

Italian opposition proceedings: from utopia to reality

Six years after the introduction of the Italian Code of Industrial Property, opposition proceedings finally come to reality

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The utopia

Since the publication of the Code of Industrial Property, introduced by the Legislative Decree 30/2005, opposition proceedings have long been awaited as administrative procedures to be used by trademark owners in order to prevent the registration of identical or confusingly similar trademarks. However, the implementing rules were not adopted until the publication of Regulation 33/2010 and Legislative Decree 131/2010, amending a number of provisions of the Industrial Property Code.

Until now, any objection to an Italian trademark application or an Italian designation of an international registration had to be raised by bringing an invalidity action before the Italian specialist courts.

At best, first instance proceedings on the merit take between 12 and 18 months; however, in most of the cases it takes two to three years for a decision to be issued and the legal costs are typically higher than the costs of opposition proceedings.

Italy is unfortunate to be known for the "Italian torpedo effect", which is used as a way of delaying proceedings by taking advantage of the lengthy timeframe of civil litigation. This legal loophole has been exploited to produce distorted behaviors. For example, IP owners tended to tolerate the existence of confusingly similar or even identical trademarks. As the Italian Patent and Trademark Office does not examine applications for novelty, if a subsequent application is not voluntarily withdrawn an invalidity action is the only remedy. Thus, the coexistence of marks became a necessity - to the detriment of consumers' interests.

In addition, Italy has been often selected as the country of origin for international registrations by applicants having a connection through establishment, domicile or nationality in order to prevent a "central attack" (ie, the defeat of the registration for all designated countries by means of a single invalidation or revocation action against the basic registration).

As a result, the new opposition proceedings have been eagerly awaited and Regulation 33/2010 appeared to turn utopia into reality.

Implementing regulation

The new proceeding has been designed along the lines of the opposition proceedings before the Office for Harmonization in the Internal Market, although it contains some notable differences.

An opposition may be filed in Italy by the owner or exclusive licensee of a prior trademark registration or application only against an identical or similar trademark in respect of the same or similar goods or services.

Moreover, oppositions may be filed by the persons, entities and associations mentioned in Article 8 of the Code of Industrial Property. That article regulates the registration as trademarks of names or signs corresponding to or including names, portraits and well-known signs.

Prior rights such as unregistered trademarks, company names or domains cannot be enforced within oppositions, but may be claimed only in an invalidation action before courts, as well as claims of extended protection for well-known or famous marks.

As a result, owners of IP rights other than trademarks must still accept coexistence with identical or confusingly similar trademarks if they cannot afford the costs and time involved in civil actions.

The reality

In principle, opposition proceedings will permit the more efficient protection of trademarks, and thus of owners' and consumers' interests, by avoiding civil actions. However, in practice, the procedure could not be used up to now for a variety of reasons, including the following:

- Bulletins for the publication of Italian applications had not been issued.
- The official fees had not been established.
- The forms for filing a petition had not been created.
- The examiner training had not been completed.

The latest news is that opposition proceedings will take effect from July. The publication of the Italian trademarks on the National Bulletin has been set for the first week of July 2011 and will include trademark applications filed as of May 2, 2011. Oppositions against Italian trademark applications can be filed within three months from the publication date of the application on the National Bulletin.

Oppositions against Italian designations of International trademarks can be filed within three months running from the first day of the month subsequent to the publication on WIPO's Official Gazette. Italian designations of International trademarks will be published for opposition purpose on WIPO's official Gazette as of July 2011, irrespective of their registration date.

Oppositions will certainly offer trademark owners a cheaper and presumably faster alternative to court actions, which have so far been the only instrument to enforce trademark rights in Italy to prevent registration of potentially conflicting trademarks. At present, Italian opposition proceedings appear to be almost a reality and it is not anymore an utopian vision.

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