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1. FUNCTIONS OF TRADEMARKS

There are mainly two factors through which a manufacturer may exercise influence and persuasion through a trademark. The first of these factors emanates from the contemporary methods of production. Thus, because production in our time does not take place through personal labor and skills, and especially not through that of the manufacturer himself, the latter relies on industrial processes to produce the goods he is placing on the market. That being the case, the end result is not a reflection of the manufacturer's personal skills[1], but instead a reflection of applied industrial processes and methods, including the choice of raw materials used, methods of production, know-.how and patents used, quality standards and quality controls applied[2] etc. Hence, from the consumer's standpoint the personality of the manufacturer is usually not only unknown, but also readily ignored. Even contemporary legal literature accepts that the origin function of the trademark (normally thought as the origin in terms of a specific manufacturer) does not truly reflect the reality, since in many occasions consumers are not aware of, or are not interested in differentiating between specific manufacturers producing specific products. On the contrary, it is increasingly understood nowadays that the origin function tends to denote not so much the undertaking from which the specific product originates, but mainly the fact that all products bearing the same trademark share the same quality standards. Therefore, it may be argued that the origin function overlaps with that of the quality guarantee function[3]. Indeed, the first

[1] N. Rokas, Operational developments of the right to a trade mark, Commercial Law Review 1997, p. 447

[2] Quality standards and quality controls culminate in more than 50% of the total production of goods being denied a place in the market. In the case of high quality products, this high rate of goods rejected is the reason behind their high sales prices.

[3] N. Rokas, Utilization and protection of advertising value, Commercial Law Review 1999, p. 2, Operational developments of the right to a trade mark, Commercial Law Review 1997, p. 446, Th. Liakopoulos, Industrial Property, 5th Edition, 2000, p. 316, E. Delouca & Ch. Chrissanthis in N. Rokas,

reason for which a manufacturer, through his trademark, may exercise influence over the consumer is because today's industrial production is standardized. It follows that those products with the same trademark may, and usually do, share the same physical features and the same quality standards. Without the quality implication carried by the trademark, the latter would not be of any importance to the consumer, neither would it be capable of any influence or persuasion.

The second factor with which a manufacturer may exercise influence or persuasion through his trademark emanates from the rudimentary purpose of using a trademark in the first place, that is naming the product. Essentially, the primary function of a trademark is the naming of the product. Thus, in the mind of any consumer the product ceases to be one of a generic type, e.g. Virginia tobacco, and becomes Marlboro, Camel or Winston. This "naming function" has a dual connotation. First, it differentiates the product from other like and competing products. Second, the name of the product enables its manufacturer to advertise it by emphasizing the very name by which the product is known to the public. There could be no advertising for an anonymous product, and we all recognize today the importance of advertising in the shaping of consumer awareness, consumer opinion and consumer choice. As long as the trademark stands for a name for the product bearing it (an identifying and individualizing factor), it makes it possible to the manufacturer to communicate information to consumers regarding the product, i.e. its availability on the market, its features, its quality standards, the consumption needs it can meet etc. This is the informative function of the trademark.

Freedom of competition, present in our current economic system, signifies the presence of many like, and consequently competing,

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Trademark Law, 1996, article 1, p. 29, E. Soufleros in N. Rokas, Unfair Competition, 1996, p. 114, A. Sinanioti-Maroudi, The services' trademark, 1995, p. 43, 106.

products in the market that aim at the fulfillment of identical consumer needs. Within this environment, a manufacturer's need to inform the consuming audience about his product and elaborate on its advantages is not only self-evident, but also vital. This informational process takes place through various advertisement methods, as well as through the trademark itself, which thus performs an informative function. At this point, it should be noted that in some instances consumers might be interested only in the external characteristics of the product becoming thus the determining factor for the purchase, that is characteristics that can be easily and readily understood through the senses, i.e. vision, touch smell etc. In these instances, the influence of the trademark itself over its potential purchasers may be trivial. However, and in most of the times, the attributes and characteristics of a product cannot be empirically realized before the purchase and use of the said product, but following it. This applies in particular with respect to the durability of the goods and their respective ability to sustain heavy use, wear and tear. It is in these instances that a trademark becomes highly influential and its informative function is in effect. This is because a consumer who recognizes a specific trademark expects that upon purchase, he will experience the same attributes, qualities and pleasure he experienced in the past with a product carrying the same trademark, which is closely related to the function of quality guaranteeing.

The most determinative factor for the acquisition, preservation and even increase of the market share of a product is the advertising function of a trademark. The gist of this function lies on the exercise of influence and persuasion over consumers with the purpose of tampering the consumers' buying will. This tampering succeeds with the formation, within a consumer's mind, of certain positive, inner, psychological or cognitive representations that associate the product's trademark with a number of messages or values prescribed by the manufacturer himself. These representations may allusively point to a

number of attributes such as high quality standard of the product, its sturdy structure, its modern design, the product's approval/ recognition by certain social classes, the manufacturer's personality or even to the purchaser's personality and so on. For example, for a possessor of a Rolex watch we would expect him to be of a mature age, professionally successful and financially affluent. Admittedly, it would be difficult for us to imagine a civil servant or a young secretary wearing a Rolex watch (at least under ordinary and ethically acceptable course of things). On the contrary, a Swatch purchaser would linger in our minds as an individual of youth with an amiable and not demure personality. We would also suppose that a Rolex watch is sturdily build, made of expensive and durable material as opposed to the lighter Swatch. To give another example, a spouse would reasonably appreciate very much a Rolex watch as a present by her husband to celebrate e.g. their first decade of marriage; but it would probably make no good impression as a present by a teenager to his girlfriend. Instead, a Swatch would be better received in the latter case. These are some of the representations cultivated in the public's mind by the advertising campaigns of respective manufacturers. The way representations are created falls beyond the ambit of legal scholarship, but what is important for the lawyer is to understand that through advertising a manufacturer aims to reinforce not only the informative, but also the advertising function of his trademark. To a great extent, it is because of the latter function that a product acquires and maintains a certain market share.

Recapitulating, we may assert that a trademark performs primarily a naming and informative function, a differentiating –from other competing products- function, a quality-guaranteeing function and advertising function, while secondarily it performs the origin function. All these functions are carried out for the benefit of the manufacturer and for this reason the use of a trademark by a manufacturer creates a private right, whose use and protection can be thought of as being

equal to the protection of private interests. Only in a complimentary and inadvertent way the legal protection of the trademark contributes to the protection of consumer expectations with respect to quality standards of the product[4]. In contrast to the contemporary situation, under the pre-industrial revolution regime (that is the guilds' regime) a trademark served as a sectional control device and the protection of guilds' privileges, rather than a communication channel between the manufacturer and consumers.

The signs that may comprise the trademark may be visual, sonic, verbal, artistic or devices etc. Regardless of the signs used, trademarks are distinguished between those with conceptual meaning and those without. If a trademark has a conceptual meaning, it can possibly be either generic or descriptive of the type of products on which it is attached, their quality and their other attributes, or it can be (directly or indirectly) complimentary of the quality of the products, that is, let us say, "laudatory". The degree of descriptiveness may vary. As a general rule, the law does not permit the registration of generic and descriptive signs, while it deals with laudatory signs (such as DE LUXE, MASTER, CLASSIC, EXTRA, GLORIA, VICTORIA, SPECIAL, TRIUMPH, ALPHA-A, SELECTED, EXCLUSIVE, MEGA, EXTRA, SUPER, GOLDEN, BRAVO[5], EASY-BANK[6], DOUBLEMINT[7], VITALITE[8], etc) more leniently – wrongfully according to the present writer – and seems to accept their registration[9]. Descriptive signs provide direct

[4] N. Rokas, Trademark Law, 1978, II, Unfair Competition, 1975, 25, K.G Pampoukis The Law on Distinctive Marks, 1965, p. 164, B. Antonopoulos, Industrial Property, 2002, p. 426, Th. Liakopoulos, Industrial Property, 5th Edition, 2000, p. 321.

[5] For the sign "BRAVO" see the ECJ case C-517/1999, 4.10.2001, ECR 2001, I-6959. For other cases from national courts regarding laudatory trademarks like the ones mentioned see INTA, The Trademark Register, vol. 86, pp. 658, 824, 894, 905, vol. 87. pp. 1007, 1032 and 1053, 1045, 1047, 1053, 1049, 987, as well as in vol. 86, pp. 913, 951, vol. 87, pp. 1047, 1107, 1049.

[6] Court of First Instance, T- 87/00, 5.4.01, ECR 2001, II-1259.

[7] Court of First Instance, T-193/99, 31.1.01, ECR 2001, II-417, which was reversed by the ECJ, C-191/01, 23.10.03, ECR 2003, I-0000

[8] Court of First Instance, T-24/00, 31.1.01, ECR 2001, II-449.

[9] However, it is interesting to note that recent developments of the ECJ jurisprudence of the ECJ jurisprudence may have substantially altered the position of EEC law towards laudatory signs. For example, the ECJ in its judgment C-191/01, 23.10.03 rejected registration of the sign Doublemint for chewing gum on the basis that it is descriptive. Similarly, the ECJ has on the same basis rejected

information with regard to the type of product, its nature, its attributes and so forth. Laudatory signs provide indirect information, because such signs operate as positive insinuations. It is possible that a sign has a specific conceptual meaning or points indirectly to a specific conceptual meaning, which, however, is irrelevant with the corresponding product. In that case, informing the consuming audience through the trademark takes place in an indirect way. Where the sign has no conceptual meaning, that is, the sign is imaginary, then the informing process through the trademark is again indirect.

From the above, we may conclude the following:

a. Trademarks tend to be descriptive (to the extent that may be registered under the law as it currently stands), in other words trademarks that provide direct information should be entitled to a different (lesser) legal protection than those providing indirect information. This is so because direct information requires no additional time, work or expenses from the manufacturer, in order for his product to be established or publicly recognized, as opposed to trademarks providing indirect information about the product and where the establishment/ recognition process is gradual and i

b. Interference with and frustration of either the informative or advertising function of a trademark should amount to an infringement of the pertinent right, since it impoverishes the marketing function/ capability of the trademark. Since the trademark operates as a communication channel between the manufacturer and the consumers, it follows that its use by any third person disrupts the trademark's informative function and, therefore, it infringes the

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registration of the marks Streamserve (C-150/02, 5.2.04) for digital recording products, Postkantoor (C-363/99, 12.2.04), Biomild (C-265/00, 12.2.04) for food products. All these marks were strongly laudatory of the features and quality of the respective products. Although the Court did not discuss the issue of registrability of laudatory marks, one could argue that the above judgments in effect disapproved registrability of such marks.

pertaining right. It is an infringement regardless of whether the products are competing or not. In other words, the affront of a trademark can take place either by methods creating confusion with respect to the product's origin, i.e. manufacturing company, quality standards etc, or by methods that, while create no confusion, they interfere, nonetheless, with the trademark's informative function. Further, the entitlement of legal protection should be granted irrespective of the level of the trademark's repute; it suffices to have a trademark that is slightly recognizable. It follows that the likelihood of confusion should not be the central concept in the law of trademarks and should not form the sole ground of their civil protection.

c. The subject matter of trademark protection is the mark's capacity to communicate information to consumers and to be communicated as such and to be promoted among consumers as a reliable mark used in trade by a reliable or otherwise highly esteemed manufacturer. This is the quintessence of the mark's informative and advertising functions. One could even go as far as to assert that the essence of a trademark is the identity attached to the product after it has entered the market and has been used and established within the market.

d. Trademark law should aim at protecting private interests of the trademark owner. Consumer protection against confusion is not the core or the purpose of trademark law. Trademark law should be interpreted in view of this purpose.

e. It is worth emphasizing that while our legal system bluntly accepts that the law of trademarks protects the private right of the trademark owner, it uses as a criterion for the granting of legal protection the consumer. Thus, in determining whether the trademark owner is entitled to legal protection the law considers the average consumer and the potential confusion he might experience. In other words, legal protection is granted not according to the trademark owner's interests,

but those of the average consumer. Even if we accept that the above is not an example of legal contradiction, it is not, in the least, consonant with what common sense dictates. This critique is not a new one; on the contrary, it dates back to the beginning of the 20th century when trademark legislation was in its infancy[10].

2. LIKELIHOOD OF CONFUSION

It is a central legal concept in both trademark law and this part of unfair competition law which deals with infringement of other marks used in the course of trade. Likelihood of confusion is the test which is applied by courts, in order to identify whether there is an infringement of trademark, corporate name, design or other trade name or mark used in the course of trade. It is also the test applied by the Patent Office or any other appropriate administrative body, in order to identify whether there is any relative ground for refusing registration of a trademark or corporate name, due to prior rights. It is also the test used in any opposition or cancellation proceedings.

The conjecture as to the existence of a likelihood of confusion comes mainly from a combination of two factors: a) a comparison of the conflicting marks themselves in terms of sight, sound and meaning and b) a comparison of the goods and/ or services in connection to which the marks are used and registered.

The classic test for identifying whether there is, or there is not, a likelihood of confusion is the “sight, sound and meaning similarity”, which is always appreciated in view of the similarity of the products or services upon which these marks are used. The volume of resemblance and the conclusion whether there is or there is not a likelihood of confusion is made taking into consideration the similarity of products or services upon which the conflicting marks are used.

[10] F.I Schechter, The rational basis of trademarks protection, 40 Harv. L.R, 1927, 813.

Moreover, for the notion of likelihood of confusion to apply there must be a similarity as to the products or services upon which conflicting marks are used. Similarity as to products or services is examined in view of their respective nature and use and on the basis of the understanding of the average consumer; that is products/ services are similar, if the average consumer so believes and if he could be deceived that such similar products/ services (bearing identical or similar marks) originate from the same business enterprise. It is not necessary that the respective products/ services be directly competing one another. Products/ services are usually found to be confusingly similar, if they are addressed to the same prospective consumers. Hence, clothes, hygiene products and perfumes have been found to be similar by many courts. Computers have also been found to be confusingly similar with telecommunication products, while it is possible that products be confusingly similar with services rendered for such products, as has been held in connection to computer hardware products and software services.

The classic and usual type of consumers' confusion in trade is **forward confusion**. Forward confusion is caused when we have a senior user of a certain trademark, as well as a junior user of a confusingly similar mark. Consumers by mistake believe that the goods of the junior user originate from, or are affiliated in any way to the goods of the senior user. So consumers buy the goods of the junior user believing that they originate from the senior.

The notion of forward confusion derived from the practice of producing goods bearing distinctive marks similar in terms of sight, sound and meaning to other products' distinctive marks[11]. In these cases, the consumer is affected by the similarity between the external features of

[11] Greek Supreme Court (Areios Pagos) Cases 399/1989 (Commercial Law Review 1990, 711), 1009/1991 (Commercial Law Review 1992, 148) and 310/1990 (Commercial Law Review 1990, 709).

the goods concerned and is deceived that a product originates from a certain (the senior) user, whilst it derives from the junior one. This confusion is attributed to the fact that nowadays most consumers consider purchasing products based on the external features and marks of the products for sale in e.g. a supermarket store, instead of asking the salesman or even ordering for a particular product. Hence, in order to identify a likelihood of confusion it is important to compare the external features of the products (e.g. the coloring of the product's packaging) instead of their differentiating names in terms of sound. These coloring external features of a product are the ones that capture the attention of a consumer in a supermarket store. Of course, in most cases following the initial confusion and as long as the consumer is not in a hurry, he will eventually realize that the product does not originate from the senior user, as he was initially made to believe. However, even this initial confusion with respect to the true origin of the product elected qualifies as a "likelihood of confusion" in terms of law and amounts to an infringement of a registered trademark. The latter conclusion is substantiated by marketing reports on consumer behavior evidencing that as soon as the consumer has made a choice to purchase a particular product believing that it originates from a particular enterprise, he will eventually proceed into buying it, even if in the meantime (prior to the point of sale) he realizes the true origin of the product. In addition, the junior user succeeds a) in capitalizing on the fact that the goods of the senior user are already well-recognized in the market and b) in indirectly persuading the consumer that his goods are of a similar quality as the goods of the senior user. The latter argumentation was adopted by a US Court in McNeil-PPC v. Guardian Drug Co (984 F. Supp. 1066, 45 U.S.P.Q. 2d 1437 E.D. Mich. 1997)[12], where an infringement of a trade mark was identified by reason of a pharmaceutical product bearing similar distinctive marks in terms of color in comparison with the color and other distinctive marks of a different well-known pharmaceutical product.

[12] McNeil-PPC v. Guardian Drug Co (984 F. Supp. 1066, 45 U.S.P.Q. 2d 1437 E.D. Mich. 1997).

The Court reiterated the fact that, although the consumer might identify the true origin of the product prior to the point of sale, the initial confusion, by reason of which the consumer is tempted to purchase the product, substantiates adequately an actionable infringement of a trade mark.

A landmark judgment with respect to forward confusion was the US judgment "Grotrian, Helfferich, Schulz, Th. Steinweg v. Steinway & Sons"[13], where the Court adopted the view that the trademark proprietor was entitled to a remedy for confusion arising prior to the point of sale. It was found that the use of GROTRIAN-STEINWEG (pronounced "Steinway") in connection to pianos amounted to an infringement of the "STEINWAY & SONS" mark, even though it was unlikely consumers would purchase a GROTRIAN-STEINWEG piano under the mistaken belief it was a STEINWAY & SONS piano. The confusion resulted from the likelihood that consumers would believe (at least initially) that GROTRIAN-STEINWEG was affiliated with STEINWAY & SONS and purchase a GROTRIAN-STEINWEG piano on that basis.

Further, an actionable infringement of a trademark has been identified by application of the notion of forward confusion in the case where a third party used a registered trademark as his own Web (Internet) address; in the latter case the Court found that, if the "epix.com" Web address were used, then the consumers, who had bought in the past goods bearing the EPIX trademark, would visit this Web address and consider purchasing the goods promoted through the latter Web link[14].

[13] Grotrian etc. v. Steinway & Sons, 365 F. Supp. 707, 717, 180 U.S.P.Q 506 (S.D.N.Y 1973).
[14] Interstellar Starship Services Ltd. V. EPIX Inc., 184 F. 3d 1107 9th Circuit, USA.

3. DEVELOPMENT OF THE NOTION OF LIKELIHOOD OF CONFUSION

Based on the traditional approach in legal theory and case law, the right to a registered trademark is an absolute right only in case of identity between the mark and the sign and goods or services[15]. This means that, according to Greek law (article 4 par. 1a of Law 2239/1994), this is the only case where the registered trademark is granted full protection against any third party. The ECJ[16] and Directive 1989/104/EEC use the same wording as well. However, it would be more accurate to say that, according to the prevailing view in legal theory and practice, the right to a trademark is not absolute, but is protected against any third party who uses the trademark on similar products or services without being entitled (without having a right) to do so.

Taking into account the above (as against the "origin, naming and advertising" function of a trademark) one would say that the restraint of the absolute character of the right to a trademark restrains the scope of protection, as the trademark would be protected only where there is a likelihood of confusion.

However, the notion of likelihood of confusion has been expanded by case law to include apart from the classic and usual type of consumers' confusion (that is, forward confusion) other similar cases.

[15] N. Rokas has correctly contested the "absolute" nature of such right- see Trademarks Law, 1978, p. 15, Antonopoulos, p. 540 par. 582.
[16] C- 251/1995 Sabel/ Puma, 1997, I-6191 para. 20-21, C-39/1997 Canon, para. 15. See also Greek case law/ Supreme Court (Areios Pagos) 399/1989. However, the ECJ has adopted a much lighter wording in the Arsenal case (Arsenal FC v. M. Reed, C-206/2001) providing ground for a different approach in the future and particularly highlights the quality guarantee function of the trademark.

Reverse Confusion. In particular, **reverse confusion**[17] is the opposite of forward confusion. In reverse confusion we have a senior user whose trademark, although senior, has not become a famous one and has not developed a strong reputation. We also have a junior user who uses a confusingly similar trademark or other mark; but this junior user enters the market with so strong advertisement and promotion, that achieves to make his junior (confusingly similar) mark well known and established within a short period of time. This is to the detriment of the senior user, for consumers, influenced by the mass advertisement of the junior, tend to believe that it is the senior user who is an infringer and that the senior user's goods are infringing and counterfeit goods. Reverse confusion is equally prohibited to forward confusion.

A landmark case in foreign case law on reverse confusion is "Big Foot" case (Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co. 561 F. 2d 1365, 195 US P.Q 417 10th Circuit 1977 – 434 US 1052, 54 L. Ed. 2nd 805, 98 S. Ct 905 -1978). A small company (Big O Tire) had been using the Big Foot trademark as from the spring of 1974. During the summer of the same year, Goodyear decided to use the term "Big foot" in a nationwide advertising campaign of approximately 6 million US $ to promote the sale of its new type of tire. By reason of the mass advertising of the Goodyear tires, the consumers who asked from the small enterprise for the Goodyear Big Foot tires were taken by surprise when they realized that the enterprise was not trading the Goodyear tires. Moreover, they were given the impression that the small enterprise was intentionally producing tires intentionally resembling the Goodyear Big Foot tires' marks. The US Courts awarded to the small enterprise 4.7 million US $ as compensation. Further, a similar case was that of the Tiffany's trademark, wherein the US Courts identified a "reverse confusion" case when the well-

[17] J.P MacCarthy, On trademarks & unfair competition, West Group Publishing, par. 23.10 – R. Kirkpatrick, Likelihood of confusion in trademark law, Practicing Law Institute, par. 1.4.C, 7.9.E, 8.1, J. Phillips, Trade Mark Law, Oxford University Press 2003, par. 10:130.

known Tiffany's New York jewelry store expanded its business activities and attempted to use its trademark on beauty goods, where, however, a trademark of a smaller enterprise entitled Tiffan-e had been registered beforehand.

In addition, it is worth noting that the 1995 US Restatement (Third) of Unfair Competition Act refers to "reverse confusion" as an infringement of a right to a trademark.

A requirement for reverse confusion to apply is that the users should be of a different financial status and advertising outlook. On the contrary, if the prior user is an equally strong enterprise and enjoys a strong advertising presence, then it is difficult for a reverse confusion to apply. Taking into consideration that the notion of reverse confusion is not associated with the origin function of the trademark, but with the nature of the goods as genuine or not, it results that the test of "origin function" is inadequate for determining the scope of protection.

After sales confusion[18]. Confusion usually affects consumer at the point of sale and at the time of sale, that is when he is deciding to purchase a certain item of trade. However, confusion may affect other consumers as well, at a later stage in time. So, post sale confusion is the confusion of others than the purchaser; the purchaser himself may have been confused at the time of purchase, but may have been not also. For example, luxury Rolex watches sold for 1$ at an open fair market are clearly not genuine Rolex watches originating from the well known Swiss manufacturer. The purchaser of an 1$ Rolex watch can hardly believe that he is buying a genuine Rolex, which is sold

[18] J. Th. McCarthy, Important trends in trademark and unfair competition law during the decade of the 70's, 71 Trademark Rep. 93, 107 (1981), R.L Kirkpatrick, 1.7, 2.6, 6.5, D. Tichane, The maturing doctrine of post sale confusion (1995) 85 Trademark Rep. 399, J. Phillips 10.122, A.M McCarthy, The post sale confusion doctrine: Why the general public should be included in the likelihood of confusion inquiry? 67 Fordham L.R. 1999, 3337.

exclusively in selected luxurious stores and at extremely high prices. However, other consumers who see the purchaser to wear the 1$ Rolex may well be confused in thinking that this is a genuine Rolex. This confusion is again actionable, because it causes detriment to the owner of the trademark and devaluates the value of his mark. In the USA case law an "after sales confusion" was identified in a case where Rolex watches were sold for 25$ in an open fair market[19].

Since every prospective buyer could understand that he was not buying a genuine Rolex watch, it would be hard to identify a "forward confusion" according to the standard criteria & tests, for there was no confusion as to the true origin of the goods. Based on the judgment's argumentation, the trademark infringement was founded by reason of the confusion created to third parties, who would take the Rolex as a genuine one. This confusion is again actionable, since the producer of such not genuine goods capitalizes on the false impression/ esteem caused to third parties[20], who would see the purchaser wearing the watch and would believe that it is a genuine one. Similar case law may be found in cases like OSCAR[21], which involved an infringement of the OSCAR Award Winning trademarks, the trademark of WRANGLER'S[22] trademark, which was found to be infringed by a mark named "Wranger's", REEBOK[23] sports shoes, whereby an infringement was identified when a third party put in the market shoes bearing similar distinctive designations.

Moreover, it is highlighted that the case law in many States, such as England[24], Ireland[25] and Spain[26], accepts that "after sales confusion"

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[19] Rolex Watch USA Inc. v. Canner, 645 F. Supp, 484, 1 U.S.P.Q 2d 1117 (S.D. Fla. 1986)

[20] See also similar case law in ATMOS: Mastercrafters Clock & Radio Co v. Vacheron & Constantin-Le Coultre Watches, Inc. 221 F. 2d 464, 105 U.S.P.Q. 160 (2d Cir. 1955).

[21] Academy of Motion Pictures Arts & Sciences v. Creative House Promotions, Inc. 944 F. 2d 1446, 19, U.S.P.Q 2d 1491 (9th Circuit 1991).

[22] Levi Strauss & Co. v. Blue Bell, Inc. 632 F. 2d 817, 208, U.S.P.Q. 713, 718 (9th Cir. 1980)

[23] Payless Shoesource, Inc, v. Reebok Int'l Ltd., 998 F. 2d 985, 27 U.S.P.Q 2d 1516 (Fed. Cir. 1993)

[24] Reckitt & Colman v. Borden [1990] Reports of Patent Cases 340 (HL).

[25] United Biscuits Ltd v. Irish Biscuits Ltd [1971] Irish Reports

constitutes an actionable infringement of the trademark. Such is also the view of the European Court of Justice, as recently expressed in the Arsenal Case[27] (C-206/2001), which involved the sale of scarves referring to Arsenal FC by an independent salesman (freelancer) from several stalls located outside the grounds of Arsenal Football Club. In the latter case, it was found that, even though these consumers would not conclude that these were supplied by Arsenal FC as trademark proprietor, the use, however, of a sign identical to the trademark was liable to jeopardize the origin function of the mark, by reason of the impression that there is a material link in the course of trade between the goods concerned and the trade mark proprietor.

Affiliation. Some times two or more marks may not seem so similar so as to cause a likelihood of confusion with respect to the origin of the respective goods from a certain undertaking. However, they may resemble one another in a way that a consumer may reasonably tend to believe that there is some form of affiliation between their owners. The situation is described as likelihood of affiliation and is legally treated in the same way as likelihood of confusion. Such likelihood of affiliation may arise from the goods or services offered by the trademark owners. For instance, if a bank uses the mark ALPHA for banking services and then appears an insurance company using this same mark, consumers will usually and reasonably believe that there is some sort of affiliation between the two. Under EEC trademark law (the EEC 89/104 Directive) likelihood of affiliation is understood in a more narrow way, in the sense that it is believed to be ancillary and supplementary to the likelihood of confusion. The ECJ in its judgment dated 11.11.1997 in case C-251/1995, Sabel/ Puma[28] clarified that it is not the likelihood of any sort of affiliation that it is actionable under EEC trademarks law, but only the likelihood of such an affiliation that

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[26] Judgment of 24.04.2002 (III) with respect to the ACUPREL - AQUAPRED trademarks.
[27] ECJ 12.11.2002, C-206/2001 para. 57
[28] See also ECJ C-426/00 (Adidas, 22.6.2000) ECR 2000, I-4861, C-317/1991 (Quatro, 30.11.1993) ECR 1993, I-6227, C-39/1997 (Cannon, 29.9.1998) ECR 1998, I-5507.

is likely to lead to confusion. In this sense, affiliation is actionable only when it somehow leads to confusion, or. In other words, the likelihood of affiliation cannot stand alone and independent from the likelihood of confusion, but it is understood to be a form of confusion.

4. ADDITIONAL GROUNDS & TESTS FOR IDENTIFYING LIKELIHOOD OF CONFUSION

As is correctly stipulated by French legal literature on trademarks, EU trademarks law has adopted additional criteria for identifying a likelihood of confusion. Before the entry into force of Directive 89/104/EEC, the likelihood of confusion could be identified by means of a comparison between distinctive marks and the products or services involved. However, both the Directive 89/104/EEC and ECJ case law have added up a number of (by no means conclusive) additional criteria/ standards. For instance, additional elements that may substantiate a likelihood of confusion include, among else: elements deriving from the distribution networks (through which the distribution of products takes place), the possibility and prospect of expansion of an enterprise to other markets, the extent to which a trademark is recognizable (enjoys recognition) in a market, the indication of “origin function” of the trademark, the sales marketing methods adopted by each individual enterprise etc. However, it should be highlighted that the latter “additional grounds” may lead to a restraint of the scope of protection. In particular, a number of cases, which would qualify as a likelihood of confusion in the past according to the standard tests (comparison between products and distinctive marks), could now be deprived of any legal protection as not amounting to a likelihood of confusion according to the modern- additional tests. It is worth noting that the modern- additional tests are primarily aimed towards a legal framework protecting the “origin” function of a trademark instead of the “naming and advertising” one.

5. APPLICATION OF TRADEMARKS LAW IN GREECE

Even the less experienced on the application of the law on trademarks by the Courts recognize the "legal uncertainty" as its fundamental "principle", which is substantiated by the numerous conflicting judgments and diverse criteria and elements taken into consideration by the Greek and international case law. This "legal uncertainty" is particularly unwelcome to the legal professionals who believe that legal certainty with respect to the bundle of rights and obligations of a person reflects a sine-qua-non for commercial transactions.

A common practice adopted in the application of trademarks law is that the registration of a trademark is effected by means of an administrative act. This results into some of the disputes arising in relation to the application of trademarks law being tried by Administrative Courts, whilst others are tried by Civil Courts. It is worth noting that an Administrative Judge cannot effectively capitalize on his legal training in trying a trademarks law case, which essentially involves a deep understanding of the function of financial markets & trade.

Moreover, a case tried before a Civil Court (e.g. a claim for a freezing injunction aiming at protecting a trademark from a third party's infringement) may have to be adjourned until the issuance of a judgment of an Administrative Court addressing the regularity of the administrative act, by means of which the trademark had been registered with the Patent Office. Such adjournment of the Civil Court case may lead to a long delay of even 10 years, as the procedure before the Administrative Courts can be quite time-consuming.

In addition, the intervention of the Greek Administration with respect to the registration of a trademark and the Civil Servants, who are involved in the registration process, is not understandable, since the

latter do not possess any expertise or relevant know-how in evaluating an Application for Trademark registration. It would be much more effective to grant by law such authority to the Civil Courts, whereby the Judge would be given the authority to evaluate such an Application and order its registration with the Patent Office (or reject the application).