

## TRADEMARK OPPOSITION KICKS OFF IN ITALY

*By Andrea Klein, SIB Società Italiana Brevetti, Italy*

Italy's long wait for trademark opposition proceedings to become available is finally over. The basic legal framework for trademark opposition has actually been in place in Italy since 2005, enshrined in the Industrial Property Code. The delay was due both to the need for an implementing regulation, adopted only last year, and to organizational issues which the Italian Patent and Trademark Office has meanwhile addressed and solved.

A ministerial decree, awaiting publication, set the date on which trademark opposition will become available. Below is an essential outline of how it will work.

### Trademarks subject to opposition

- a) Italian trademark applications filed as of May 1, 2011.
- b) Italian designations of International trademarks, irrespective of their registration (or subsequent designation) date, published on WIPO's Gazette as of July 2011.

### Time limit

Three (3) months starting from the publication date of the application on the National Bulletin or from the first day of the month subsequent to the publication of the Italian designations of International trademarks on WIPO's Gazette.

### Official fees

A fee of Euro 250 must be paid prior to the filing of the opposition.

### Grounds

- Earlier trademark registrations or applications in force in Italy concerning trademarks that are:
  - a) identical to the trademark in the application to be opposed and covering identical goods/services,
  - or
  - b) identical or similar to the trademark in the application to be opposed and covering identical or similar goods/services when there exists a likelihood of confusion on the part of the public.
- Image rights if the trademark in the application to be opposed consists of a portrait of a person.
- Personal names if use of the trademark in the application to be opposed can be detrimental to the reputation, credit or dignity of the person entitled to the name.

- Well-known personal names, signs used in artistic, literary, scientific, political or sports fields, denominations and abbreviations of exhibitions or events and of non-profit bodies or associations as well as their emblems.

Additional grounds can be invoked only in invalidity actions.

## **Procedure**

The parties are assigned a 2-month cooling-off period which may be extended, with both parties' consent, by up to a year from the first communication of the Office.

Supporting documents (registration certificates, translations and the like) may be filed also after the expiration of the cooling-off period.

Applicants may request proof of use of the marks on which the opposition is based that were registered more than five years prior to the date of publication of the opposed application. The Office forwards this request to the Opponent setting a 60-day term for filing proof of use.

The Office may award costs to the winning party for a maximum of Euro 300 in professional fees and Euro 250 in official fees.

According to the implementing regulations, decisions shall be rendered within 24 months starting from the opposition date.

Since official forms and guidelines have not yet been issued, some aspects of the procedure are still to be clarified – most importantly, whether supporting arguments should be filed with the Notice of Opposition itself or at a later stage.

## **Appeal**

Any decision may be appealed before the “Commissione dei Ricorsi” (Board of Appeals) within a non-extendable term of 60 days from the communication of the decision.

### ***For more information, please contact:***

Andrea Klein  
Italian and Community Trademark Attorney  
SIB Società Italiana Brevetti  
Email [andrea.klein@sib.it](mailto:andrea.klein@sib.it)  
Website [www.sib.com](http://www.sib.com)

Andrea Klein is a Partner of SIB Società Italiana Brevetti. He is a qualified Italian and European Trademark Attorney and European Design Attorney with 12 years' trademark practice.

Andrea advises major multinational corporations and Italian companies on trademark and copyright issues; he manages Italian, Community and International trademark applications, deals with trademark clearance, filing and prosecution. He regularly counsels the Italian Patent and Trademark Office on trademark classification issues.

He is an active member of INTA, taking part in the association's Trademark Office Practices Committee, OHIM Subcommittee. Andrea is also a member of the Italian Industrial Property Consultants Institute.)