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## **The Greek Supreme Civil Court rules that book titles cannot be registered as trade marks**

Areios Pagos, the Greek Supreme Civil and Criminal Court, has recently ruled that book titles cannot be registered as trade marks. The judgment (No. 1309/2009) is based on the older, pre-harmonization law [the case is a couple of decades old!], but should be considered valid, as the relevant provisions of the current trade mark law (Act No. 2239/1994) are identical.

The dispute revolved around use of the mark “NEA SYNORA” (new borders), the title of an old literary magazine, that had been filed in 1970 (and registered) as a trade mark, in connection with magazines (Greek trade mark law includes an express provision that titles of newspapers and/or magazines can be registered as trade marks). Publication of the magazine stopped between 1975 – 1983 and the trade mark lapsed. However, in 1983, its owner (and plaintiff in the proceedings) registered a slightly different graphic version of the mark, retaining its word elements, this time covering not only magazines, but also books. In 1972, while the initial mark was still valid, a publishing house started using the same mark as its own distinctive sign and published books bearing that sign, together with the trade name of the publishing house (“Livanis Publications”). An initial attempt to stop the publishing house failed as the plaintiff’s preliminary injunction action filed in 1977 was rejected on lack of urgency (the court held that the plaintiff had been aware of the infringement since 1972 but took no action for 5 years). No

further legal action was taken. When the magazine was revived in 1983, the plaintiff sent the publishing house a rather soft extrajudicial letter, seeking a meeting to resolve the dispute. The magazine ceased publication again in 1986 and then another cease and desist letter was sent in 1989, followed by another equally unsuccessful preliminary injunction action, since 17 years of inaction are much harder to justify than 5. Still, following a main infringement action, the case reached the Court of Appeal, which dismissed it. The Court of Appeal held that the use of the publishing house's trade name in addition to the mark NEA SYNORA precluded the risk of confusion and also pointed that the publishing house used the mark NEA SYNORA for its books before the plaintiff registered the mark NEA SYNORA for books in 1983. This probably means that the appellate court thought that the plaintiff lost his right in and to the much earlier unregistered mark NEA SYNORA because of the "on and off" use thereof. The other alternative would be that the appellate court considered books and literary magazines as dissimilar products, which would not seem particularly wise.

Areios Pagos affirmed that ruling, which was all it had to do. However, it went a bit further: Restating a general consensus in Greek IP legal theory, Areios Pagos held that a book title cannot be registered as a trade mark, because it identifies the book itself as a literary work and not the publishing house. It also acknowledged instances where book titles can and actually have been registered as trade marks, namely collective works and cases when the mark was filed to designate the book – product as originating from the publisher. The last proposition should not be taken to mean that the publisher can register the book title, usurping an author's (potential) rights to the title of his/her book. It most likely is an alternative to collective works, namely a book series, in the context (and under the title) of which the publisher offers different books from different writers.

It is rather peculiar that Areios Pagos ruled on the registrability of book titles, because the core of the case did not call for any such analysis. To begin with, the validity of the trade mark, indeed registered to cover books, did not appear to be an issue in the (long) course of this litigation. The lower courts proceeded with examining and rejecting the likelihood of confusion claim, on the obvious basis of the validity of the mark. Additionally, under Greek law, civil courts have competence only over infringement cases, whereas the issues of validity and/or registrability of marks lie with the competence of the Trade Marks Administrative Committee (TMAC) and the administrative courts. Civil courts are bound by the decisions and judgments of the TMAC and the administrative courts and are not allowed to rule, even as an obiter dictum,

on the validity of a registered trade mark. Therefore, Areios Pagos may have overstepped its authority in this case and for no apparent reason.

Setting aside this harmless initiative by Areios Pagos, the case is a lucid example of how important consistency is for the protection of a mark whether registered or unregistered.

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