

ITALY- Overview on the TRADEMARK PROSECUTION SYSTEM

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Until now the Italian Patent and Trademark Office (Ufficio Italiano Brevetti e Marchi - UIBM) can hardly count itself among the world's most efficient and modern industrial property offices. However moves are certainly being made in the right direction.

This is partly due to the efforts made by Italian legislators who since 2005 have introduced a number of measures aimed at reorganising and at filling the large gaps that have existed for some time now in the Italian industrial property system, and more particularly in the trademarks system. In particular and implementing regulation of the Industrial Property Code has been finally approved on of 13 January 2010 (Ministerial Decree No 33).

OPPOSITION system implemented

That regulation provides the last missing regulatory component needed to redress the situation of a TM prosecution system lacking an opposition procedure. Now it is very likely that the opposition system will take effect in Italy from July 2011. We are waiting for a Decree that should confirm how the system will definitively be implemented, but the time frame seems to be the following.

The first week of July the first IP Bulletin for the publication of TM applications should be published. This bulletin will include trademark applications filed as of May 2, 2011. The new opposition system will only apply to application filed on or after May 2, 2011. Oppositions can be filed within three (3) months from the publication date of the applications on the IP Bulletin. The opposition procedure will be also open against Italian designations of International trademarks published on WIPO's official Gazette as of July 2011, irrespective of their registration date.

Oppositions can be filed against identical or similar Italian trademark applications and against identical or similar Italian designations of International registrations, covering identical or similar goods/services. Unfortunately, reputation is not valid basis for opposition against dissimilar goods or services. In order to enforce reputation of mark owners will therefore need to proceed with cancellation actions in front of IP courts.

UIBM PERFORMANCE

Last year, in the preparatory phase for the opposition system, the Italian Patent and Trademark Office has devoted considerable resources to clearing the examination backlog (the exam is by law restricted to formal aspects and absolute grounds for refusal) that has always dogged it.

Anyone who has ever had to file an Italian trademark knows that registration in our country, at least up until a couple of years ago, rarely took less than three to four years. It will thus come as a surprise to hear that the UIBM is currently issuing registration in few months.

There are three main reasons for this results: improved IT systems within the Office – even though as we shall see there is quite some work left to do -, use of part-time examiners in addition to the 15 (only!) already working full-time on absolute grounds, but above all planning and implementation of an automatic renewal system.

As is well known, Italian national trademarks are assigned a new number on renewal: applications for renewal are assigned new application numbers, and once registered, new registration numbers are assigned to renewals.

Until quite recently this was no mere formality: there was a new examination, both formal and substantial, of applications for renewal. This has not to be considered a surprise if we consider that

until 2005 the TM law allowed for the possibility at renewal of altering trademarks provided that this did not change their distinctive characters, so that an examination was necessary.

Now finally the UIBM has put in place an automatic renewal system. Unfortunately the principle of allotting new numbers to renewals has not been abandoned. It follows that in order to show renewal of an Italian mark it is important to have a chain of all the new titles (and numbers) issued by the Office.

Nevertheless, Office has now cleared its renewals backlog. The system is still not perfect, but just a few figures will give an idea of the huge progress made. Last year 171,000 applications were processed, including 70,000 automatically processed renewals. This very surprising figure should be compared to the average figure for the Office from 2008 on of 80,000 registrations annually.

These figures, which are quite unlike anything achieved by the UIBM that we have come to know, should also be seen in the light of annual volumes of new applications, with over 54,000 in 2009 and over 56,000 in 2010. This shows that the current examination rate is well in line with the level of demand from end users, something which bodes well for the introduction of opposition proceedings.

There are still quite a number of lingering problems however, including the significant issue of the relationship between the Office and the Chambers of Commerce, which by law are delegated responsibility for receiving trademark applications and thus for managing the interface between the UIBM and end users. The first thing that has to be underlined is that the IT systems used by the Chambers of Commerce have not been fully synchronised with the UIBM's internal databases. To make matters worst, the database accessible to the public at www.uibm.gov.it is in fact a third database periodically updated using the internal UIBM database. Even though the reliability of this online database has very much improved, doubts regarding correlation with real current data persist. It also has to be pointed out that international trademarks for registration in Italy are still handled almost entirely in hardcopy.

RECORDALS and TRADEMARKS

The final performance-related question has to do with the procedures for recordal of changes in ownership and changes of name and addresses of trademarks. Considerable progress has been made thanks to the successive legislative reforms that we have covered. However it can hardly be denied that the system for registering changes of ownership of trademarks still in force at the UIBM is among the most cumbersome in all of Europe. To be honest, especially in more recent times, this has little to do with UIBM procedures, which have been greatly simplified, but is rather due to the wider legal framework existing in Italy for formalities to be conducted with the public administration.

At present, recordal of assignment of a trademark with the UIBM necessarily involves a visit to the Italian public registry Office, and in many cases a further visit to an Italian notary. In any case, processing of applications for change of ownership is still very slow, with replies from the Office not forthcoming in less than a year or two. Matters would be greatly improved were simplification to be introduced, as has already been done for example for recording of changes in company names and addresses, for which the Office no longer requires any special supporting documentation.

OTHER SERVICES

In closing it must also be stressed that the Italian Patent and Trademark Office is not just involved in registering trademarks, patents and other industrial property titles. Indeed its official name as of 2009 is the Direzione Generale per la Lotta alla Contraffazione –UIBM, - the Anti-Counterfeiting Directorate General - UIBM. Within the institutional framework of the Ministry for Economic Development this general directorship is charged with “recognising and protecting Industrial Property, in order to support the fight against counterfeiting while sustaining innovation and competitiveness within enterprises” as can be read on the homepage of the body's site.

The Office is indeed very active in the area of promotion of anti-counterfeiting measures and the protection of Italian-made products. However, for the time being its main area of operation continues to be UIBM-related activity and it is to be hoped that this will continue to be the case. Indeed, in a

country that stands out for its creativity but also for its counterfeiting, all efforts made in combating this scourge are doomed to failure in the absence of proper policies for filing and protecting industrial property titles.

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