

By **Marina Perraki** Legislative framework and causes of action

## Trademark law, rules and regulations

Trademarks in Greece are regulated by Law 4679/2020, which implements the EU Trademark Directive 2015/2436 and the EU Enforcement of Intellectual Property Rights Directive (2004/48). Law 4679/2020 replaced Law 4072/2012.

Unregistered marks are protected in Greece under unfair competition law provisions, namely Law 146/1914. EU trademarks – protected throughout the European Union (including Greece) – are regulated by EU Regulation 2017/1001, which is directly applicable in Greece.

Greece has also ratified the following international laws:

- the Paris Convention for the Protection of Industrial Property (through Law 213/1975);
- the Madrid Protocol Concerning the International Registration of Trademarks (through Law 2783/2000); and
- the Nice Agreement on the Classification of Goods and Services (through Law 2505/1997).

## Causes of action

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

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

The owner of a registered trademark may respectively prohibit any third party from doing any of the above, to the extent that:

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

The trademark owner may also prohibit:

- the affixing of the sign on the goods or their 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 be put on the market by 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 sign, or offering or supplying services thereunder;
- the import or export of the goods under the sign;
- the use of the sign as a trade or company name or part of a trade or company name;
- the use of the sign on business papers and in advertising, including on social media; and
- the use of the sign in comparative advertising in a manner that is contrary to Article 9(2) of Law 2251/1994 (misleading advertising).

## Alternative dispute resolution

### Mediation and arbitration

By virtue of Law 4640/2019 (published 30 November 2019), all civil and commercial law disputes, including disputes concerning trademarks initiated before civil courts, can be voluntarily submitted to mediation as long as 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 and the multi-member first-instance court (concerning lawsuits filed as of 15 March 2020); and
- disputes arising from contracts which contain a valid mediation clause (concerning lawsuits filed as of 30 November 2019).

In case of the abovementioned disputes, the 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 person of the mediator, the latter 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 up to 30 days when any of the parties reside abroad. The requirement of the initial mediation session is fulfilled if the parties appear before the mediator, even if they agree not to proceed to mediation. In such case, the minutes of the session are drawn by the mediator and will be filed with the submissions of the parties before the court, constituting a condition for the admissibility of the hearing of the case. If the parties eventually agree to proceed to mediation, they draw the agreement to mediate and must complete the mediation within 40 days, unless they agree on a later date. In such case, the respective minutes, including the settlement agreement, may be submitted to the court secretariat for certification and become an enforcement title. When mediation is not mandatory, lawyers are still obliged to inform their clients in writing about the mediation option, as it constitutes a condition for the admissibility of the hearing of the case before court. Interim measures are not precluded pending mediation proceedings.

By virtue of Article 867 of the Greek Civil Procedure Code, private disputes can be submitted to arbitration on 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 acquisition or cancellation. Arbitration can, for example, be agreed between parties in case of disputes arising from trademark licensing agreements.

## **Litigation venue and formats**

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

Under the previous Law 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 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 in regard to oppositions and – under the new law – civil courts in regard to revocation and invalidity actions. The 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 (in various cities around Greece), the civil courts of appeal (mainly in Athens, Piraeus, Thessaloniki, Larissa, Patra and Herakleion) and the Supreme Court (Areios Pagos). The administrative court system consists of the First-Instance Administrative Court, the Administrative Court of Appeal and the Administrative Supreme Court. Both the the Administrative and Civil Supreme Court are based in Athens. All administrative judicial proceedings also take place in Athens. 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 Civil Procedure Code, 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). Rebutting 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 on the basis of the defendant's place of seat or residence and the court competent on the basis of tort – namely, where the infringement took place.

For cross-border disputes, the relevant Greek Civil Procedure, EU or international legal texts apply, providing for 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 sign 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 in the press and/or online.

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 for three alternative possibilities of a damages claim. 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. In case of 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 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 in cases of trademark infringement and counterfeiting.

## Injunctive relief

Trademark owners may seek injunctive relief by:

- filing a preliminary injunction petition requesting temporary measures (eg, temporarily cease and desist from producing, manufacturing, offering for sale, exporting, advertising and generally commercialising the infringing goods);
- delivery of information on sales figures and networks or channels of distribution of the infringing products (eg, orders and invoices to end-consumers or retailers); 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. It is therefore relevant when the trademark owner first discovered the infringement. The hearing is normally scheduled within three to four months of the filing date, and the relevant court decision is issued within the following three to five months.

Given the application of normally available civil procedures to disputes arising from trademark infringement, civil courts may order any type of interim measure or remedy that is suitable for the protection and preservation of the right or legal relationship until the issue of the judgment on the main trial, as long as the enforcement of such order does not satisfy what would have been the main claim, namely leading to an award of the full exercise of the right or legal interest to the applicant party.

Injunctive relief is granted on the following conditions:

- the claim will be probably 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 (eg, illegal use, reproduction and distribution of the infringing products) 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 the movable and immovable property, in the case of an infringement committed on a commercial scale, including the blocking of his or her 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 case of contempt of the decision and for each violation of the decision's provisions; and
- publication of the respective injunction order in the press or online.

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 a possibility provided by law.

## Evidencing the case

### Investigations and first steps

Before the commencement of the 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 that will be 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 law suit or interim measures petition, the delivery of information by the infringer on sales figures and networks or channels of distribution of the infringing products (eg, orders and invoices to end-consumers or retailers). 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.

To the extent that a trademark owner has produced evidence to support its infringement claim, and also 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 the risk of confusion allegations.

### Use of expert witnesses

Expert witnesses are provided in the Civil Procedure Code. It is unlikely that a court will appoint such an expert witness. However, trademark owners may use expert witnesses (eg, by providing expert witness affidavits) to support their claims.

### Available defences

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

- no likelihood of confusion or dilution between marks;
- the sign is used in a descriptive way rather than as a trademark;
- own-name defence;
- use in order to denote the purpose and context of spare parts;
- use of a right of mere local significance;
- acquiescence by the owner of the earlier mark, to the extent the trademark owner knew of the infringing use for more than five years and knowingly took no action against it, unless the later mark was used in bad faith;
- limitation of a trademark right;
- 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 actually 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 such a defence and the case law has been crystallised in both the new EU Trademark Directive and in the new national law on implementation of the directive.

In the context of the 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, in case the decision has not been served.

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

# Tsibanoulis & Partners

LAW FIRM

## Tsibanoulis & Partners Law Firm

18 Omirou Street  
Athens 106 72  
Greece

**Tel** +30 210 36 75 100

**Fax** +30 210 36 75 164

Web <https://tsibanoulis.gr/>



### Marina Perraki

Partner

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

## TAGS

[Greece](#)