

International Comparative Legal Guides



Trade Marks 2020

A practical cross-border insight into trade mark work

Ninth Edition

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ISBN 978-1-83918-032-3
ISSN 2049-3118

Published by

glg global legal group

59 Tanner Street
London SE1 3PL
United Kingdom
+44 207 367 0720
info@glgroup.co.uk
www.iclg.com

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Printed by
Ashford Colour Press Ltd.

Cover image
www.istockphoto.com

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International Comparative Legal Guides

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This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.

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From the Publisher

Dear Reader,

Welcome to the ninth edition of *The International Comparative Legal Guide to: Trade Marks*, published by Global Legal Group.

This publication provides corporate counsel and international practitioners with comprehensive jurisdiction-by-jurisdiction guidance to trade mark laws and regulations around the world, and is also available at www.iclg.com.

This year, there are two expert chapters which provide an overview of online intermediary liability and trade mark infringement and the overlap between trade mark and design rights from an Indian perspective.

The question and answer chapters, which in this edition cover 48 jurisdictions, provide detailed answers to common questions raised by professionals dealing with trade mark laws and regulations.

As always, this publication has been written by leading trade mark lawyers and industry specialists, for whose invaluable contributions the editors and publishers are extremely grateful.

Global Legal Group would also like to extend special thanks to contributing editor Nick Aries of Bird & Bird LLP for his leadership, support and expertise in bringing this project to fruition.

Rory Smith
Group Publisher
Global Legal Group

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Eleni Papacharalambous



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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Intellectual and Industrial Property Section of the Registrar of Companies and Official Receiver.

1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is:

- the Trade Marks Law, Cap. 268, as amended by Law No. 63 of 1962, 69 of 1971, 206 of 1990, 176(I) of 2000 and 121(I) of 2006;
- the Control of the Movement of Goods Infringing Intellectual Property Rights Law No. 61(I)/2018;
- the Law Ratifying the Paris Convention on the Protection of Industrial Property No. 63/1965 and 66/1983;
- the Trade Mark Law Treaty Ratifying Law No. 12(III)/1996;
- the Madrid Agreement concerning the International Registration of Marks, Ratifying Law No. 3(III)/2003;
- the Protocol relating to the Madrid Agreement concerning the International Registration of Marks Ratifying Law No. 4(III)/2003; and
- the Council of Ministers Regulations issued between 1951 and 2015.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Any sign capable of being reproduced graphically (particularly in words, including personal names, designs, letters, numbers, the shape of products or of their packaging or any combination of these), that is capable by itself of distinguishing the goods or services of one undertaking from those of other undertakings, provided that this sign is used or will be used for the purposes of such distinction (section 2(1) of Cap. 268), can be registered as a trade mark.

2.2 What cannot be registered as a trade mark?

According to section 11 of Cap. 268, trade marks will not be registered if:

- They fall outside the legal definition of a trade mark.

- They lack distinctiveness.
- They consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods, provision of the services or other characteristics of the goods or services.
- They consist exclusively of signs or indications that have become customary in the current language or in the *bona fide* established practices of the trade for designating the goods or services.
- They consist exclusively of:
 - i) the shape which follows the very nature of the goods;
 - ii) the shape necessary to obtain a technical result; or
 - iii) the shape that gives substantial value to the goods.
- They are of such a nature as to deceive the public, especially with regard to the nature, quality or geographical origin of the goods or services.
- They are unacceptable or void under Article 6 *bis* of the Paris Convention for the Protection of Industrial Property.
- They include a sign of great symbolic importance, like a religious symbol.
- They are trade marks for which applications were made in bad faith.

According to section 13 of Cap. 268, a trade mark will not be registered if it is a scandalous design or if it is contrary to public policy or to accepted principles of morality.

2.3 What information is needed to register a trade mark?

The trade mark's representation (words or device or both), the Applicant's details (name, address, description, nationality), the class and the goods or services under which the trade mark seeks protection, and any priority claims. If the Applicant wishes to register a coloured trade mark, its representation will need to be in colour.

2.4 What is the general procedure for trade mark registration?

A trade mark application, including the details mentioned in question 2.3 above, is filed before the Registrar. This application must be signed by a lawyer authorised to practise in Cyprus. If the application is filed in hardcopy then it must be accompanied by a Power of Attorney Form signed and sealed (if a seal exists) by the Applicant, authorising the lawyer to file the application. However, if the application is filed via the Registrar's e-filing

system then no Power of Attorney is required. The Registrar, within approximately 10 working days from the date of receiving the trade mark application, informs the representative lawyer of the filing number of the trade mark. The Registrar then proceeds with a search (on both absolute and relative grounds) in order to establish the trade mark's registrability.

If the Registrar objects to the trade mark's registration, then the relevant opposition proceedings commence before the Registrar. If the Registrar decides that the trade mark is registrable, it is then published in the Official Gazette of the Republic of Cyprus. Any third party intending to raise an opposition to the registration of the trade mark has the right to file its opposition within two months from the date of the trade mark's publication in the Official Gazette. If no opposition is filed, the Registrar issues the trade mark's registration certificate on payment of the relevant fee. If an opposition is raised by a third party, then the relevant opposition proceedings commence before the Registrar.

2.5 How is a trade mark adequately represented?

The elements of the trade mark (either words or devices or both) need to be clearly represented. In the case of a coloured trade mark, its representation will need to be in colour. Smell or sound trade marks are not yet covered by our legislation and therefore are not yet protected in Cyprus.

2.6 How are goods and services described?

They are classified according to the Nice Classification system. Additionally, it is no longer permissible for an Applicant to claim "all goods or services included in a class". A specific indication of the goods or services of a class should be mentioned in a trade mark application.

2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

All trade marks are filed before the Registrar either in hard copy or electronically. There are no special measures required for any trade marks in order to file them before the Registrar.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No proof of use is required for trade mark registrations and/or renewal purposes.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Only Cyprus is covered by a Cypriot trade mark.

2.10 Who can own a trade mark in your jurisdiction?

A legal entity or a natural person, based either in Cyprus or abroad, can own a trade mark.

2.11 Can a trade mark acquire distinctive character through use?

Yes; however, an Applicant arguing this point will need to provide sufficient evidence to the Registrar proving this argument.

2.12 How long on average does registration take?

If no opposition is raised, the registration procedure will take approximately six to seven months.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for the registration procedure for one trade mark in one class (if no opposition is raised) is EUR 150, including the filing of the trade mark application, the advertisement fees and the fees for the registration certificate. The professional fees are not included in this amount.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

Registration of a trade mark in Cyprus can be obtained with the filing of:

- a national trade mark application;
- a Community trade mark application; or
- an international trade mark application designating Cyprus or the European Union as a Contracting State.

2.15 Is a Power of Attorney needed?

An original Power of Attorney is always required by the Registrar in order for a lawyer practising in Cyprus to act for a client in all trade mark matters. However, if a trade mark application for registration or for renewal is filed via the Registrar's e-filing system, no Power of Attorney is required.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

The Power of Attorney does not require notarisation and/or legalisation from the Applicant's end. Its legalisation is done in Cyprus by the representative lawyer.

2.17 How is priority claimed?

On the trade mark application form, a priority can be claimed. The trade mark application form needs to be filed within six months from the filing date of the earlier trade mark. Additionally, the Applicant needs to file the original or certified true copy of the application/registration documents of the earlier trade mark. Translation into Greek of these documents is necessary, together with a Translator's Affidavit verifying the correctness of the translation. These documents can be filed with the Registrar at a later stage.

2.18 Does your jurisdiction recognise Collective or Certification marks?

Certification and Collective Marks are recognised in Cyprus under sections 37A and 37B of Cap. 268, respectively.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The absolute grounds of refusal are covered by section 11 of Cap. 268, as mentioned in question 2.2 above.

3.2 What are the ways to overcome an absolute grounds objection?

According to the Law and in relation to the absolute grounds, which refer to trade marks which: (a) lack distinctiveness; (b) consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods, provision of the services or other characteristics of the goods or services; and (c) consist exclusively of signs or indications that have become customary in the current language or in the *bona fide* established practices of the trade for designating the goods or services, an absolute grounds objection can be overcome if the trade mark has acquired distinctiveness through its use (section 11(2) of Cap. 268). Sufficient evidence of its use will need to be submitted to the Registrar either by the filing of a “considered reply” or during a hearing procedure before the Registrar.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal of registration from the Registrar can be appealed before the Administrative Court.

3.4 What is the route of appeal?

The Applicant can apply to the Administrative Court, within 75 days from the date of the Registrar’s decision, for judicial review of the decision.

If the Applicant is not satisfied with the Administrative Court’s decision then he/she can file an Appeal to the Supreme Court, within 42 days from the date of the Administrative Court’s decision.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal of registration are defined by section 14 of Cap. 268.

Under section 14(1)(a), where a trade mark is identical to an earlier trade mark and the goods or services for which the trade mark is declared or registered are identical to the goods or services for which the earlier trade mark is protected, it cannot be registered or, if registered, might be declared void.

Under section 14(1)(b), where a trade mark, due to its identity or its similarity with an earlier trade mark, and due to the identity or similarity of its goods or services with the goods or services of the earlier trade mark, might create confusion for the public, about, among others, its relation with the earlier trade mark, it cannot be registered or, if registered, might be declared void.

Under section 14(1)(c), where a trade mark is identical or similar to an earlier trade mark which is applied for or registered for goods or services dissimilar to the goods and services for which the earlier trade mark is registered, and the earlier trade mark has a reputation in the Republic of Cyprus and the use of the later trade mark without due cause would take unfair advantage of the distinctive character or the reputation of the earlier trade mark or would be detrimental to the distinctive character or reputation of the earlier trade mark, the later trade mark will be refused registration or, if registered, might be declared void.

Under section 14(1)(d) of Cap. 268, the registration of a trade mark may be prohibited due to the existence of an earlier right to a name, an earlier right to personal portrayal, an earlier copy-right or an earlier industrial property right.

Section 14A of Cap. 268 provides the definition of “earlier trade marks” and it includes:

- Registered trade marks.
- International trade marks, the registration of which has effect in Cyprus.
- Registered European Community Trade Marks.
- Applications for registration of any of the above.
- Trade marks which are “well-known marks” in the Republic of Cyprus in accordance with Article *6bis* of the Paris Convention.

4.2 Are there ways to overcome a relative grounds objection?

A relative grounds objection raised by either the Registrar or a third party can be overcome in many ways, depending on the facts of each case.

If the objection is raised by a third party, it may be overcome by:

- an agreement signed by the two parties which may include the limitation of goods or services covered by the later trade mark;
- an alteration of the representation of the later trade mark; or
- initiation of invalidation proceedings against the earlier trade mark.

If the objection is raised by the Registrar, it may be overcome by:

- a letter of consent signed by the Proprietor of the earlier trade mark;
- the limitation of goods or services covered by the later trade mark;
- an alteration of the representation of the later trade mark; or
- the initiation of invalidation proceedings against the earlier trade mark.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal of registration from the Registrar can be appealed before the Administrative Court.

4.4 What is the route of appeal?

The route is as mentioned in question 3.4 above.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on absolute grounds under section 11 of Cap. 268 (as mentioned above in question 3.1) and on relative grounds under section 14 of Cap. 268 (as mentioned above in question 4.1).

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A trade mark application can be opposed by the Registrar either on absolute or relative grounds (or both). Furthermore, a trade mark application can be opposed by any third party. Usually “third party” oppositions are raised by the owners of earlier rights and their oppositions are based on relative grounds.

5.3 What is the procedure for opposition?

Where a trade mark application is opposed by the Registrar, the Applicant has the right either to file “a considered reply” or to proceed with a hearing before the Registrar. In both cases, the Applicant will argue his/her views and will present his/her arguments on why the trade mark should be accepted. Then, the Registrar will decide as to whether the trade mark should be registered or not.

Where a trade mark application is opposed by a third party, the Registrar will provide the Applicant with a copy of the opposition. The Applicant will then file a counter-statement, outlining his/her arguments as to why the trade mark should be registered. Then, the third party will file a Written Affidavit presenting his/her facts and arguments in detail, and the Written Affidavit of the Applicant will follow. The third party has the option to then file a Written Affidavit in Reply. After the completion of the Written Affidavits procedure, both parties appear before the Registrar in order for the Registrar to grant them the timeframe for filing their Final Statements. After the completion of the Final Statements procedure, both parties appear before the Registrar for a hearing. After hearing both parties and studying the evidence provided, the Registrar will decide whether the trade mark should be registered or not.

6 Registration

6.1 What happens when a trade mark is granted registration?

A registration certificate is issued after the filing of the relevant application and the payment of the relevant fee to the Registrar.

6.2 From which date following application do an applicant's trade mark rights commence?

Such rights commence from the date of the filing of the trade mark application.

6.3 What is the term of a trade mark?

A trade mark registration lasts for a seven-year period, counting

from the date of the filing of the trade mark application. At the expiration of this term, the trade mark needs to be renewed for an additional period of 14 years. The trade mark must then be renewed every 14 years.

6.4 How is a trade mark renewed?

A trade mark is renewed by the filing of the relevant application and the payment of the renewal fee (EUR 80) to the Registrar.

If a trade mark is not renewed on time, the Registrar will proceed to its advertisement in the Official Gazette under the section, “Trade Marks not Renewed”. Following its advertisement in this section, a grace period of two months (from the date of its advertisement) is provided to the trade mark’s owner for the payment of the renewal fee plus a penalty fee (€20) and the filing of the relevant application for late payment.

If the trade mark is not renewed within this two-month period, it is removed from the Registrar’s records and a procedure for its restoration needs to be initiated before the Registrar.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

A trade mark assignment can be recorded before the Registrar with the filing of the relevant form and the payment of the relevant fees.

The assignment form needs to be accompanied by an original Power of Attorney signed and sealed (if a seal exists) by the Assignee, together with either the original assignment document signed and sealed (if a seal exists) by both the Assignor and the Assignee or a certified true copy of this document. If the Assignment document is not in the Greek language, then its translation into Greek also needs to be filed together with a Translator’s Affidavit verifying the correctness of this translation.

7.2 Are there different types of assignment?

A partial assignment for certain goods or services is acceptable and a trade mark can be assigned with or without goodwill.

7.3 Can an individual register the licensing of a trade mark?

A trade mark licence can be recorded before the Registrar with the filing of the relevant form and the payment of the relevant fees. The licence form needs to be accompanied by a Statutory Declaration/Statement of Case signed by the Proprietor of the trade mark.

This Declaration/Statement of Case must include the terms and conditions under which the licence is agreed. If, in the Declaration, reference is made to any written agreement between the Proprietor and the Licensee, then this Agreement must be attached to the Declaration. The Statutory Declaration and Agreement need to be either original or certified true copies. If the Statutory Declaration and Agreement are not in the Greek language, then their translations into Greek also need to be filed together with a Translator’s Affidavit verifying the correctness of these translations.

7.4 Are there different types of licence?

A trade mark can be licensed for all its goods or services or for certain goods or services, to one or more licensees, and can last for a certain duration or for an unlimited duration.

7.5 Can a trade mark licensee sue for infringement?

A trade mark Licensee can sue for infringement under section 29(3) of Cap. 268, which provides the following:

In compliance with any agreement that exists between the parties, a licensee of a trade mark has the right to request that the Proprietor of the trade mark initiate infringement proceedings, and if the Proprietor denies or neglects to proceed accordingly within two months after receiving the licensee's request, the licensee has the right to initiate proceedings for infringement under his/her name as if he/she were the Proprietor, and the Proprietor is added as a defendant to the proceedings.

7.6 Are quality control clauses necessary in a licence?

No, they are not, and a licence with no quality control clauses is legally recognised in Cyprus.

7.7 Can an individual register a security interest under a trade mark?

There is no provision in the Trade Marks Law for the registration of a security interest under a trade mark.

7.8 Are there different types of security interest?

This is not applicable – see question 7.7 above.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

Under section 28(1) of Cap. 268, a trade mark can be revoked if:

- a) for a period of five consecutive years, there has not been *bona fide* use of the trade mark by its Proprietor and where no proper reason for its non-use exists;
- b) after the date of registration of the trade mark, due to actions or lack of actions of the Proprietor, the trade mark has become a usual trade name of the goods or services for which the trade mark has been registered; or
- c) due to the use of the trade mark by its Proprietor or with his/her consent, for the goods or services for which it has been registered, there is a likelihood of confusion of the public particularly as to the nature, quality or geographic origin of its goods or services.

8.2 What is the procedure for revocation of a trade mark?

The procedure consists of the filing of the relevant application at the District Court or at the Registrar's Office.

8.3 Who can commence revocation proceedings?

According to section 28(1) of Cap. 268, an application for revocation can be filed by any person who has grounds to complain. Normally, revocation proceedings are commenced by persons or legal entities whose rights were refused registration due to the existence of the trade mark against which they are commencing revocation proceedings or by persons or legal entities who possess earlier rights that are affected by this trade mark.

8.4 What grounds of defence can be raised to a revocation action?

Continuous *bona fide* use of the trade mark by its Proprietor can be raised as a defence. Evidence of this use will need to be submitted before the body handling the revocation action (either the District Court or the Registrar's Office).

According to section 28(2) of Cap. 268, a trade mark will not be removed from the Registrar's records if, after the expiration of the five-year period, but before the initiation of the proceedings for the revocation of the trade mark, *bona fide* use of the trade mark has commenced. However, the commencement or resumption of *bona fide* use of the trade mark during the period of three months before the submission of the application for revocation of a trade mark will not be taken into account if the preparatory actions for the commencement or resumption of the *bona fide* use of the trade mark happened after its Proprietor was informed that there was a possibility for the filing of a revocation action.

8.5 What is the route of appeal from a decision of revocation?

If the decision of revocation is issued by the Registrar, any of the parties can apply within 75 days from the date of the decision for judicial review of the decision to the Administrative Court. If the party is not satisfied with the Administrative Court's decision, then he/she can file an Appeal to the Supreme Court within 42 days from the date of the decision of the Administrative Court. If the revocation decision is issued by the District Court, then any of the parties can file an Appeal to the Supreme Court within 42 days from the date of the decision.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

Invalidity of a trade mark can be claimed on absolute grounds under section 11 of Cap. 268 (as mentioned in question 3.1 above) and on relative grounds under section 14 of Cap. 268 (as mentioned in question 4.1 above).

Furthermore, invalidity of a trade mark can be claimed if the trade mark is a scandalous design or is contrary to public policy or to accepted principles of morality.

Bad faith is also a ground for invalidity of a trade mark.

9.2 What is the procedure for invalidation of a trade mark?

The procedure consists of the filing of a law action at the District Court or of an application at the Registrar's Office.

9.3 Who can commence invalidation proceedings?

Any person or legal entity whose right is affected by the trade mark can commence such proceedings.

9.4 What grounds of defence can be raised to an invalidation action?

The grounds of defence are:

- that the trade mark has acquired distinctiveness through its use;
- that there was *bona fide* use of the trade mark by the Proprietor;
- that the Proprietor of the earlier right has consented to the registration of the later trade mark; or
- that the later trade mark was used for five consecutive years and the Proprietor of the earlier trade mark had knowledge of this use and tolerated it.

9.5 What is the route of appeal from a decision of invalidity?

If the decision of invalidity is issued by the Registrar, any of the parties can apply within 75 days from the date of the decision for judicial review of the decision to the Administrative Court. If the party is not satisfied with the Administrative Court's decision, then he/she can file an Appeal to the Supreme Court within 42 days from the date of the decision of the Administrative Court. If the decision of invalidity is issued by the District Court, any of the parties can file an Appeal to the Supreme Court within 42 days from the date of the decision.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

When the rights established by the registration of a trade mark are infringed, the Proprietor of the trade mark can file a court action before the District Court against the infringer.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Firstly, the Proprietor of the trade mark (Plaintiff) will file the court action before the District Court. Then, the Infringer will file his/her written defence and counter-claim (if any) and the Plaintiff will submit his/her Written Reply and an application requesting the court to set a date on which both parties will appear before the court. On that date, the attorneys of both parties will appear before the court to discuss the case with the Judge. If there is a possibility for an out-of-court settlement, the court will set a further date for discussion of the case. However, if there is not a possibility for an out-of-court settlement, the court will set a hearing date.

A trial of a court action usually commences within four years from its filing before the court.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions are available and can be made either

ex parte if there are issues of urgency, or by summons. The application for a preliminary injunction must be accompanied by an Affidavit.

Under section 32 of the Courts of Justice Law, the Applicant must prove that:

- there is a serious question to be tried;
- there is a probability that the Plaintiff is entitled to relief; and
- unless interlocutory relief is granted, it will be difficult or impossible for complete justice to be done at a later stage.

Final injunctions are also available in the form of remedies. For example, a final injunction may be granted ordering the destruction of infringing goods or restraining the future use of the trade mark by the defendant.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Under Civil Procedure Rules, Order 28, a party can apply to the court for an order for discovery on oath or inspection of documents relating to any matter in question, which are in the possession or under the control of the other party.

If the party that has been ordered to make a discovery fails to proceed accordingly, this party will not have the liberty afterwards to submit, as evidence in the court action, any of the documents that he/she had failed to disclose, unless he/she satisfies the court that he/she had a sufficient excuse for failing to do so.

In the case that the documents for which disclosure or inspection is sought are confidential or are privileged in general, a claim for privilege may be raised.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

During a hearing procedure, evidence may be presented in writing in the form of a written statement. The witness can adopt the content of his/her written statement and, in this case, the written statement is submitted in the Court and is considered as part of the, or the entire, witness's examination-in-chief.

However, evidence during a hearing procedure may also be presented orally, i.e. oral examination of the witness by his/her advocate.

In both cases, the witness may then be cross-examined by the other party and subsequently re-examined by his/her advocate.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

In the case where resolution of validity of a trade mark is pending before the Registrar's Office or a District Court and infringement proceedings have commenced in a District Court, the parties may request orally that the court adjourn the infringement proceedings until the validity issue is decided.

In the case where resolution of validity of a trade mark is pending before the Supreme Court and infringement proceedings have commenced in a District Court, the parties can request in writing that the District Court remove the infringement case from the court's records until the Appeal case is decided.

10.7 After what period is a claim for trade mark infringement time-barred?

Pursuant to the Law on Limitation of Actionable Rights No. 66(I)/2012, a claim for trade mark infringement filed before the court has to be brought within six years from the date the infringement took place.

10.8 Are there criminal liabilities for trade mark infringement?

According to Article 12 of Law No. 61(I)/2018, in relation to the Control of the Importation of Goods Infringing Intellectual Property Rights, any person who in his/her knowledge is involved in, among others, the importation or exportation of products which infringe intellectual property rights, in the Republic of Cyprus, commits a criminal offence and is subject to, in case of conviction, imprisonment for up to three years and/or a fine of €30,000 for a first-time offence, and to imprisonment of up to five years and/or a fine of €50,000 for any subsequent offence. In the case that the convicted person was not aware of the infringing nature of the imported/exported products, he/she is subject to a fine of up to €15,000.

10.9 If so, who can pursue a criminal prosecution?

A criminal prosecution may be pursued by the Law Office of the Republic of Cyprus.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

This is not applicable.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The grounds of defence are as follows:

- No optical and/or acoustical similarity between the trade marks involved.
- No similarity between the goods or services covered by the trade marks involved.
- The trade marks involved cover different circles of consumers.
- The trade mark against which infringement proceedings have commenced is not used in the trade.
- The reputation acquired by the trade mark against which infringement proceedings have commenced.

11.2 What grounds of defence can be raised in addition to non-infringement?

The following grounds can be raised:

- Honest, concurrent use of the trade marks involved.
- *Bona fide* use of the trade mark against which infringement proceedings have commenced.
- Unreasonable delay by the Plaintiff in the initiation of the infringement proceedings.
- Use of the trade mark with the consent of the other party.

12 Relief

12.1 What remedies are available for trade mark infringement?

The following remedies are available:

- A court injunction restraining the future use of the trade mark by the defendant.
- A court injunction ordering the destruction of the infringing goods.
- A court may order the defendant to provide an account of the profits he/she has made from the sale of goods or the provision of services in relation to which the Proprietor's trade mark was infringed.
- Damages.

12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The payment of the costs is at the discretion of the court, which normally orders the losing party to pay all of the successful party's costs. Furthermore, in most cases, the court orders these costs to be calculated by its Registry Office. The proportion of the costs usually recovered amounts to 70–80%.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Any party to the action has the right to file an Appeal before the Supreme Court against a District Court's decision. If it is a final decision, then the Appeal needs to be filed within 42 days from the date of its delivery.

If it is an interim order decision for an application made by summons, the Appeal needs to be filed within 14 days from the date of its delivery; and if it is an interim order decision for an *ex parte* application, the Appeal needs to be filed within four days from the date of its delivery.

An Appeal could be filed for issues other than a point of law, but the Supreme Court will only depart from the first instance court's (District Court's) assessment of the facts under certain conditions and only in exceptional circumstances.

If an Appeal is filed with respect to a judgment of the Administrative Court, then this Appeal may only relate to a point of law.

13.2 In what circumstances can new evidence be added at the appeal stage?

The addition of new evidence at the Appeal stage is very rarely allowed by the Supreme Court and only in circumstances where it is proved that no-one could have predicted at an earlier stage that this evidence would arise. An application requesting the addition of this evidence must be filed at the Supreme Court and must be served to the other party, which has the right to oppose this application.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, there is. The authority responsible is the Customs Department and the applicable legislation is:

- The Customs Code Law No. 94(I)/2004 as amended by Law No. 265(I)/2004 and by Law No. 9(I)/2011.
- Law No. 61(I)/2018 in relation to the Control of the Importation of Goods Infringing Intellectual Property Rights.

A Proprietor of a trade mark can file a written application to the Customs Department requesting the suspension of the importation of goods in cases where the Proprietor's intellectual property rights are violated.

If the application is accepted, the Customs Department suspends the importation of goods in cases where it suspects that they violate the Proprietor's intellectual property rights, after prior consultation with the Applicant, and informs the importer about the suspension.

According to section 8 of Law No. 61(I)/2018, in case the importer of the goods does not consent to the destruction of the infringing goods, the Applicant has to file a court action within 10 days (or within three days in case of perishable goods) from the date that the Customs Department has communicated to him/her the suspension of the delivery of the products or their seizure. An extension may be given by the Customs Department.

It should also be mentioned that the Customs Department has the right to suspend the importation of goods even in cases where no application has been filed (*ex officio*), in the case that it suspects violation of intellectual property rights.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Section 4 of Cap. 268 provides that no person is allowed to initiate proceedings to prevent the infringement of an unregistered trade mark or to seek damages arising from such infringement. However, it further states that no provision included in Cap. 268 affects any rights of action for fraudulent presentation of goods as goods of another person, or any available remedies for these circumstances.

Section 35 of the Civil Wrongs Law, Cap. 148, provides protection to unregistered trade marks, according to which: any person who, by imitating the name, description, sign or label or otherwise causes or attempts to cause any goods to be mistaken for the goods of another person, so as to be likely to lead an ordinary purchaser to believe that he is purchasing the goods of such other person, shall commit a civil wrong against such other person.

Therefore, unregistered trade marks can be enforced under section 35 of Cap. 148 with the initiation of a passing-off action.

15.2 To what extent does a company name offer protection from use by a third party?

To the extent that the term "company name" is construed as "trade name" or "business name", the Registrar may refuse to

register a trade name which is identical or similar to a trade name already registered or may refuse to register a trade name which is considered to be confusing or misleading. There are no statutory remedies available for the misuse of a trade name by a third party. In the event of an infringement, a passing-off action may be initiated under section 35 of Cap. 148.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The right to a name or to a personal portrayal confers IP protection.

16 Domain Names

16.1 Who can own a domain name?

Domain names can be registered to Cyprus-registered companies and to Cyprus permanent residents who are over the age of 18, or to other companies or physical persons whose authorised representatives are registered (in case of a company) or have their permanent residence in Cyprus.

16.2 How is a domain name registered?

For the registration of a domain name, the relevant application shall be submitted before the University of Cyprus, which is the responsible body. Furthermore, the relevant registration fees shall be paid.

16.3 What protection does a domain name afford *per se*?

The University of Cyprus may reject an application for registration of a domain name which is identical or very similar to a domain name which is already registered.

If a person disagrees with a decision of the University regarding the non-registration of a domain name, this person must firstly appeal to the University, requesting the re-examination of the decision. If the Complainant is not satisfied with the University's decision then he can apply for a Hearing before the University. If the matter is not resolved by the University, the Complainant may appeal to the Commissioner of Electronic Communications & Postal Regulations. The decision of this body will be binding for both the Complainant and the University. Any decision of the Commissioner is subject to judicial review by the Administrative Court.

16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

.cy is the country code top-level domain (ccTLD) for Cyprus.

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, there are. If a person disagrees with the registration of a domain name, he can file an application to the University for the cancellation of the registration of the domain name. If the dispute is not resolved by the University or if any of the parties involved is not satisfied with the University's decision, then

an appeal can be filed before the Commissioner of Electronic Communications & Postal Regulations. The decision of this body will be binding for both the Complainant and the University. Any decision of the Commissioner is subject to judicial review by the Administrative Court.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

The Registrar has launched a new website for its Departments, including the Trademarks Department. Additionally, the Registrar has upgraded its online e-filing system.

Furthermore, the Registrar has proceeded with seminars in relation to the new Trademarks Law which will harmonise the domestic legislation with European Trade Mark Directive No. 2015/2436 and Regulation (EU) No. 2015/2424. The new Trademarks Law is before the Attorney General for legislative check.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The following first instance judgments, amongst others, were issued within the last 18 months.

- **Law Action No. 305/2019.** This judgment concerns an application for the issuance of interim order in a passing-off claim, prohibiting the respondent/defendant from trading/marketing/advertising and/or using in any way the claimant's trade name and from registering a trade name or company including the claimant's trade name. In the first decision, the District Court decided that the conditions for the issuance of an interim order are satisfied and issued an order prohibiting the respondent/defendant from using the Plaintiff's trade name in the course of his business until the trial and completion of the main law action.

- **Law Action No. 1313/2019.** This judgment concerns an application for the issuance of interim order in a trade mark infringement and passing off claim, prohibiting the respondent/defendant from using, in the course of his business, the Plaintiff's trade marks. In the first decision, the District Court decided that the conditions for the issuance of an interim order are satisfied and issued an order prohibiting the respondent/defendant from using the Plaintiff's trade marks as part of his name in the course of his business until the trial and completion of the main action.

17.3 Are there any significant developments expected in the next year?

The following developments are anticipated:

1. The substitution of the existing Trade Marks Law and Regulations (Secondary Legislation) with the new Trade Marks Law and Regulations (Secondary Legislation), which will harmonise the domestic legislation with European Trade Mark Directive No. 2015/2436 and Regulation (EU) No. 2015/2424.
2. The current official trade mark forms will be replaced by new official forms which will comply with the provisions of the new Trade Marks Law and the new Regulations (Secondary Legislation).
3. Regarding the Registrar's e-filing system, it is expected that more services will be offered for trade marks in addition to the applications for trade mark registrations and applications for trade mark renewals which are now available.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No, there are not any general practice or enforcement trends that have become apparent over the last year or so.



Eleni Papacharalambous is the Head of the Intellectual Property Department. Eleni acquired her law degree from the University of Exeter in the UK, before going on to complete the Bar Vocational Course with Gray's Inn. She then successfully completed the Cyprus Bar Examinations and is a member of the Nicosia Bar Association.

Eleni deals with all aspects of intellectual property law and is a litigation lawyer on intellectual property matters.

For a number of consecutive years, *The Legal 500* has listed Eleni as a "Leading Individual" in Intellectual Property Law.

Furthermore, according to *The World Trademark Review 1000*, 2019:

"The driving force behind this ensemble is Eleni Papacharalambous, who always look at the issues from a domestic and international perspective."

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Georgia Charalambous has been a member of the Cyprus Bar Association since 2017. She initially worked at the firm as a trainee and now holds the Advocate position. She studied law at the University of Southampton and then received a Postgraduate Diploma in Legal Practice (LPC) from BPP Law School in London. Georgia subsequently obtained an LL.M. (European Master's in Law and Economics) from the Erasmus University Rotterdam and the Universities of Bologna and Hamburg. Prior to qualifying as an advocate in Cyprus, she worked as a Trainee in the secretariat of the Committee on Internal Market and Consumer Protection of the European Parliament. Georgia mainly works in legal advisory, especially in the areas of procurement and banking law. She also regularly appears before all levels of District Courts.

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Koushos Korfiotis Papacharalambous LLC comprises more than 20 lawyers based in our offices in Nicosia. KKP is a full-service law firm with an industry focus on financial services including financial, insurance and banking institutions, intellectual property, real estate and construction, and corporate and securities law. The firm operates in multi-disciplinary teams, which allows us to provide clients with individualised and expert advice. Our team of lawyers has more than 30 years of experience, combining an extensive knowledge of the Cyprus legal system with an in-depth understanding of international and European law. Partners of the firm are members of professional legal organisations such as the International Trademark Association (INTA), the European Communities Trade Mark Association (ECTA), MARQUES, AIPPI, the Pharmaceutical Trade Marks Group (PTMG), the International Tax Planning Association,

and the Chartered Institute of Arbitrators, while a number of them are also endorsed and highly rated by the world's leading international legal directories, including *The Legal 500*.

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