

applicable provisions of the Civil Code. The Court codified existing case law by holding that general provisions should not be used where specific provisions of the Trademark Act apply.

In "Mac Dog," the Court faced the issue of whether McDonald's Corporation and its German subsidiary could preclude use of the marks "MAC Dog" and "MAC Cat" for pet food. Acknowledging the standing of a licensee to sue, the Court focused on the degree of notoriety enjoyed by "Mc" and BIG MAC in 1983 when the defendant started to use "MAC Dog" and "MAC Cat." The Court remanded the case for a determination of that point, suggesting that the defendant's selection of the marks "MAC Dog" and "MAC Cat" could be indication that plaintiff's marks were sufficiently well-known if the defendant could not offer a plausible reason for selecting them. Finally, the Court found that the defendant could not raise the defense of laches if he was aware of the notoriety of the plaintiff's marks and willfully infringed.

GREECE

I.B.4. Geographical Names

The trademark application TOKYO ELECTRON LIMITED for electronic and associated products in International Classes 7, 9, and 11 was refused registration by the Trademark Committee on the grounds that the mark sought to be registered included a geographical reference to the Japanese city, Tokyo. The Committee specifically referred to the fact that Japan has a reputation for the production of such goods.³⁵⁰

Similarly, in a geographic name case with a twist, the Trademark Committee rejected an application for the trademark UNITED STEAKS OF AMERICA which was intended to cover goods in Class 29, including meat.³⁵¹

In its three-pronged decision the Committee took unequivocal exception to the use of the geographic term AMERICA, per se. In addition, the Trademark Committee found the use of the term AMERICA misleading since in this particular case the goods in question would not be originating from an American company, but instead, from a European company. Finally, the Trademark Committee found the mark to be descriptive of the goods intended to be covered, namely steaks, and therefore lacking in distinctiveness, as well.

350. Decision No. 5279/1998 of the Trademark Committee (unpublished).

351. Decision No. 6717/1998 of the Trademark Committee (unpublished).

I.B.7. Device and Design Marks

The applicant filed a device trademark application consisting of a two-toned relief pattern configuration for goods in International Class 18.³⁵²

The Trademark Committee refused registration, citing lack of distinctiveness as the grounds. The Court of the First Instance reversed, finding that the device in question had acquired specific distinctive properties as a result of the applicant company's intensive advertising campaign on the Greek market since 1990 and its extensive international commercial activities.³⁵³

Louis Vuitton Malletier filed a device trademark application consisting of a two-toned relief pattern configuration for goods in International Class 18.³⁵⁴ The Trademark Committee refused registration, citing lack of distinctiveness. The Court of the First Instance reversed, finding that the device in question had acquired specific distinctive properties as a result of the applicant company's extensive advertising in the Greek market since 1990 and its substantial international commercial activities.³⁵⁵

In a recent case involving a bottle design mark consisting of a bottle design in the form of a limbless male torso with a gold neck for all goods in International Class 5, the Court had the opportunity to uphold the functionality doctrine.³⁵⁶

The Trademark Committee refused registration for perfume products, citing its lack of distinctiveness for those goods. In reversing this decision, the Court of the First instance found the device original and therefore sufficiently distinctive to identify the source of the goods in question. Moreover, the Court specifically held that the bottle in question could not be considered descriptive of the products for which it is intended, since the design thereof was not dictated by functionality.

I.B.8.c. Conflict Between Trademarks and Corporate Names

A trademark application for MIDAS CHRIMATISTIRIAKI A.E. (in Greek script) was filed by a company of the same name to distinguish services in International Class 36. Opposition was lodged by the owner of the trademark MIDAS which was registered in 1985 to cover products in International Classes 9 and 16. While the Committee found

352. Decision No. 9035/96 of the Trademark Committee (unpublished).

353. Court of the First Instance of Athens, decision of September 30, 1998.

354. Decision No. 9035/96 of the Trademark Committee (unpublished).

355. Court of the First Instance of Athens (Section 18), decision of September 30, 1998.

356. Court of the First Instance of Athens (Section 8), decision of September 30, 1998.

that the MIDAS trademark is indeed well-known, it dismissed the opposition holding that the applicant's company name, as fully reflected in its trademark, benefits from the enhanced protection provided company names under the Greek Trademark Law in conjunction with the Paris Convention.³⁵⁷

The Committee noted that MIDAS CHRIMATISTIRIAKI A.E. had shown uninterrupted use of its company name since its establishment in 1990.

I.B.12. Famous Marks

Globe Elegance B.V. opposed registration of the mark VALENTINO for condoms and related goods in International Class 10 on the basis of its own trademark VALENTINO which was registered in 1977 for products in International Classes 8, 9, 16, 18, 26 and 34. The Trademark Committee accepted the opposition, finding that the opposing company's trademark has acquired a prominent position on the market and is highly esteemed by consumers.³⁵⁸ Indeed, the Trademark Committee held that the prior trademark is famous and therefore subject to heightened protection under both Greek Trademark Law and related provisions of the Paris Convention.

Alpitour Italia SpA. sought to register BRAVO CLUB and device for services related to tourism in International Classes 39 and 42. The Trademark Committee rejected the application, based on the locally well-known prior trademark, BRAVO, which is registered for goods in Classes 1 through 34.³⁵⁹

BRAVO A.E. is the distinguishing title of a very well-known Greek company which has marketed its products, in particular coffee, in Greece since 1952. The Court of the First Instance upheld the Trademark Committee decision, finding that the prior trademark had acquired a reputation in Greece and is highly esteemed by consumers.³⁶⁰

As a result, the Court found that use of the term BRAVO CLUB by the applicant would constitute unjust enrichment.

I.B.13. First to Apply Versus First to Use

A dispute concerning the ownership of the trademark REEL MAGIC was recently resolved by the Greek Courts in favor of the prior user. The first application for the trademark REEL MAGIC was filed

357. Decision No. 5248/1998 of the Trademark Committee (unpublished).

358. Decision No. 5056/1998 of the Trademark Committee (unpublished).

359. Decision No. 830/1997 of the Trademark Committee (unpublished).

360. Court of the First Instance of Athens, decision of September 29, 1998.

on September 28, 1993 by Barcrest Limited to cover slot machines and related goods in International Class 9.³⁶¹

JPM International, which had been utilizing the trademark on the Greek market since the beginning of 1993, thereafter applied to register the trademark REEL MAGIC on May 26, 1994, for the same goods in International Class 9, and related services in International Class 36.

The Court found that the unregistered trademark REEL MAGIC had become well-known as a mark of JPM International Limited, as a result of its prior use. It therefore held the second applicant was the senior party and refused registration to the first to file.

II.A. Formalities for Acceptable Filings

Office National Interprofessionnel des Vins Onivins, a French organization established under public law, filed a standard trademark application intended to cover wine in International Class 33. The Trademark Committee summarily rejected the application on formalistic grounds, finding that the application in question should have been filed for a collective trademark due to the fact that the applicant organization is a public law entity.³⁶² The First Instance Court of Athens reversed, holding that a ruling on the acceptable form of a trademark filing entails a factual determination of whether the trademark is intended for use by the applicant organization or its members.³⁶³ This case was remanded to the Trademark Committee for review upon the substantive merits thereof.

In a series of cases with wide-reaching implications, the First Instance Court of Athens has rejected trademark applications consisting of minor variations of registered trademarks, when those applications are filed by the proprietors of the prior registered trademarks and are intended for the same product coverage. This series of unrelated cases heralds a new trend in Greek trademark practice; one which would appear to provide the proprietors of Greek trademarks with significantly broadened trademark protection.

Indicative of this series of cases, is the application by AT&T Corp. for the trademark WORDPLUS to distinguish services in International Class 38. This application was rejected by the Trademark Committee, due to the applicant's prior trademark WORD PLUS, covering the same services.³⁶⁴

The Athens Court of the First Instance upheld the Trademark Committee decision, holding that WORD PLUS and WORDPLUS are

361. Court of the First Instance of Athens (Section 10), decision of July 31, 1998.

362. Decision No. 9388/1996 of the Trademark Committee (unpublished).

363. Court of the First Instance of Athens, decision of June 30, 1998.

364. Decision No. 12335/1995 of the Trademark Committee (unpublished).

substantially similar trademarks intended to distinguish identical goods and that therefore the applicant has no legal interest in acquiring the protection requested for the latter mark since that protection is already in effect via the existing registered mark.³⁶⁵

The Court specifically indicated that third party use or registration of the term WORD PLUS, in either form, for the same services would be subject to prohibition.

In a somewhat similar situation, Acer, Incorporated applied to register a trademark consisting of the letter "A" (included within a black square) followed by the term "Open" for goods in International Class 9. The Trademark Committee rejected the application, citing the applicant's prior trademark covering the same goods and consisting of the letter "A" (also included within a black square) placed above the word "Open."³⁶⁶

The First Instance Court upheld the Trademark Committee decision finding that "A OPEN" constitutes a substantial imitation of the registered trademark "A" over OPEN.³⁶⁷ In light of the fact that both trademarks are intended to cover the same goods, the Court held that the applicant lacked a legal justification in procuring registration of the applied for trademark.

III.A.5. Fair Use

In a shortsighted decision, the Court of the First Instance of Rhodes ruled that the alteration of labels on duly trademarked products does not constitute infringement of a trademark proprietor's rights therein.

In *Brauerei Besk GmbH & Co. v. E. Tatakis & Sons S.A.*, plaintiff successfully proved that defendant imported items produced by the former and intended for distribution through tax free outlets within EU Member States.³⁶⁸ Plaintiff further proved that defendant altered the labels affixed to those products by removing the DUTY/FREE indication placed thereon by plaintiffs.

Nevertheless, the Court refused to hold that any change or impairment of plaintiff's goods and trademark resulted from these alterations. Indeed the Court found that the DUTY/FREE sign removed by defendant was an "annexed" indication which does not appear on the plaintiff's products, as circulated on the Greek market by plaintiff's distributors.

365. Court of the First Instance of Athens, decision of April 30, 1998.

366. Decision No. 3979/1996 of the Trademark Committee (unpublished).

367. Court of the First Instance of Athens, decision of August 31, 1998.

368. Court of First Instance of Rhodes, decision of November 28, 1997.

III.B.8. Slavish Imitation

The Lego Group sought an injunction against the Greek distributor, the Italian manufacturer and the Italian exporter of toy bricks which were allegedly identical to the famous LEGO toy bricks, claiming unfair competition (i.e., slavish imitation) in reliance on Lego's³⁶⁹ copyright and trademark rights in the LEGO toy bricks.

The Athens Court of the First Instance granted preliminary injunctions, holding that the defendant's toy bricks were a slavish imitation of the LEGO toy bricks, which are widely-known in Greece. The Court rejected the defendants' claim that use of its LIMA and/or KLIP trademarks on the packaging prevented confusion because the court found the confusion to consumers ensues from the fact that consumers base their purchase decisions on the design of the bricks, which in this case are identical.

III.J. Gray Marketing and Counterfeiting

In a recent gray marketing case, the Court upheld its Selective Distribution System Doctrine to the detriment of yet another distribution network non-member.

Fiat SpA successfully petitioned for an injunction against use of its FIAT trademark by a parallel importer, Auto Plaza S.A., on the latter's storefront.³⁷⁰ The Court found that the activities of Auto Plaza S.A. falsely create the impression that it was a member of the selective distribution system which Fiat has established in Greece.

This case confirms the Greek Courts' Selective Distribution System Doctrine which restricts the exhaustion of trademark rights provision incorporated in Greek Trademark Law No. 2239/1994. Under that provision, Greek trademark proprietors are, in principle, not entitled to enjoin use of their trademark in connection with goods which have been placed on an EC Member State's market with the express consent of the trademark owner. However, the Greek courts have allowed trademark owners to enjoin activities which encroach upon the "promotional function" of their trademark in cases where a selective distribution system has been organized by the trademark proprietor and the parallel importer creates the false impression of belonging to that network.

369. Court of the First Instance of Athens (Provisional Measures Section), decision of June 3, 1999.

370. Court of the First Instance of Athens (Provisional Measures Section), decision of May 26, 1999.