

GETTING THE DEAL THROUGH®

Trademarks

in 52 jurisdictions worldwide

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1 Ownership of marks

Who may apply?

Under the new Greek Trademark Law, any natural person or legal entity may file a trademark application. The provision includes non-commercial enterprises and enterprises without a direct or specified profitable aim. There is no 'intent to use' requirement. Non-residents may own a trademark registration in Greece.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

The new Greek Trademark Law allows for trademark rights to be constituted pursuant to registration as follows:

Any sign that can be represented graphically and that is capable of distinguishing the products or services of one undertaking from those of another may be registered as a trademark. Any type of sign that has the above characteristics may be registered as a trademark, even if it is not included in the following non-exhaustive list set out in law: words, the names of natural or legal persons, nicknames, devices, designs, letters, numbers, colours, sounds (including musical phrases), the shape of the product or of its packaging and slogans. Also, the titles of newspapers or magazines may be registered as trademarks.

According to Greek trademarks law and practice, the following are absolute grounds for refusal of trademark registrations:

- trademarks that cannot be represented graphically and that are not capable of distinguishing the products or services of one undertaking from those of another;
- lack of distinctiveness;
- if the mark consists exclusively of signs or indications that may serve in trade to designate the kind, quality, characteristics, quantity, intended purpose, value, geographical origin or time of production of the product or the provision of the services, or other characteristics of the products or services (descriptive marks);
- if the mark consists exclusively of signs or indications that have become customary in the current language or in the good faith and established course of trade;
- if the mark consists exclusively of the shape that results from the nature of the products distinguished, or is necessary to obtain a technical result or give substantial value to the products distinguished;
- if the mark is contrary to public policy or accepted principles of morality;
- if the mark is of a nature that can deceive the public, especially as to the nature, quality or geographical origin of the product or service;
- if the marks distinguish wines or spirits and contain or consist of a geographical indication, protected according to EU legislation, identifying wines or spirits, if the specific wines or spirits do not have that origin; or

- if the marks contain or consist of a designation of origin or a geographical indication for agricultural products and foodstuffs registered in accordance with EU legislation and regarding the same type of product, on condition that the application for registration of the trademark has been submitted after the date of filing of the application for registration of the designation of origin or geographical indication.

For signs that lack distinctive character, are descriptive or have become customary in everyday language and in the course of trade, although inherently not registrable, those can be registered if they have acquired distinctiveness through use before the filing of the trademark application.

Further, a sign cannot be registered as a trademark pursuant to article 6-ter of the Paris Convention, namely, if it consists of flags, symbols, state symbols or signs of great symbolic importance, especially religious symbols, representations and words.

Trademark applications filed in bad faith are rejected.

3 Common law trademarks

Can trademark rights be established without registration?

Greek trademark legislation does not contain common law provisions for the acquisition of rights on signs that perform the function of trademarks.

Unregistered rights on signs performing the function of trademarks may be protected under the provisions of the Law on Unfair Competition No. 146/1914. Under these provisions, if a sign is recognised to be distinctive, as to its source or origin, to the products or services that it distinguishes through use in trade, this may be protected against use by third parties. However, such protection is limited to the geographical area where the sign is established in trade and in respect of the items it is established to distinguish.

4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

Time frame

According to current practice under the previous trademark law, the registration of an unopposed trademark application took approximately 18 to 20 months. This is still the case for trademarks filed until 10 October 2012, because the provisions of the old law applies still in this respect. However, in respect of trademarks filed after 11 October 2012, the registration of an unopposed trademark application, which has also not faced any official objections, takes approximately four to seven months.

The procedure for the registration of a trademark is, by law, as follows.

According to the new Trademarks Law, trademark applications can be submitted either in the form of documents accompanied with their electronic form in a suitable digital disk or memory stick, or electronically. On the day of filing, the trademark application is granted the number and date of filing.

The examiner examines the new applications in respect of absolute and relative grounds of refusal. Should the examiner not locate any grounds for refusal, he or she must issue a decision accepting the application within one month from the filing date of the relevant application. The existence of objections on relative or absolute grounds would increase the estimated time and cost of a trademark application receiving a registration. In such a case the Trademark Office informs the applicant accordingly and invites him or her to either withdraw the application, proceed with a limitation of the list of goods and services (so that the grounds for refusal are eliminated) or file observations in support of the acceptance of the trademark as filed within a deadline of one month (two months for foreign applicants). After filing the observations, the examiner shall issue his or her decision on the acceptance or refusal of the trademark.

Following the publication of the accepting decision on the website of the Trademark Registry, an opposition may be filed against registration of a trademark application, wholly or in part, within a deadline of three months from the date of publication. If no oppositions are filed during the opposition period, or if any decisions accepting an opposition are successfully appealed, the trademark will be registered.

Costs

When filing a trademark application for products or services in one class, since 11 October 2012 the official fees are €110 plus approximately €65 for disbursements (stamp duties and bar association expenses). For any additional class, one must add official fees of €20. The attorneys' fees for filing a trademark application are no longer regulated, but depend on agreement between the parties. In general, attorneys' fees are increased in the case of translations of the products or services distinguished or the certifications of documents. An approximate total cost to file a trademark application in Greece in a single class is between €450 and €500.

Deviation from the above average costs can be caused if the application is provisionally refused on absolute or relative grounds during examination. In that case, written arguments supporting the application may be filed to argue the reasons why the mark is registrable. This procedure costs the applicant, approximately, an additional €600 (including expenses of approximately €120). Attorneys' fees may be higher depending on the complexity of the case.

If the application is opposed by a third party, the time frame and legal costs can vary, depending on the complexity and implications of the case.

A power of attorney, simply signed by the applicant, is required for filing a trademark application. If the applicant is a Greek legal person, additional documents proving the authority of the signatory to represent the company are required. However, the latter are not required in the case of a foreign legal person.

5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The Nice International Classification system is followed and the 10th edition is in force at present. Multi-class applications are available and the estimated cost saving is that of filing a new trademark application for each class.

6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

Trademark applications are examined for potential conflicts with prior trademarks. In detail, the steps that are followed by the Trademarks Registry are as follows.

The interested party files with the Ministry of Development (trademarks division) an application for a trademark registration. The filing date is important because the right to the trademark in question is acquired upon registration and counts back from the date of filing. The examiner, as a single officer, examines the new applications in respect of absolute and relative grounds of refusal. A control is conducted for prior trademark rights valid in Greece (Greek trademarks, Community Trademarks (CTMs) and International Registrations (IRs) designating Greece). Should the examiner not locate any ground for refusal, he or she must issue a decision accepting the application within one month from the filing date of the relevant application. If there exist any such objections on relative or absolute grounds, the Trademark Office informs the applicant accordingly and invites him or her to, within a deadline of one month (two months for foreign applicants), either withdraw the application, proceed with a limitation of the list of goods and services (so that the grounds for refusal are eliminated) or file observations in support of the acceptance of the trademark as filed. The trademark application will be either accepted and then the accepting decision is published on the website of the Trademark Registry within one month from the date that the restriction or the observations were filed by the applicant, or the trademark application will be refused. The rejecting decision is notified to the applicant and published on the website of the Trademark Registry.

Following the publication of the accepting decision on the website of the Trademark Registry, an opposition may be filed against registration of the trademark application, wholly or in part, within three months of this publication. If no opposition is filed during the opposition period, or if any decisions accepting an opposition are successfully appealed, the trademark will be registered.

In the case of citations or absolute grounds of refusal, it is advisable that the trademark applicant be represented by an attorney-at-law, so as to present evidence and arguments (eg, on differentiation or on acquired distinctiveness). Such arguments may be accompanied by any written evidence and other documents. All arguments are submitted in writing and the ruling may accept or reject the trademark application wholly or in part. Sworn affidavits, duly legalised, may be submitted as well and are taken into consideration as witnesses' testimonies.

The possibility of dividing a trademark application has been introduced with the new trademark law, namely, if a trademark is accepted for part of the products or services it is distinguishing and the applicant decides to challenge the decision that rejected the trademark application in part, then the applicant may decide to divide the trademark application so that they may proceed to registration for the accepted part of the products or services only, while proceedings continue for the contested part. Such division cannot take place after the filing of an opposition or of a cancellation action against the trademark, if the divisional application has the effect of introducing a division among the goods and services against which the opposition or cancellation is directed.

7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Prior use of a trademark is not a requirement for the trademark to be accepted for registration and to become registered.

Proof of use does not need to be submitted at the filing of a trademark application, as prior use of a trademark is not required for its registration.

However, in the case of trademarks that are considered by the examiner to be inherently devoid of distinctive character, descriptive or to have become customary in everyday language and the course of trade, it is necessary to submit proof of use to support the registration of the trademark with the argument that it has acquired distinctiveness through use until the filing date. This proof of use must be submitted by the applicant within a month after the relevant notification by the examiner. Submissions are made by the applicant or through a local attorney-at-law in the form of observations with evidence supporting the acquired distinctiveness.

Even though registration is granted without proof of use or proof of intent to use, the trademark can later be removed from the Registry through revocation (cancellation) proceedings. To maintain the registration or defeat a challenge on grounds of non-use, the trademark has to be put into genuine use within five years from the date of its registration. Simple preparatory actions are not sufficient to block cancellation. Also, the trademark must not be out of use for a continuous period of five years or more. The cancellation of a trademark for non-use may be avoided if the trademark owner proves that there was a good reason for not using the trademark. In jurisprudence, it has been recognised that 'good reason' includes, for instance, the bankruptcy of the enterprise of the trademark owner.

Foreign trademark applications filed in a member state of the Paris Convention are granted rights of priority provided that the same trademark application is filed in Greece within six months of the filing date of the application in the Paris Convention member state.

8 Appealing a denied application

Is there an appeal process if the application is denied?

The only appeal process possible is to file a recourse against the rejection of a trademark application by the single examiner, which may be introduced before the Trademark Administrative Commission within 60 days of notification of the rejection, or within 90 days in the case of a foreign trademark owner, as is the case for IRs. Such notification is performed ex-officio by the examiner.

The decision of the Trademark Administrative Commission, if this is still denying the trademark application, may then be appealed in front of the Athens First Instance Administrative Court. The latter decision may be appealed before the Athens Administrative Court of Appeals and ultimately a recourse may be filed against the Court of Appeals' decision before the Supreme Administrative Court (Council of the State).

9 Third-party opposition

May a third party oppose registration, or seek cancellation of a trademark or service mark? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not yet have protection?

Any third party may file an opposition or a cancellation action against the registration of a trademark or service mark.

The following grounds are admissible for opposition:

- relative grounds (based on prior proprietary rights, eg, conflicting prior registration) are the following:
 - the trademark is identical to an earlier trademark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trademark is protected;
 - the trademark is identical or similar to an earlier trademark, there is identity or similarity of the goods or services covered by the trademarks, and there exists a likelihood of confusion (including the likelihood of association) to the part of the public; or
 - the trademark is identical or similar to an earlier trademark and is to be registered for goods or services that are not similar to those for which the earlier trademark is registered, when the later trademark has acquired a reputation and the use without due cause of a later trademark, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.

For the purposes of Greek law, 'earlier trademarks' include:

- earlier registered national trademarks, including IRs designating Greece;
- earlier registered CTMs (taking into account priority rights and valid seniority claims for Greece);
- earlier applications of the above, subject to registration; and
- marks that are well-known on the date of the application, within the meaning of article 6-bis of the Paris Convention.

Other grounds admissible for opposition against a trademark are the following:

- if it conflicts with a non-registered trademark or with any other distinctive sign or feature used in the course of trade that confers upon its owner the right to prohibit the use of any later trademark, provided such rights have been acquired prior to the date of filing or priority;
- if it conflicts with an earlier right of personality or copyright or industrial property right; or
- if it is likely to be confused with a registered trademark that is in use in a foreign country on the filing date of the application, provided that the application was made in bad faith by the applicant.

A trademark that is similar or identical to an earlier trademark is registered if the owner of the earlier trademark consents to such registration. Consent must be in writing, it may be conditional and may be submitted at any stage of the trademark's examination until the procedure before the Administrative Court of Appeal.

Other grounds for opposition, besides related grounds, are:

- absolute grounds (based on non-proprietary rights, eg, descriptiveness) apply to the signs that are outside of the scope of protection of trademark law, as described above, under 'Scope of protection';

- bad faith in the filing of the trademark application: there is a distinction between opposition and cancellation in respect of bad faith as basis of rejection of an opposed trademark application and cancellation of a trademark registration, according to current jurisprudence: In the case of an opposition, significant similarity of the signs and the goods or services distinguished under comparison proves 'objective' bad faith. However, in a cancellation action 'subjective' bad faith needs to be proven;
- breach of copyright;
- rights under article 6-bis of the Paris Convention (notorious or well-known mark);
- rights in a prior company name and a personality right in general;
- rights under article 8 of the Paris Convention (prior trade names established in trade); and
- other rights or interests that may be grounds of an opposition including a trademark already registered abroad at the time of filing the trademark application, where there is a possibility of confusion and the trademark was filed in bad faith.

The following grounds are not provided for as opposition grounds: Rights under article 6-septies of the Paris Convention (registration in the name of the agent or other representative of the proprietor of the mark). However, although this is not specifically provided for, there is jurisprudence to support opposition in such a case, which is considered as filing a trademark in bad faith, and, thus, provisions for bad faith filings apply.

International registration extensions to Greece may be opposed as national applications.

International registration extensions to Greece and CTMs may be used as a basis for an opposition on relative grounds.

The opposition and cancellation authority is part of the Trademarks Registry or Office, namely, the Trademarks' Administrative Commission.

Opposition is filed at the post-grant stage. An opposition is filed after a mark is accepted for registration, but before actual registration of the mark.

A major change introduced by the new Trademark Law is that the holder of an opposed application may raise as a defence the opposer's non-use of the cited trademark right within five years of registration, like for CTMs.

A cancellation action can be filed on all the relative and absolute grounds of refusal named above, provided that the cancellation action is filed within five years from the registration of the trademark in question. An additional relative ground for cancellation is the existence of a CTM with a recognised valid seniority claim for Greece, even if the Greek trademark providing basis for the seniority has lapsed due to non-renewal or has been withdrawn.

As an exception, there is no deadline for filing a cancellation action on the above grounds, provided that the trademark in question was filed in bad faith. Cancellation is available if the opposition term has expired.

Other grounds for cancellation are:

- absence of substantial use of the trademark during five consecutive years after the effective registration date;
- if the enterprise of the trademark owner has ceased to operate for five years (in both cases described above the mark will not be cancelled if the owner proves that there was reasonable cause for the non-use or pause of operations);
- if the trademark has become generic for the products distinguished due to the actions or non-action of the trademark owner; or
- if use of the trademark by its owner or a licensee of the owner may deceive the public as to the nature, the quality or the geographical origin of the products or services distinguished.

Statutes of limitation or acquiescence provisions can prevent a cancellation action. If one has acquiesced to the use of a mark for five consecutive years, then it is no longer possible to request cancellation of the mark.

Opposition proceedings are generally preferable, compared to cancellation proceedings for the same grounds. In cancellation actions it is more difficult to prove bad faith, as jurisprudence requests the existence of deliberate (subjective) bad faith, namely that the mark was filed even though the applicant knew it had no right to file it. On the other hand, for the purposes of opposition, objective bad faith suffices.

10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

A registration remains in effect for 10 years from the filing date. To maintain the trademark, the registration has to be renewed before expiration of the 10-year period. However, it is still possible to renew a trademark within the 'grace' period, namely within six months after expiry, although official fees for such an application will be 50 per cent higher.

It is necessary to file a petition for the renewal of the trademark, accompanied by the stamp duties (official fees) within the above deadlines. The petition must be accompanied by a power of attorney of the trademark owner to the signatory of the said petition.

A trademark that is not used for five consecutive years or more is not automatically cancelled, but it is prone to be cancelled through filing of a cancellation action by any third party who has legal interest. In order to prevent the risk of cancellation the trademark owner must prove effective trademark use. Sample use and simple preparation for use are not sufficient. Regarding preparation, significant steps for circulation of the products under the trademark must have been taken.

11 The benefits of registration

What are the benefits of registration?

The benefits of registration are nationwide protection of the trademark and an absolute right arising from the trademark's registration. Only after its registration can a trademark be enforced as such. Until registration of a sign, this is protected only as a distinctive sign with application of the provisions of unfair competition law. These provisions grant protection to a sign if it is used in trade and it is established to distinguish the products or services from those of other undertakings; therefore there is more extensive need of evidence. Territorial protection in particular is granted for the territory where the sign is used in a substantial way.

12 Licences

May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?

A licence may be recorded against a trademark. A licence to use a trademark may be restricted to only some of the goods or services covered by the trademark. The recordal takes place upon filing of the relevant application at the Trademark Registry, either by the licensor or by the licensee with submission of the licence deed or certified copy thereof. Licensors can pursue licensees for trademark infringement if the latter fail to comply with the licence terms. Exclusive licensees are entitled to initiate infringement action against third parties, provided that the licensor has not taken such action. Non-exclusive licensees may do so, only upon the licensor's consent.

In the event of filing of a lawsuit for infringement by the licensor, the licensees have the right to intervene in the said lawsuit seeking the damages suffered.

The recordal of a licence is not mandatory. The benefit of having the licence recorded is that it makes it easier for the licensee to prove their legal interest for initiating an infringement action against third parties in the event the licensor fails to take such action.

The recordal of the licence is not required to prove the use of the trademark during cancellation proceedings. According to recent case law, use of a trademark is considered to be made by any third party with the owner's consent, even if the user is not a registered licensee.

13 Assignment

What can be assigned?

Greek trademark law allows for the assignment of a trademark alone, without assignment of the whole business behind it, which was not the case before 1994.

A trademark may be assigned for all or for part of the products or services distinguished.

No other business assets must be assigned to have a valid transaction. According to the law, the trademark is an asset independent of the business as a whole.

Assignment of an earlier trademark, which was cited as an obstacle to the registration of a new trademark, to the owner of the latter trademark application will permit the registration of the new trademark until proceedings before the Second Instance Administrative Court (Court of Appeals), but no later than that.

14 Assignment documentation

What documents are required for assignment and what form must they take?

A copy of the assignment deed or a confirmatory deed thereof must be filed at the Trademarks Office when requesting the recordal of an assignment. The signatures of both parties to the transactions must be included in this deed. The assignment deed needs legalisation with an apostille, or at the local Greek consulate for countries that have not ratified the Hague Convention (for apostille).

15 Validity of assignment

Must the assignment be recorded for purposes of its validity?

By law, the assignment of a trademark is valid against third parties to the assignment only after it is recorded. The trademarks division of the Ministry of Development records the assignment after a formal control. However, even if it is not recorded, the assignment is a valid contract binding its contracting parties only.

16 Security interests

Are security interests recognised and what form must they take?

Must the security interest be recorded for purposes of its validity or enforceability?

It is possible to record security interests against trademarks.

A trademark may be 'confiscated' or 'seized' following the issuance of a court decision. A pledge may also be recorded against a trademark, following a contract. The formalities to be followed for the recordal of a security interest are the same as for a trademark assignment and the documents to be submitted also need to be legalised.

The security interest must be recorded for information purposes and also for protecting the party in favour of which it is recorded against possible expropriation of the trademark.

17 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

There is no explicit reference in trademark law and trademark marking is not mandatory in Greece.

The benefit of using trademark marking is to warn third parties not to copy the sign in question. The only risks of using such marking arise when such marking is incorrect, which would amount to a misrepresentation to the public.

18 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

To enforce the rights of a trademark owner against any infringer or anyone that makes dilutive use of a famous trademark, the following proceedings are available to a trademark owner:

Civil court judicial proceedings

Civil protection can take two forms: injunctive measures or normal proceedings. The trademark owner, as plaintiff, seeks to reverse the effects of the infringement (cease and desist) and claim damages. The new Trademark Law has fully incorporated the Enforcement Directive (EC Directive No. 2004/48) in respect of the civil actions and provisional measures against the trademark infringers.

Provisional measures

The trademark owner or beneficiary may obtain against any infringer, through a provisional court order, the following measures:

- provisional seizure and withdrawal of the trademark infringing merchandise before this enters into circulation through trade networks;
- in the case of commercial-scale infringement or imminent infringement, the court can, even without prior hearing of the alleged infringer, issue an ex parte order for the provisional seizure of the alleged infringer's assets and the freezing of his or her bank accounts, on the condition that the trademark beneficiary provides evidence that the payment of indemnification to be decided following a civil action will be endangered. In addition, the court may also order the alleged infringer to provide all the banking, financial and commercial documents and any other information regarding the trademark infringing activities; and
- provisional measures may also be claimed and ordered by the court against intermediaries whose services are used for trademark infringement by an infringer.

Border enforcement mechanisms

EU Border Control Regulation No. 1383/2003 applies, and for criminal proceedings, the Greek Trademark Law includes criminal provisions against infringers. Under the new Trademark Law the act of infringement of a famous trademark is now explicitly considered to be a criminal offence. Moreover, there are additional criminal offences included in the Penal Code that apply to trademark infringement according to Supreme Court jurisprudence, for example 'forgery' (article 216 Penal Code) and 'fraud' (article 386 Penal Code).

19 Procedural format and timing

What is the format of the infringement proceeding?

The rights to registered and unregistered marks are enforced by the civil courts in cases of actual or threatened infringement. For registered marks, civil courts cannot question the validity of the trademark registration and are obliged to accept irrevocable administrative decisions on registration. Discovery, as known in the common law system, is not allowed. Live testimony is allowed in both normal proceeding and injunctive measures. One witness is heard orally in front of the court for each side. Other witnesses may testify through written sworn affidavits taken in front of a magistrate or a notary public. Experts may be heard as witnesses. In injunctive measures a single judge decides whether or not to grant the preliminary ruling (in very urgent cases) or the provisional order. In normal proceedings, it is the first instance single-member court that deals with trademark infringement. If the lawsuit is based also on the Unfair Competition Law or tort provisions, then the first instance multi-member court is competent.

A provisional order will be granted immediately or within a few days of filing a petition for a preliminary injunction, following a hearing by a single judge. Where a permanent injunction is sought, a hearing will usually take place within six months to two years of filing, depending on the court's location and the type of court chosen. The decision will be issued between four and 12 months after the hearing. The judgment may be provisionally enforceable, even before an appeal has been heard.

At second instance, on appeal, the hearing will generally take place six to seven months after the filing, and the judgment will be issued approximately four to seven months later.

In a final appeal to the Supreme Court (only on issues of law) the same time frame as for a second instance appeal is applicable.

In the case of criminal liability of the defendant, the usual criminal procedure is followed.

20 Burden of proof

What is the burden of proof to establish infringement or dilution?

The burden of proof is always on the plaintiff. To ease the burden of proof, the Trademarks Act provides that where the infringing mark is identical to the plaintiff's mark, infringement may be fully proven by simply presenting to the court the trademark's registration certificate from the Trademarks Registry.

21 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

The trademark owner can seek protection by use of the above-mentioned means.

According to the law, the licensee can file a civil lawsuit together (in common) with the trademark owner. If the licensee has the trademark owner's permission, he or she may seek protection of the trademark through infringement proceedings and compensation only in his or her name. For a licensee to act alone, he or she must be the exclusive licensee or in the case where the trademark owner is informed of the infringement but does not act to protect from it. A licensee can always intervene and participate in infringement proceedings started by the trademark owner and to support the trademark owner's request.

22 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

Activities taking place outside the country may support a charge of infringement or dilution only indirectly, in that this may show a pattern of activities by the infringer.

Also, if it is proven that the production of the infringing goods is made within Greece and the goods are not offered in the internal market but are exported directly, sale of the infringing goods abroad amounts to trademark infringement in Greece.

23 Discovery

What discovery/disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

The new Greek Trademark Law has fully incorporated the Enforcement Directive (EC Directive No. 2004/48) in respect of the civil actions and provisional measures against trademark infringers. In the event of commercial-scale infringements, the court, following the claimant's justified request, can order the infringer to provide all the banking, financial and commercial documents and any other information regarding the trademark infringing activities and persons (such as names of producers, importers, distributors, intermediaries, shop-owners, invoice details, volume of goods, orders, price lists etc). If the infringer does not provide the above information and data, there is the presumption of his or her admission or confession of all the claimant's allegations and he or she may be sentenced to pay a monetary penalty of €50,000 to €100,000.

24 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

At present, normal procedure hearings in front of the Athens Single Member District Court (when the plaintiff uses a purely trademark law basis) are set within six months.

When a normal procedure lawsuit is filed with an additional legal basis (ie, unfair competition, company name infringement etc), a hearing is set in front of the Athens Multi-Member Court. At present, and due to the current court workload, a lawsuit obtains a hearing date around 15 months after filing. The first hearing may be postponed ex officio and is expected to take place approximately two years after the filing date.

After the hearing, a decision is expected within four and 12 months.

An interim decision that appoints a court expert may be issued within four and six months, if the circumstances of the matter require it. After the court expert has expressed an opinion, a new hearing will be set for final deliberation.

In the appellate courts a hearing is set six to seven months from filing and a decision is issued within four to seven months.

In injunctions, a full hearing of a preliminary injunction is set under current practice of the two Community Trademark Courts as follows: in Athens the hearing would be set approximately six months from filing and in Thessaloniki approximately three months from filing. The decisions for injunctions are usually issued within three weeks and three months.

Under current practice, preliminary injunctions are heard in Athens the same date as filing the request or within approximately two to three days from filing the request, while in Thessaloniki the preliminary injunction hearing takes place within 24 hours of filing such a request. The decision on the preliminary injunction request is usually issued on the same day of the hearing and sometimes, it may also be issued on the next day.

25 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The costs of a trademark infringement lawsuit depend on the complexity of the case and on the nature of the infringed rights, the extent and time needed for elaboration, multiple hearings and other matters.

26 Appeals

What avenues of appeal are available?

There are two grounds for appeal: that the law was violated or that the evidence was not fully and justly appreciated.

27 Defences

What defences are available to a charge of infringement or dilution, or any related action?

In civil law cases for trademark infringement that request ceasing and desisting from the infringement in the future, the defendant can defend itself by claiming that:

- there is no danger that the infringement will occur again in the future;
- it is not using the sign as a trademark;
- there is no likelihood of confusion between the marks;
- the infringing mark has been used in trade unaffectedly for a long period for the same type of transactions;
- the trademark owner has acquiesced to such use;
- the proprietor is using his or her own personal name;
- it is using a customary or descriptive sign;
- it has a prior right;
- the use of the mark by the plaintiff is misleading; or
- the mark was registered in bad faith by the plaintiff ('abuse of right').

28 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The core remedies in a trademark infringement case are the following:

- a court order that seeks to invert the effects of the infringement, for example by ordering the destruction of the infringing items;
- an injunction that orders the infringing party to stop using the trademarks and not to use them in the future;
- a claim for damages deriving from the infringement. It is now explicitly provided that in civil actions, the damages in favour of the trademark owner or beneficiary can be calculated based on lost royalties, in the case that a licence would have been granted to the infringer besides the claiming of lost profits. Also, damages may be calculated based on the profits earned by the trademark infringer (unjust enrichment). In the absence of the existence of intent to infringe or of gross negligence by the trademark infringer, the profits derived from the infringement by the infringer or lost by the trademark owner or beneficiary may be awarded in favour of the trademark owner or beneficiary;
- in the event of commercial-scale infringements, the court, following the claimant's justified request, can order the infringer to provide all the banking, financial and commercial documents and any other information regarding the trademark-infringing activities and persons (such as names of producers, importers, distributors, intermediaries, shop owners, invoice details, volume of goods, orders, price lists, etc). If the infringer does not provide

the above information and data, there is the presumption of his or her admission and confession of all the claimant's allegations and he or she may be sentenced to pay a monetary penalty of €50,000 to €100,000;

- 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 (in even more urgent cases), usually having the same content as a preliminary injunction.

In practice, a preliminary order is perhaps the most important means of protection for the trademark owner. It has to prove that there is imminent danger that has to be avoided or that there is great urgency. It offers a rapid procedure and immediate remedies to the plaintiff.

Criminal remedies

The infringing party can be arrested and the infringing goods can be seized by the police. The new Trademark Law has introduced stricter criminal sanctions for trademark infringement. The minimum imprisonment sentence has been doubled to six months and the minimum monetary penalty has been increased to €6,000. The act of infringement of a famous trademark is now explicitly named as a criminal offence. Trademark counterfeiting, namely, the unauthorised use of identical marks for the same or similar products pursuing widespread profit or damages on a commercial or professional scale is regarded as an aggravated circumstance incurring much stricter penalties (a minimum two-year imprisonment and a monetary penalty of €6,000 to €30,000. Third parties knowingly infringing trademarks, even if they are acting as intermediaries such as distributors, importers, holders or exporters of trademark infringing goods, face criminal sanctions as well.

29 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

It is possible to resort to alternative dispute resolution for matters that may be decided between parties. On the other hand, it is not possible to use alternative dispute resolution for matters that are in the competence of the Trademark Registry, such as matters of registrability.

30 Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

A famous foreign trademark may be protected even if it is not used domestically, but in this case it must be known domestically. If the mark is not used domestically, protection via an injunction may be denied on grounds of lack of urgency, but protection may be sought under normal proceedings.

In general, under Greek law theory and case law, the requirements that have to combine for a trademark to be characterised as a 'famous trademark' are the following:

- the particularly good position of the trademark in the marketplace, namely, the ascertainment that the trademark has been established with a major part of the consumer audience (high degree of recognition);
- the uniqueness of the indication, namely, the ascertainment that there are no goods or services in the marketplace, even of an irrelevant nature with the goods and services of the trademark in question, using the indication;

Update and trends

In the past couple of years, a very effective practice has been the seizure and destruction of counterfeit goods by the authorities with the administrative authority for the destruction. It remains to be seen how these provisions will continue to apply given recent administrative changes of competences.

- the originality of the trademark in question, namely, a trademark cannot be characterised as ‘famous trademark’ if it consists of a ‘weak’ indication, namely an indication with a low level of distinctiveness; and principally
- the positive appreciation by consumers of the goods and services distinguished by the trademark. Sometimes this can constitute the only critical factor taken into consideration by the Greek courts to establish that a trademark is indeed ‘famous’ and can be protected for all the goods and services.

The court usually takes into consideration as evidence of fame the following:

- the broad advertising of the goods bearing the trademark;
- the advertising expenditure for the promotion of the goods;
- the sales in Greece during the years; and
- the market share in Greece.

Finally, a significant indicator to the recognition of a mark as a ‘famous mark’ would be the fact that it had been continuously used by the claimant for the distinction of its products throughout the international market and had been broadly advertised and its distinctive character not impaired by being used by third parties on dissimilar products and services.

Protection means that the famous mark may be a bar to registration of a prior trademark application during trademark prosecution proceedings as the basis of an opposition or an intervention action. Also, the famous mark can be protected through litigation aimed at ceasing the infringement and at compensation.

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