
Greece adopts new trademark law (Law 4679/2020)

March 2020

20 March 2020 saw the enactment of Greece's long awaited new trademark law. Law No. 4679/2020 serves a dual aim: to, even belatedly, transpose Directive 2015/2436 into national law and to further align the Greek trademark system with that of the European Trademark. The new trademark law is ground-breaking, for better or worse, in more than one aspects.

Key features of the new Greek TM System:

Relative grounds for refusal are no longer examined ex-officio

The Trademark Office will no longer examine trademark applications with respect to relative grounds for refusal. So, prior rights owners cannot anymore rely on the screening of the Office; they are of course entitled to file opposition before the Trademarks Administrative Committee (Arts. 5 and 25). In line with the EUTM system, prior rights owners will receive notification of publication of the later mark

Civil courts' competence in trademark invalidity proceedings

The competence to rule upon the validity of trademarks has been transferred from administrative to civil courts. A cancellation action before the Trademarks Administrative Committee is always available, but the Committee's decision are now subject to appeal before the single-Member First Instance Court of Athens and not before the administrative courts. This change goes hand-in-hand with the introduction of invalidity / cancellation counter-claims in infringement proceedings before the civil courts.

It should be noted, however, that the decisions of the Trademarks Administrative Committee regarding the registration of a trademark (i.e., in recourse against the Examiner's refusal) procedure are still subject to recourse action before administrative courts (Art. 47).

Invalidity counter-claims in infringement proceedings before the civil courts

The defendant in infringement proceedings now has the option to file a counterclaim for revocation or cancellation of the trademark (Art. 38 para. 12). In order to avoid parallel proceedings (e.g. a cancellation action before the Trademarks Administrative Committee) and the risk of conflicting judgments, the law provides that after the lawsuit has been served on the defendant, he may seek revocation or cancellation of the trademark only by way of a counterclaim before the civil courts (Art. 38 para. 15). Similarly, when an application for revocation or cancellation has been already filed before the Trademarks' Administrative Committee, the civil court may suspend infringement proceedings until the invalidity proceedings are finalised and also order temporary measures for the duration of the invalidity proceedings (Art. 38 para. 16).

Non-use as defense in infringement proceedings

The defendant in infringement proceedings can raise non-use of the trademark as a defense, rather than having to file separate cancellation action before the Trademarks' Committee, as was the case under the previous legal regime. Art. 40 of the new law sets up a particular procedure for such proof of use request, essentially 'cracking' the general rules of civil procedure.

Defenses in preliminary injunction proceedings

The non-use defense is also available to the defendant in preliminary injunction proceedings. Moreover, he is given the option to file a separate temporary relief action seeking (temporary) revocation or (temporary) cancellation of the trademark. However, the court's judgment on the cancellation request cannot invalidate the trademark (Art. 42).

Remedies for infringement

Damages are awarded to the trademark owner only in the event of willful infringement or gross negligence on the part of the infringer (Art. 38 para. 5), while, under the previous legal regime, any type of negligence would suffice for damages purposes. The new law also explicitly mentions the availability of non pecuniary damages, "*depending on the nature of the infringement*".

The wording employed is based on the Greek text of Art. 13 para. 2 of the IPR Enforcement Directive, which translates, perhaps unsuccessfully, "reasonable grounds to know" as "gross negligence". This provision may be problematic. such type of (higher) culpability standard for damages is not present in any other intellectual property law instrument (e.g. copyright or patent) and represents an unjustifiable differentiation from the body of enforcement rules in Greek intellectual property law.

On the plus side, threatened monetary penalty in case of violation of the courts' judgment (i.e., repetition of the infringement) has been increased from €10.000 to €100.000 (Art. 38 para. 3).

Mediation

Following the recently introduced mandatory mediation in infringement proceedings, Law 4679/2020 provides the possibility of voluntary mediation in the proceedings before the Trademarks Administrative Committee in order to facilitate amicable solutions between the parties (Art. 31).

Other notable provisions include

- ✓ Changes in the renewal procedure to mirror Art. 49 of Directive 2015/2436 (Art. 36), including that the Office will now notify trademark owners of the need to renew. The "twist" in the new system is that late renewal will not *"overturn rights of third parties which were acquired in the meantime"*. Whether this means registered trademarks only, or also trademark applications remains to be seen.
- ✓ The transposition of Art. 8 of Directive 2015/2436 (art. 53) where lack of distinctive character or of reputation of an earlier trademark prevents the cancellation of a later trademark.
- ✓ The transposition of Art. 18 of Directive 2015/2436 (Art. 48) establishing the "intervening right" defense of the owner of a later trademark in infringement proceedings.
- ✓ A slight change in the Greek Trademark Office's fees structure to favour online filing and renewal.