

# Yearbook

2021/2022

A global guide for practitioners

Greece

**Dr Helen G Papaconstantinou and Partners**

*Fotini Kardiopoulis and Miranda Theodoridou*

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Greece's long-anticipated new trademark law was enacted on 20 March 2020. Law 4679/2020 has finally transposed EU Directive 2015/2436 into Greek law and brings the treatment of national trademarks in line with EU trademarks (as regulated by EU Regulation 2017/1001).

### Legal framework

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

- the Trademark Law (4679/2020);
- the Unfair Competition Law (146/1914), as amended by Law 3784/2009;
- relevant EU legislation (eg, Directive 2015/2436, the EU Trademark Regulation (2017/1001) governing substantive aspects of EU trademarks and secondary legislation such as the EU Delegated Regulation (2018/625) and the EU Implementing Regulation (2018/626) governing certain procedural aspects);
- 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 concerning the International Registration of Marks.

### Unregistered marks Protection

Unregistered signs are protected under Articles 13 to 15 of the Unfair Competition Law and may constitute relative grounds for refusal. 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



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Ms Kardiopoulis is one of the founding partners of Dr Helen G Papaconstantinou and Partners and heads the anti-counterfeiting and anti-piracy department of firm. She has dealt with a broad range of IP matters since 1998, with an emphasis on trademarks, geographical indications, copyright and plant breeders' rights. She has extensive experience in IP litigation, consulting and contract drafting, devising and implementing anticounterfeiting programmes and border enforcement.

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Miranda Theodoridou holds a law degree and an MBA from the University of Athens.

As one of the founding partners of Dr Helen G Papaconstantinou and Partners, she has more than 35 years' extensive experience in handling a broad spectrum of IP issues, including consultation for and legal representation of major multinational companies and market leaders in administrative proceedings and courts of all instances. She has handled numerous cases focusing on trademark and domain name matters.

Ms Theodoridou is a European patent attorney and a council member of the European Communities Trademark Association, as well as member of the International Association for the Protection of Intellectual Property, the European Patent Office and INTA.

She has been repeatedly ranked as a recommended individual in various international IP law guides.

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 and substantial.

## Registered marks

### Ownership

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

### Power of attorney

The trademark application must be signed by the applicant or its authorised attorney, whose appointment is optional. If a lawyer is appointed, a signed power of attorney is required, which remains valid for five years.

### Scope of protection

The new trademark law abolished the requirement for trademarks to be represented graphically. Consequently, 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 another, it is sufficient that same sign is represented in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection offered to its owner. In this respect, the representation of the trademark may be submitted in any appropriate form using generally available technology, so long as it is clear, precise, easily accessible, intelligible, durable, self-contained and objective.

Due to this change in the law, a wider variety of signs are now available for registration, such as three-dimensional marks, patterns, sounds, motion marks, position marks, holograms and audiovisual marks. It is a prerequisite for the filing of some of these marks to introduce the necessary infrastructure to the Greek Trademark Office; however, this has yet to materialise.

The new trademark law provides for two types of ground for refusal or invalidation:

- absolute grounds; and
- relative grounds.

Both grounds are, at least in principle, analogous to those provided for in Directive 2015/2436.

Traditional guaranteed specialties and plant varieties have, for the first time, been introduced as absolute grounds, while geographical indications and appellations of origin are set out as both absolute and relative grounds.

Bad faith is primarily an absolute ground for refusal, although a special case of bad faith (eg, the filing of a trademark by an agent without the rights holder's authorisation) has been introduced as a new relative ground. Such a

mark will not be accepted for registration, while the rights holder may prohibit its use or request its assignment.

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

The use of general terms, including the general indications of the class headings of the Nice Classification, is interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. Consequently, when a trademark applicant uses the entire heading of a class, that application will only be protected for goods and services mentioned specifically and not for all the goods or services of the class.

According to the explanatory memorandum of the law, the provision applies not only to applications filed following the entry into force of the new law but also to already existing trademarks.

### **Certification marks**

The new trademark law has introduced the notion of 'guarantee marks' or 'specification marks' for the first time in Greece. However, the law has not implemented the related option offered by the directive, according to which signs or indications that may serve in trade to designate the geographic origin of the goods or services may constitute certification marks.

### **Procedures**

Trademark applications are checked in terms of completeness, representation, specification of goods or services and other formalities by the Trademark Office auditors. Designated employees (researchers) at the Trademark Office identify prior rights, whose owners will receive notification of the publication of the later mark for the purpose of filing



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an opposition before the Administrative Trademark Committee.

### Examination

The examiner only checks applications with respect to absolute grounds. If there are no such grounds for refusal, the application is published on the office's website for opposition purposes. 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 30 days as of the next day of notification. If the applicant fails to reply or comply within the set term, the application will be rejected. The examiner's decision to reject an application can be challenged before the Administrative Trademark Committee and the committee's decision is subject to further recourse before the First-Instance Administrative Court.

A smooth application from filing to registration, where no opposition is filed, usually takes six to eight months. Where an opposition is filed, the decision is expected to be issued between 12 and 18 months of filing.

### Opposition

Third parties may oppose the registration of a trademark on both absolute and relative grounds. The term for filing an opposition is three months as of the next day of the publication of the decision on the website of the General Secretariat of Commerce. If no opposition is filed, the trademark is registered. 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 as of the filing date of the opposed application, the applicant can request that the opponent submit evidence of genuine use of the mark in respect of the relevant goods or services on which the opposition is based in the five years preceding the filing date of the application, or to prove that there are proper reasons for non-use. Failure to meet these requirements will result in the rejection of the opposition for procedural reasons.

### Registration

A trademark is registered when it is accepted by a decision of the examiner or the Trademark

Committee, provided that no further legal remedies are sought or by a final decision of the administrative courts. A registered mark is granted protection for 10 years as of the filing date and is indefinitely renewable every 10 years. If renewal is not effected within the specified period, the trademark may still be renewed up to six months later on payment of a fine.

Third parties' rights acquired during said six-month grace period, however, cannot be overturned. It remains to be seen how this ambiguous provision will be applied in practice.

### Removal from register

**Surrender:** The owner may surrender the trademark at any time for all or part of the goods or services for which it is registered. The surrender must be declared in writing, otherwise it does not have effect. If the mark is subject to a (registered) licence, its surrender will be entered in the register only if the owner proves that the licensee has been duly informed of the intention to surrender the mark.

**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 five-year period;
- 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.

The new law has explicitly reversed the burden of proof. It is the trademark owner that must prove genuine use of the challenged mark.

**Invalidity:** A trademark may be declared invalid if it should not have been registered



## A trademark may be 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

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 filing a petition for the declaration of invalidity or of a related counterclaim because the trademark has since acquired distinctive character through use.

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

### Acquiescence

Acquiescence is now available as a defence in the context of invalidity proceedings. Making use of the possibility provided by the directive, this defence is available not only against owners of prior trademarks but also against holders of other rights (eg, copyright, personality rights and distinctive signs).

### Intervening rights

As per the recitals of the directive, in the interest of ensuring legal certainty and safeguarding legitimately acquired trademark rights, it is appropriate and necessary that owners of earlier trademarks should not be entitled to obtain refusal or invalidation or to oppose the use of a later trademark if it was acquired at a time when the earlier trademark was susceptible to being declared invalid or revoked, or if the earlier trademark could not be enforced against the later trademark

because the necessary conditions were not applicable.

Article 53 of the new law provides for the intervening rights defence in the context of invalidity proceedings and Article 48 in the context of infringement. The circumstances in which this defence may apply vary depending on whether the later mark is an EU or national trademark.

### Change of role of civil courts in trademark cases and new defences

Before the new law, there was a clear-cut distinction between the competence of the administrative and civil courts, resulting in a dual system. Issues regarding the registration process (eg, relative and absolute grounds, oppositions, revocation or invalidity actions) were examined by the Administrative Trademark Committee and administrative courts, whereas civil courts had sole jurisdiction for trademark infringement cases and were not permitted to challenge the validity of a registered trademark in any way. The new law changes this radically. While the Trademark Committee remains competent for both opposition and invalidity or revocation cases, appeals relating to oppositions remain in the realm of the administrative courts, whereas appeals relating to invalidity or revocation actions are transferred to the civil courts.

Further, civil courts are now empowered to deal with counterclaims for revocation or invalidity of national trademarks, as was already with the case in respect of EU trademarks, in accordance with the EU Trademark Regulation. More specifically, if an infringement action has already been



filed, the respondent can only challenge the validity of the trademark by way of a counterclaim before the civil courts. On the other hand, where a revocation or invalidity action has been filed before the Administrative Trademark Committee prior to the notification of the lawsuit, the civil court may suspend the infringement proceedings and order preliminary measures.

The respondent may now claim non-use as a defence 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 trademark had 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 non-use, provided of course that the trademark was not registered for less than five years as of the date of bringing the action.

The respondent may raise non-use as a defence in preliminary injunctions and may also file a counterclaim for the temporary invalidity or revocation of the mark in this context, even though the related court decision cannot result in the permanent revocation or invalidation of the trademark.

### Enforcement

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

- is identical to the trademark in question in relation to identical goods or services;
- is identical or similar to the trademark 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 trademark without due cause or would cause detriment to the distinctive character or reputation of the famous trademark, irrespective of whether the sign will cover goods or services that are similar to those of the earlier trademark.

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 trademark was obtained in bad faith.

The new law has also introduced a right to prohibit preparatory acts of infringement with respect to packaging or other means and sets out the parameters for the protection of trademark owners in transit cases, harmonising the treatment of national trademarks with that of EU trademarks.

### Remedies in civil proceedings

Special divisions have been established for EU trademark infringement cases in the first and second-instance civil courts of Athens and Thessaloniki. These divisions also hear national trademark infringements when they are competent to do so *ratione loci*.

The new trademark law has fully implemented the EU Enforcement of Intellectual Property Rights Directive 2004/48.



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In cases of trademark infringement, action may be pursued before the civil courts.

**Main infringement action:** In the context of a main infringement action, the rights holder may request:

- permanent cessation of the infringing activities;
- desisting from future infringing activity;
- removal of the infringing signs from the infringing goods, or the withdrawal, confiscation or destruction of the infringing goods themselves;
- imposition of penalties in cases of non-compliance – the new law has raised the penalty from €10,000 to €100,000 to act as a deterrent against recidivist infringers;
- moral and material damages; and
- publication of the judgment in the press or online, at the infringer's expense.

Remedies under bullet points one to three are also available against intermediaries.

The issuance of a first-instance decision in main civil proceedings takes on average between 12 and 16 months.

**Injunction:** A petition for an injunction requires that the situation be urgent and, consequently, it is recommended that rights holders act immediately on learning of the infringement. Preliminary measures may be also requested against intermediaries, while *ex parte* proceedings are also a possibility provided by law, under exceptional, specified circumstances.

Trademark owners may also seek injunctive relief against intermediaries.

**Temporary restraining order:** Restraining orders may be requested only if a petition for injunction has also been filed simultaneously and are available only in cases of extreme urgency. As a rule, the judge invites the respondents to attend the hearing, although proceedings may also take place *ex parte*.

### Damages

In the calculation of damages, the negative economic consequences suffered by the rights holder, including loss of profits, as well as profits made by the infringer, are taken into

account. Damages may also be calculated on the basis of hypothetical royalties.

According to the new law, damages and moral damages may be claimed only in cases of wilful misconduct or gross negligence, which will certainly present related challenges in future litigations. Concerns have been expressed that this provision may actually work to the benefit of the infringers and is inconsistent with the degrees of negligence required for copyright and patent infringement.

### Customs procedures

EU Customs Regulation 608/2013 is directly applicable in Greece and, since no national border law exists, the regulation sets out the domestic customs intervention procedure.

### Criminal penalties

Criminal penalties are provided for various acts of trademark infringement, although criminal prosecution does not take place *ex officio* but following the filing of a related criminal complaint by the rights holder. Professional and commercial-scale infringement are considered as aggravating circumstances.

### Mediation

Recent Law 4640/2019 put in place a compulsory initial mediation session before the hearing of a case in a legal dispute arising, *inter alia*, from trademark infringement. That session, along with proof of the lawyer's compliance with the obligation to inform the client in writing about the option of mediation, have become a prerequisite for the admissibility of a main infringement action. The new law provides for the possibility of voluntary mediation in the Trademark Committee's proceedings.

### Ownership changes and rights transfers

Ownership changes (eg, assignments and mergers) and various other changes (eg, changes of name, address and legal style of the rights holder) must be recorded before the Trademarks Office in order to be enforceable against third parties.

Likewise, licence agreements must also be properly recorded in the Trademark Register in order for the licensee's use of the mark to benefit the trademark owner.

The signatures of the parties on both assignment deeds and licence agreements must be authenticated by a notary public and the documents must be further legalised with apostille. Evidence regarding the right of the signatories to represent the contracting parties is also required.

### Related rights

There are clear areas of overlap between trademarks and other IP rights, as trademark protection may also be complemented by other related 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 enjoy related rights of priority and protection.

### Online issues

The regulation of telecoms 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 March 2018. The regulation sets out the procedures for registering domain names in the country code top-level domain '.gr' or '.ελ' and the grounds for cancellation petitions, which may also include a request for the transfer of the contested domain name to the petitioner. Commission decisions can be appealed to the Athens Administrative Court of Appeal within 30 days of their official notification to the parties. **WTR**



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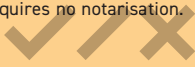
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### Examination/registration

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

Yes: power of attorney required.  
No: requires no notarisation.



Examination for relative grounds for refusal based on earlier rights?

No



Registrable unconventional marks

3D; aspects of packaging; slogans; colour combination; sounds; position; holograms; motion; patterns; audio-visual.



### Unregistered rights

Protection for unregistered rights?

Yes



Specific/increased protection for well-known marks?

Yes



### Opposition

Opposition procedure available? Term from publication?

Yes: three months from publication on Trademark Office website.



### Removal from register

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

Yes: following 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

Is registration mandatory for assignment/licensing documents?

Yes



### Online issues

National anti-cybersquatting provisions?

No: no special provisions, general provisions apply. Concept of cybersquatting applicable to bad faith.

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

Yes: Hellenic Telecommunications and Post Commission.

