



**World
Trademark
Review**

Trademark Litigation 2017

A Global Guide

Greece

Ballas, Pelecanos & Associates LPC

George Ballas, Nicholas Gregoriades and Maria Spanos



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Legislative framework and causes of action

Legislative framework

The main legislative texts governing trademarks in Greece are Law 4072/2012 (as amended by Law 4155/2013) (Articles 121 to 196), and Law 146/1914 (as amended by Law 3784/2009) on unfair competition.

The following statutes also govern some aspects of trademarks:

- Law 213/1975, ratifying the Paris Convention for the Protection of Industrial Property;
- Law 2290/1995, ratifying the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- Law 2505/1997, ratifying the Nice Agreement on the Classification of Goods and Services;
- Law 2783/2000, ratifying the Madrid Protocol Concerning the International Registration of Trademarks;
- Law 2943/2001, establishing the EU trademarks departments within the Greek courts (Chapter C); and
- EU Regulation 207/2009 (as amended by Regulation 2015/2424) on the EU trademark.

Rights and limitations

Rights conferred: The right to the exclusive use of a trademark is obtained by its registration.

Protected use of a trademark also includes:

- using the mark in a differing form as to some of its elements without altering the mark's overall distinctive character;
- affixing the trademark to products or their packaging destined exclusively for export;
- using the trademark with the owner's consent; and
- using a collective trademark by anyone entitled by law to do so (eg, any person whose goods or services come from the same geographical region may – under the requirements set by law – become a member of the legal entity entitled to use the collective mark).

Limitations to trademark protection:

The right conferred through trademark registration on the proprietor does not prevent third parties from using in trade:

- their name, surname, trade name and address;
- indications concerning the kind, quality,

intended purpose, value, geographical origin, production time of products or time of rendering of the services or other characteristics thereof;

- the trademark itself, if it is necessary to indicate the intended purpose of a product or service, in particular in case of accessories or spare parts, if such use is in accordance with honest practices in industrial or commercial matters; and
- earlier rights applicable to particular localities, if such rights are exercised within the territorial limits where they are recognised.

Unregistered signs: Unregistered signs deemed to have acquired, through their use, distinctive power in relation to the relevant goods or services may constitute relative grounds (as prior signs) for refusal of the registration of a trademark and are protected under the unfair competition provisions of Law 146/1914 (Articles 13 to 15).

Causes of action

The rights holder is entitled to prevent all third parties from using in trade without its permission any later sign that:

- is identical to its trademark for goods or services that are identical to those for which the trademark has been registered;
- creates a likelihood of confusion, including a likelihood of association, with the rights holder's trademark because of its identity or similarity to the rights holder's trademark and between the goods or services covered; and
- is identical or similar to the rights holder's trademark that has a reputation where the use of the later sign would take, without due cause, unfair advantage of the distinctive character or the repute of the rights holder's trademark or would damage or be detrimental to its distinctive character or reputation, regardless of whether the later sign is intended to distinguish goods or services that are similar to the goods or services of the rights holder's trademark.

The rights holder can also prohibit trademark infringement resulting from:

- the circulation of counterfeit products in transit;
- the production of authentic products that are destined to circulate unbranded;
- the circulation of products whose trademark has been removed or that bear a different trademark; and
- the import of authentic products into the European Economic Area from a third country without the rights holder's consent.

Administrative proceedings

Trademark owners can also seek to protect their signs through administrative proceedings.

Examination: If an examiner of the Greek Trademarks Office rejects totally or partially a trademark application on absolute and/or relative grounds, the examiner's decision is subject to recourse before the Administrative Committee for Trademarks within 60 days (90 days for applicants residing abroad) of the date of notification to the applicant.

Opposition: Any person or entity with a legitimate interest may file an opposition based on the existence of absolute grounds for refusal of the trademark (eg, absence of distinctive character, descriptive trademark, commonly used trademark) within three months of publication of the examiner's decision accepting a trademark application.

Holders of prior trademark rights that are identical and/or similar to a later trademark, distinguishing identical and/or similar products and/or services (identity and/or similarity of products is not required for prior reputed/well-known signs) may file an opposition based on such prior rights (relative grounds for refusal).

If the prior mark has been registered for more than five years, the opposing party may request proof of its use.

Claiming the reputation of a prior mark entails the obligation to prove such reputation.

Appeals: Decisions of the Administrative Committee for Trademarks are subject to recourse before the First-Instance Administrative Court within 60 days (90 days for applicants residing abroad) of notification

of the decision to the party entitled to such recourse.

Decisions of the First-Instance Administrative Court are subject to appeal before the Second-Instance Administrative Court within 60 days (120 days for applicants residing abroad) of notification of the decision to the party entitled to such appeal.

Appeals in cassation may be filed before the Council of State within 60 days of notification of the decision to the party entitled to such appeal. Such appeals may be based only on grounds regarding legal issues of the Second-Instance Administrative Court decision and not on the merits of the case.

Evidence

Admissible means of evidence in trademark administrative proceedings mainly include market surveys, invoices, advertising/marketing materials and written affidavits.

Alternative dispute resolution

Greek law allows for the use of the following processes that help parties to resolve their disputes without a trial.

Conciliation

Out-of-court conciliation: Article 214A of the Code of Civil Procedure provides for optional out-of-court conciliation at the parties' initiative.

Specifically, when a private law dispute that qualifies for settlement by means of a compromise is the subject of pending litigation, litigants may, until a final court decision is reached, attempt to reconcile through negotiation, regardless of the standing stage of the trial, with or without the engagement of a third party (conciliator) and without any judicial interference.

Judicial conciliation: Alternatively, litigants may, by virtue of Article 293 of the Code of Civil Procedure, appear before the court at any stage of the trial until a final decision is reached and declare that they have reconciled. This declaration is recorded in the court minutes, which constitute either an enforceable title or simply evidence of entitlement. Such declaration may also be made before a notary public. In both cases, court proceedings are terminated.

Mediation

Mediation is mainly regulated by Law 3898/2010 on mediation in civil and commercial matters, which provides for out-of-court mediation, and by Article 214B of the Code of Civil Procedure, which provides for judicial mediation.

The mediation procedure constitutes mainly a consensual and voluntary process. There is no mandatory recourse to mediation under Greek law.

Mediation may be ordered by a (non-Greek) EU court in cross-border disputes (Article 3(1)(c) of the Mediation Law).

Out-of-court mediation: The scope of the Mediation Law covers all private law disputes that may be lawfully brought before Greek civil courts, as well as all civil and commercial cases in cross-border disputes within the European Union – except for rights and obligations on which the parties are not free to decide themselves under the relevant applicable law.

Judicial mediation: Article 214B of the Code of Civil Procedure provides for a judicial mediation procedure for private law disputes that may be lawfully brought before Greek civil courts.

Such mediation is a court-connected process conducted by presidents or senior judges of courts of first instance and courts of appeal, appointed as full-time or part-time mediators.

Arbitration

According to Article 867 of the Code of Civil Procedure, private law disputes can be submitted to arbitration upon agreement of the parties if the parties have power of disposal of the subject of the dispute. Such power is not provided with regard to trademark rights throughout the administrative proceedings phase. However, arbitration can be agreed between the parties in case of disputes arising out of trademark licensing agreements.

Online dispute resolution

Online dispute resolution can be an efficient method (time and cost-wise) for

dispute resolution, including for trademark infringement disputes. Most notably, the Uniform Domain Name Dispute Resolution Policy of the Internet Corporation for Assigned Names and Numbers allows trademark owners to fight cybersquatting – that is, to resolve disputes between trademark owners and those who have registered a domain name in bad faith or are taking advantage of the reputation of a trademark.

Litigation venue and formats

Court system and litigation venues

The civil court system in Greece is made up of courts of first instance, courts of appeal and the Supreme Court of Cassation (*Areios Pagos*). Civil law disputes regarding national trademarks are brought before the civil single-member first-instance court at the place where the defendant resides, or before the civil multi-member first-instance court if the action includes other bases, such as unfair competition claims. Disputes arising from the infringement of EU trademarks fall under the exclusive competence of a special department within the Courts of Athens and Thessaloniki.

Forum shopping

In specific circumstances, legal protection of EU trademarks can offer forum shopping opportunities. Article 97(5) of EU Regulation 207/2009 sets out the requirements for international jurisdiction. It provides, among other things, that infringement actions may be brought before the courts of the member state in which the act of infringement has been committed or threatened.

Jury versus bench

Trademark disputes are heard in bench trials; there are no jury trials in Greece.

Damages and remedies

Ordinary civil proceedings

The first remedy available is the filing of an ‘ordinary’ civil lawsuit. The civil action commences with the filing of the lawsuit with the competent first-instance court. The suit must include the grounds for the action and a clear statement of the relief sought.

- An ordinary lawsuit may include claims for:
- permanent cessation of the illegal activities;



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Mr Ballas’s practice focuses on all aspects of intellectual property, with particular emphasis on trademarks and passing off, as well as patent litigation. He often advises major multinational and domestic clients on structuring and implementing effective anti-counterfeiting strategies. His diverse background includes experience at the office of the secretary general of the Greek Parliament.

- withdrawal of the products bearing the infringing sign or removal of the sign from the products;
- confiscation and destruction of the infringing products;
- moral and/or material damages; and
- publication of the decision in the press or online.

According to the Code of Civil Procedure, after the ordinary lawsuit has been filed, the parties must submit their pleadings and evidentiary material in support of their



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arguments within 100 days (130 days for parties residing abroad). The plaintiff must serve the lawsuit on the defendant within 30 days (60 days if the defendant resides abroad or if the defendant's address is unknown). Mutual replies to the parties' arguments are filed within 15 days of the expiry of the aforesaid 100/130-day deadline. The file is considered complete upon filing of the parties' pleadings and replies thereto.

The hearing date must be scheduled within 45 days of the date of completion of the file. The court will issue its decision

within approximately four to six months of the hearing. Oral presentation of the case and examination of witnesses before the court are not provided for at this stage. Following a review of the case and examination of the evidentiary material, the court may decide to examine witnesses, in which case an order will be issued for the repetition of the hearing. Following the witnesses' examination, the hearing is concluded and the parties have eight working days to file their respective evaluations of the witnesses' testimonies.

The ordinary lawsuit may result in the

same remedies as the preliminary measures described below. The difference is that in the ordinary lawsuit, the plaintiff enters a claim for permanent cessation of the illegal activity.

Preliminary measures

Preliminary measures involve the filing of an injunction application before the civil single-member first-instance court. Prerequisites for the granting of injunctive relief are that:

- the claim has substance;
- the infringement is current or imminent and constitutes a threat to the mark owner's rights; and
- there is an urgent need for a court decision.

The hearing date is usually fixed within one to two months of filing of the application. The pleadings (memoranda) and evidentiary material are usually filed within two or three days of the hearing date. The court decision must be issued within 48 hours of either the hearing or the deadline possibly granted to the parties for submission of their memoranda and evidence. It is only for exceptional reasons that a decision on an injunction application may be issued later than the 48-hour time limit and, in any case, not later than 30 days after either the hearing or the expiry of the deadline possibly granted to the parties for submission of their memoranda and evidence.

The preliminary measures that the court may impose on the infringer are:

- cessation of the infringement (illegal use and/or reproduction and/or distribution of the infringing products) and temporary withdrawal of the infringing products from the market;
- the provision of a detailed inventory of the infringing items in the possession of the infringer or their temporary confiscation and placement under custody;
- the audit of the commercial records and books for the gathering of data as to the infringing items produced/marketed;
- the threat of penalties (in the form of monetary fines and personal incarceration) in case of contempt of

the decision and for each violation of its provisions; and

- publication of the injunction order in the press and/or online.

Despite its temporary nature, an injunction order is enforceable while it maintains its validity and until the issuance of a final decision on the ordinary lawsuit on the same matter.

Upon filing the injunction application, the rights holder may request that a court-appointed judge grant a temporary restraining order with the aim of preserving the right until the preliminary measures have been granted. In practice, a temporary restraining order will result in the immediate cessation of the infringing activity.

The judge reviews immediately the application for a temporary restraining order and either grants an *ex parte* order (without notifying and summoning the defendant) or fixes an *inter partes* hearing date within the next day or two, summoning at the same time the defendant.

If granted, the temporary restraining order will remain in force until the hearing of the injunction application and can be extended at the discretion of the injunction court until the issuance of the decision on the injunction application.

The measures that the judge may order by virtue of a temporary restraining order are mainly:

- the imposition upon the infringer of an obligation to cease the infringement;
- the temporary withdrawal from the market of products bearing the infringing trademarks; or/and
- the seizure of such products.

Evidencing the case

Investigations and first steps

As part of its enforcement strategy, a rights holder should, as a first step, organise the systematic monitoring of the market in order to discover any infringement. Where infringement is ascertained, test purchases should be conducted. Advertising and promotional material in the press and/or online will constitute effective evidence;



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it is also necessary to monitor further the infringer's infrastructure and practices with regard to the trade of the infringing products/services.

Survey evidence

Surveys can be very effective in proving the establishment of a trademark in the market and the extent of its use, as well as the risk of confusion among consumers as to the source of the goods/services stemming from use of the infringing sign.

Use of expert witnesses

In trademark litigation cases the court does not appoint expert witnesses in order to obtain specialised opinions. The rights holder may, however, submit the testimony of such experts to the court.

Available defences

The defendant may object that:

- there is no confusing similarity between the marks or the earlier mark does not enjoy a reputation;
- there is no danger of repetition of the infringement in the future;
- the sign alleged to be infringing is not used on a commercial scale;
- the sign is used in a descriptive way and not as a trademark;
- the trademark is used in a legitimate way to inform customers that products under this trademark are being sold;

- the right of the mark owner to seek a cease and desist order has lapsed; or
- there is no urgent need for a court decision (in preliminary measures proceedings).

Appeals process

Any of the parties to the first-instance proceedings based on an ordinary lawsuit can file an appeal:

- within 30 days of the decision being served, if the party resides in Greece;
- within 60 days of the decision being served, if the party resides abroad; or
- within two years of the decision's issuance, if the decision has not been served.

Injunctive relief decisions and temporary restraining orders may not be appealed. **WTR**



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