

# International Comparative Legal Guides



TM

## Trade Marks 2021

A practical cross-border insight into trade mark work

**10<sup>th</sup> Edition**

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# Cyprus



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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 Trademarks Law, Cap. 268, as amended by Law Nos 63 of 1962, 69 of 1971, 206 of 1990, 176(I) of 2000, 121(I) of 2006 and 63(I) of 2020.
- 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 Trademark 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.
- The Council of Ministers Trademark Regulations issued in 2020.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of the good or the packaging of the good, or sounds, provided that these signs:

- (a) are capable of distinguishing the goods or services of one undertaking from the goods or services of other undertakings; and
- (b) are being represented on the Register as specified in the regulations in a manner which enables the authorities of the Republic and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor.

### 2.2 What cannot be registered as a trade mark?

According to Section 6 of the Trademarks Law, the following cannot be registered as trade marks:

- (a) Signs which cannot constitute a trade mark according to the provisions of Section 4 of the Trademarks Law.
- (b) Trade marks that lack distinctive character.
- (c) Trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the good or of rendering of the service or other characteristics of the good or service.
- (d) Trade marks which consist exclusively of signs or indications, which have become customary in the current language or in the *bona fide* and established practice of the trade.
- (e) Signs which consist exclusively of the shape or another characteristic:
  - (i) which results from the nature of the good itself;
  - (ii) of the goods which are necessary to obtain a technical result;
  - (iii) of the good which gives substantial value to the good;
- (f) Trade marks which are contrary to public policy or to accepted principles of morality.
- (g) Trade marks which could deceive the public, especially as to the nature, quality or geographical origin of the good or service.
- (h) Trade marks or signs of them, of the escutcheons, flags and state emblems that belong to the Contracting Member States and which, without the consent of the Registrar are not accepted or are invalid according to Article 6ter of the Paris Convention.
- (i) Trade marks that include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention or signs of high symbolic value and of special public interest and especially religious symbols, representations and words.
- (j) Trade marks which their registration is excluded pursuant to the provisions of the Law of 2006 for Protection of Designations of Origin and Geographical Indications for Agricultural Products and Food Stuff as amended, or pursuant to the Union legislation or to the international agreements to which the Union is a party, providing for protection of designations of origin and geographical indications.
- (k) Trade marks which their registration is excluded pursuant to the provisions of the Council of Viticultural Products Law, the Union legislation, the legislation of the Republic of Cyprus or the international agreements to which the Union is a contracting party, providing for protection of the traditional terms for wine.

- (l) Trade marks which registration is excluded pursuant to the Union legislation or the international agreements to which the Union is a contracting party, providing for protection of traditional specialities guaranteed.
- (m) Trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with the provisions of the Law for Protection of new plant varieties or the Union legislation or the international agreements to which the Union or the Republic of Cyprus is a contracting party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species.
- (n) A trade mark is not accepted for registration if its application for registration was made in bad faith by the applicant. A trade mark is accepted for registration in accordance with paragraph (b), (c) or (d) above (and may not be declared void pursuant to these paragraphs) if, before the date of application for registration, following the use which has been made of it, it has acquired a distinctive character. These provisions also apply where the distinctive character of the trade mark was acquired after the date of application for registration but before the date of its registration in the Registrar's records.

**According to Section 7 of the Trademarks Law, a trade mark is not registered when:**

- (a) it is identical to an earlier trade mark, and the goods or services for which the trade mark is applied for are identical to the goods or services for which the earlier trade mark is protected;
- (b) because of its identity with, or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the two trade marks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion also includes the likelihood of association with the earlier trade mark.  
 "Earlier trade marks" for the purposes of the above paragraph are:
  - Trade marks of which the date of application for registration is earlier than the date of application for registration of the trade mark, taking into account, where appropriate, the priority rights of those trade marks, and which fall to the below categories:
    - (i) EU trade marks;
    - (ii) trade marks registered in the Republic of Cyprus;
    - (iii) trade marks with an international registration which has effect in the Republic of Cyprus.
  - EU trade marks for which seniority is validly claimed, in accordance with Regulation (EC) No. 2017/1001, of a trade mark referred to in points (ii) and (iii) above, even when the later trade mark has been surrendered or allowed to lapse;
  - applications for the trade marks referred to above, subject to their registration;
  - trade marks, which, on the date of filing of their application, or, where appropriate, on the priority date that is claimed, are well known in the Republic of Cyprus, in accordance with the meaning of Article 6*bis* of the Paris Convention.

**Furthermore, a trade mark is not registered when:**

- (a) it is identical to, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied for are identical to, or similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State in respect of which an application for registration is filed or,

- in the case of an EU trade mark, it has a reputation in the Union and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;
- (b) an agent or representative of the proprietor of the trade mark files an application for registration in his own name and without the proprietor's authorisation, unless the agent or representative justifies his action;
- (c) an application for a designation of origin or a geographical indication has already been submitted in accordance with the provisions of the Law for the Protection of Designations of Origin and Geographical Indications of Agricultural Products and Foodstuff of 2006 as amended or the Union legislation prior to the date of application for registration of the trade mark or the date of the priority claimed, subject to the subsequent registration of the designation of origin or of the geographical indication.  
 The owner of the designation of origin or geographical indication, according to the provisions of the Law for the Protection of Designations of Origin and Geographical Indications of Agricultural Products and Foodstuff of 2006, has the right to prohibit the use of a subsequent trade mark.

**Furthermore, a trade mark is not registered where and to the extent that:**

- (a) rights to a non-registered trade mark or to another sign used in the course of trade have been acquired prior to the filing date of the application of the subsequent trade mark or the priority date claimed to support the application of the subsequent trade mark, and the non-registered trade mark or the other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;
- (b) the use of the trade mark may be prohibited by virtue of an earlier right, other than the rights referred to in the definition of "earlier trade marks" above, and in particular:
  - (i) a right to a name;
  - (ii) a right of personal portrayal;
  - (iii) a copyright;
  - (iv) an industrial property right,
- (c) when it is possible that the trade mark could be confused with an earlier trade mark protected in other countries, provided that, on the date of filing of the application, the applicant acted in bad faith.

### 2.3 What information is needed to register a trade mark?

The trade mark's representation according to the Trademarks Regulation No. 5, and which shall meet the requirements mentioned in question 2.1 above, the Applicant's details (name, business address, telephone number and email address, and if the applicant is a company, its tradename, its seat address, its legal form, telephone number and email address), the name, professional address, telephone number and email address of the representative and a declaration that he is lawfully representing the applicant, the class and the goods or services under which the trade mark seeks protection, and any priority claims.

### 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 either electronically or in hard copy. An application number, an application date and a time of filing is assigned to the trade mark

application and it is recorded in the Registrar's records. The Registrar examines whether the application meets the typical requirements. If not, then the Registrar calls the Applicant to proceed with the relevant corrections within a term of two months. 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 three 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. 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?

A trade mark is represented in any proper format with the use of widely available technology. Its representation in the Register has to be made with a clear, specific, independent, accessible, comprehensible, permanent, and objective way, so as to allow the competent authorities and the public to indicate with clarity and accuracy the object of protection that is granted to its owner.

#### 2.6 How are goods and services described?

They are classified according to the Nice Classification system. The goods and services for which protection is sought are described by the Applicant with sufficient clarity and accuracy in order for the competent authorities and the financial institutions, exclusively on this basis, to indicate the extent of the protection sought.

#### 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?

The representation defines the object of the application. The Trademark Regulation No. 5 provides that the representation depends on the kind of trade mark that will be declared in the application and the Regulation defines the ways that the different types of trade marks shall be represented. Trademark Regulation No. 5 furthermore provides that in case the trade mark does not belong to any of the kinds that are mentioned, then such a trade mark is represented in any proper format with the use of widely available technology, provided that its representation in the Register can be made with a clear, specific, independent, accessible, comprehensible, permanent and objective way, so as to allow the competent authorities and the public to indicate with clarity and accuracy the object of protection that is granted to its owner. The representation can be accompanied with the description of the trade mark.

#### 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?

According to the Trademarks Law, citizens of the Member States of the European Union and of the contracting parties of the Paris Convention, the Madrid Agreement Concerning the International Registration of Marks, and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, or the legal persons who have their seat in those states, can file an application for the registration of a Cyprus 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 (if no opposition is raised) is EUR 141 for the first class and EUR 102 for each additional class if trade mark application is filed in hardcopy. If the trade mark application is filed online then the official fee is EUR 129 for the first class and EUR 94 for each additional class. 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?

No, a Power of Attorney (PoA) is not needed in Cyprus.

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

This is not applicable to Cyprus.

### 2.17 How is priority claimed?

If with the trade mark application priority is claimed based on a prior filing, a Declaration is attached which mentions the date and the country or the regional organisation before which the prior filing has been made. Furthermore, a filing certificate, issued from the Authority where the prior filing has been made, and from which the filing date of the prior trade mark derives, needs to be filed along with the country of filing, the representation of the trade mark and the goods and services that the trade mark covers arise. If the language of the prior filing is not Greek, the Registrar will request the Applicant to file the translation in Greek within two months.

### 2.18 Does your jurisdiction recognise Collective or Certification marks?

Certification and Collective Marks are recognised in Cyprus under Sections 46 to 55 of the Trademarks Law.

## 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 6 of the Trademarks Law, 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 distinctive character; (b) consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the good or of rendering of the service or other characteristics of the good or service; (c) consist exclusively of signs or indications, which have become customary in the current language or in the *bona fide* and established practice of the trade, an absolute grounds objection can be overcome if the trade mark has acquired distinctiveness through its use before the trade mark's application date (Section (6)(4) of the Trademarks Law). Sufficient evidence of its use will need to be submitted to the Registrar. The provisions of Section (6)(4) also apply where the distinctive character has been acquired after the trade mark's application date but before its registration in the Register.

### 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 of refusal are covered by Section 7 of the Trademarks Law, as mentioned in question 2.2 above.

### 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;
- initiation of invalidation proceedings against the earlier trade mark;
- filing by the Applicant of a request for proof of use towards the Opponent. If the Opponent fails to prove the considerable use of the trade mark or the existence of a legitimate reason for non-use of the trade mark, then the opposition is rejected.

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.

### 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 6 of the Trademarks Law (as mentioned above in question 3.1) and on relative grounds under Section 7 of the Trademarks Law (as mentioned above in question 4.1).

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

If the opposition is based on absolute grounds, the opposition can be filed by any person having a legitimate interest. If the opposition is based on relative grounds, then the opposition can be filed by the owners of the earlier trade marks or rights and from the owners of the designation of origins and geographical indications.



### 5.3 What is the procedure for opposition?

Where a trade mark application is opposed by the Registrar, either on absolute or relative grounds, the Registrar calls upon the Applicant to file its Observations within two months and if its Observations are accepted by the Registrar, then the trade mark application is accepted.

Where a trade mark application is opposed by a third party, the Registrar, upon examining that the opposition meets the formal requirements, will provide the Applicant with a copy of the opposition and will inform both parties that they have a two-month period (a cooling-off period) to settle the matter amicably, in case the opposition is based on relative grounds included in Section 7 of the Law. This period can be extended for up to six months if both parties apply for an extension. If no amicable solution is reached, then the Opponent has a two-month period to file evidence supporting its opposition and to explain in detail the grounds of its Opposition. This evidence will be provided to the Applicant and the Registrar will request from the Applicant to file its Observations together with the evidence that the Applicant considers necessary, in order to confront the Opposition. This material will be given to the Opponent who has the right to reply within two months, if it deems it is necessary. If a reply is filed, then this reply is provided to the Applicant. If the Applicant files a request of proof of use against the Opponent, then the Opponent shall file its observations and evidence that prove the substantial use within the deadline provided by the Trademarks Regulations.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

A registration certificate is issued by the Registrar in hard copy.

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

According to Section 33 (3) of the Trademarks Law, a trade mark that has been accepted by the Registrar is considered registered on the date on which the registration procedure has been concluded. However, the priority right in the trade mark commences from the trade mark's application date.

### 6.3 What is the term of a trade mark?

A trade mark registration lasts for a 10-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.

### 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 to the Registrar. The trade mark application can be filed within the last six months of the protection of the trade mark. If a trade mark is not renewed on time, the renewal application can be filed within an additional period of six months from the expiration of the 10-year protection, provided that the renewal surcharge is paid.

## 7 Registrable Transactions

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

A trade mark assignment shall be recorded before the Registrar with the filing of the relevant form and the payment of the relevant fees. It is not necessary to file supporting documents proving the assignment, before the Registrar, if the assignment application is signed by both the Assignor and the Assignee or their respective representatives.

### 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, irrespective of the assignment of the business.

Furthermore, rights under trade mark applications (not only rights under registered trade marks) can be assigned.

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

A trade mark licence shall be recorded before the Registrar with the filing of the relevant form and the payment of the relevant fees. Supporting documents proving the provision of the licence and the licence agreement, together with the certified Greek translation of these documents, need to also be filed before the Registrar.

### 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. It can last for a certain duration or for an unlimited duration, and it can be registered for the whole or just part of the territory of Cyprus.

### 7.5 Can a trade mark licensee sue for infringement?

A trade mark licensee can sue for infringement of the trade mark, only with the consent of the Proprietor of the trade mark. However, a trade mark licensee holding an exclusive licence can sue for infringement, if, after giving a written notice to the Proprietor within a reasonable time, the Proprietor does not file a law action for trade mark infringement before the Court.

Furthermore, a trade mark licensee holding an exclusive licence has the right to participate in an infringement action, that the Proprietor has initiated, as a third party, in order to succeed restoration of the damage that he has suffered.

### 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?

Yes, an individual can register a security interest under a trade mark by the filing of the relevant application before the Registrar and the payment of the relevant fees.

### 7.8 Are there different types of security interest?

Yes, a trade mark can be granted as security, be pledged, be the subject of another right *in rem*, be subject to enforcement, independently of the business, and it can be subject to insolvency proceedings.

## 8 Revocation

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

A trade mark shall be liable to revocation, if:

- within a continuous five-year period from its registration, it has not been put to genuine use for the goods or services for which it has been registered or if its use has been interrupted for five consecutive years;
- as a result of acts or inactivity of its Proprietor it has become the common name in the trade for the good or service in respect of which it is registered;
- as a result of the use of the trade mark by its Proprietor or with his consent in respect of the goods or services for which it has been registered, it is likely to mislead, particularly as to the nature, quality or geographical origin of those goods or services.

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

The filing of the relevant application before the Registrar and the payment of the relevant official fee. The Registrar will then notify the Applicant in writing to proceed, within a deadline of two months, with the filing of the evidence supporting the revocation action. The Registrar, upon receiving this evidence, will then provide copies of the revocation application and of the evidence supporting the revocation action to the Proprietor of the trade mark, requesting him to file his observations within a deadline of two months. The Proprietor of the trade mark shall file his observations before the Registrar and shall provide to the Applicant copies of his observations within two months. The Applicant can file observations in reply within a deadline of two months and copies of these observations in reply need to be provided to the Proprietor of the trade mark by the Applicant. In exceptional cases and depending on the complexity of the case, the Registrar may give permission to the parties, upon their request, to file additional observations and evidence.

The revocation procedure is conducted in writing. However, upon a justified request by the parties involved and provided it is justified by the circumstances, the Registrar may, upon application by the parties involved, allow the oral hearing.

According to Trademarks Law, a revocation procedure can also be brought before the Court.

### 8.3 Who can commence revocation proceedings?

Any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, provided that according to the Law of the Republic it has the capacity to sue in its own name and to be sued.

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

No revocation action can be successful in case the proprietor proves that there is reasonable reason for the lack of genuine use of the trade mark, or in case after the expiration of the five-year period, but before the filing of the application for the revocation of the trade mark, *bona fide* use of the trade mark has commenced or resumed. 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 final decision or within 14 days for any interlocutory order.

## 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 6 of Cap. 268 and on relative grounds under Section 7 of Cap. 268 (as mentioned in question 2.2 above).

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

The filing of the relevant application before the Registrar and the payment of the relevant official fee. The Registrar will then notify the Applicant in writing to proceed, within a deadline of two months, with the filing of the evidence supporting the invalidation action. The Registrar, upon receiving this evidence, will then provide copies of the invalidation application and of the evidence supporting the invalidation action to the Proprietor of the trade mark, requesting him to file his observations within a deadline of two months. The Proprietor of the trade mark shall file his observations before the Registrar and shall provide to the Applicant copies of his observations within two months. The Applicant can file observations in reply within a deadline of two months and copies of these observations in reply need to be provided to the Proprietor of the trade mark by the Applicant. In exceptional cases and depending on the complexity of the case the Registrar may give permission to the parties, upon their request, to file additional observations and evidence.

The invalidation procedure is conducted in writing. However, upon a justified request by the parties involved and provided it is justified by the circumstances, the Registrar may, upon application by the parties involved, allow the oral hearing. According to the Trademarks Law, an invalidation procedure can also be brought before the Court.

### 9.3 Who can commence invalidation proceedings?

The following can commence invalidation proceedings in Cyprus:

- any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, provided that according to the Law of the Republic it has the capacity to sue in its own name and to be sued;
- the proprietor of an earlier trade mark;
- the person, who, according to the provisions of the Law of 2006 for Protection of Designations of Origin and Geographical Indications for Agricultural Products and Food Stuff as amended, is allowed to exercise the rights arising from a protected designation of origin or geographical indication.

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

The grounds of defence are:

- Proof that the proprietor of the earlier trade mark, has acquiesced, for five consecutive years, in the use of the later trade mark registered in the Registrar's records, while being aware of such use.
- A person is not allowed to request the invalidation of a trade mark based on relative grounds, if he has already based an opposition on these grounds or if he has already based a revocation or invalidation actions on these grounds and these applications have been rejected.
- The fact that an application, the basis of which is an earlier trade mark, would not have been successful if it was submitted at the filing date or the priority date of the later trade mark for any of the following reasons:
  - (a) the earlier trade mark, liable to be declared invalid pursuant to paragraphs (b), (c), or (d) of paragraph 1 of Section 6 of the Law, had not yet acquired a distinctive character as referred to in Section 6(4);
  - (b) the application for a declaration of invalidity is based on paragraph (b) of Section 7(1) of the Law and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of the said paragraph;
  - (c) the application for a declaration of invalidity is based on paragraph (a) of Section 7(3) of the Law and the earlier trade mark had not yet acquired a reputation within the meaning of the aforementioned paragraph.
- In addition, an invalidation application, the basis of which is an earlier trade mark with an earlier filing date or priority date, will be rejected in case the proprietor of the later trade mark so requests and the proprietor of the earlier trade mark fails to provide proof that:
  - (a) during the five-year period preceding the date of the application for invalidity, the earlier trade mark has been put to genuine use, as provided for in Section 16 of the Law, in connection with the goods or services in respect of which it is filed and which are cited as justification for the invalidation application; or
  - (b) there is sufficient reason for non-use, provided that the registration process of the earlier trade mark has, at the date of the application for invalidity, been completed for at least five years.
- Where, at the filing or date of priority of the later trade mark, the five-year period within which the earlier trade mark was to have been put to genuine use, as provided

for in Article 16, had expired, the proprietor of the earlier trade mark shall, in addition to the proof required under the above paragraphs (a) or (b), furnish proof that the trade mark was put to genuine use during the five-year period preceding the filing date or date of priority, or that proposed reasons for non-use existed.

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

A decision of refusal of registration from the Registrar can be appealed before the Administrative Court. The route is as mentioned in question 8.5 above.

## 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.
- 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 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.

Under Section 77 of the Trademarks Law, in case a party who presents reasonably available evidence which adequately support his allegations of trade mark infringement pursuant to the Law, whereas at the same time alleges that the opposing party has evidence under his control, the Court may order the counterparty to provide this evidence to the former party, subject to conditions imposed by the Court in order to safeguard the confidentiality of the said information.

Furthermore, in case an infringement at commercial scale is alleged, the Court may, following an application filed by a party, order the disclosure of banking, financial or commercial documents which are under the control of the opposing party, subject to conditions imposed by the Court in order to safeguard the confidentiality of the said information and in order for the disclosed documents to be merely used for the purposes identified on the court order. In addition, under Section 78 of the Law, in any trade mark or trade name infringement proceedings on a commercial scale, the Court may, following a justified request by a party, order the provision of information regarding the origin, distribution networks of the goods or services which (allegedly) infringe the trade mark or trade name, by the suspect and/or any other person who:

- (a) unlawfully possesses the illegal goods on a commercial scale; or
- (b) unlawfully uses the illegal services on a commercial scale; or
- (c) has been ascertained that he is the person who provides (on a commercial scale) services used to infringe the relevant rights; or
- (d) has been identified by any of the persons referred to in paragraphs (a), (b) or (c) as being involved in the production, manufacturing, or distribution of the goods or in the provision of the services.

This said information should include the full names and addresses of the producers, manufacturers, suppliers, distributors or other previous possessors of the good or service, the recipients, wholesale and retail sellers, information on the amounts produced, manufactured, delivered, received or ordered as well as the consideration received for the said goods or services.

#### 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 before the Court 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 to the Court and is considered as part of the – or can be considered the entire – witness's examination-in-chief.

However, evidence during a hearing procedure before a Court 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.

In addition, under Section 57 of the Law, the Registrar may (where the circumstances require so) order the stay of the registration, opposition, revocation and invalidation proceedings or grant deadline extensions.

#### 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 Section 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 EUR 30,000 for a first-time offence, and to imprisonment of up to five years and/or a fine of EUR 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 EUR 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 reputation acquired by the trade mark against which infringement proceedings have commenced.
- The Defendant's trade mark consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade.
- The signs consist exclusively of the following which are used in the course of trade and in accordance with honest practices in industrial or commercial matters:
  - (a) the name or address of the Defendant, where the Defendant is a natural person;
  - (b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;
  - (c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.
- The Defendant uses, in the course of trade, an earlier right which only applies in a particular locality, provided that right is created pursuant to the Law and the use of that right is within the limits of the territory of the Republic of Cyprus.

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

Depending on whether the infringement proceedings are held against a trade mark which has not yet been registered, or against a registered trade mark on revocation grounds or against a registered trade mark on invalidation grounds, the defences already mentioned earlier on in the chapter can be raised.

## 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 along with the publication of its decision or the performance of any other measure which will result in the dissemination of the decision.
- 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 relies on 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 rejecting 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 working days (or within three working 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?

As explained in question 2.2 above, a later trade mark is not registered where and to the extent that rights to a non-registered trade mark or to another sign used in the course of trade have been acquired prior to the filing date of the application of the subsequent trade mark or the priority date claimed to support the application of the subsequent trade mark, and the non-registered trade mark or the other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

In addition, Section 35 of the Civil Wrongs Law, Cap. 148, provides protection to unregistered trade marks, by providing that 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. 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?

A right to a name, a right of personal portrayal, a copyright, an industrial property right.

## 16 Domain Names

### 16.1 Who can own a domain name?

Domain names can be registered to any person, either natural or legal, irrespective of whether he/she is a permanent resident in the Republic of Cyprus or not (for natural persons) and irrespective of whether its legal seat is in Cyprus (for legal persons).

### 16.2 How is a domain name registered?

For the registration of a domain name, the relevant application shall be submitted online before the University of Cyprus, which is the responsible body, along with the supporting documentation. The responsible body shall assess the application and either reject or approve the domain name within one day. Prior to the registration of the domain name, and within six days following the approval of the name, the relevant registration fees shall be paid.

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

In addition to the right of use of the domain name that the registered owner is granted (for the period during which the registration remains in force), 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 are 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?

On the 12<sup>th</sup> June 2020, the new Trademarks Law, which harmonises the Cyprus Trademarks Law with the EU Directive No. 2015/2436 and which applies the EU Regulation No. 2017/1001, was published in the Official Gazette of the Republic of Cyprus, and the new Trademark Regulations were published in the Official Gazette of the Republic of Cyprus on the 16<sup>th</sup> June 2020.

The new Trademarks Law and Regulations bring major changes to the already existing procedure for the registration and protection of the Trademarks, simplify the already existing procedures and also introduce new procedures.

The new Trademarks Law and Regulations, include, amongst others, the following:

- Establishment of a multi-class system.
- Introduction of new types of trade marks, such as motif, movement, holographic, sound, position and trade marks consisting of colours.
- A single official fee for the trade mark registration paid at the beginning of the registration procedure.
- Reduced official fees for online trade mark registration applications and for online renewal applications.

- Abolition of the requirement of filing of PoA in trade mark procedures.
- Introduction of the possibility of dividing the registered trade mark.
- Additional absolute and relative grounds of refusal.
- Simplification of assignment procedure.
- Extension of the opposition period from two months to three months.
- Introduction of cooling off period of two months during opposition proceedings.
- The right of the trade mark applicant, in opposition proceedings, to request the Opponent to provide proof of actual use of the earlier trade mark.
- Non-use as a defence in opposition proceedings.
- Extension of the duration of the trade mark from seven years to 10 years.
- Clarification of the start date of the period of use of a national and international trade mark registration.
- Provision that a trade mark owner can prohibit not only the import and export of infringing goods, but also their transit.
- The trade mark may be given as a security or be pledged or be the subject-matter of a security *in rem* or be subject to mandatory enforcement, irrespective of the business, or be included in an insolvency procedure.

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

Some of the important judgments in the trade marks sphere that have taken place in Cyprus in the last 18 months are the following:

- **Law Action No. 1313/2019:** This judgment concerns an application for the issuance of an 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.

- **Civil Appeal No. 84/2014:** In its judgment issued on the 3<sup>rd</sup> July 2020, the Supreme Court ruled, among others, that good faith does not constitute a defence to a trade mark infringement claim and, more importantly, it overturned the first instance court's decision to award to the trade mark proprietor damages which significantly exceeded the profit that the infringer had gained via the infringing act. In particular, the Supreme Court ruled that no additional damages could be awarded since no evidence was presented to support that the trade mark proprietor had suffered any reduction in their sales or a damage in their good will or any damage of another nature. Therefore, the Supreme Court concluded, that the issuance of the prohibitory orders in itself, constituted adequate remedy.
- **Law action No. 1655/2019:** In the judgment issued by the first-instance court on the 14<sup>th</sup> September 2020, the Court ruled that a descriptive word which obtains reputation and contributes to the good will of a business may be protected under Section 35 of the Torts Law, which precludes passing-off.

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

The Intellectual and Industrial Property Section of the Registrar of Companies and Official Receiver is continuously updating its newly introduced electronic platform, in order to reach a stage where most or even all application forms which can be filed pursuant to the new Trademarks Law and Regulations will be submissible electronically.

Re-evaluation and reduction of a part of the official fees, which have been established under the new Trademarks Law and Regulations.

#### 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.



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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* and *The World Trademark Review (WTR)*.

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Foreign Direct Investment Regimes  
Franchise  
Gambling  
Insurance & Reinsurance  
International Arbitration  
Investor-State Arbitration  
Lending & Secured Finance  
Litigation & Dispute Resolution  
Merger Control  
Mergers & Acquisitions  
Mining Law  
Oil & Gas Regulation

Patents  
Pharmaceutical Advertising  
Private Client  
Private Equity  
Product Liability  
Project Finance  
Public Investment Funds  
Public Procurement  
Real Estate  
Renewable Energy  
Restructuring & Insolvency  
Sanctions  
Securitisation  
Shipping Law  
Technology Sourcing  
Telecoms, Media & Internet  
Trade Marks  
Vertical Agreements and Dominant Firms