

phrases “simply the best” and “Alpine” that appeared in the same colors on the respective packaging of the goods of the parties. However, the cartons had different pastel coloring, and the brand names BINATONE and MIKACHI appeared respectively on the cartons of the plaintiff and defendant.

In ruling on the case, the Court noted that it is an actionable wrong for a trader to conduct his business in such a way to lead the “casual and unwary customer” to believe that its goods are those of another. In this case, the crucial issue was whether the unregistered phrase “simply the best” had become so associated by the public with the plaintiff’s goods that the appearance of that phrase would make buyers expect to obtain the plaintiff’s goods; *i.e.*, whether the phrase had taken on a secondary meaning as a term distinctive for the plaintiff’s goods. The Court ruled that confusion between the plaintiff’s goods and those of the defendant was unlikely given that the brand names of the respective parties were distinctive and had reasonable prominence on their respective cartons. The Court noted: “[s]imilarity in get up per se seldom gives a cause of action particularly if the name or trademark of the trader in issue is given reasonable prominence.”

The plaintiff’s claim of passing off was dismissed and the defendant was awarded nominal damages for the putative loss it sustained during a twenty-day period during which it was enjoined from selling its fans.

GREECE

I.B.2. Merely Descriptive Terms

An action for injunctive relief was brought by Kostarelos & Sia to enjoin Babor et al. (“Babor”) from using the word COVERDERM on its cosmetics products. Kostarelos & Sia had been using the trademark COVERDERM for its cosmetic products since 1974. The word COVERDERM was printed in gold capital letters on a beige colored box. Babor has been using the word COVERDERM for its cosmetics products on a white and blue rectangular box, with the trademark BABOR in white capital letters on a dark blue background. The letter O of the word BABOR vertically crosses the picture of a flower. On some, but not all, of these boxes, the word COVERDERM appears written in lower case italics underneath the trademark BABOR.

The Court of First Instance found that the action brought by Kostarelos & Sia was without merit.³⁵⁶ The Court found that the word COVERDERM used by Babor, in conjunction with its trademark BABOR, to be merely a descriptive term and not a

³⁵⁶ Court of First Instance, Decision No. 7474/2002 (published in *Epitheorisi Emporikou Dikaiou* – Commercial Law Review, Volume 1, 2003 p.157).

trademark because its sole purpose was found to be the communication of the intended use of the product to the consumer. In addition, the Court concluded that the complete packaging, print, colors, etc., of the Kostarellos & Sia products and those of Babor are totally different and, therefore, there is no risk of confusing the average consumer.

I.B.7.a. Two-Dimensional Marks

The trademark ZANTAC was originally registered by Glaxo Group Limited (“Glaxo”) in Greece in 1978. This trademark has been used as a label for pharmaceutical, medical, and veterinarian products and materials in International Class 5. In 1981, Glaxo attempted to register the trademark ZANTAC printed in bold, large characters with the letter Z written artistically, extending its bottom vertical line as a curve beneath the letters A and N.

The Court of First Instance did not allow Glaxo’s application in 1981, stating that the trademark for which Glaxo applied was previously registered by Glaxo in 1978.³⁵⁷ Greek law does not allow the application for registration of the same trademark by the company who has legal right to it because this contradicts the principle of possessing a legitimate interest to do so, which is a condition precedent for trademark applications in Greece.

The Court of Appeals did not agree with that decision and found instead that the trademark registered in 1978 was merely a word mark, and that the subsequent trademark, as described above, is different in its appearance and the impression it creates to the consumer.³⁵⁸ Thus, Glaxo’s application was allowed.

I.B.8.a. Similarity of Marks

Plexaco Inc. applied to register the trademark PLEXIVYL for certain flexible plastic pipes, both colored and transparent, in International Class 17. The Trademark Committee accepted the application.³⁵⁹ Rohm GmbH opposed the decision on the ground that the trademark is confusingly similar to its own previously registered trademarks PLEXI GLAS, PLEXIDUR, PLEXIGLAS, PLEXICUR, and PLEXILITH for products in the same class.

The Trademark Committee rejected the opposition and allowed the registration of PLEXIVYL because it found that the trademark PLEXIVYL is not confusingly similar to the trademarks PLEXI GLAS, PLEXIDUR, PLEXIGLAS, PLEXICUR, or PLEXILITH due to the suffix –VYL, which, it held, created a

357. Decision No. 1494/1982 of the Trademark Committee (unpublished).

358. Court of Appeals Decision No. 2725/2002 (published in *Epitheorisi Emporikou Dikaiou* – Commercial Law Review, Volume 4, 2002 p.896).

359. Decision No. 468/1994 by the Trademark Committee (unpublished).

difference in the visual and phonetic aspects of the trademark PLEXIVYL.³⁶⁰ The Court of First Instance agreed.³⁶¹

Upon review of that decision, the Court of Appeals did not agree.³⁶² It ruled that the suffix –VYL of the trademark PLEXIVYL was not sufficient to create a phonetic and visual distinction between the trademarks PLEXIVYL and PLEXI GLAS, PLEXIDUR, PLEXIGLAS, PLEXICUR, or PLEXILITH so as to avoid the likelihood of confusion of consumers for products in the same class.

I.B.9.a. No Similarity of Marks

House Of Prince A/S applied to register the trademark KING'S FAVOURITES for products in International Class 34, and, in particular, for cigarettes. The word KING'S appeared in large, bold, capital letters printed in black on a white background, inside a vertical rectangular black frame similar to a cigarette pack. The word FAVOURITES was printed in a smaller, finer font, in black, directly underneath the word KING'S. A shield of polygonal shape appeared directly on top of the word KING'S, inside of which there was a circle, the center of which was the picture of a lion with a crown on top, drawn outside the circle.

The application was opposed by Imperial Tobacco Limited on the ground that it is confusingly similar to its previously registered trademarks, SUPERKINGS JOHN PLAYER and SUPERKINGS. The trademark SUPERKINGS JOHN PLAYER is composed of a vertical rectangular frame similar to a cigarette pack, where, on the left side, the word SUPERKINGS is written vertically inside a black frame with capital letters printed in white on a black background. The remainder of the rectangular frame (outside the black background) is filled with black and white vertical stripes. On top of the rectangular frame, there is a picture of a shield composed of two lions facing each other embracing a flag. Underneath the flag, inside a white background, the words JOHN PLAYER appears in a black small font written in capital letters. This trademark has been used for Class 34 products, and, in particular, for processed and unprocessed tobacco, and related tobacco material used for medical or therapeutic purposes, as well as matches.

The SUPERKINGS trademark is composed of a horizontal rectangular frame similar to a cigarette pack, in the lower part of which there are thick, horizontal, black and white stripes. The

360. Decision No. 9808/1995 by the Trademark Committee (unpublished).

361. Decision No. 11560/1997 of the Administrative Court of First Instance (unpublished).

362. Administrative Court of Appeals Decision No. 5134/2001 (published in *Epitheorisi Emporikou Dikaiou – Commercial Law Review*, Volume 1 2003, p.159).

upper part of the rectangular frame is composed of a black background, while the word SUPERKINGS is printed horizontally in white, large, thick, capital letters next to a polygonal shield similar to the one used in the SUPERKINGS JOHN PLAYER trademark. This trademark has also been used for Class 34 products, such as processed and unprocessed tobacco, and related tobacco material used for medical or therapeutic purposes, as well as matches.

The Trademark Committee accepted the opposition and did not allow the registration of the KING'S FAVOURITES trademark because it found that the trademarks KING'S FAVOURITES and SUPERKINGS to be confusingly similar and likely to confuse the average consumer of products in the same Class.³⁶³

The Court of First Instance did not agree, and upon reviewing the Trademark Committee's decision, noted that there is a clear verbal, phonetic, and visual distinction between the trademarks. Specifically, the word SUPERKINGS is sufficiently distinguishable from the word KING'S due the prefix SUPER and the apostrophe in the word KING'S, as well as the additional words JOHN PLAYER in one of the two trademarks in question.³⁶⁴ Furthermore, the word FAVOURITES is not commonly used in the Greek vocabulary and, as such, it is sufficient to create a visual and phonetic distinction between the aforementioned trademarks. In addition, the visual part of the trademark was found to be dissimilar because it contains different colors and designs, e.g., white versus black print, one lion instead of two, vertical versus horizontal lines, etc. Thus the Court allowed the registration of the trademark KING'S FAVOURITES by House Of Prince A/S.

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

A.E. K. Basiakos applied to register the trademark BA-CO for products in International Class 9, and in particular for electrical switches, outlets, and other related electrical materials. Baco Constructions Electriques anct. Baungarten filed an intervention against the approval of the application on the grounds that it is visually and phonetically similar to its own trademark BACO that was registered in France in 1965 and subsequently registered in other countries, and has enjoyed commercial reputation in Greece since 1972.

The Trademark Committee allowed the registration of the BA-CO trademark because it determined that BACO products had

363. Decision No. 8166/1999 of the Trademark Committee (unpublished).

364. Administrative Court of First Instance of Athens, Decision No. 6519/2002 (unpublished).

been circulating in the Greek market since 1988 while BA-CO products had been circulating there since 1980.³⁶⁵

Upon review of that decision, the Court of First Instance did not agree.³⁶⁶ Instead, it found that the circulation of BACO products in the Greek market in fact started in 1972, while the circulation of BA-CO products in the Greek market began in 1973. This finding was substantiated by 1) evidence of correspondence between Baco Constructions Electriques anct. Baungarten and its Greek licensee, Stylva & Co starting in 1972, which provided a list of BACO products to be distributed by Stylva & Co in the Greek market; 2) copies of Trademark Registration Certificates for BACO in France, the USA, Canada, Korea, Ireland, India; and 3) a copy of a decision of the French administrative authority whereby the application for registration of the trademark CO-BA by A. E. K. Basiakos was denied because the mark was found to be confusingly similar to the mark BACO. Thus, the Greek Court did not allow the registration of the BA-CO trademark on the ground that the owner of the BACO trademark had priority due to prior use/reputation in Greece and registration in other countries.

III.A.11.a. No Similarity of Marks

D. Sofronas Co. filed a petition for injunctive relief to enjoin L'Oreal S.A from using the trademark OPEN on its hair coloring products. As grounds, D. Sofronas Co. asserted that the same trademark was registered by D. Sofronas Co. for use on cosmetic products, namely, shampoo, conditioner, shower cream, and nail polish remover in International Class 3.

The petitioner argued that the similarity of products, in conjunction with the slavish imitation of its mark, would likely confuse the average consumer. The Court of First Instance did not agree.³⁶⁷ Instead, it held that the word OPEN to be merely descriptive of the product's purpose when used in conjunction with the word COLOR. The word OPEN literally translated in Greek may also mean to "lighten" the consumer's hair color. In addition, the fact that the name L'Oreal Paris is clearly written on the packaging was certainly a distinguishing factor for these products and, therefore, the average consumer would not be confused.

365. Decision No. 8083/1999 by the Trademark Committee (unpublished).

366. Decision No. 5051/2002 of the Administrative Court of First Instance (unpublished).

367. Court of First Instance, Decision No. 1159/2003.