

Greece - Dr. Helen G. Papaconstantinou and Partners Law Firm

A trademark application for E-MARKET E-BAY HELLAS was filed and accepted for registration in Greece in Classes 35 and 42 (management of commercial corporations, management of corporate affairs, research (and planning) services, industrial analysis and research services, design and development of software and hardware).

US company eBay Inc filed an opposition with the Administrative Trademark Committee on the basis of its existing series of Greek and Community trademarks characterised by the element 'ebay', covering goods and services in Classes 9, 14, 16, 18, 20, 21, 25, 28, 30, 35, 36, 38, 41, 42 and 45.

In its opposition eBay submitted a substantial amount of evidence, including registration certificates, of its existing series of marks. It also supplied evidence of the worldwide recognition of the EBAY mark and gave details of the significant financial status of the company.

The Administrative Trademark Committee rejected the opposition on the grounds that there was sufficient visual and aural differentiation between the marks. The committee opined that the distinctive features of the contested mark were its colour device and the word 'Hellas'; whereas the word 'ebay' could not be considered a distinguishing feature of the mark. The committee concluded that there was no risk of confusion for consumers as to the origin of the service.

eBay pursued recourse through the Administrative Court of First Instance seeking reversal of the decision. eBay complained that the committee:

- had not taken into consideration that its trademarks, all characterised by the element 'ebay', were famous and therefore enjoyed enhanced protection; and
- had erred in finding that there was no similarity or identity between the marks under comparison because the words 'Hellas' and 'market' lacked distinctiveness and were commonly used in many Greek trademarks; therefore, the dominant feature of the contested mark

was the element 'ebay', which would invoke confusion in even the most attentive consumer's mind.

eBay also submitted two lists from the Greek Trademark Office showing several Greek trademark registrations comprising the words 'Hellas' and 'market', as well as Office for Harmonisation in the Internal Market case law recognising the status of the EBAY trademark.

In its Decision 20652/2015, Division 20 of the Athens three-member Administrative Court of First Instance made a detailed assessment of the visual, aural and conceptual similarities of the trademarks under comparison. It observed that the word 'ebay' was contained in all Community trademarks of the opponent, which either consisted solely of this word or contained the word in combination with other commonly used or descriptive elements (eg, 'live', 'you can get it' or 'adcontext'), which lacked distinctiveness.

The court stated that the word 'ebay' used in the contested mark not only was identical to the earlier marks from an aural and conceptual point of view, but also presented a high degree of visual similarity, because the colour combination it used was similar to that used by the opponent in many of its Community trademarks, in its logo and on its website since 1999.

The court found that the services covered by the marks were either identical or similar, given that they were:

- provided exclusively on the Internet;
- aimed at the same or similar needs; and
- targeted at the same group of consumers.

When assessing the fame of the opponent's marks, the court took into consideration that eBay:

- was a US company founded in 1995 and active in 39 countries, having become internationally renowned as a retail company and service provider via the Internet;
- had since 1998 owned a series of Community trademarks with the distinguishing feature 'ebay', which had been used since then to cover goods and services in various classes;
- had significant financial status; and

- enjoyed a noteworthy reputation at international level and among Greek consumers.

The court concluded that the EBAY marks were famous and therefore should enjoy enhanced protection.

Contrary to the Trademark Committee, the court held that the overall visual and aural impression created by the marks under comparison was similar because of the use of the word 'ebay' in a dominant position in the contested mark. According to the court, use of the word 'ebay' - even in isolation - formed an independent series of Community trademarks of the opponent.

The court ruled that the addition of the words 'Hellas' and 'market', as well as of the device, was not sufficient to overcome the similarity. It also held that the device had not been proved to have been established in transactions; nor was the geographical indication 'Hellas' or the descriptive word 'emarket' distinctive. Therefore, the dominant element attracting e consumers' attention was the word 'ebay'.

As the services covered by the contested mark were identical or similar to those of the opposing marks, which enjoyed a noteworthy reputation, the court found that there was a serious risk of confusion as to the origin of the services.

Finally, the court ruled that by filing the contested mark, the applicant had acted in bad faith because he was aware that the opposing Community trademarks were famous and had been used to cover similar services for the past 10 years.

Consequently, the court accepted the recourse, reversed the contested decision and refused registration of the mark E-MARKET E-BAY HELLAS.

Maria Athanassiadou, Dr Helen G Papaconstantinou and Partners, Athens