At last, a trade mark opposition procedure in Italy!

By Laura Orlando, Simmons & Simmons, Italy

The long Italian wait for an opposition procedure against trade mark applications seems to be finally close to an end.

The situation before the introduction of the opposition procedure

The Italian IP Code foresees that owners of earlier trade marks may oppose national applications by submitting a motion to the Italian Patent and Trademark Office (IPTO) and sets out the backbone of relevant rules at Articles 174 to 184. A Regulation of Implementation was enacted with Decree number 33 issued by the Ministry of Economic Development on 13 January 2010, in force since 10 March. Legislative Decree 131/2010 of 13 August 2010, which came into force on 2 September 2010, further amended a number of provisions of the Industrial Property Code, including those relating to trade mark oppositions.

Nevertheless, until now the procedure has not been up and running due to the absence of a number of necessary formalities, including a Bulletin for the publication of trademark applications.

Although publication in a Bulletin is expressly provided for in the IP Code, nothing has been circulated for decades. So far notices of trade mark applications can only be obtained through direct access to the IPTO's databases at the Italian Chamber of Commerce. This has been the sole way for trade mark watch service providers and search companies in Italy to obtain this information. A database is also available online at www.uibm.gov.it. However, although this has recently been improved, the level of update and accuracy is still not sufficient for rights holders to rely on.

Along with some difficulties in appropriately staffing and restructuring the IPTO, it seems that the absence of publication has played a key role in rendering opposition procedures unfeasible in practice.

The Italian IP Code also allows observations to be submitted via the IPTO against pending applications. However, observations have been rarely considered by the IPTO and, in practice, have no impact on the actual status of the application. Indeed, the IPTO has no obligation to examine on relative grounds and matter-of-factly the third-party observations procedure is hit and miss.

Given the above circumstances, in practice the only means of challenging a trade mark in Italy so far has been by filing a cancellation action before the IP Chamber with the competent Courts, with obvious downsides in terms of increased costs for rights holders.

What's new?

A new Decree was eventually issued on 11 May 2011 by the Italian Ministry of Economic Development, introducing the final details and regulating the outstanding formalities for the implementation of the Opposition procedure, including the Bulletin, costs and deadlines. This Decree confirmed 1 July 2011 as the starting date for trade mark opposition in Italy.

The Italian opposition procedure has been designed along the lines of the opposition proceedings before the OHIM (European Community Trade Mark Office), albeit with some notable differences.

An opposition against an Italian trade mark application must be filed within 3 months from its publication in the Bulletin, which shall be available monthly - only online at the IPTO's website www.uibm.gov.it - starting from July 2011.

Trade marks subject to publication in the Bulletin and opposition are

- Italian trade mark applications filed as of 1 May 2011;

- Italian designations of International trade marks, irrespective of their registration (or subsequent designation) date, published on WIPO's Official Gazette as of July 2011.

The Bulletin will start by publishing national applications filed from 1 May 2011.

The deadline for filing an opposition is 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 trade marks on WIPO's Gazette. The deadline for filing an opposition cannot be extended beyond the 3-month term.

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

Oppositions may be filed only by:

- owners or exclusive licensees of an earlier trade mark registration or application, with effect in Italy, against an identical or similar trade mark for identical or similar products/services;
- persons, entities and associations listed in Article 8 of the Industrial Property Code, which regulates the registration as a trade mark of a portrait, a name or a sign corresponding to or including names, portraits or well-known signs owned by such persons, entities or associations.

Possible grounds for opposition are

- earlier trade mark registrations or applications in force in Italy concerning trade marks that are: i) identical to the trade mark in the application to be opposed and covering identical goods/services, or ii) identical or similar to the trade mark 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 trade mark in the application to be opposed consists of a portrait of a person.
- personal names if use of the trade mark 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.

Hence, oppositions cannot be based on:

- unregistered trade marks;

- company names;

- domain names;

- an earlier trade mark registered or applied for dissimilar goods or services.

These latter listed rights may be asserted only in Court proceedings.

If the notice of opposition is found admissible, the IPTO will notify the opposition to the applicant within 2 months from the expiry of the opposition term and the parties will have a 2-month period ("cooling-off period") to explore an amicable settlement.

In the absence of an agreement within the "cooling-off period", the IPTO will start the procedure by setting a term for the applicant to reply to the opposition.

Unlike OHIM's, Italian rules currently provide that the opponent must submit the grounds for opposition together with the notice of opposition, within the term for opposing the application and not after the expiration of the cooling-off period. Supporting documents (registration certificates, translations and the like) may also be filed after the expiration of the cooling-off period.

Challenged 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 IPTO forwards this request to the Opponent setting a 60-day term for filing proof of use. Failure to do so will result in the opposition being dismissed.

In general, the IPTO shall communicate observations and documents filed by one party to the other, granting a term within which to submit the observations in reply.

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

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

The Office's decision on the opposition can be appealed before a Board of Appeal within 60 days from the communication of the decision.

The decision of the Board of Appeal can be further appealed before the Supreme Court, exclusively on points of law.

For the future…

The trade mark opposition procedure will offer rights holders a less expensive and presumably faster route for the resolution of trade mark conflicts. This is compared to cancellation actions before the courts of law, which were the only option to challenge potentially conflicting trade marks available previously.

The current Italian opposition system, however, allows only identical or similar trade marks for identical and similar goods/services; therefore, for owners of unregistered trade marks, domain names, company names or trade marks having a reputation registered or applied for dissimilar goods and services, the only open route is still to go for court proceedings.

In this latter respect, there seems to be a lost opportunity, particularly with respect to domain names, given the increasing role played by the Internet in business.

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