

Cyprus

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1 Relevant Authorities and Legislation

1.1 What is the relevant Cypriot trade mark authority?

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

1.2 What is the relevant Cypriot trade mark legislation?

The legislation governing trademarks is the Trade Marks Law, *Cap* 268 as amended by Laws N.63/1962, N.69/1971, N.206/1990, N.176 (I)/2000 and N.121 (I)/2006, and the Council of Ministry Regulations 1951-2003.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

A registered trademark can be any sign capable of being reproduced graphically (particularly in words (including personal names), designs, letters, numbers, the shape and package of the products or any combination of these) and capable of distinguishing the goods or services of one undertaking from those of other undertakings, provided that the sign is used or is going to be used for the purposes of that distinction (*Section 2(1) of the Trade Marks Law, Cap 268*).

2.2 What cannot be registered as a trade mark?

If a mark falls within the scope of Article 11 of the *Cap* 268 – absolute grounds of refusal of registration (please see question 3.1 below), then it cannot be registered as a trademark.

Furthermore, a trademark will not be registered if it is of a scandalous design or contrary to public policy or accepted principles of morality.

2.3 What information is needed to register a trade mark?

The trademark application must include the following information:

- the full name and address of the applicant – request of registration;
- a description of the goods and services for which the trademark is seeking registration;
- the Power of Attorney, appointing a lawyer authorised to practise in Cyprus;

- if priority is claimed, the original or certified true copy of the application/registration documents of the already registered mark, translated into the Greek language; and
- one or more reproductions of the mark.

2.4 What is the general procedure for trade mark registration?

The trademark application should be filed with the Registrar based on the information/documents indicated in the above question 2.3. The Registrar checks the documents and, if everything is in order, informs the representative of the filing number of the trademark and proceeds with a search as to the registrability of the mark.

2.5 How can a trade mark be adequately graphically represented?

A trademark should be clearly represented in the submitted application. For coloured trademarks a representation in colour is required.

2.6 How are goods and services described?

The trademarks in Cyprus are classified as per the Nice Classification system, and each trademark should indicate specifically the goods and services for which it is being used. Since last year, it is not permissible to claim “all goods and services included in a class”.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a Cypriot trade mark?

Only Cyprus is covered by Cypriot trademark.

2.8 Who can own a Cypriot trade mark?

Legal entities and physical persons based either in Cyprus or abroad can own a Cypriot trademark.

2.9 Can a trade mark acquire distinctive character through use?

Yes, an applicant can claim distinctive character through use and should provide the Registrar with evidence proving this.

2.10 How long on average does registration take?

If no opposition is raised, it takes around 10 months to complete the registration.

2.11 What is the average cost of obtaining a Cypriot trade mark?

The costs depend on the complexity of the procedure (if an opposition is raised or not, etc.) and the number of classes for which the trademark is to be registered. Application for only one class of goods and services costs around 150 EUR, including publication fees and a registration certificate.

2.12 Is there more than one route to obtaining a registration in Cyprus?

A registration can be obtained by filing a national application, by filing an application with Community trademark or through the Madrid System for International Registration of Trademarks if Cyprus is designated.

2.13 Is a Power of Attorney needed?

Yes, the issuance of a Power of Attorney to a lawyer practising in Cyprus, in the form prescribed by the Registrar, is required with the filing of the application.

2.14 How is priority claimed?

Priority can be claimed by submitting the documents listed in the above question 2.3(d) within six months from the filing of the earlier application.

2.15 Does Cyprus recognise Collective or Certification marks?

Yes, they are both recognised.

Certification marks are recognised by section 37A of *Cap 268* and Collective marks are recognised by section 37B of *Cap 268*.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal of registration of a trademark as they are set out in Article 11 of Trade Mark Law, *Cap 268* are the following:

- a proposed trademark that does not fall within the definition provided by the law;
- trademarks that are devoid of any distinctive character;
- trademarks that consist exclusively of signs or indications which may serve in trade to designate the kind, quantity, quality, intended purpose, value, geographical origin, time of production of the goods, the provision of the services or other characteristics of the goods or services;
- trademarks that consist exclusively of signs or indications that have become a part of the current language or in the *bona fide* established practices of the trade;
- trademarks that consist of:
 - a) a shape that follows the nature of the good;
 - b) a necessary shape to carry out a technical result; and

c) a shape that gives substantial value to the good.

- trademarks that can deceive the public as to the nature, quality or the geographical origin of the goods or services;
- trademarks which under Article 6*bis* of the *Paris Convention for the Protection of Industrial Property* are unacceptable or void;
- trademarks that include symbolic importance, especially a religious symbol; and
- trademarks for which their application has been made in bad faith.

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

If a mark has acquired a distinctive character through its use, then it can overcome the absolute grounds of refusal.

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

In the case of a refusal of registration of a trademark, the decision can be appealed only in its entirety.

3.4 What is the route of appeal?

If the Registrar refuses registration then the applicant can apply for a judicial review of the decision of the Registrar to the Supreme Court on its revisionary jurisdiction. The decision of the Supreme Court can be appealed within 42 days to the Appeal Court.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal of registration of a trademark are set out in Article 14 of Trade Mark Law, *Cap 268*, and include the following:

- a trademark that is identical to an earlier and already registered trademark; and the goods or services to which the trademark has been registered or indicated are again identical with those that the earlier trademark is protected, cannot be registered or it can be declared void after any chance of registration;
- it cannot be registered if, due to its identification or its similarity with an earlier trademark and the identification or similarity of its goods or services that the two trademarks determine, there is a danger of causing confusion to the public that includes the danger of correlation with the earlier trademark; and
- it would not be registered, or if registered, it would be declared void, if a trademark is identical or similar to an earlier trademark but the goods or services that the trademark is determined and registered for are not similar to those protected by the earlier trademark, as long as the earlier trademark has a reputation in the Republic of Cyprus and the use of the later trademark unreasonably would take unfair advantage of the distinctive character or the reputation that would be detrimental for the earlier trademark.

4.2 Are there ways to overcome a relative grounds objection?

There are many ways to overcome an objection on relative grounds raised either by the Registrar or by any third party.

The applicant may:

- a. alter the representation of the mark;
- b. ask for a consent letter from the holder of the earlier mark;
- c. limit the list of goods and services seeking protection; and
- d. start procedures for cancellation or invalidation of the earlier.

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

The applicant has the right of appeal of the Registrar's decision in its entirety.

4.4 What is the route of appeal?

Please see the above question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

A trademark can be opposed on either absolute grounds as they are provided by section 11 of *Cap* 268 (question 3.1) or 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 Cypriot trade mark?

An opposition can be raised by the Registrar or by any other individual (usually by persons who own an already registered trademark), within two months from the advertisement of application. The notice of opposition should be sent in writing including all reasons of opposition.

5.3 What is the procedure for opposition?

If the Registrar opposes an application, then the applicant has the right to file a reply or ask for a hearing before the Registrar.

If any individual files an opposition to the registration of a trademark then the Registrar notifies the applicant and the applicant has the right of a counterclaim to insist on the registration of the trademark. The Registrar notifies the opponent of the counter statement, who has the right to bring evidence to support the opposition. The same should be done by the applicant. The Registrar will finally hear both parties and, based on the provided evidence, should give a final decision as to whether the trademark will be registered or not.

6 Registration

6.1 What happens when a trade mark is granted registration?

The Registrar issues the certificate of registration.

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

The rights of the applicant commence from the date of the filing of the application.

6.3 What is the term of a trade mark?

Section 22 of the *Cap* 268 provides that the registration of the trademark lasts for seven years from the date of the filing of the application. Then the mark should be renewed for 14 (fourteen) years periodically.

6.4 How is a trade mark renewed?

A trademark can be renewed with the filing of the necessary form and the payment of the relevant fee to the Registrar (80 EUR). Furthermore, if a trademark has not been renewed on time then it is advertised in the Official Gazette and the holder has a grace period of two months from the date of advertisement to file and pay for its renewal. If the holder fails again to pay within this period of two months then the mark is removed from the Registry.

7 Registrable Transactions

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

The assignment of trademarks is registrable with the filing of the relevant form to the Registrar, accompanied with the assignment document either as original or certified true copy.

A new Power of Attorney to the advocate of the assignee should also be provided.

7.2 Are there different types of assignment?

A partial assignment can be registered in relation to all or any of the goods and services.

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

The licensing of trademarks is available for individuals with the filing of the relevant form to the Registrar and payment of the applicable fee. The form should be accompanied by a Statutory Declaration and Statement of Case, signed by the proprietor of the trademark and any available contract between them should also be submitted either as original or certified true copy. The statutory declaration must refer to the duration of the permitted use, the relationship between the parties, the number of the licensed users and any other information that may be required by the Registrar.

7.4 Are there different types of licence?

The registration of a licence can be obtained for all or certain goods or services for limited or unlimited periods of time. The licence can be obtained either by one licensee or by more than one licensee.

7.5 Can a trade mark licensee sue for infringement?

A trademark licensee can only sue for infringement in the case where the owner of the trademark did not proceed to undertake any legal action after two months from the day of the request of the licensee.

When the licensee proceeds with legal actions he should always add the proprietor as defendant to the proceedings.

7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary for the licence.

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

There is no provision for the registration of a security interest under a trademark in Cyprus.

7.8 Are there different types of security interest?

No, the Trade Mark Law and the practice of the Registrar in Cyprus do not refer to any types of security interest.

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

A registered trademark can be revoked for any of the reasons listed in Section 28 of the Law:

- a. if the proprietor has not used the goods and services for a period of five consecutive years and there is no reason for that;
- b. if, after the registration of the mark, due to the acts or omissions of the proprietor the trademark has become a usual trade name of the goods and services for which it has been registered; and
- c. if, due to the use of the trademark, by its proprietor or using his consent, for the goods and services it has been registered there is a likelihood of confusion to the public, specifically as to the nature, quality or geographical origin of the goods and services.

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

The procedure of revocation requires an application at the District Court or to the Registrar.

8.3 Who can commence revocation proceedings?

Revocation proceedings can be filed by any individual who has reasonable grounds to complain.

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

A defence to the revocation can be the evidence of *bona fide* use of the trademark by its proprietor. Section 28.2 of *Cap 268* provides that a trademark will not be revoked from the Registrar if, within the period between the application of revocation and expiration of the five years, there was a *bona fide* use of the trademark.

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

If the Registrar refuses registration, the applicant can apply for a judicial review of the decision to the Supreme Court within 75 days from the decision. The decision of the Supreme Court can be appealed to the Appeal Court within 42 days from the date of the decision of the Supreme Court. A revocation decision issued by the District Court can be appealed by any party within 42 days from the date of the decision.

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

The trademark law does not provide an exhaustive list of grounds for invalidity of a trademark.

However as already mentioned above in question 3.1, there are absolute grounds for invalidation of a trademark and relative grounds. Section 13 of *Cap 268* provides that scandalous designs or designs contrary to public policy or to accepted principles of morality cannot be registered.

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

The filing of a legal action with a District Court.

9.3 Who can commence invalidation proceedings?

Any person (physical or legal) who has evidence and a legitimate interest.

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

The Trade Marks Law *Cap 268* provides as defence the cases where:

- a. the mark has acquired distinctive character through use;
- b. if the Registrar or the court consider that it was a *bona fide* use of the mark by the proprietor;
- c. the proprietor of the earlier right has consented to the registration; and
- d. the later mark has been used for five consecutive years and the owner of the earlier trademark has never proceeded any action against him.

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

The applicant may follow the judicial route of an appeal to the Appeal Court (deadline of 42 days from the date of the Appeal Court decision).

10 Trade Mark Enforcement**10.1 How and before what tribunals can a trade mark be enforced against an infringer?**

Infringement of trademark rights can be enforced by a court action before the District Courts.

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

Infringement proceedings begin with the filing of a court action before the District Court by the plaintiff. The infringer (defendant) should file a written defence. He can also file a counterclaim. The plaintiff should submit a written reply and request for a date to appear (both parties) before the court and then the court will set a hearing date. It usually takes between two to four years to obtain a court decision. Furthermore, efforts should be made for an out-of-court settlement before the hearing to avoid further delay.

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

Both preliminary and final injunctions are available.

An application for preliminary injunctions can be made to the court either *ex parte* or by summons. Final injunctions are granted as remedies where infringement is proved.

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

The ordinary rules governing disclosures also apply to trademark actions and the Civil Procedure Rules provide that a party can apply to the court for an order of disclosure. If the party that has been ordered to make a discovery fails to proceed accordingly then it will not have the opportunity to use it afterwards in a court action.

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

Submission by counsel can be presented either in writing on request of the court or orally, or even both. At the hearing procedure, evidence may be presented in writing in the form of a written statement that can be adopted by the witnesses. These written statements will be submitted as an exhibit to the court, forming part of the witnesses' examination in chief. Counsel may ask the witness further questions and then the witness can be cross-examined on his examination in chief.

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

Yes, infringement proceedings can be stayed upon request from the court if there is any resolution of validity pending in another court.

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

Not applicable under Cyprus Law.

10.8 Are there criminal liabilities for trade mark infringement?

No, there are no criminal liabilities for trademark infringement.

10.9 If so, who can pursue a criminal prosecution?

Not applicable under Cyprus Law.

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

Not applicable under Cyprus Law.

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?

Defences to a claim of infringement of a trademark depend on a case-by-case basis. The most common defences may be listed as follows:

1. The plaintiff has no title.
2. There is no *likelihood* of confusion and the mark is not the same or similar to the plaintiff's mark.
3. There is no chance of unfair advantage since the alleged one is very well known to the public and there is no possibility of confusion.
4. The trademarks address different categories of consumers.
5. There was no infringement.
6. The registration is invalid for other reasons.
7. The defendant has an independent right to use the mark.

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

Further possible defences are:

- a. Any honest concurrent right (derived from use) of the defendant.
- b. Any independent right to use the mark.
- c. There was unreasonable delay to the infringement procedures.

12 Relief

12.1 What remedies are available for trade mark infringement?

Available remedies depend on which procedure will be followed. Options are the *ex parte* injunction and *Anton Piller* order:

- a. Account for profits and damages.
- b. Court injunction to prevent the defendant to use the marks.
- c. Court order for destruction of the goods.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

In most cases the losing party pays its own costs, as well as the costs of the other party, unless the court orders that each side pays its own costs or unless the parties make an agreement between them as to the payment of the costs.

13 Appeal

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

There is a right to appeal from a first instance judgment of the District Court to the Appeal Court. An appeal can be filed not only as regards a point of law but also as regards the District Court's judgment and reasoning in reaching its decision.

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

Further evidence can be added at the appeal stage but only with the approval of the Appeal Court upon filing an application, and the Appeal Court is usually strict in allowing new evidence to be submitted. The application must be served on the other party who can oppose the application or ask to file evidence in reply if the court agrees with the first party adducing new evidence.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

The responsible authority is the Cyprus Customs Department. In the case of the importation of infringing goods or services, the proprietor of the intellectual property rights can make an application to the Customs Department instructing them to seize or suspend the importation of goods. The Customs Department checks the information, and once the application has been accepted they suspend or seize the goods and inform the trademark owner and the importer. They have 10 days from the date the Customs Department communicated its decision, for filing a court order.

Customs can initiate procedure to suspend importation of goods *ex officio* if they have reasonable grounds to believe that there is an infringement of intellectual property rights.

15 Other Related Rights

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

The rights of an infringement of an unregistered trademark can be protected under the Civil Wrongs Law, *Cap* 148 and the tort of passing off. Section 35 of the *Cap* 148 provides 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, commits civil wrong against such other person”.

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

A company name offers protection against third parties applying to register the same name as trade name since 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. If the company name is misused/infringed, action may be taken under the tort of “passing off”.

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 a title of a book or broadcasting may confer rights and can be used for passing off actions.

16 Domain Names

16.1 Who can own a domain name?

From September 2005 any Cyprus-registered company or Cyprus permanent resident can own a domain name.

16.2 How is a domain name registered?

Domain names ending with “.cy” are registered at the University of Cyprus. The applicant should file the applicable form, submitted with the supporting documentation and the applicable fee (which depends on the duration of licence and the category of the domain name).

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

The applicant or owner of a domain name is protected by the laws of Cyprus, including International Treaties ratified by the Republic of Cyprus from time to time relating to intellectual property issues as well as the ICANN Dispute Policy. Furthermore, once a domain name is registered, it is protected by the University of Cyprus and it may reject identical or similar applications. Additionally the Registrar ensures that no other person than the owner will take advantage of it. The licence cannot be transferred to another person except for the following cases, after being notified to and approved by the Registrar:

- the right of succession of natural persons; and
- the collaboration or consolidation with other legal person or redeeming by other legal person.

17 Current Developments

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

Last year there was change to the practice of the Registrar for the classification of the services of “sales” and “trade”, which will now be under Class 35 and not Class 36.

Furthermore, during the last year Cyprus joined TM View.

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

No there are not, except potential new court decisions which may provide clarification on the interpretation of the law.

17.3 Are there any general practice or enforcement trends that have become apparent in Cyprus over the last year or so?

No there are not.



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Andreas M. Sofocleous & Co LLC is one of the most successful Corporate and Commercial law firms in Cyprus. Headquartered in Limassol, and with offices in Eastern Europe and the UK, the firm provides legal services for individuals and companies at both the national and multinational level across a wide range of industries, dealing with mergers and acquisitions, cross-border transactions, joint ventures and intellectual property licensing, as well as company formation and management and other business arrangements.

Since 1995 our firm has been working successfully in the market of legal and consulting services. The skills and experience of our partners and staff, along with the use of modern technology, enable us to deliver high quality and rapid results for the benefit of our clientele, which include multinational corporations, public companies, and both small and medium-sized enterprises and individuals.