

exclusion of trademark rights only if the marked products have been brought into commerce within the EC with the consent of the trademark owner.³⁹⁴

The sale of the original goods imported without the consent of the trademark owner can be stopped in Germany because of trademark infringement. The border seizure so far had not been held admissible because of Article 1, Paragraph 4 of the Product Piracy Regulation. The Federal Finance Court now has held that a trademark infringement due to lack of exhaustion warrants a border seizure according to Section 146 of the German Trademark Act. German law applies insofar as the European product piracy regulation is not applicable. Thus, the loophole for parallel imports has been closed.

Under German law, a border seizure can take place only if the trademark infringement is obvious. Thus, the importer has to prove that there has been no consent with the import. If he applies for a border seizure, he may do this by disclosing the distribution channels and naming an exclusive importer.

GREECE

I.B.9. No Likelihood of Confusion

Omega S.A. opposed the application to register SPACE MASTER filed in the name of Citizen Tokei Kabushiki Kaisha to cover wristwatches and clocks in International Class 14.

Omega S.A. argued that its trademark SPEEDMASTER covering, inter alia, the same goods in Class 14, had acquired a secondary meaning that associated it with space travel due to the intensive advertisement thereof in connection with the United States NASA Space Program.

The opposition was rejected by the Trademark Committee,³⁹⁵ and the Court of the First Instance³⁹⁶ upheld that decision upon recourse, finding that since the foreign terms SPEED and SPACE are not commonly recognized by Greek consumers, the Omega S.A. trademark could not be considered to bring the secondary meaning in question to the minds of those consumers.

I.B.20. Color/Shape

The Greek Trademark Committee summarily rejected Legrand's application to register the color yellow in a rectangular shape for goods in Class 9, holding that the trademark consists solely of color and therefore lacks distinctiveness. Legrand's applications to register the

394. See European Court of Justice, C-355/96 (1998).

395. Decision No. 7298/1997 of the Trademark Committee (unpublished).

396. Court of the First Instance of Athens (Section 4), decision of June 24, 1999.

color red in a rectangular shape³⁹⁷ and the color green in a rectangular shape³⁹⁸ met with the same fate.

II.F. International Issues

Scalaris SrL sought to register the word mark BY AMERICAN with a device depicting a section of the American flag, for clothing and related goods in Class 25. The Greek Trademark Committee rejected the application, holding that use of the seemingly American mark by an Italian company would mislead consumers as to the origin of the products.³⁹⁹ On appeal, the Court upheld the decision, refusing to apply Article 6quinquies, of the Paris Convention, despite evidence of registration in Italy.⁴⁰⁰

The Administrative Court of Appeals applied the “telle quelle” principle of Article 6quinquies, of the Paris Convention to reverse prior decisions with respect to the trademark SALVADOR DALI and device for goods in Class 3.⁴⁰¹

The Trademark Committee⁴⁰² and the Administrative Court of the First Instance⁴⁰³ had both rejected the application, finding that the name of a third party is not registrable as a Greek trademark, notwithstanding consent thereto.

In dictum, the Court of Appeals noted that if the mark infringed upon the name or personality of a third party, the “telle quelle” principle would not have applied to the case.

III.A.2. Likelihood of Confusion

J.W. Spears & Sons plc brought an action against D. Karavias and Sia EPE for, inter alia, infringement of J.W. Spears’ registered trademark SCRABBLE.⁴⁰⁴ D. Karavias and Sia distributed an analogous board game marketed under the unregistered marks SCRAMBLE and LEXORAMA.

The Court found for plaintiff, holding that the addition of the term LEXORAMA could not sufficiently distinguish the SCRAMBLE product from the plaintiff’s SCRABBLE product, in light of the fact that the board games under consideration shared a common philosophy as well as common external and internal appearances.

397. Decision No. 5474/1999 of the Trademark Committee (unpublished).

398. Decision No. 5475/1999 of the Trademark Committee (unpublished).

399. Decision No. 2003/97 of the Trademark Committee (unpublished).

400. Court of the First Instance of Athens (Section 18), decision of June 30, 1999.

401. Court of Appeals of Athens (Section Z), decision of September 28, 1999.

402. Decision No. 5926/1993 of the Trademark Committee (unpublished).

403. Court of the First Instance of Athens (Section 26), decision of August 28, 1995.

404. Court of the First Instance of Athens (Main Action Procedures), decision of May 19, 1999.

III.A.18. Equitable Defenses

Aglukon Spezialdunger GmbH & Co., as successor to the rights in the Greek trademark COMPLESAL (No. 36606) from Hoescht A.G., filed a Petition for Injunctions against the alleged unauthorized use of that trademark by Aventis Crop Science Aebe.

The Court⁴⁰⁵ refused to grant injunctions, finding that both Hoescht A.G. and Aglukon Spezialdunger GmbH & Co. had consented to the use of said trademark by both Aventis Crop Science Aebe and its predecessor, Agrevo Hellas Abee, for a period of approximately six years.

Applying the doctrine of laches, the Court found that neither Hoescht A.G. nor Aglukon Spezialdunger GmbH & Co. had ever commercialized fertilizer products bearing the trademark COMPLESAL in Greece, while the respondent and its predecessor had been doing so in 1994.

Finally, the Court found that the petitioner could not claim a right in the trademark COMPLESAL, having failed to record its ownership thereof prior to filing the Petition for Injunctions under consideration. In this regard, the Court was particularly formalistic since the petitioner did duly record its ownership of the trademark COMPLESAL, prior to the hearing of this case.

III.B.6. Configuration of Goods

In *Lego et. al v. Kroko Boy Paihnia EPE*⁴⁰⁶ the Court of the First Instance found that the elements of Lego toy bricks constituted “distinguishing features” of the source companies, due to the long-standing circulation thereof throughout one hundred fifty countries worldwide. The Court therefore held that by distributing elements of the same size, shape and assembly potential, defendants were guilty of unfair competition.

III.J. Gray Marketing and Counterfeiting

The Greek courts continue to restrict the exhaustion of trademark rights provision incorporated in Greek Trademark Law No. 2239/1994 pursuant to their Selective Distribution System Doctrine. As a recent series of distinct cases involving the FIAT⁴⁰⁷ and ALFA ROMEO⁴⁰⁸

405. Court of the First Instance of Athens (Provisional Measures Section), decision of July 6, 2000.

406. Court of the First Instance of Athens (Main Action Procedures), decision of June 4, 1999.

407. Court of the First Instance of Nafplio (Provisional Measures Section), decision of September 15, 1999. Court of the First Instance of Rodopis (Provisional Measures Section), decision of November 17, 1999. Court of the First Instance of Rodopis (Provisional Measures Section), decision of February 3, 2000.

trademarks suggests, this doctrine has become well-established with respect to the automobile market.

This exception to the general rule requiring exhaustion of trademark rights within the EU has been repeatedly applied in cases where a formal selective distribution system had been organized by the trademark proprietor and the parallel importer created the false impression of belonging thereto. Until recently, however, the doctrine only allowed the owners of famous trademarks to enjoin activities that encroach upon the "promotional function" of those trademarks.

A recent decision of the Court of First Instance of Piraeus appears to have significantly broadened the scope of the doctrine by allowing Ernesto Stoppani SpA to enjoin use of its registered STOPPANI trademarks and its unregistered device trademark by Simon's Marine EPE.⁴⁰⁹ Simon's Marine EPE distributes genuine Ernesto Stoppani SpA products; first use of the marks in question on its storefront signs and advertising materials was prohibited.

GUATEMALA

I.B.1. Generic Names

On March 20, 1995, Laboratorios Farmacéuticos GHI, S.A. applied to the Industrial Property Register of Guatemala for the registration of the mark UÑA DE GATO in International Class 5 (Cat Nail in English). The Register ordered the application to be allowed for registration. Industria Farmacéutica, S.A., with trading name INFASA, opposed the registration of this mark. The Register, by means of a resolution dated March 20, 1996, admitted the objection because it considered that the phrase UÑA DE GATO described a range of medicinal products, and that the words both were of general use among the consuming public and indicated the nature of the products.

Following this decision, Laboratorios Farmacéuticos GHI, S.A. brought an appeal. It was resolved by the Ministry of Economy by means of Resolution No. 288 of March 5, 1997, which denied the appeal and confirmed the resolution issued by the Industrial Property Register on the same grounds.

Even so, Laboratorios Farmacéuticos GHI, S.A. continued to insist on its registration and brought a complaint against the resolution

408. Court of the First Instance of Piraeus (Provisional Measures Section), decision of October 25, 1999. Court of the First Instance of Rodopis (Provisional Measures Section), decision of February 3, 2000. Court of the First Instance of Nafplio (Provisional Measures Section), decision of September 15, 1999. Court of the First Instance of Rodopis (Provisional Measures Section), decision of February 3, 2000.

409. Court of the First Instance of Piraeus (Provisional Measures Section), decision of November 16, 1999.