentiary materials and all necessary documents, within 100 days of filing the action, while they have another 15 days within which to submit rebuttal arguments, with the case file closing 15 days later. The hearing of the case takes place within 30 days of the closing of the file – without oral witness testimonies in court, unless the bench decides that this is absolutely necessary. Although there are no specific provisions as to the timeframe for the delivery of judgments, they are expected to be issued approximately three to six months following the hearing.

Damages

Damages may not be sought during the injunctive stage, but may be awarded as part of the claims during a main infringement

action for actual loss and/or moral damages. The court will take into account, among other things, the negative economic consequences suffered by the rights holder, including any undue profits made by the infringer. Undue profits may be awarded to the claimant, regardless of the infringer's liability (unjust enrichment). Damages may also be calculated on the basis of hypothetical royalties.

Simplified procedure

Law 4155/2013 provides for a simplified procedure with respect to the seizure and expedited destruction of counterfeit goods (analogous to the one set out in EU Regulation 608/2013), which is implemented by a number of enforcement agencies, such as Customs, the Economic Crime Unit, market control agencies, the police and the Coast Guard. The consent (express or presumed) of the owner of the infringing goods is a necessary prerequisite and implementation of the procedure depends on the discretion and availability of the competent authorities.

Criminal penalties

Criminal penalties have always been available in trademark infringement cases, but under the new law, they have become more severe. Professional and commercial-scale infringement can be considered as aggravating circumstances.

Ownership changes and rights transfers

Ownership changes (eg, assignments, mergers) and various other changes (eg, changes of name/address/legal form of the rights holder) must be recorded with the Trademarks Office in order to be enforceable against third parties. A trademark may be partially assigned, provided that such assignment does not mislead consumers.

Assignment of an earlier trademark which has been cited against the registration of an application will allow registration of that application, irrespective of when such assignment takes place and even during proceedings before the Administrative Court of Appeal.

A pledge or other right *in rem* may be recorded against a trademark. Such recordal may also be effected by the receiver following a bankruptcy order.

There is no longer any need for the Trademark Committee to examine and approve licence agreements. Such agreements must be executed in writing and may be recorded upon the petition of either the licensor or the licensee, duly authorised by the licensor.

The recordal of a licence is not compulsory, but it is highly recommended.

Related rights

There are clear areas of overlap between trademarks and other IP rights. The object of trademark protection can also be protected by other IP rights, provided that the protection criteria of such rights are met.

Shapes of products or their packaging, trade dress, logos and business names, as well as other unregistered rights, may under certain circumstances enjoy similar protection to that afforded to trademarks under unfair competition law. If certain conditions are met, these may all be regarded as non-registered marks and acquire rights of priority and protection in this manner.

The 'Greek mark'

The 'Greek mark', indicating the national origin of goods and services, was created during a time of deep economic crisis and aims to encourage demand for Greek products and increase export activities.

The mark consists of a *sui generis* flag-shaped device mark, accompanied by the words "Greek mark" in Greek and English (shown below).



Regulations for the award of the Greek mark have already been issued for alcoholic drinks, dairy products, olive oil and olives.

Online issues

The regulation of telecommunications in Greece is vested in the Hellenic Telecommunications and Post Commission. The main legal framework can be found in the Regulation on the Management and Assignment of Domain Names, which was most recently amended in February 2015. The regulation sets out the procedures for registering domain names in the country-code top-level domain '.gr' and the grounds for cancellation petitions that are heard by the commission. Commission decisions can be appealed to the Athens Administrative Court within 30 days of their official notification to the parties. **WTR**



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Examination/registration

Representative requires a power of attorney when filing? Legalised/notarised?

Yes/No



Examination for relative grounds for refusal based on earlier rights?

Yes



Non-traditional marks registrable?

3D (shape of products or package); colours.

**Unregistered rights**

Protection for unregistered rights?

Yes



Specific/increased protection for well-known marks?

Yes

**Opposition**

Opposition procedure available? Term from publication?

Yes: two months, extendable under cooling-off/finalising settlement terms, with consent.

Removal from register

Can a registration be removed for non-use? Term and start date?

Yes: five years' non-use from registration or suspension of use.



Are proceedings available to remove a mark that has become generic?

Yes



Are proceedings available to remove a mark that was incorrectly registered?

Yes

**Enforcement**

Specialist IP/trademark court?

Yes



Punitive damages available?

No



Interim injunctions available? Time limit?

Yes: urgency required.

**Ownership changes**

Mandatory registration for assignment/licensing documents?

No; but highly recommended.

**Online issues**

National anti-cybersquatting provisions?

No; but concept of cybersquatting applicable to bad faith.



National alternative dispute resolution policy (DRP) for local ccTLD available?

Yes: Hellenic Telecommunications and Post Commission.

