

Greece enacts new Trademark Law

After a bit more than a year passed since the initial, public consultation phase on the draft that would later become the new Trademark Law (TML), the finalized text, made its way through the processes of the Greek Parliament and was finally published in the Government Gazette on March 20th 2020 (A71/20.03.2020), becoming, with the exception, of a select few provisions, effective immediately.

The new TML 4679/2020 implementing EU Directives 2015/2436 (Trademark Directive) and 2004/48 (Enforcement Directive), consists of 90 articles and replaces the previous and short-lived trademark Law 4072/2012.

The present brief, aims to highlight, on a high-level, without going into a theoretical analysis, some of the main changes that the TML brings about and to underline their practical importance:

1. Introduction of new types of TMs - Representation (Articles 2 and 56-70):

- The new TML expands the definition of what can be registered as a trademark by introducing new types of marks such as **position, sound, shape, pattern, motion, multimedia and hologram marks** and providing for the criteria they have to meet in order for them to be able to be represented on the Register in a clear and precise manner (e.g. colour marks have to be accompanied by a reference to a specific colour code).
- The new TML also introduces **guarantee and certification marks** and of course provides for the registration of collective marks (already available under the previous law).

2. Abolishment of the ex officio examination of relative grounds for refusal (Article 5 par.5):

In a sweeping change of practice, the TML abolishes the *ex officio* examination of relative grounds for refusal by the Examiners of the Greek Trademark Office (GTMO) and rolls this burden over to proprietors of earlier marks that have to monitor new filings. Under the new framework, the GTMO's Researchers (GTMO staff members tasked with

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identifying prior rights, on the basis of which their holder could elect to file oppositions) will notify third parties which in their view could have an interest to oppose the application.

In light of this change, earlier rights holders, should henceforth be more proactive in watching the trademarks that are accepted and published by the GTMO in order to ensure that oppositions are filed on time.

3. Clarifications on the rights conferred by a trademark and on the acts that a trademark proprietor may prohibit (Article 7 par.4):

The TML introduces, in more detail the specific acts that a trademark proprietor may prohibit. Although not an exhaustive list, this covers the most important and commonly found infringements that trademark proprietors are confronted with. A trademark registration confers to its proprietor the right to prohibit the use of an identical or similar sign for identical or similar goods that is liable to cause confusion and in particular to prohibit the following uses of such a sign:

- affixing it to the goods or to the packaging thereof,
- offering of the goods or putting them on the market, or stocking them for those purposes, or offering or supplying services thereunder with the sign,
- importing or exporting the goods under the sign,
- using the sign as a trade or company name or part of a trade or company name (abolishing thus a frequently raised defence by infringers)
- using the sign on business papers and in advertising, including social media,
- using the sign in illegitimate comparative advertising

4. Introduction of a right to prevent third parties from bringing unauthorized goods, from third countries in the course of trade (Article 7 par.5):

The TML contains a special provision granting the power to trademark proprietors to prevent third parties from bringing goods, in the course of trade, into Greece, where such goods, come from third countries and bear without authorization a trademark which is identical with a trademark registered for such goods, or which cannot be distinguished in its essential aspects from that trade mark. This applies regardless of the Customs status that such infringing products are found, including those goods that are not destined to be put in circulation on the Greek market (exceptions apply).

5. Introduction of a right to prohibit preparatory acts in relation to the use of packaging or other means (Article 8):

The TML introduces also a right to prohibit preparatory acts, in the course of trade, in relation to the use of packaging or other means and in particular to prohibit the:

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- Affixing of a sign identical with, or similar to a trademark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed,
- offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.

6. Reproduction of trademarks in dictionaries (Article 9):

The right of a trademark proprietor to ensure that the reproduction of the trademark in a dictionary, encyclopaedia or similar reference work is accompanied by an indication that it is a registered trademark, is introduced.

7. Right to prohibit the use of a trademark registered in the name of an agent or representative without the proprietor's consent (Article 10):

This newly introduced provision will better equip rights holders to defend themselves against trademarks filed by their representatives without their authorization. It provides for the defence against such use as well as for the possibility to have the trademark transferred following court proceedings.

8. Assignment of trademark applications and registrations (Article 16 par.5 and 6):

The TML introduces an unassuming yet procedurally important improvement. It provides that if a trademark application is transferred while it is still pending before the Administrative Trademark Committee or the Administrative Courts and the new proprietor files an intervention, the latter substitutes the applicant, in the ongoing proceedings.

A further welcome addition is, that aside from the possibility to acquire and have an earlier mark that acts as a relative ground for refusal, transferred to the applicant so that an application proceeds, to registration, it is now explicitly provided for, that if the earlier mark lapses, the later mark may proceed to registration.

9. Amendments to the registration procedure (Article 20 par.3 and Article 24):

Aside from the abolishment of the *ex officio* examination of relative grounds for refusal, the TML introduces several amendments throughout the examination and registration process. In particular:

- The trademark application is checked (in terms of its completeness, representation, description of the goods and services, fees and any other information or documents

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accompanying it) by the GTMO's **Auditor** (a new role that is introduced with the TML)

- A research relating to earlier marks is carried out by the TMO's **Researcher** (also a new role that is introduced with the TML) who informs the proprietors of any of the earlier rights identified during the search, about the new application
- The **Examiner** is tasked with ascertaining that no absolute grounds for refusal, that prevent the application from being registered exist. In the absence of such grounds the application is published on the website of the GTMO within **50 days** of the next day of the filing.
- In the absence of any successful opposition, the trademark is then entered into the Register by the **Registrar**.
- The decision which rejects (partly or in whole) an application is notified to the applicant or his representative, and published on the website of the GTMO, without such publication initiating the deadline to file an opposition but only the deadline for the applicant to appeal it.
- The introduction of the possibility for the GTMO to communicate with applicants via email is an amendment that will facilitate the quicker administration and processing of cases, abolishing the burden of having documents served on applicants via process servers.

10. Introduction of a cooling-off period in opposition proceedings (Articles 25-27):

Although under the previous framework and practice it was rather common for parties to obtain consecutive extensions in opposition proceedings, the TML introduces the concept of a **cooling-off period**. In order for the cooling-off period to begin, the parties have to file a joint request at the hearing, to be granted a minimum period of two months in order to pursue the possibility of a friendly settlement.

Practice will show, if the cooling-off period will truly be treated as an opportunity to amicably settle disputes or if it will be abused by parties wishing to delay proceedings by filing repetitive requests.

11. Amendments to the procedure for proof of use (Article 28 par. 2):

The TML contains provisions with the aim of streamlining the opposition procedure and in particular where the applicant raises an objection thus forcing the opponent to prove use of the earlier mark:

- The proof of use objection has to be raised at the hearing of the opposition otherwise it will be inadmissible and therefore it will be dismissed
- The opponent is granted **at least 30 calendar days** in order to submit material proving its use of the earlier mark along with a supporting writ.

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- The applicant is granted **at least 25 calendar days** starting on the day, that the deadline granted to the opponent to prove use, expired in order for it to evaluate the proof material and submit a writ/evidence.
- **Within 3 calendar days** following the expiry of the above deadline, both parties may submit their rebuttals.

All in all, if a proof of use objection is raised, the procedure from the hearing to the final submission will require **almost two months**.

12. Value of well-known facts when assessing proof of use requests (Article 28 par. 2):

A very interesting and welcome addition that the TML brings, is that in the process of assessing whether or not the opponent has indeed genuinely used the earlier mark, the Administrative Trademark Committee may also rely on facts that are so well-known, so that no doubt remains, that they are true.

This is a defence that will assist brand-owners of reputed and well-known marks in defending their marks against abusive proof of use requests.

13. Mediation (Article 31):

One novel provision is, that in the context of cases that are pending before the Administrative Trademark Committee, the parties may file a joint request in order for them to try and resolve the dispute by submitting it to mediation. The process is not mandatory and has to be completed within 6 months (with the possibility to extend it by an additional 3 months) from submitting the request. The signed mediation protocol is submitted to the Administrative Trademark Committee.

14. New defence lines for defendants in infringement proceedings (Articles 38 par. 12 and 40):

Perhaps one of the most significant changes that the TML brings, is the introduction of two new defence lines for defendants in trademark infringement proceedings that are brought before Civil Courts. These are a) the counterclaim for revocation or invalidity and b) the objection of non-use of the earlier mark(s) that forms the basis of the claim.

- As to the counterclaim for revocation or invalidity, although it was available in proceedings that involved EUTMs, it did not apply to national trademarks. The TML now introduces such counterclaim also against national trademarks. However, the provisions are explicit, that such action can only be raised as a counterclaim and not as an independent action and in order for the counterclaim to be admissible, the defendant has to notify the GTMO of the fact by the date of the court hearing, at the very latest.

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Furthermore, once the infringement action has been filed by the plaintiff, the defendant can no longer challenge the validity of the plaintiff's trademark by filing a separate cancellation/revocation action before the GTMO, although it remains at the court's discretion to suspend the proceedings brought before it, in case a cancellation/revocation action had been filed against the plaintiff's trademark before the GTMO already prior to the filing of the civil claim. In such an event, the court may also order provisional measures in favour of the plaintiff, so that the latter is not left without any protection at all.

Finally, a counterclaim for revocation or invalidity shall be dismissed by the courts where the matter has already been decided in proceedings with the same subject between the same parties.

- As to the objection of non-use of the earlier mark(s), the defendant has the right within 30 days as of the date the civil claim was served on it, to file a special claim (with the obligation to subsequently serve the same on the plaintiff (all in the same 30-day deadline)) before the competent court, requesting that the plaintiff proves use of the earlier mark. Should the plaintiff fail to do so or manages to prove use for only part of the goods/services, then the claim will be dismissed either in part or in whole.

15. Application of the new defence lines also in interim injunction proceedings (Article 42 par. 1 and 9):

What is truly novel in the TML and also a source of concern, is that the defendant in interim injunction proceedings is also granted the right to file a counterclaim for invalidity/revocation of the earlier trademark(s). This is an oddity, especially if the fact is acknowledged that by accepting such a counterclaim, an interim injunction judge would in essence be handing down a conclusive decision leading to the cancellation of the earlier mark, something which would be counter to the nature and scope of interim injunctions which are meant to only apply temporarily.

Although the initial draft submitted to the Parliament for approval, lacked any additional provisions on the matter, an further sentence was added later on, possibly in an effort to remedy this deficiency, which provides that any decision issued in interim injunction proceedings and concerns a counterclaim for invalidity/revocation of an earlier mark does not lead to the invalidation/revocation of the earlier mark. In other words, such a negative decision for the earlier trademark owner does not have effect *erga omnes* and does not affect the status of the earlier mark.

It remains to be seen how the courts will treat counterclaims for invalidity/revocation of earlier trademark(s) and how they will apply this provision.

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Aside from counterclaim for invalidity/revocation the defendant in interim injunction proceedings, also has the possibility to raise an objection of non-use of the earlier mark(s). Such request can be raised orally, at the hearing, and if the plaintiff fails to prove use, then the interim injunction request shall be dismissed.

16. Transfer of appeal proceedings relating to invalidation/revocation actions to the Civil Courts (Article 47 par. 4.b):

Although, invalidation/revocation proceedings (and opposition proceedings) are by definition administrative proceedings and as such, appeals relating thereto, are heard by the Administrative Courts, the TML makes a deep cut to what had been standard practice for decades and transfers appeals to the Civil Courts by what seems to be a not very well founded legal construct.

In other words, some of the appeals on decisions issued by the GTMO will be heard by Administrative Courts and others by the Civil Courts, leading to a complicated situation where the matter is split. It remains to be seen, if such arbitrary transfer of matter that by law belongs to the Administrative Courts, will stand the test of possible objections of unconstitutionality.

17. Publication of decisions, on social media (Article 46):

Although, the publication of court decisions handed down in infringement proceedings, in the press had been available, the TML now allows for trademark holders to request to have the full decision or parts thereof published on social media. A welcome addition, that may perhaps make sense for a lot of brand owners whose main target audience is predominantly young consumers.

18. Intervening rights in infringement proceedings (Article 48):

The TML also introduces the intervening right defence, in infringement proceedings, in favour of the proprietor of a later registered mark. In this context, the proprietor of the earlier trademark cannot prohibit the use of a later registered mark where that later trademark would not be declared invalid (pursuant to articles 12, 53 or 54 for national marks and article 53(1), (3) or (4), 54(1) or (2) or 57(2) of the EUTMR).

19. Reverse of burden of proof in revocation proceedings for non-use (Article 50 par.5):

Although, this was something followed in practice, the lack of an explicit reversal of the burden of proof when filing a revocation action due to non-use, often forced trademark holders that were on the offensive to engage in laborious and expensive research in trying to prove a negative, i.e. that the proprietor of the contested trademark had not

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put it, to genuine use. The TML resolves, that by reversing the burden of proof, thus forcing the trademark proprietor to prove that it has used its mark.

20. Certification marks (Articles 56-63):

The TML adopts almost verbatim, the provisions on certification marks of the Directive.

21. Changes in fees (Article 87):

Last but not least, the TML also brings adjustments to the official fees. The most interesting point, is that official fees for the recordal of changes of name, legal form and address, are henceforth free of charge.

For more information see the table of fees attached to the present.

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NEW OFFICIAL FEES FOR TRADEMARK MATTERS			
Type of Action		Official fees* (excluding stamp duties where applicable)	
		Paper filing	E-filing
1.	Trademark application (first class)	120 €	110 €
	Each additional class	20 €	20 €
2.	Conversion requests of EUTMs, IRs into Greek trademarks or division request	150 €	150 €
	Each additional class	20 €	20 €
3.	Renewal request (first class)	110 €	90 €
	Each additional class	20 €	20 €
	Renewal request within the 6-month grace-period (50% surcharge)	165 €	135 €
	Renewal request for each additional class within the 6-month grace-period (50% surcharge)	30 €	30 €
4.	Recordal of an assignment	90 €	90 €
5.	Recordal of change of name, change of legal form and change of address	No fees	No fees
6.	Recordal of a license agreement	90 €	90 €
7.	Recordal of securities (pledge)	40 €	40 €
8.	Review and transmission of IR application	15 €	15 €
9.	Replacement of a national trademark by an IR	110 €	110 €
10.	Filing of appeals, oppositions, interventions and applications before the Administrative Trademark Committee	70 €	N/A
11.	Hearings of appeals, oppositions, interventions and applications before the Administrative Trademark Committee	40 €	N/A
12.	<i>Restitutio in integrum</i>	110 €	N/A
13.	Copies of trademark records	1 €	N/A

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