



PRACTICAL LAW

MULTI-JURISDICTIONAL GUIDE 2012/13

IP IN BUSINESS TRANSACTIONS

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Italy

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PATENTS

1. What are the legal requirements to obtain a patent?

The legal requirements are:

- Absolute novelty.
- Inventive step.
- Applicability to industry.
- Lawfulness.

2. What categories are excluded from patent protection?

The excluded categories include:

- Discoveries, scientific theories and mathematical methods.
- Plants, principles and methods for intellectual activity, games or commercial activity and computer software.
- Presentations of information.
- Methods of surgical or therapeutic treatment of the human/animal body and methods for diagnosis applied to the human/animal body.
- Plant varieties and species of animals, and essential biological procedures aimed at obtaining the same.
- Biotechnological inventions set out under section 81 *quinques* of the Italian Code of Industrial Property (such as the human body, any process aimed at human cloning and so on).
- Violations of public policy or accepted principles of morality.

3. Which authority registers patents? Does its website provide guidance on the application procedure? If not, please give brief details of this.

The Italian Patents and Trade Marks Office (*Ufficio Italiano Brevetti e Marchi*) (UIBM). Guidance is available on its website (www.uibm.gov.it).

4. On what grounds and when can third parties oppose a patent application?

There is no administrative remedy of opposition. A lawsuit can be filed at any time before the Intellectual Property Court (IP Court) based on failure to meet the requirements, such as:

- Lack of novelty.
- Lack of inventive step.
- Lack of industrial character.
- Not lawful.
- Insufficient description.
- The patent object extends beyond the content of the original application.
- The applicant was not entitled to file.

5. When does patent protection start and how long does it last?

Patent protection starts from the patent filing date and lasts for 20 years from the filing date.

6. On what grounds can a patent infringement action be made?

The grounds include:

- Direct infringement.
- Infringement for equivalents.
- Contributory infringement.

7. Which courts deal with patent infringement actions?

The courts dealing with patent infringements are:

- The IP Court in civil proceedings.
- The criminal court.

8. What are the defences to patent infringement actions?

Defences include:

- Non-infringement.
- Infringement action barred (statute of limitation).
- Private/non-commercial use.
- Experimental purposes.
- Nullity.
- Exhaustion of owner's right.
- Right of prior use.

9. What are the remedies in patent infringement actions?

The remedies include:

- Provisional and permanent relief: seizure, description or injunction.
- Removal and destruction of infringing materials.
- Prohibition of further use.
- Ordering disclosure of information about the origin of the infringing products or about any third party involved in the infringement.
- Payment of damages or profits.
- Publishing of the judgment.
- Reimbursement of legal costs.
- Criminal sanctions in cases of intentional infringement.

TRADE MARKS

10. What are the legal requirements to obtain a trade mark?

The legal requirements include:

- Capacity of being represented graphically.
- Novelty.
- Distinctive character.
- Lawfulness.

11. Is it necessary or advisable to register trade marks?

Registration of a trade mark is always highly recommended to have effective and broad protection.

Prior use of an unregistered trade mark does not imply lack of novelty for an application to register an identical trade mark, unless the sign has acquired notoriety due to the prior use. The third party pre-user has a right to continue to use the trade mark but this is limited to the use made up to the application date.

It is not necessary to register a trade mark if it has obtained secondary meaning, or if it is notorious or well known in Italy under Article 6*bis* of the Paris Convention, and therefore enjoys the same protection as a registered trade mark.

12. Which authority registers trade marks? Does its website provide guidance on the application procedure? If not, please give brief details of this.

See *Question 3*.

13. On what grounds can the regulatory authority refuse to register a trade mark?

The UIBM conducts a formal examination to verify if a trade mark complies with the requirements. It does not conduct a substantive examination based on the existence of prior identical and/or confusingly similar trade marks.

14. On what grounds and when can third parties oppose a trade mark application?

It is possible to file an opposition procedure against trade marks that:

- Are identical or similar to trade marks previously registered for identical or similar products or services.
- Have been registered without the necessary consent of the person holding the right (such as for persons' portraits, names and well-known signs under Article 8 of the IP Code).

To be admissible the opposition must be filed within the mandatory limit of three months from the date of the publication of the:

- Trade mark (in the WIPO Gazette for international trade marks).
- A registration application (capable of being registered under Article 170, par 1 letter a) or deemed capable of registration on the basis of a final judgment granting the registration.

In addition, a claim can be filed at any time before the IP Court.

A trade mark can be declared invalid:

- If it is not capable of being represented graphically.
- For lack of novelty.
- For lack of distinctive character.

A trade mark can be revoked if it is not used by the holder, or with the holder's consent, for the products or services for which it has been registered within five years from registration.

15. When does trade mark protection start and how long does it last?

Trade mark protection starts from the application date and lasts ten years from the application date. It is renewable indefinitely.

16. On what grounds can a trade mark infringement action be made?

Use without authorisation of:

- A sign identical to a registered trade mark for identical products/services with those for which the trade mark is registered.

- A sign identical or similar to a registered trade mark for identical or similar products/services, if due to identity or similarity, there is the likelihood of confusion for the public.
- A sign identical with or similar to a registered trade mark, even if the products/services are not similar, if the registered trade mark has a reputation in the country, and if the use of the sign without due cause allows to take an unfair advantage over the distinctive character or the reputation of the trade mark.

17. Which courts deal with trade mark infringement actions?

See *Question 7*.

18. What are the defences to trade mark infringement actions?

Defences include:

- Non-infringement.
- Infringement action barred (statute of limitation).
- Private/non-commercial use.
- Invalidity of the trade mark.
- Descriptive use.
- Revocation for non-use.
- Right of prior use.
- Exhaustion of owner's right.
- Customary term in the current language.

19. What are the remedies in trade mark infringement actions?

See *Question 9*.

COPYRIGHT

20. What are the legal requirements to obtain copyright protection?

The original works must have creative character that reflects the author's personality.

21. Can copyright be registered?

Copyright can be registered, but registration is not required. Published works can be registered at the Ministry for Cultural Heritage (*Ministero per i Beni e le Attività Culturali*), and unpublished works at the Italian Society for Authors and Publishers (*Società Italiana degli Autori ed Editori*) (SIAE). Guidance on the application procedures is provided at www.librari.beniculturali.it and www.siae.it respectively. Registration gives the work a fixed date.

22. When does copyright protection start and how long does it last?

Copyright protection starts from the creation of the work and lasts for 70 years after the author's death.

23. On what grounds can a copyright infringement action be made?

Grounds for a copyright infringement action include:

- Violation of moral rights.
- Exploitation by a non-authorised subject of one of the economic rights.
- Violation of one of the neighbouring rights (that is, rights that do not belong solely to the author of the work but to subjects connected to it, for example, performers, phonographic producers, producers of cinematographic or audio-visual works, radio and television broadcasting companies and so on).

24. Which courts deal with copyright infringement actions?

See *Question 7*.

25. What are the defences to copyright infringement actions?

Defences include:

- Non-infringement.
- The work entered the public domain.
- The use falls in the category of free use.
- Exhaustion of rights.

26. What are the remedies in copyright infringement actions?

See *Question 9*.

REGISTERED DESIGNS

27. What are the legal conditions to obtain a registered design right?

The conditions are:

- Novelty.
- Individual character.



28. Which authority registers designs? Does its website provide guidance on the application procedure?

See *Question 3*.

29. On what grounds and when can third parties oppose a registered design application?

There is no administrative remedy of opposition. A lawsuit can be filed at any time before the IP Court. A registered design can be declared invalid on the following grounds:

- Lack of the requirements such as novelty, individual character and lawfulness.
- If the product embodying the design is not visible during its normal use.
- If the appearance of the product embodying the design is only determined by a technical function.
- If the applicant was not entitled to file.

30. When does registered design protection start and how long does it last?

Registered design protection starts from the filing date and lasts five years. It can be renewed for four subsequent periods of five years.

31. On what grounds can a registered design infringement action be made?

Infringement includes unauthorised use such as:

- Manufacturing.
- Offering for sale.
- Putting on the market.
- Importing.
- Exporting.
- Using a product in which the design is incorporated, or to which it is applied.

32. Which courts deal with registered design infringement actions?

See *Question 7*.

33. What are the defences to registered design infringement actions?

Defences include:

- Non-infringement.
- Infringement action barred (statute of limitation).

THE REGULATORY AUTHORITY

**Italian Patents and Trade Marks Office
(Ufficio Italiano Brevetti e Marchi) (UIBM)**

W www.uibm.gov.it/it

Main areas of responsibility. Registration of trade marks, patents, utility models.

Guidance on application procedure. Can be obtained from website.

- Private/non-commercial use.
- Experimental purposes.
- Invalidity of the registered design.
- Exhaustion of owner's right.
- Right of prior use.

34. What are the remedies in registered design infringement actions?

See *Question 9*.

UNREGISTERED DESIGNS

35. What are the legal conditions for unregistered design rights to arise?

Unregistered designs are protected by Regulation (EC) No. 6/2002 on Community designs. The requirements are:

- **Novelty.** A design is new if before the date on which it was first disclosed to the public, no identical design has been made available to the public.
- **Individual character.** A design is deemed to have this if the overall impression it produces on the informed user differs from the overall impression produced on the user by any previously disclosed design.

36. When does unregistered design protection start and how long does it last?

Protection starts when the product enters the EU market for the first time and lasts for three years.

37. On what grounds can an unregistered design infringement action be made?

Infringements include unauthorised use such as:

- Manufacturing.
- Offering for sale.
- Putting on the market.



- Importing.
- Exporting.
- Using a product in which the unregistered design is incorporated, or to which it is applied, provided the infringing product is identical to the unregistered design.

Under Italian case law, the owner of an unregistered design must show that the individual character and creative element significantly differentiate the product from other designs already available in the EU.

38. What are the defences to unregistered design infringement actions?

Defences include:

- Non-infringement.
- Private/non-commercial use.
- Autonomous development of the design.
- Lack of the requirements for the protection of an unregistered design.
- Exhaustion of owner's right.

39. What are the remedies in unregistered design infringement actions?

See *Question 9*.

CONFIDENTIAL INFORMATION

40. What are the legal conditions for rights in confidential information to arise?

Rights in confidential information arise if the information, consisting of business information and technical-industrial

expertise, including commercial expertise, is subject to the owner's legitimate control and provided it:

- Is secret.
- Has an economic value due to it being secret.
- Is subject to measures to keep it secret.

41. On what grounds can an action for unauthorised use of confidential information be made?

Grounds include disclosure, acquisition or use of confidential information in an unlawful way without the consent of those who have the right to control the information.

42. Which courts deal with actions for unauthorised use of confidential information?

See *Question 7*.

43. What are the defences to actions for unauthorised use of confidential information?

Defences include:

- Not confidential in nature.
- Not kept secret.
- Otherwise known to the public.

44. What are the remedies in actions for unauthorised use of confidential information?

See *Question 9*.

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