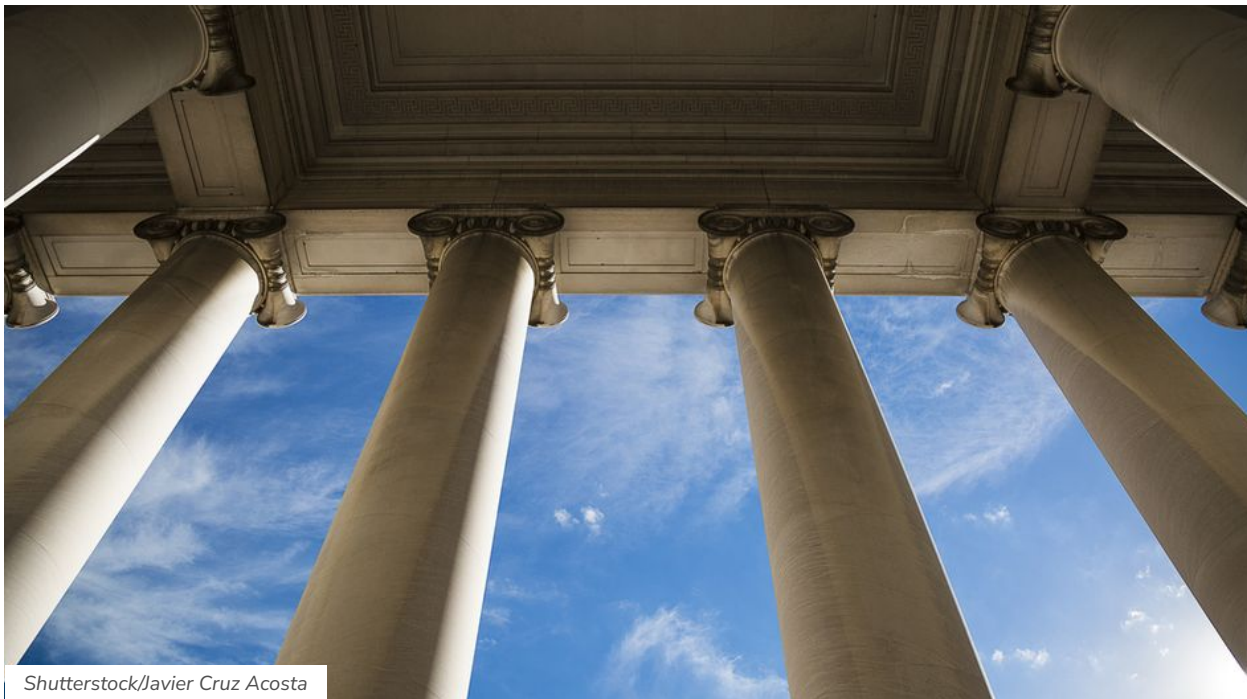


## Greece: trademark litigation

Marina Perraki

*Tsibanoulis & Partners Law Firm*

30 November 2022



### Injunctions at a glance

Preliminary injunctions are obtained through a court ruling (or judge order) upon petition of the trademark owner if the urgency, risk and probability of winning the lawsuit are established.

Permanent injunctions are obtained by virtue of a court ruling upon petition of the trademark owner if an infringement of rights is proved and substantiated.

The payment of a security or deposit is not necessary to secure an injunction, but the court may order it.

Regulation (EU) No. 608/2013 concerning customs enforcement of IP rights and Commission Implementing Regulation (EU) No. 1352/2013, as amended and in force, provide for the ability of customs authorities to seize counterfeit goods. They are directly applicable in Greece.

### Legislative framework and causes of action

#### Trademark law, rules and regulations

Trademarks in Greece are regulated by Law No. 4679/2020, which implements Directive (EU) 2015/2436 (the Trademark Directive) and Directive 2004/48/EC (the Enforcement Directive).

Unregistered marks are protected in Greece under unfair competition law provisions – namely, Law No. 146/1914. EU trademarks are regulated by Regulation (EU) 2017/1001, which is directly applicable in Greece.

Greece has also ratified:

- the Paris Convention for the Protection of Industrial Property (through Law No. 213/1975);
- the Madrid Protocol Concerning the International Registration of Trademarks (through Law No. 2783/2000); and

- the Nice Agreement on the Classification of Goods and Services (through Law No. 2505/1997).

## Causes of action

The owner of a registered trademark may rely on its exclusive right to bring action against infringers. A trademark owner can:

- use the trademark;
- characterise services; and
- affix the trademark on:
  - goods;
  - covers and packaging of the goods, writing paper, invoices, price lists, notices, advertisements and any other printed material, or electronic, audiovisual or social media; and
  - goods or packaging intended exclusively for export.

The owner of a registered trademark may prohibit any third party from doing any of the above if:

- the sign used by the third party and the goods or services at issue are identical to those of the trademark owner; or
- risk of confusion or dilution is created.

The trademark owner may also prohibit:

- the affixing of the trademark on goods or packaging;
- the transit of infringing or counterfeit goods through Greece;
- the affixing of the trademark on genuine products that the trademark owner intended to be anonymous or intended to put on the market under another trademark;
- the removal of the trademark from genuine products and their sale with a different brand or without any brand;
- offering the goods or putting them on the market, or stocking them for those purposes, under the trademark, or offering or supplying services thereunder;
- the import or export of the goods under the trademark; and
- the use of the trademark:
  - as a trade or company name, or part of a trade or company name;
  - on business papers and in advertising, including on social media; and
  - in comparative advertising in a manner that is contrary to Article 9(2) of Law No. 2251/1994 (misleading advertising).

## Alternative dispute resolution

### Mediation and arbitration

By virtue of Law No. 4640/2019, all civil and commercial law disputes, including disputes concerning trademarks initiated before civil courts, can be voluntarily submitted to mediation provided that the parties have the authority to dispose of the subject of the dispute. Exceptionally, submission to a mandatory initial mediation session is introduced for the following civil and commercial disputes:

- family disputes (concerning lawsuits filed as of 15 January 2020);
- disputes under the standard civil procedure falling within the jurisdiction of the single-member first instance court when the value of the subject matter of the dispute exceeds €30,000 (concerning lawsuits filed as of 15 March 2020); and
- disputes arising from contracts that contain a valid mediation clause (concerning lawsuits filed as of 30 November 2019).

In the above cases, a mediator will be appointed by mutual consent of the parties or the claimant will submit a request for recourse to mediation to an accredited mediator included in the register of the Ministry of Justice. If the respondent does not agree on the mediator, the mediator will be appointed by the Central Mediation Committee. The mediator must notify the

other party (or parties) of the request and arrange the date and place of the initial mediation session. This session takes place no later than 20 days from the day following the claimant's request to the mediator, extended by up to 30 days when any of the parties reside abroad.

By virtue of Article 867 of the Civil Procedure Code (CPC), private disputes can be submitted to arbitration upon agreement between the parties and to the extent that the parties may dispose of the object of the dispute. Therefore, the above points do not apply to matters falling within the administrative process of trademark rights acquisitions or cancellations. Arbitration can, for example, be agreed between parties in disputes arising from trademark licensing agreements.

## **Litigation venue and formats**

### **Court system and litigation venues**

Under the previous Law No. 4072/2012, a bifurcated system existed in Greece. The Trademark Office and the administrative courts were exclusively competent for all matters related to the existence and cancellation of marks (including oppositions and invalidity actions) and the civil courts were exclusively competent for infringement matters. Pursuant to the new Law No. 4679/2020, civil courts have acquired jurisdiction for examining the validity of national trademarks. More specifically, the Administrative Trademarks Committee remains competent to hear both oppositions and invalidity or revocation actions. However, the decisions of the committee are subject to appeal before administrative courts regarding oppositions and – under the new law – civil courts regarding revocation and invalidity actions. Competence regarding disputes concerning invalidity or revocation actions is transferred from the administrative courts to the civil courts for both separate invalidity or revocation actions at second instance and for counterclaims of the defendant in trademark infringement proceedings concerning revocation or invalidity.

The civil court system consists of the first instance civil courts, the civil courts of appeal and the Supreme Court. The administrative court system consists of the First Instance Administrative Court, the Administrative Court of Appeal and the Administrative Supreme Court. In Greece, most cases are appealed at second instance on matters of fact and law. Several appeal rulings are also challenged before the Supreme Court on matters of law.

Disputes arising from the infringement of EU trademarks are brought before the exclusively competent special departments within the courts of Athens and Thessaloniki. It is standard in trademark infringement disputes to combine trademark infringement claims with unfair competition and tort claims. If claims are based on trademark infringement, they may be brought before a single-member court. If combined with unfair competition, they will be brought before a multi-member court.

According to the CPC, after filing the lawsuit, the parties must submit their pleadings and evidence supporting their arguments within 100 days (or 130 days for parties residing abroad). Witness affidavits should also be produced. The plaintiff must serve the lawsuit to the defendant within 30 days (or 60 days if the defendant resides abroad or the defendant's address is unknown). Rebuttals of the other side's arguments will be submitted in writing within 15 days of the expiry of the 100 (or 130) day period. When the file closes, a hearing date is set. Following a typical hearing – where only in exceptional circumstances will a witness examination take place – a ruling is rendered within a few months.

### **Forum shopping**

For national civil disputes, plaintiffs may choose between the court competent based on the defendant's place of seat or residence and the court competent based on tort – namely, where the infringement took place.

For cross-border disputes, the relevant Greek civil procedure, EU or international legal texts apply, providing the available venues from which the plaintiff can choose.

### **Jury versus bench**

In Greece, trademark disputes are heard in bench trials. There is no provision for jury trials.

## **Damages and remedies**

### **Available remedies**

In the main civil procedure (permanent injunction), the following remedies are available:

- ceasing the infringing activity;
- refraining from future infringing activity;

- withdrawing the products bearing the infringing trademark and, if necessary, the materials used for the manufacture of said goods;
- destroying or confiscating the infringing goods and, if necessary, the materials used for the manufacture of said goods;
- a threat of penalties (in the form of monetary fines and personal incarceration) should the defendant fail to comply with the above;
- damages;
- moral damages; and
- the publication of a summary of the ruling.

Damages and moral damages may be claimed if the infringement was intentional or due to gross negligence. Greek trademark law implementing the Enforcement Directive provides that the trademark owner may claim:

- actual damage suffered (including lost profits);
- the licence fees that would be requested if a licence agreement existed; or
- the amount that the infringer profited from the exploitation of the mark.

Intentional infringement of a trademark is a criminal offence. Criminal prosecution is initiated on filing a criminal complaint by the trademark owner. Criminal penalties include at least six months' imprisonment and a minimum fine of €6,000. For counterfeit products, when particularly high profits result or damages occur on a commercial or professional scale, stricter penalties apply (ie, a minimum of two years' imprisonment and a fine of between €6,000 and €30,000). General provisions of the Penal Code (with respect to forgery under Article 216) and fraud (Article 386) may also be applicable.

## **Injunctive relief**

Trademark owners may seek injunctive relief by:

- filing a preliminary injunction petition requesting temporary measures;
- delivery of information on sales figures and networks or channels of distribution of the infringing goods; or
- temporary confiscation of the infringing goods.

The issue of urgency in the petition is critical. If no urgency is established, the petition will be dismissed for formal reasons.

Injunctive relief is granted if:

- the claim will probably be substantiated;
- the infringement is current or imminent and constitutes a threat to the owner's rights; and
- an urgent need for court regulation of the matter exists.

The preliminary measures that the court may impose on the infringing party include:

- a temporary cease of the infringement and temporary withdrawal of the infringing products from the market;
- drawing up a detailed inventory of the infringing items in the possession of the infringing party or temporary confiscation and placement under custody of the items;
- the audit of the commercial records and books for gathering data on the infringing items produced or marketed;
- the precautionary seizure of movable and immovable property in the case of an infringement committed on a commercial scale, including the blocking of bank accounts if the injured party demonstrates circumstances likely to endanger the recovery of damages;
- the threat of penalties (in the form of monetary fines and personal incarceration) in the case of contempt of the decision and for each violation of the decision's provisions; and

- publication of the injunction order.

On filing the petition, the trademark owner may also request that a judge grant a temporary order. This is available only in cases of extreme urgency. The judge may invite the respondents to appear at the hearing, which is usually the case even though *ex parte* proceedings are also an option provided by law.

## Evidencing the case

### Investigations and first steps

Before the commencement of judicial proceedings, it is recommended to have in place all evidence that the plaintiff will use to substantiate the claim. Lawsuits in Greece must be precise and refer to all points of fact under judicial review. No supplementing of the facts is allowed subsequent to filing. As a first step, a test purchase of the goods at issue is usually recommended.

Further, the trademark owner may request, through a lawsuit or an interim measures petition, the delivery of information by the infringer on sales figures and networks or channels of distribution of the infringing products. The same may be requested by a third party contributing to the infringement, to the extent that:

- the third party was found to possess infringing products, or was using or providing infringing services on a commercial scale; or
- the third party was involved in the production, manufacture or distribution of infringing goods, or in the provision of infringing services.

If a trademark owner has produced evidence to support its infringement claim and claims that evidence is in the hands of the defendant, it may request the court to order the defendant to provide such evidence.

In cases of infringement on a commercial scale, the court may also order the defendant to submit bank, financial or commercial books and records.

### Survey evidence

Surveys are used in Greece, but they are of low probative value because they are easily rebutted by the other side, mainly on grounds of subjectivity and lack of independence. They may constitute evidence of a trademark's establishment in the market, repute and extent of use. Occasionally, surveys may be used for strengthening risk of confusion allegations.

### Use of expert witnesses

Expert witnesses are permitted under the CPC. It is unlikely that a court will appoint an expert witness. However, trademark owners may use expert witnesses to support their claims.

## Available defences

In civil law cases, the defendant may invoke the following defences:

- no likelihood of confusion or dilution between trademarks;
- the sign is used in a descriptive way rather than as a trademark;
- own-name defence;
- use to denote the purpose and context of spare parts;
- use of a right of mere local significance;
- acquiescence by the owner of the earlier trademark if the trademark owner knew of the infringing use for more than five years and knowingly took no action against it, unless the later trademark was used in bad faith;
- limitation or exhaustion of a trademark right;
- prescription;
- counterclaim for revocation or invalidity; and

- objection of non-use of the earlier marks that form the basis of the claim.

Until recently, the defendant could also invoke the fact that the infringing sign used was a registered trademark in the defendant's name. However, following recent European Court of Justice case law, the Greek courts have now started to dismiss this defence. This case law has been crystallised in both the new Trademark Directive and the national law implementing this directive.

In the context of administrative proceedings (opposition or invalidity), if the grace period for non-use of the registered mark has expired, the defendant can request the trademark owner to prove that it has put its trademark to genuine use within the relevant period.

## Appeals process

Any party participating in the first instance proceedings based on an ordinary lawsuit can file an appeal according to the following timeframe:

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

Injunctive relief decisions and temporary restraining orders are not subject to appeal.

---

## Marina Perraki

Author | Partner

[m.perraki@tsibanoulis.gr](mailto:m.perraki@tsibanoulis.gr)

Tsibanoulis & Partners Law Firm

Unlock unlimited access to all WTR content

**[Subscribe Now](#)**