

OPPOSING TRADEMARKS IN ITALY



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Most EU countries have administrative procedures that allow trademark registrations to be opposed but, until recently, Italy did not. This is despite the fact that an opposition system is provided for in the current intellectual property (IP) Code, which has been in force since 2005.

The procedure remained a dead letter because the implementing regulation had never been enacted and a system to publish trademark applications had never been put in place. The only way for the owner of an earlier right to challenge a trademark application was to commence a cancellation action through ordinary courts in Italy.

The opposition procedure has finally become a reality. In 2010, the implementing regulations of the IP Code were enacted. On May 11, 2011, the Ministry for Economic Development passed the long-awaited Opposition Decree, a further regulation detailing, *inter alia*, the timetable for implementing the opposition procedure. The procedure for opposition against the registration of trademarks finally became available in Italy in July 2011.

The procedure applies to trademark applications filed in Italy as of May 1, 2011, and international trademarks published as of the first issue of the July 2011 WIPO (World Intellectual Property Organization) *Gazette of International Marks*.

The new procedure should significantly assist IP rights holders to protect their investment in trademarks and brand development. Furthermore, Italy's move harmonises options for trademark opposition with broader international practice.

It comes as a welcome change, as it offers an alternative to expensive and lengthy judicial cancellation proceedings. In addition to lower costs for the parties and strict time limits that require a decision within 24 months, the procedure includes a mandatory initial cooling-off period of two months, thereby encouraging parties to meet and settle their differences quickly before beginning adversarial proceedings.

The Italian Patent and Trademark Office (Ufficio Italiano Brevetti e Marchi, UIBM) estimates that it will handle approximately 3,000 to 3,500 oppositions per year (based on national filing statistics and the Office for Harmonization for the Internal Market [OHIM] averages).

The procedure

The Italian opposition procedure is based on the opposition proceedings at OHIM, although it has some notable differences.

Oppositions to Italian trademarks may be filed within three months of the publication of the application for registration in the *Official Bulletin of Trademarks*, as of July 2011. For international trademarks extended to Italy, the term is three months from the first day of the month following the international trademark's date of publication in the *WIPO Gazette*.

The notice of opposition has to be filed with UIBM in writing, using a standard form. Once completed, the form needs to be transmitted in four copies to the UIBM by hand, registered letter or authenticated email. A fee of €250 (\$340) must be paid prior to filing the opposition.

Legitimate opponents include: owners of earlier trademarks registered in the state or having effect within the state; applicants who have filed applications within the state for registration of trademarks on earlier dates, or having effect within the state on earlier dates by virtue of priority rights or valid seniority claims; holders of exclusive licences for use of a trademark; persons, entities and associations under Article 8 (rights holders of persons' portraits, names, well-known signs).

A peculiarity of the Italian opposition procedure, with respect to the European Community trademark procedure, is that it is not possible to base the opposition on unregistered trademarks, the reputation of an earlier trademark registered or applied for dissimilar goods or services or other IP rights such as company names, domain names or copyright. These rights may be asserted only in court proceedings.



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If the notice of opposition is found admissible, UIBM will notify the opposition to the applicant within two months from the expiry of the opposition term.

As with the Community opposition procedure, a two-month period is provided to allow the parties to reach a settlement agreement, which may be extended, by common request of the parties, by up to one year from UIBM's first communication.

Also, if an agreement is not reached, supporting documents (registration certificates, translations and the like) may be filed by the opponent after the expiration of the cooling-off period and the applicant may present its reply in writing within a term set by UIBM.

In accordance with Article 178(4), at the request of the applicant, opponents holding previous trademarks registered for at least five years are obliged to provide, within 60 days, evidence of the effective use of such trademarks, or face a rejection of the opposition.

UIBM shall communicate the observations and documents filed by one party to the other, granting a term within which to submit observations in response. At the end of the adversarial part of proceedings, UIBM will admit the opposition, refusing the trademark application in full or in part where the trademark cannot be registered for any or some of the goods and services listed in the application; otherwise, the opposition will be rejected.

UIBM must issue its decision within 24 months, not including any suspension periods. It may award costs to the winning party up to a maximum of €300 (\$400) in professional fees and €250 (\$340) in official fees.

Article 182 states that “the measure used by the UIBM to declare the opposition inadmissible or to reject the opposition is notified to the parties, who have 60 days as of the date of notification to file an appeal

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IT IS ADVISABLE TO PUT IN PLACE A MONITORING SERVICE TO IDENTIFY THIRD-PARTY TRADEMARKS THAT MIGHT POTENTIALLY INTERFERE WITH OWNED TRADEMARKS SO THAT TIMELY OPPOSITIONS CAN BE FILED.

with the Board of Appeal". Decisions of the Board of Appeal may in turn be appealed against in the Supreme Court.

Advantages

Owners of trademarks will no longer be forced to turn to the civil courts in order to protect their rights but may instead take advantage of an administrative opposition procedure that is faster and cheaper than a court application for invalidity.

Suggestions

Oppositions may be based on prior filed or registered trademarks but not on unregistered trademarks. The prompt filing of all trademarks that are to date held only by virtue of use is therefore prudent.

It is advisable to put in place a monitoring service to identify third-party trademarks that might potentially interfere with owned trademarks so that timely oppositions can be filed.

It is also advisable to keep all supporting documentation that attests to the effective use of owned trademarks, as this might be requested during an opposition.

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Sonia Fodale joined Rapisardi in 2002. She holds a degree in law and is a qualified trademark attorney in Italy and a professional representative before OHIM. She has experience in managing the acquisition, protection and enforcement of trademark rights. Her practice includes litigation as well as general trademark law advice.



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