

~~In short and contrary to some speculations the
aforementioned decisions do not amount to a significant change in
the existing case law. Liability arising from unjustified cease and
desist letters alleging trademark infringements continues to be
limited to cases of negligence, which cannot always be assumed
where a trademark owner misjudges the scope of protection (or, as
in the present case, even the permanent validity) of its mark.⁴⁷³~~

GREECE

I.B.3. Not Merely Descriptive Terms

The Athens Administrative Court of First Instance affirmed the Administrative Trademark Committee's acceptance of the application filed by Tong Yang Confectionery Corporation for registration of the trademark CHOCOPIE, covering chocolates, ice creams, wafers, candy, gum, and other goods in International Class 30.⁴⁷⁴ The Court held that the mark was not merely descriptive. Accordingly, it dismissed the recourse against the Committee's acceptance filed by Lotte Confectionery Co. Ltd., a firm with headquarters in South Korea.⁴⁷⁵

Lotte had opposed Tong Yang's application on the grounds that the mark (1) was merely descriptive; (2) had no distinguishing ability; and (3) should not be protected as a trademark because that would confer on the applicant the unfair advantage of a monopoly on a descriptive term, when CHOCOPIE should be left to be freely used by all as a common term. In addition, the opponent had submitted evidence reflecting the rejection of applications for registration of the mark in other jurisdictions, which had deemed it to be a merely descriptive term.

The Administrative Trademark Committee had not been convinced. It found that in fact the mark at issue had distinguishing ability. Therefore, it dismissed Lotte's opposition and allowed the trademark CHOCOPIE to proceed to registration.⁴⁷⁶

Tong Yang thereupon filed recourse with the Administrative Court of First Instance. It reiterated its argument concerning the descriptive nature of the mark, citing as support decisions from other jurisdictions affirming that assertion.

473. German Federal Supreme Court, decision of January 19, 2006, GRUR 432 (2006).

474. Athens Administrative Court of First Instance, Decision No. 2294/2005, issued October 19, 2005.

475. Recourse Filing No. 11729/2000, filed February 2, 1999.

476. Administrative Trademark Committee, Decision No. 6920/1998, issued November 4, 1998.

Regardless, the Court affirmed the Committee's decision. It reasoned, among other things, that, notwithstanding conflicting decisions from such jurisdictions as Guatemala, Korea, and Germany, in Greece the word elements CHOCO and PIE did have distinguishing ability, given that they were of foreign origin and as such had not been integrated into the Greek language. This finding was further supported by the fact that the opponent did not furnish the Court any evidence reflecting its assertion that the Greek consumer public considered CHOCO and PIE to be commonplace words. Consequently, the Court of First Instance dismissed the recourse and allowed the trademark CHOCOPIE to proceed to registration.

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

Pharmacia & Upjohn A.B. (Pharmacia) applied to register a device mark in the form of a stylized cat, to cover a pharmaceutical preparation for veterinary use in International Class 5 (see below).



The Administrative Trademark Committee rejected the application on the ground that the mark lacked distinctive character.⁴⁷⁷ Pharmacia filed recourse before the Athens Administrative Court of First Instance.

In its decision the Court took into consideration the fact that Pharmacia's trademark had been registered since 1996 in various other countries for goods in Class 5. It found that the device distinguished the veterinary character of the covered goods, and therefore was capable of identifying Pharmacia as the origin of those goods.

Accordingly, the Court of First Instance reversed the Committee's decision and allowed the mark to proceed to registration.⁴⁷⁸

I.B.8. Likelihood of Confusion

The Greek company Farmaten E.p.e. submitted an application for registration of the word mark FAMADOL, for pharmaceutical

⁴⁷⁷. Administrative Trademark Committee, Decision No. 3157/2001, issued April 9, 2001.

⁴⁷⁸. Athens Administrative Court of First Instance, Decision No. 8482/2005, issued September 23, 2005.

products in International Class 5. The Administrative Trademark Committee accepted the application.⁴⁷⁹

Sterling Winthrop Group Limited, a British firm, filed an opposition on the basis of its prior trademark registrations for PANADOL, PANADOL EXTRA, PANADOL VITAMIN-C, and PANADOL NIGHT TIME PAIN, covering various pharmaceutical products in Class 5. Sterling alleged that the FAMADOL mark was visually and aurally similar to its registrations for PANADOL because the order of their letters was similar and their suffixes were identical; therefore, it argued, the opposed mark presented a likelihood of confusion of consumers as to the origin of the covered goods. The Administrative Trademark Committee, however, rejected the opposition on the ground that there was not sufficient similarity between the marks under comparison to cause confusion.⁴⁸⁰

Upon recourse by SmithKline Beecham P.L.C., which in the meantime had acquired the aforementioned PANADOL trademarks, the case was brought before the Athens Administrative Court of First Instance. SmithKline alleged that the similarity between its marks and the opposed mark FAMADOL was very close, and that it was made stronger by the close aural similarity of the letters M and N, the difference between the initial letters F and P not being sufficient to differentiate the marks from each other. SmithKline also stressed the fact that the pharmaceuticals sold under the PANADOL trademarks had been used for many years and were very well known to consumers.

The Court accepted that the distinguishing feature of the plaintiff's trademarks was the term PANADOL. Confirming SmithKline's allegations regarding the similarity between the marks under comparison, the Court underlined the fact that the goods covered were also similar. It emphasized, further, that the goods sold under the PANADOL trademark were mainly analgesic-febrifuge (pain-relieving, fever-reducing) pharmaceuticals, which were not necessarily sold under a physician's prescription.

For those reasons the Court of First Instance reversed the decision of the Trademark Committee and rejected the trademark application for FAMADOL. The Court so ruled notwithstanding the fact that the goods to be covered were pharmaceuticals and that, as recorded in both the literature and the jurisprudence, trademarks covering such goods had been accepted for registration

479. Administrative Trademark Committee, Decision No. 2627/2000, issued August 21, 2000.

480. Administrative Trademark Committee, Decision No. 2222/2002, issued March 12, 2002.

even though their differences from prior registrations were very slight.⁴⁸¹

I.B.8.a. Similarity of Marks

Mustang Bekleidungswerke GmbH & Co. KG, a German company, applied to register the word mark HERMANS, covering eyeglasses; sunglasses; disks; compact disks; audiovisual cassettes; magnetic image and sound carriers; data carriers with computer programs, especially computer games; apparatus for recordal, reproduction, and transmission of sound or images; goods of leather and imitations of leather, namely bags and other containers; small goods of leather, in particular purses, pocket wallets, key wallets, and leather labels; handbags; schoolbags; trunks; travel bags; umbrellas; parasols; and mens-, womens-, and childrenswear, including sports clothes, belts, hats, and shoes, in International Classes 9, 18, and 25. The application was accepted by the Administrative Trademark Committee.⁴⁸²

The French company Hermès International filed an opposition based on its prior trademark registrations for HERMÈS, dating back to 1980 and covering goods in Classes 9, 18, and 25. Hermès claimed that the opposed mark (1) had five letters in common with its own marks, thus giving a similar overall aural and visual impression; (2) had been filed in bad faith, given that Hermès' trademarks were famous; and (3) infringed Hermès' company name, which was protected by Article 8 of the Paris Convention.⁴⁸³ Mustang then proceeded to limit the specification of goods to be covered by its trademark by deleting eyeglasses, sunglasses, disks, audiovisual cassettes, and magnetic image and sound carriers from Class 9, and trunks, travel bags, umbrellas, and parasols from Class 18.

The Administrative Trademark Committee rejected the opposition on the grounds that there was sufficient dissimilarity between the marks, because the word HERMÈS was pronounced and understood as the Greek word ΕΡΜΗΣ (ERMIS), one of the gods of the ancient Greeks, and that the word HERMANS was totally imaginary.⁴⁸⁴

Upon recourse, the Athens Administrative Court of First Instance reversed the Committee's decision and accepted Hermès'

481. Athens Administrative Court of First Instance, Decision No. 11978/2005, issued October 10, 2005.

482. Administrative Trademark Committee, Decision No. 3135/1996, issued September 29, 1997.

483. Article 8 provides: "A trade name shall be protected in all the countries of the [Paris] Union without the obligation of filing or registration, whether or not it forms part of a trademark."

484. Administrative Trademark Committee, Decision No. 3780/2001, issued May 4, 2001.

opposition.⁴⁸⁵ The Court took into consideration the fact that (1) the opposed mark consisted of seven letters (Hermès' trademarks consisted of six), of which the first four, as well as the final S, were identical to the letters of the HERMÈS trademarks and appeared in the same order; and (2) neither the different linguistic background of the words HERMÈS and HERMANS, nor the Greek origin of the word HERMÈS, had an impact on the visual and aural impression conveyed by the marks, because in the Greek consumer's mind both words were foreign and, thus, similar.

In light of the above, the Court of First Instance held that the overall visual and aural impression given by the marks under comparison was similar, and it rejected Mustang's trademark application for HERMANS.

Maspex Spółka z.o.o., a Polish company, applied to register the word mark LA FESTA, covering coffee, cappuccino coffee, coffee substitutes, chocolate, dietetic chocolate beverages, cocoa, chocolate instant beverage, hot chocolate instant beverage, tea, and instant tea in International Class 30. The Administrative Trademark Committee accepted the application.⁴⁸⁶

The Italian company Ferrero S.p.A. filed an opposition based on its prior trademark registrations for FIESTA FERRERO and FIESTA & Device, covering coffee, tea, cocoa, sugar, coffee substitutes, bread, ice cream, etc., in Class 30. The Administrative Trademark Committee accepted the opposition on the grounds that the opposed mark was similar to Ferrero's prior-registered trademarks and that it was filed in bad faith.⁴⁸⁷ Maspex then filed recourse with the Athens Administrative Court of First Instance.

The Court determined that (1) the marks under comparison had in common the letters F, E, S, T, and A, the letter I constituting a difference of minor importance; (2) the addition of the article LA ("THE") did not give the applied-for mark sufficient distinctive power; (3) the marks covered the same goods; and (4) the fact that the marks coexisted in many countries did not prove that they were different.

The Court of First Instance held that there was a risk of consumer confusion as a result of the marks' significant phonetic and visual similarity. It therefore rejected Maspex's recourse and upheld the decision of the Trademark Committee.⁴⁸⁸

485. Athens Administrative Court of First Instance, Decision No. 15394/2004, issued December 27, 2004.

486. Administrative Trademark Committee, Decision No. 47/2001, issued April 20, 2001.

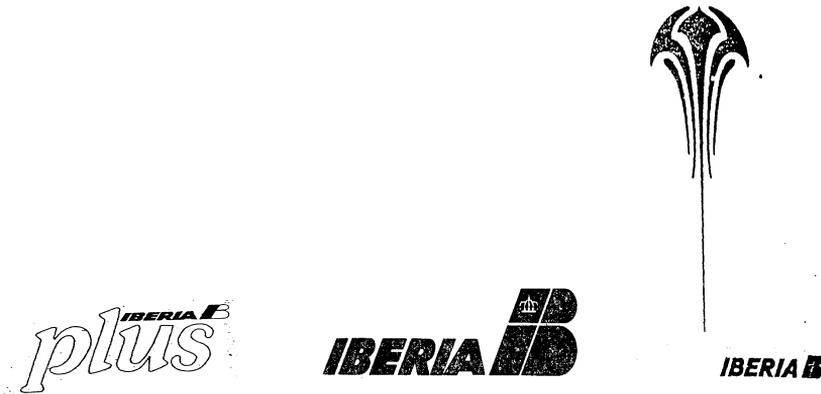
487. Administrative Trademark Committee, Decision No. 4539/2002, issued July 9, 2002.

488. Athens Administrative Court of First Instance, Decision No. 12486/2005, issued September 26, 2005.

I.B.9. No Likelihood of Confusion

Markant Handels- und Service GmbH, a German company, applied for the registration of the word mark IBERIANA, to cover goods in International Classes 29, 31, and 32 and services in Classes 35, 39, and 41. The application was accepted by the Administrative Trademark Committee.⁴⁸⁹

The national air transport carrier of Spain, Iberia, filed opposition based on its various trademark registrations for IBERIA & Design (see below).⁴⁹⁰ Iberia argued that the IBERIANA mark was confusingly similar to the airline's series of famous marks, as it contained their basic and distinguishing feature of origin, IBERIA, and covered similar services in Classes 35 and 39.



The Committee rejected the opposition.⁴⁹¹ It found that (1) the overall visual and phonetic impression given by the opposed mark IBERIANA was sufficiently different from the impression created by the IBERIA marks and that the services in the coinciding classes covered by the respective parties' marks were also different, as the services covered by the IBERIANA mark in Class 35 related to fruits and vegetables and those in Class 39 to transportation of goods for everyday needs, and none of these services were covered by Iberia's trademarks; (2) although Iberia was one of the international airlines that were active in Greece, its trademarks did not qualify as famous marks; and (3) as the trademark IBERIANA had been registered since June 13, 1994, for services in Classes 35, 39, and 41 in Germany, Markant's country of origin, where it was not considered as creating a likelihood of confusion with Iberia's trademarks, which were also known in that

489. Administrative Trademark Committee, Decision No. 11517/1995, issued May 13, 1997.

490. Opposition Filing No. 2823/1997, filed October 15, 1997.

491. Administrative Trademark Committee, Decision No. 6069/1998, issued October 1, 1998.

country, by virtue of the “*telle quelle*” clause of the Paris Convention⁴⁹² a stricter standard of scrutiny could not be applied in another member state of the Paris Convention.

Upon recourse filed by Iberia,⁴⁹³ the Athens Administrative Court of First Instance upheld the decision of the Administrative Trademark Committee.⁴⁹⁴ The Court reasoned that the trademarks under comparison were sufficiently different. Specifically, the addition of the suffix -NA in the opposed mark, and of the letter B and the word PLUS in two of the opponent’s marks, created a different overall impression, and hence the marks were not likely to cause confusion among consumers. The Court also found that adding the suffix -NA to the word IBERIA caused a change in the accent (IBERIÁNA instead of IBÉRIA), which altered the phonetic impression made by the opposed mark. The differences in the services covered by the marks under comparison provided further support for the Court of First Instance’s determinations.

Iberia appealed the decision of the Court of First Instance.

The Athens Administrative Court of Appeals affirmed the findings of the lower court.⁴⁹⁵ While it recognized that the differences in the services covered by the respective marks should not, per se, be decisive in determining whether the IBERIANA trademark application had been filed in bad faith, the Court of Appeals held that the IBERIA marks, albeit known in Greece and associated with the Spanish national airline, did not qualify as famous and that the differences in the impression created and the services covered by the marks under consideration were sufficient to ensure that any risk of consumer confusion was averted.

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

Reckitt Benckiser N.V. (previously known as Benckiser N.V.) applied for the registration of the word mark MARC, to cover (1) chemical products for industrial purposes, descaling agents, and water softeners in International Class 1; and (2) bleaching preparations and other substitutes for laundry use; cleaning, polishing, scouring, and abrasive preparations; detergents; decalcifying and descaling preparations; fabric softeners; and laundry additives in Class 3. The application was accepted by the Administrative Trademark Committee.⁴⁹⁶

492. Paris Convention, art. 6*quinquies*, para. A(1).

493. Recourse Filing No. 1809/1999, filed February 26, 1999.

494. Athens Administrative Court of First Instance, Decision No. 6297/2003, issued May 27, 2003.

495. Athens Administrative Court of Appeals, Decision No. 2741/2005, issued July 5, 2005.

496. Administrative Trademark Committee, Decision No. 4436/1999, issued November 19, 1999.

The German company Merck filed an opposition, alleging that the applied-for mark resembled its famous trademark MERCK, registered in 1934 and covering goods in Classes 1, 2, 3, and 5. The Committee rejected the opposition on the grounds that the marks under comparison were visually and aurally different and that the covered goods were not the same, and therefore there was no likelihood of confusion among consumers.⁴⁹⁷

Upon recourse before the Athens Administrative Court of First Instance, Merck argued that (1) the trademark MARC resembled both its prior-registered trademark MERCK and its Community trade mark MERCK, registered in 1999 and covering goods in Classes 1 and 3; (2) its trademark had become famous and, thus, enjoyed broader protection; and (3) the trademark MARC infringed its company name, in violation of Article 8 of the Paris Convention.

The Court of First Instance upheld the decision of the Trademark Committee.⁴⁹⁸ It found that MARC, which is a male name, and MERCK were sufficiently different, as their second letters were A and E, respectively, and the last letter of MERCK was K rather than C. Moreover, the goods covered by the marks were different. Further, the Court held that Merck did not produce sufficient evidentiary material to prove the notoriety of its mark in Greece and abroad and that Article 8 of the Paris Convention was not applicable in the case of grounds for the acceptance of a trademark.

The German company Dorina Textil GmbH applied for the international registration of the word marks DORINA FREE & EASY and DORINA HAPPY BABY, covering goods in International Classes 10, 24, and 25 (below, illustrations at top). Upon examination during the national phase in Greece, both applications were accepted by the Administrative Trademark Committee for goods in Classes 10 and 24 and rejected for goods in Class 25.⁴⁹⁹ The ground for the Committee's rejection with respect to Class 25 goods was that the applied-for marks resembled the prior-registered trademark DORINASEX, covering goods in the same class (below, illustration at bottom).

497. Administrative Trademark Committee, Decision No. 3470/2001, issued June 12, 2001.

498. Athens Administrative Court of First Instance, Decision No. 4315/2005, issued March 23, 2005.

499. Administrative Trademark Committee, Decision No. 8709/2001, issued September 27, 2001; Decision No. 9665/2001, issued October 10, 2001.

DORINA
free & easy

DORINA
happy baby



Upon recourse,⁵⁰⁰ the Athens Administrative Court of First Instance held that the trademarks under comparison were sufficiently different, in that the applied-for marks comprised three words, with the word DORINA in a special typeface and the words FREE & EASY and HAPPY BABY in lowercase, smaller-size letters, whereas the opposing mark comprised two words that appeared to be written as one, in a special script typeface, and that were accompanied by a characteristic device.

The Court of First Instance concluded that the visual and phonetic impression given by the marks DORINA FREE & EASY and DORINA HAPPY BABY was different from that given by DORINASEX, despite the fact that they had the word DORINA in common and were not likely to cause confusion among consumers as far as the origin of the goods was concerned. Consequently, the Court allowed the opposed marks to proceed to registration.⁵⁰¹

Elf Aquitaine, a French company, applied for the international registration of the trademark €CO & Device, to cover industrial oils and greases, lubricants, fuels, and petrol products in Class 4 (below, illustration at left).

Upon examination during the national phase in Greece, the application was rejected by the Administrative Trademark Committee, on the ground that the applied-for mark resembled the prior-registered Greek trademarks EKO & Seahorse Device, also covering, *inter alia*, goods in Class 4 (below, illustration at right).⁵⁰²



500. Recourse Filing Nos. 16473/2002 and 16474/2002, filed June 27, 2002.

501. Athens Administrative Court of First Instance, Decision Nos. 13170/2005 and 13171/2005, issued October 31, 2005.

502. Administrative Trademark Committee, Decision No. 9663/2001, issued October 10, 2001.

The Committee's decision was brought for reexamination at the initiative of Elf Aquitaine, which filed recourse before the Athens Administrative Court of First Instance.⁵⁰³ After reevaluating the facts before it, the Court reversed the Committee's decision and held that the trademarks under comparison were sufficiently different. The applied-for mark was in Roman letters and its initial letter was the character € , whereas the opposing marks were in Greek letters, with the initial letter E in a larger font, and were accompanied by a seahorse device.

The Court of First Instance concluded that the overall visual and phonetic impression given by the trademark €CO & Device and the prior-registered trademarks EKO & Seahorse Device was sufficiently different and that the marks under comparison were not likely to cause confusion among consumers despite the fact that they covered similar goods in the same class. Accordingly, it accepted the applied-for mark for registration.⁵⁰⁴

Interestingly, the Court did not deem it necessary to examine the special character used for the first letter of the new trademark: the symbol €, which is identical to the symbol used to denote the euro currency unit.

I.B.12. Famous Marks

The Athens Administrative Court of First Instance reversed the Administrative Trademark Committee's decisions partially accepting the applications for four CITI+ marks filed by a Greek company and granted the related recourses filed by the American firm Citigroup (which comprises Citibank N.A. and Citicorp).

In 1999, the Greek company Citishop—Electronics Merchandise and Electrical Appliances had filed applications for registration of four new trademarks, all containing the word element CITI- as their prefix: CITIPRICE, CITICHECKUP, CITIBILLS, and CITISMILE. All the applications covered goods or services in International Classes 9, 14, 16, and 38. Each mark included some descriptive terms in Greek, depending on the type of goods or services it was intended to cover, as well as minor, cartoon-like devices of mobile phones.

At first instance, the Administrative Trademark Committee, pursuant to related oppositions filed by Citigroup, partially rejected the four applications, allowing the marks to proceed to registration in Classes 14 and 38 and refusing them registration in Classes 9 and 16.⁵⁰⁵ In the Committee's opinion, although the

503. Recourse Filing No. 16464/2002, filed June 27, 2002.

504. Athens Administrative Court of First Instance, Decision No. 13731/2005, issued November 22, 2005.

505. Administrative Trademark Committee, Decision Nos. 4923/2004–4928/2004, issued May 6, 2004.

applied-for marks were confusingly similar to the well-known CITI+ series of marks of CITIGROUP, a risk of confusion existed only with regard to the conflicting classes (9 and 16). Any potential risk of confusion with respect to the other, non-coinciding classes was mitigated by the fact that none of Citigroup's CITI+ marks actually covered goods in Class 14 or services in Class 38 and there was no proximity of the goods and services actually covered by the applicant's marks to those covered by the opponent's marks. Therefore, consumers were not considered likely to be misled where telecommunications or watches, which were not covered by Citigroup's series of marks, were concerned.

Citigroup filed recourses requesting the Court of First Instance to dismiss the Greek company's four trademark applications in Classes 14 and 38 as well, primarily on the basis of the fame of its CITI+ marks and notwithstanding the fact that the particular classes applied for did not coincide with any of the classes covered by its numerous CITI+ marks.⁵⁰⁶ In substantiating this "claim to fame," Citigroup argued, *inter alia*, that, based on the evidence submitted, its CITIBANK mark was rated as one of the 75 most valuable marks worldwide, and that fact, in itself, indicated the fame of its CITI+ marks (aside, of course, from the apparently endless list of CITI+ marks registered and used around the globe). It argued, moreover, that, given today's business realities, the expansion of its activities in various fields would lead consumers to assume that the applied-for goods and services (horological and chronometric instruments and watches, and telecommunications) were part and parcel of those activities. Therefore, Citigroup contended, the onus should be on the Greek company to disprove any allegations of risk of confusion between the applied-for marks and Citigroup's world-famous CITI+ marks.

In examining the merits of the case, the Court momentarily went beyond the facts before it and drew a significant distinction between the direct and indirect risks of confusion. It held that the direct risk was the obvious, evident resemblance of the marks at issue to the earlier-registered marks, which, despite minor differences between the marks, was nonetheless capable of creating confusion in the mind of the average consumer as to the origin of the products involved.

The indirect risk of confusion, on the other hand, stemmed primarily from the subconscious perception of the average Greek consumer, who might, in the circumstances, appreciate that the particular products or services applied for did not, or could not, originate from the company that owned the prior-registered mark,

506. Recourse Filing Nos. 28017/2004–28019/2004 and 28023/2004, filed July 7, 2004. Separate recourses with respect to each of the four trademark applications were filed for Citibank N.A. and Citicorp.

but nonetheless might reasonably assume that there was some financial or legal nexus between the two companies.

Although Greek trademark law does not expressly mention the indirect risk of confusion as a factor to be considered in determining the admissibility of trademark applications, the Court deemed both the direct and the indirect risks of confusion to be of equal importance. This finding followed from the Court's interpretation of a combination of relevant provisions of Greek trademark law and upheld related precedent from the Greek Supreme Administrative Court (Council of State) as well as the European Court of Justice.

In applying the above legal principle to the facts before it, the Court was satisfied that the dispute under review involved a real, albeit indirect, risk of confusion, given that the classes of goods and services respectively covered did not entirely coincide.

The Court went on to examine the fame and goodwill associated with the CITI+ series of trademarks owned by Citigroup. After tracing the long history of Citigroup, which was founded nearly two centuries ago (1812), and its operations in Greece, which commenced in 1964, the Court was convinced that Citigroup's CITI+ series of marks enjoyed extended fame and notoriety in Greece and were therefore subject to special protection, as they derived in part from Citigroup's famous company name, which itself contained the Citi- prefix.

Notwithstanding the fact that the purported trademark applications were filed by an applicant whose own company name (Citishop) contained the prefix Citi-, the Court was satisfied that Citigroup was sufficiently shielded by its older, world-famous company name, and fortified as well by its globally famous CITI+ series of marks, including, but not limited to, CITIBANK, CITICORP, CITIGOLD, CITIFREEDOM, CITICASH, CITIDIRECT, CITIPHONE, CITIBUSINESS, CITIPAY, and CITIFUND.

It was obvious to the Court, after examining the trademark applications under review, that the dominant element of each mark was the prefix CITI- and that the remaining word and device elements were not sufficiently distinct to differentiate them, to a satisfactory extent, from Citigroup's famous, prior-registered CITI+ marks. The Court therefore held that the applied-for marks, all of which contained the word element CITI- as their prefix, were confusingly similar to the well-known series of CITI+ marks owned by Citigroup and as such had to be denied registration, despite the fact that the classes of goods and services covered by the respective marks did not coincide.

In light of all the above, the Court of First Instance held that there was a real and sufficiently detrimental risk of confusion—albeit indirect, considering the non-coinciding classes involved—

given the extended goodwill associated with the CITI+ marks of Citigroup. Accordingly, the Court refused the registration of the applied-for marks and granted the related recourses filed by Citigroup.⁵⁰⁷

The Athens Administrative Court of First Instance reversed the cancellation of the trademark registration for HENDI BAGS in the name of the company Sanitas–Sanitas S.A.⁵⁰⁸ The Court held that the mark at issue, covering food bags in International Class 16, was not confusingly similar to the well-known registered trademark FENDI, for goods in Classes 3, 16, 18, 24, and 25. Accordingly, it granted the recourse filed by the applicant for acceptance of its mark.⁵⁰⁹

Fendi S.r.L., with headquarters in Italy, filed an intervention against the acceptance of the filed recourse and ultimately for the dismissal of the trademark application for HENDI BAGS.

In reviewing the facts, the Administrative Court of First Instance held that the HENDI BAGS trademark specifically aimed to distinguish food bags sold in supermarkets, etc. As such, the likelihood of confusion of said mark with the well-known designer-brand bags was averted. In any case, the Court ruled, the HENDI BAGS mark was sufficiently distinct from the FENDI mark, as it also included the word BAGS, which is not incorporated in the Greek vocabulary and as such is not per se a descriptive term.

The Court of First Instance therefore granted the applicant's recourse and allowed the HENDI BAGS trademark to proceed to registration.

III.A.1. Famous Marks

The Administrative Court of First Instance of Athens reversed the decisions of the Administrative Trademark Committee⁵¹⁰ and revoked the cancellations of the trademark registrations for several brick elements (device marks) in the name of the Lego Group, based in Denmark.⁵¹¹ The cancellation petitions⁵¹² were filed by Lego's great Canadian rival, Ritvik, against the LEGO trademarks consisting solely of the devices depicted in the photos below.

507. Athens Administrative Court of First Instance, Decision Nos. 15347/2005–15354/2005, issued December 22, 2005.

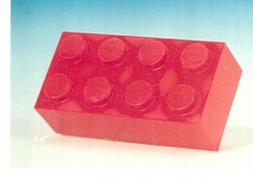
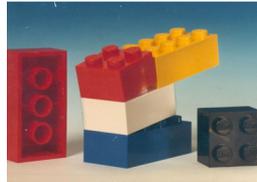
508. Athens Administrative Court of First Instance, Decision No. 6991/2005, issued January 12, 2006.

509. Recourse Filing No. 25098/2001, filed December 7, 2001.

510. Administrative Trademark Committee, Decision Nos. 5335/2001–5337/2001, issued July 2, 2001.

511. Athens Administrative Court of First Instance, Decision Nos. 15920/2005–15922/2005, issued December 29, 2005.

512. Cancellation Petition Nos. 8384/2000–8386/2000, filed September 4, 2000.



The Court held that the marks in question, which did not contain any word elements whatsoever, were neither functional nor common, and had retained their distinguishing ability throughout their long use in the Greek market.

The Court of First Instance revoked the Committee's decision to cancel the trademark registrations. The related cancellation petitions were based on several grounds, including non-use, and also on grounds of nonadmissibility (which are ordinarily used for oppositions but may also be included in certain cancellation petitions), such as lack of distinguishing ability, purely functional shape mandated by the nature of the product itself, commonly used design, etc.

Ritvik also made an unfair monopoly claim for the above reasons. It asserted that Lego sought the protection of such trademarks in bad faith and only for the purpose of enjoying an unfair monopoly of what it alleged to be commonly used bricks, whereas Lego allegedly knew that said bricks were not subject to protection because of their lack of distinguishing character.

The Court dismissed all of Ritvik's non-use claims and allegations against Lego and went into great detail in examining the merits of the case in question. In doing so, it established some very useful guidelines for determining similar trademark disputes.

First, by examining the spirit of the law and applying the relevant provisions of the Trademark Law to the facts of the dispute, the Court held that, when determining whether a trademark has been filed in bad faith, what should be taken into consideration is the circumstances and the applicable law in force at the time the application was actually filed, and *not* the circumstances and applicable law in force at the time a subsequent cancellation petition was filed.

In light of the above, the Court considered that, in 1984, when the relevant trademark applications were filed, there was no question as to the admissibility of the trademark devices in question, as there was no dispute over the originality or distinctiveness thereof. As such, Ritvik's allegation that Lego's applications for the particular trademarks were filed in bad faith (i.e., that Lego knew that said trademarks were inadmissible but nonetheless filed applications for them) was deemed unsubstantiated based on the facts. This was because no

oppositions or cancellations were ever filed against the particular trademarks by Ritvik or any other party with a legitimate interest.

Interestingly, the Court also drew a distinction between, on the one hand, a bad-faith filing, which relates to the applicant's bad faith per se and can be substantiated by proving, *inter alia*, that the applicant was aware of the fact that the trademark filed at the time would confer upon him an unfair advantage, and, on the other hand, a filing that contravenes the principle of good faith, for the establishment of which no showing of bad faith on the part of the applicant is required.

In fact, by reviewing several other related litigations initiated by Lego, the Court found that in reality it was Lego's competitors that had acted in bad faith by continually trying to copy the LEGO trademarks, and that Lego was by no means trying to engage in any unfair monopoly, or act in bad faith, but, rather, was only aiming to protect its lawful rights.

The Court of First Instance also dismissed the argument put forward by Ritvik that Lego used its trademark devices in its packaging boxes and brochures along with the names LEGO and LEGO SYSTEM, and that such use allegedly proved Lego's own conviction that its trademark devices were unable to distinguish the LEGO products alone without the presence of the LEGO name. Instead, the Court found that the particular manner of using the LEGO trademarks exhibited prudence on the part of Lego, whose intention was to avoid any risk of confusion between its products and the imitative products of its competitors, which had flooded the market and which were, as deemed appropriate, the subject matter of relevant infringement litigation.

Last, the bad faith argument, allegedly proven by the fact that Lego filed the particular trademark applications six years after the lapse of its relevant patents, was dismissed by the Court as irrelevant, as the nature of a trademark right is sufficiently distinct from that of a patent right.

The French company Hermès International (Hermès), also known by its distinguishing title Hermès, is the owner of numerous well-known trademark registrations and applications in Greece and worldwide. Hermès filed a Main Infringement Action before the Civil Court of First Instance of Athens against Ermis (Hermes) Bali Issagogiki-Exagogiki, a Greek company that trades in clothing, furniture, and decorative items in Athens.⁵¹³ The defendant had been using the word ΕΡΜΗΣ ("HERMES") in both Greek and Roman letters in its company name and as a trademark on its products, labels, and advertising material. The action was filed on the grounds that, *inter alia*, the particular company name

513. Main Infringement Action Filing No. 3634/1999, filed January 22, 1999.

infringed Hermès' own company name and prior trademark registrations and violated the provisions of Greek trademark law and unfair competition law. The Court of First Instance rejected the action.⁵¹⁴

Upon appeal filed by Hermès,⁵¹⁵ the Athens Civil Court of Appeals reversed the Court of First Instance and upheld the plaintiff's contentions.⁵¹⁶ The basis for the appellate court's decision was that the word HERMES or ΕΡΜΗΣ, which had been used by the defendant on its merchandise, labels, and brochures, was a slavish imitation of the Hermès' distinguishing title and marks, given that the version of the word in Roman letters coincided with the plaintiff's word mark and company name and the Greek version was nothing more than the Greek attribution of the same. Thus, the defendant's use of the word ΕΡΜΗΣ or HERMES constituted an intentional slavish imitation of the plaintiff's word mark and company name. The Court further found that by using the word ΕΡΜΗΣ or HERMES in its company name as a distinguishing title, the defendant had obviously and directly infringed the plaintiff's exclusive rights in the word HERMES.

The Court of Appeals revoked the lower court's decision and issued an order enjoining the respondent from using the word HERMES, either in Latin or in Greek, in its own company name and distinguishing title on its labels, its merchandise, its advertising material, or any of its stationery. The Court also ordered the seizure and destruction of all of the plaintiff's labels, merchandise, advertising material, etc., bearing the word HERMES or ΕΡΜΗΣ.

III.A.2.b. Similarity of Marks

The Rhodes Multi-Member Court of First Instance granted the Main Infringement Action⁵¹⁷ filed by the British firm Wm Morrison Supermarkets PLC (Morrison) against Michael Hatzinikolas, an individual located in Rhodes, for infringement of the company's trademark rights.⁵¹⁸

Morrison owns a well-known supermarket chain in the United Kingdom under the main brands MORRISONS and MORRISONS & M Device.

514. Athens Multi-Member Civil Court of First Instance, Decision No. 1540/2005, issued March 16, 2005.

515. Appeal Filing No. 7343/2005, filed August 31, 2005.

516. Athens Three-Member Civil Court of Appeals, Decision No. 2461/2006, issued April 7, 2006.

517. Main Infringement Action Filing No. 1154/2004, filed December 22, 2004.

518. Rhodes Multi-Member Court of First Instance, Decision No. 121/2006, issued April 17, 2006.

Mr. Hatzinikolas owned a grocery store on the island of Rhodes in the area of Faliraki, which is frequently visited by British tourists. At the front of his store, Mr. Hatzinikolas had erected a sign copying the MORRISONS logo; the shopping bags distributed to his customers bore Morrison's mark MORRISONS & M Device. As a result, British tourists who visited Faliraki and saw the MORRISONS sign were expectedly confused and misled into believing that Mr. Hatzinikolas's store was a Greek branch of the well-known British supermarket chain.

Morrison became aware of this infringement from questions addressed to the company by its clients, who had visited the island of Rhodes, discovered Mr. Hatzinikolas's store, and were inquiring whether the company was expanding its operation in Greece.

When Morrison learned of this situation, it immediately initiated legal action. Interestingly, during the hearing the Court examined the risk of confusion of the average British tourist, as the most likely visitor to that particular store, in view of its location. This deviation from the general consumer public of Greece as the threshold for establishing the risk of confusion was necessary in the circumstances, given the target group at issue.

When confronted with the facts, Mr. Hatzinikolas admitted that he was aware of the well-known brands owned by Morrison. His claim that the particular marks were not as strong or well known when he first started using them as they were at the time the action was brought was dismissed by the Court as irrelevant.

The Court of First Instance held that the fact that the marks in question were identical and the particular environment in which they were used was quite similar to that of a MORRISONS supermarket in the United Kingdom was sufficiently detrimental and capable of causing confusion of the average British tourist. The Court therefore granted Morrison's Main Infringement Action and ordered, among other things, that Mr. Hatzinikolas be enjoined from using, in any way, shape, or form, the word MORRISONS or MORRISON.

V.A. Domain Names

Microsoft Corporation successfully cancelled the domain name microsoft.gr, which had been registered by another entity of undisclosed identity.⁵¹⁹

Microsoft, with headquarters in Redmond, Washington, USA, is well known even to non-Internet users. When it attempted to register the domain name microsoft.gr in Greece, the company

519. National Telecommunications and Post Committee, Administrative Decision No. 369/40, issued December 29, 2005. Microsoft had previously been successful in a petition for injunction proceeding on the same issue. Athens Single-Member Civil Court of First Instance, Decision No. 841/2001, issued January 24, 2001. See 92 TMR 420 (2002).

discovered that the domain name had been taken by an undisclosed source. Under the relevant provisions of Greek legislation,⁵²⁰ full confidentiality can be granted to those domain name owners that opt for it.

Consequently, Microsoft filed a petition with the Public Prosecutor in order to discover the identity of the registrant. The petition was granted, and it was revealed that the registrant was Armada O.E., a personal liability company located in Athens.

The National Telecommunications and Post Committee, the Greek national authority responsible for supervising the administration of domain names, held that Armada's registration was made in bad faith and therefore violated the applicable regulations on the administration of .gr domain names, as there were no legal rights attached to this particular registration. It held, further, that the respondent's lack of use of the domain name did not eliminate the bad faith that had been found to exist.

The National Telecommunications and Post Committee granted the cancellation petition filed against the domain name orangetelecom.gr, which was initially registered in the name of the Greek company Orange Telecom International.⁵²¹ The Committee held that the domain name infringed, *inter alia*, the copyright of the well-known telecommunications company Orange Personal Communications Services (Orange PCS), as well as Orange PCS's trademarks and company name.

The copyright on the well-known ORANGE mark (consisting of the word "orange," in lowercase white characters, at the bottom of an orange square device) belonged to Orange PCS and was part and parcel of the company's intellectual property rights in the trademark and all related domain names.

Following a successful petition for injunction proceeding on the issue of the infringement of the trademark and company name, as well as the copyright,⁵²² the Committee confirmed that the only entity entitled to use the domain name orangetelecom.gr was Orange PCS, as the owner of the relevant copyright, trademarks, and well-known company name.

The National Telecommunications and Post Committee issued a decision granting the cancellation petition filed against the domain name dainese.gr, which was initially registered in the

520. National Telecommunications and Post Committee, Administrative Order No. 268/73, *superseded by* Administrative Order No. 351/76, issued May 20, 2005.

521. National Telecommunications and Post Committee, Administrative Decision No. 373/37, issued February 1, 2006.

522. Athens Single-Member Civil Court of First Instance, Decision No. 4128/2005, issued May 30, 2005. *See* 96 TMR 421 (2006).

name of the Greek company Papafilopouloi Bros. O.E.⁵²³ The Committee found that the domain name was registered in bad faith and infringed, *inter alia*, the trademarks and company name of the Italian firm Dainese.

Dainese, which is well known for its bikers' accessories, was founded in 1972. Since then it has developed a network of stores on six continents, maintaining three large retail stores in Greece alone.

Without the need for confirmation by a court decision in any preceding litigation, the Committee was able, based on the facts before it, to determine that the registration of the domain name *dainese.gr* by Papafilopouloi Bros. was done in bad faith, as the firm had no relation to Dainese, had no relevant rights in Dainese's company name, and was engaged in the same field of activity. In fact, the Greek company was selling secondhand items bearing the Italian company's trademarks.

The Committee held that the fact that Papafilopouloi Bros. was obviously aware of Dainese (as it in fact admitted), coupled with the Greek company's clear effort to extract clientele or divert online visitors from the Italian company, substantiated a finding of bad faith and provided sufficient grounds for granting the petition for cancellation.

The National Telecommunications and Post Committee granted the cancellation petition⁵²⁴ filed by Microsoft Corporation against the domain name *microsoft.com.gr*.⁵²⁵

Prologic A.E., a Greek company, applied for and registered the domain name in 2004. Prologic had absolutely no relation to, or affiliation or financial or other business nexus with, Microsoft. However, it took advantage of the fact that, with respect to .gr domain names, no showing of legitimate interest is necessary in order to allow the registration by a given entity of a particular domain name.

After considering all the facts before it, the Committee affirmed its previous judgments on similar matters, which involved both Microsoft and other entities.

In something akin to a preemptive strike, the Committee started its analysis by emphasizing that, given the extent of high-level promotion and the enormous quantity of the trademarks containing the word MICROSOFT, which is the same as Microsoft's company name, Prologic was estopped from denying

523. National Telecommunications and Post Committee, Administrative Decision No. 376/39, issued March 2, 2006.

524. Cancellation Petition No. 9092/17-3-2006, filed March 17, 2006.

525. National Telecommunications and Post Committee, Administrative Decision No. 393/30, issued June 29, 2006.

that it was aware of Microsoft prior to registering the particular domain name.

Applying the principles it had followed in similar disputes in the past to the facts of the dispute at issue, the Committee affirmed relevant precedent submitted by the petitioner, which was based primarily on similar WIPO decisions, and held that Prologic's registration of the domain name microsoft.com.gr constituted a bad-faith registration for purposes of the administrative regulations applicable in Greece.⁵²⁶ Not only did Prologic have no legal rights in the particular name, but also, as indicated by the WIPO decisions, the fact that the relevant site was inactive did not shield the defendant from liability. Quite the contrary, it constituted a clear showing of bad faith per se.

After taking into account all of the above, the Committee ordered the immediate cancellation of the domain name microsoft.com.gr in the name of Prologic A.E. so that its proper owner, Microsoft Corporation, would have the opportunity to register it.

~~HONG KONG~~

~~*I.B.8.a. Similarity of Marks*~~

~~Fujian Septwolves Group Corp. applied to register the composite mark SEPTWOLVES 七匹狼 & Device, for "tobacco; cigars; cigarettes; tobacco pipes; cigarette cases, not of precious metal; cigarette holders, not of precious metal; matches; lighters for smokers; cigarette filters; cigarette paper; [and] smokers' articles" in International Class 34 (below, illustration at left), pursuant to the old Trade Marks Ordinance (Cap. 43) (the "Ordinance").⁵²⁷~~

~~The mark was accepted after examination and was advertised in the government gazette. Longyan Cigarette Factory opposed the registration on the grounds that use of the mark would likely deceive or cause confusion among consumers and that the mark was not entitled to protection in a court of justice under Section 12(1) of the Ordinance. The opponent's composite mark SEPTWOLVES 七匹狼 & Device (below, illustration at right) was nearly identical to the applicant's mark.~~

⁵²⁶. National Telecommunications and Post Committee, Administrative Order No. 351/76, issued May 20, 2005.

⁵²⁷. ~~Application No. 200117507, filed October 26, 2001.~~