

## Opposition proceedings in Italy: two years on

*By Laura Pedemonte, Barzanò & Zanardo, Italy*

Since July 2011, when the Italian trade mark opposition became operative, to date a significant number of oppositions have been lodged at the Italian Patent and Trademark Office (IPTO).

In order to interpret the statistics and numbers a brief overview of the procedure follows.

Opposition proceedings may be brought against national applications and International registrations designating Italy, respectively within **three months** of publication or starting from the first day of the month following the one in which the trademark was published in the WIPO Gazette.

### The Grounds of opposition.

- 1) Earlier 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;
  - b) identical or similar to the trademark in the application to be opposed covering identical or similar goods or services when there exists a likelihood of confusion on the part of the public;
- 2) image rights if the trademark in the application to be opposed consists of a portrait of a person;
- 3) 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;
- 4) 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.

### The Procedure.

The Office, after verifying the admissibility of the opposition, informs the parties, automatically granting an initial **two month “cooling-off” period** (which may be extended, with both parties’ consent, by up to a year from the first communication of the Office), after which the opponent has a **further two months** to file the statement of grounds to sustain the opposition and the applicant **a further two months** for submitting its observations in reply.

Then the Office is entitled to request further documentation, information or observations from the parties within a fixed term.

Applicants, in their initial observations in reply, may request **proof of use** of the trademarks 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’s ultimate decision must be issued within **twenty four months** from receipt of the notice of opposition (excluding the cooling off period and other eventual suspensions of the proceedings). The Office may award costs to the winning party for a maximum of Euro 300 in professional fees and Euro 250 in official fees.

## Appeals.

The appeals may be filed with the Board of Appeals **within a non-extendable term of sixty days** from the decision.

It is worth considering that no opposition in Italy can be filed on the basis of:

- unregistered rights (with the exception of the cases listed at the above points 2-to-4 of the Grounds of opposition paragraph);
- copyrights, company names, domain names or emblems referring to denominations of origin;
- applications/registrations filed by an agent or representative without owner's consent;
- the "reputation" of an earlier registered or applied for trademark, claiming dissimilar goods;
- a well-known trademark according to article 6bis of the Paris Convention.

The above rights may be asserted in Court proceedings only.

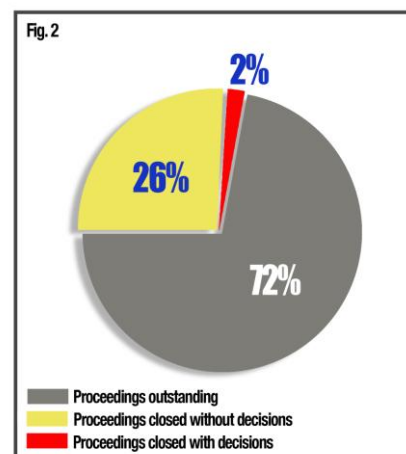
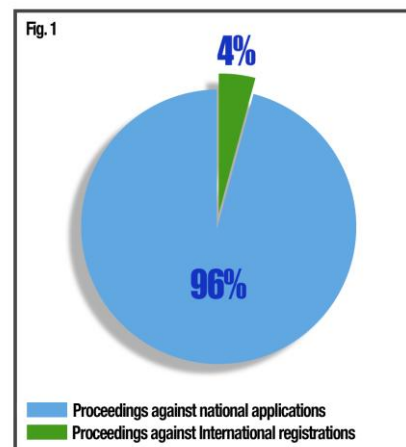
### ***But what happened in the practice of the opposition proceedings in these two years?***

#### ***Numbers and statistics***

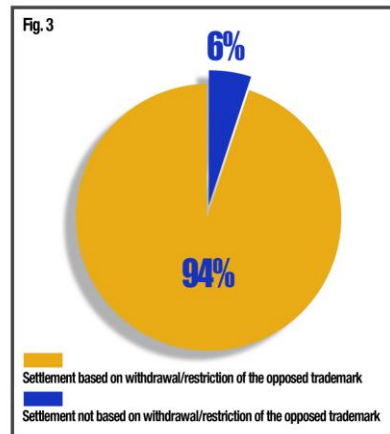
Up to now about **2,462 oppositions** have been filed at the IPTO, around 96% against national applications and 4% against International registrations designating Italy (please see Fig. 1).

**More oppositions have been filed by foreign companies.**

Around 26% of the proceedings have been closed or are very near to conclusion without a decision on their merits (please see Fig. 2).



Among them, around 94% of the cases have been settled by the parties, mainly during the cooling-off period, by the withdrawal or the restriction of the opposed application. Whereas 6% of the cases have been closed following a settlement between the parties not based on withdrawal or limitation of the opposed application (please see Fig. 3).



To date, in around 2% of the proceedings, IPTO has handed down the rulings. **Of the 34 decisions issued up to now**, 25 have been served to the parties and already published on the IPTO online website. Among said rulings, 19 upheld the opposition (of which 6 partially) and 6 rejected the same.

Under the very recent practice, **the decisions are issued by the Office within around 18 months from filing the opposition.**

To date, **5 appeals have been lodged** but no decision has yet been issued.

So far the IPTO has never requested the parties to file second briefs. This means that under the current practice the opponents file their arguments supporting the opposition, the applicant submits a counter-statement in response and, if no evidence of use is requested from the opponent, then the Office issues the decision.

**If this practice continues, Italian opposition proceedings turn out to be relatively short and not too expensive.**

#### ***What about the decisions?***

As to the rulings, the decision structure strongly recalls the OHIM opposition sentence lay out, also in the partition of the paragraphs.

Due to the valuable co-operation set up between the examiners of the IPTO and of the OHIM (including training and continuing support in issuing the decisions on behalf of the OHIM examiners), also the merits of the rulings and the assessment of the likelihood of confusion between the trademarks are clearly based on the OHIM case law. Obviously the decisions take into account the point of view of the Italian consumers and our local jurisprudence (not always concordant with the OHIM, in particular regarding the assessment of any similarity between the products and/or services).

By examining the (few) decisions issued to date in connection with a comparison between goods and services, it is possible to notice that opposition case law has been generally concordant with the OHIM jurisprudence. By way of example, the Office considered some more or less debated issues, in accordance with the majority of the OHIM case law, namely:

- “*sanitary products*” dissimilar from “*food for babies*” (class 5);
- “*veterinary preparations*” similar to “*dietetic substances*” and dissimilar from “*food for babies*” (class 5);
- “*leather and leather imitations, animal skins, hides*” dissimilar from the other products in class 18;
- “*glasses cases and frames*” (class 9) dissimilar from both “*bags and backpacks*” (class 18) and “*clothing, footwear, headgear*” (class 25);
- “*leather and leather imitations, trunks, umbrellas and suitcases*” (class 18) dissimilar from the items belonging to class 25;
- “*ice*” dissimilar to “*ice creams and sorbets*” (class 30) (the OHIM case law seems to be divided on this issue).

Whereas,

“*umbrellas*” dissimilar from “*bags, backpacks*” (class 18) in one decision (in accordance with the majority of the OHIM case law) but similar in another one;

“*sanitary products*” dissimilar from “*dietetic substances*” (class 5), in discordance with the majority of the OHIM case law considering said goods as similar.

Till now, there are no pronouncements on the evaluation of the evidence of use of the opposing trademark.

As to the assessment of the evidence of use proving that a trademark has increased its distinctive character due to its intense use, the Office recalled the sentence of the Court of Justice, C-375/97, of September 14, 1999, for the case “General Motors”. The IPTO affirmed that in order to analyze the extent of the increase of the distinctive character of a mark, it is necessary to take into account the market share held by the sign, the intensity, the geographical extent and the duration of its use, as well as the amount invested by the company in promoting the brand. However to date there are no significant pronouncements on the assessment of the relevant evidence.

### ***Some more practical aspects.***

The Office is currently communicating by certified email if both parties have a certified email address and by registered letter in all other cases. The communication via fax has not been adopted by the IPTO.

The notices sent by registered letter can, however, cause uncertainty about the due dates of the proceedings as **the deadlines start from the receipt of the registered letter**, which may be received by the parties on different dates. Between representatives the problem is solved exchanging the deadlines, but in all other cases there may exist uncertainty about the due dates of the procedure when the parties are not prepared to collaborate.

As to the request for refund of the opposition fees, it is accepted only if the withdrawal or restriction of the application is filed within the cooling-off period and is the subsequent result of the agreed settlement by both parties. Obtaining the refund however can take a number of years.

## **Conclusions.**

The above picture highlights that the new proceedings have been well received and that a consistent number of oppositions have been lodged.

In particular foreign companies already used to such proceedings appear to be more inclined to file an opposition than Italian companies.

Statistics also reveal that the great majority of the proceedings are concluded by a settlement between the parties and that the decisions are issued in a relatively short period, as the Office is not requesting that the parties exchange second briefs.

Even if the highlighted numbers show that the majority of decisions (around 77%) upheld the opposition it is however too early to assess the concrete attitude of the Office.

In the light of the above, it is possible to assert that on one hand the proceedings may be an incisive and cost-effective tool to force the other party to amicably solve the matter; and also on the other hand, in case of non-settlement, that it is a very accessible and quick instrument to bar the registration of conflicting marks so avoiding expensive proceedings before the Courts.

In conclusion, it is certainly advisable to monitor the Italian database and, if there is a case, not hesitating to use the means of opposition as a tool of pressure or as an effective instrument to prevent infringing trademarks in the Register.

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



Laura Pedemonte  
European and Italian Trademark Attorney  
[Barzanò & Zanardo](#) Milan Office  
[l.pedemonte@barzano-zanardo.com](mailto:l.pedemonte@barzano-zanardo.com)  
[b-zmilano@barzano-zanardo.com](mailto:b-zmilano@barzano-zanardo.com)

Laura Pedemonte is an European and Italian Trademark Attorney and European Design Attorney. She started practice in 1999 and has significant experience in trademark clearance and pre-filing advice, filing, prosecution and maintenance of trademarks, both before the Italian and European Trademark Office. She has also extensive experience in trademark opposition, negotiation of out-of-court settlements and coexistence agreements as well as in worldwide trademark portfolio management.