

INTRODUCTION OF OPPOSITION PROCEDURE IN ITALY

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A Ministerial Decree (11 May 2011) has finally been issued by the of the Ministry of Economic Development which allows for a trade mark opposition procedure to become operative in Italy. Although it does not include all administrative details it is a large step forward including a start date of July 2011.

The first steps towards a trade mark opposition procedure in Italy were laid down back in February 2005 when the Industrial Property Code was first enacted (see Arts 174 . 184). A set of more detailed rules for opposition proceedings before the Patent and Trade Mark Office were contained in the Decree 33/2010 of January 2010 enacted in March 2010 and further amendments relating to oppositions were included in the Legislative Decree no. 131/2010 of August 13, 2010 which came into force in September 2010 (Art. 91 – 97).

It is generally considered that the delays in implementation were substantially due to lack of resources within the Italian Patent and Trade Mark Office which would appear to have been overcome now that dates have been set for full implementation.

The latest Decree of 11 May 2011 provides that as of July 2011 the Italian Trade Mark Bulletin will be available on-line at the Italian Trade Mark and Patent Office website and will include all new trade mark applications filed in Italy starting from 1st May 2011 which may be subject to opposition. Additionally oppositions may be filed against all international trade mark applications which designate Italy and are published from July 2011 in the WIPO Gazette. This would appear to be irrespective of the international application or designation date.

The opposition procedure would appear to be rather similar to the opposition proceedings before OHIM European Trade Mark Office however there are some important differences.

From a timing perspective an opposition against an Italian trade mark application needs to be filed within 3 months from the publication date of the Italian application in the Italian Bulletin and in the case of international applications within 3 months from the first day of the month subsequent to the publication of the international application designating Italy in the WIPO Gazette.

The official fee fixed at Euro 250 will be payable at the time of filing the opposition and evidence of such payment will need to be submitted with the opposition documentation. It is important to note that at this stage the Italian rules require that not only the notice of opposition be filed but also the grounds for opposition and an explanation of such grounds including any other observations. Thus it would appear that the full opposition needs to be filed at this time although this aspect may be further clarified when additional guidelines are issued.

The opposition may be lodged by hand at the Patent or Trade Mark Office, by post or courier or by email using a certified electronic mail system.

The Ministerial Decree includes a copy of the forms to be used for filing oppositions. The grounds are either those set out in Art. 8 or those in Art. 12 (1)(c)(d) of the IP Code and give rights to the following subjects:

- Owners or exclusive licensees of earlier trademarks registration or application, with effect in Italy, against an identical or similar trade mark for identical or similar products/or services where there exists a likelihood of confusion on the part of the public;
and
- rights owners of images/portraits if prior consent has not been obtained by the applicant
- those with personal names if the use in the new application is detrimental to the credit or dignity of the person,
- persons, entities and associations with well known personal names, well known signs used in artistic, literary, scientific, political or sports fields
- right owners of well known signs and emblems used by non profit entities or associations
- family members (up to the fourth generation) of well known personal names and images.

There does not appear to be the possibility to file oppositions for unregistered trade mark owners, for company names, domain names or for earlier registered trademarks where the goods or services are dissimilar but the mark has acquired a reputation. Such rights can only be asserted in the context of invalidity proceedings before the Italian Courts.

The Opposition division will evaluate whether the opposition is admissible and the Office will notify the opposition to the applicant within 2 months from expiry of the opposition term so that the applicant will learn of the opposition up to 5 months after the initial publication in the Italian Bulletin. On receipt of notice of opposition the parties will have a two month 'cooling off' period to explore an amicable settlement. This can be extended upon mutual consent for up to a year.

Proof of use may be requested by the applicant in its first reply if earlier registration is more than 5 years earlier than the opposed application and upon receipt of notification from the Office. The opponent will have a 60 day term for providing evidence of use.

The Patent and Trade Mark Office will administer communications between the parties and at the end of the adversarial phase the rules state that a decision shall be rendered within 24 months.

Appeals must be filed within 60 days from communication of the decision.

It is expected that the opposition procedure will offer existing trade mark owners with a substantially more cost effective means of protecting their trade marks in Italy which is much more closely in line with other European countries. It should also provide a much more quicker route to the resolution of trade mark disputes otherwise handled by the courts.

Those working in the trade mark sector hope that the final guidelines to render the new system operational will be issued shortly.

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