



JONES DAY
COMMENTARY

NEW OPPOSITION PROCEDURE FOR ITALIAN TRADEMARKS

The modernization of Italian intellectual property law continues and is now closer to the European standards after the introduction of an opposition procedure against applications for new trademarks. This new procedure is quicker and less expensive than opposition proceedings before a court and will be handled by the *Ufficio Italiano Brevetti e Marchi* (i.e., the Italian Patent and Trademark Office, “IPTO”).

The new procedure entered into force on July 2011 and completes an ongoing process that also led to the approval in 2005 of the new Code of Industrial Property (Legislative Decree No. 30/2005, “IP Code”).

CONTENT OF THE OPPOSITION

The opposition consists of an administrative procedure before the IPTO through which the validity of a new trademark’s application can be contested. It is made by completing the form provided by the Ministerial Decree

of May 11, 2011 and can be filed electronically, directly by hand at the IPTO, or sent by mail.

The opposition can address only a single trademark filing and will have to be in written form (in Italian), duly completed and with evidence attached. In addition to the opponent’s details, it shall identify the applicant of the opposed trademark, the number and date of application, and goods and services against which the opposition is made. The previous trademark(s), the product(s), and/or service(s) or other rights on which the opposition is based shall also be clearly identified.

In particular, through the opposition, it is possible to contest the registration as trademarks of: (i) new signs that are identical to already existing valid trademarks for which an application was previously filed by a third party and covering identical products and/or services; or (ii) new signs that are identical, or merely similar, to already existing valid trademarks

for which an application was previously filed by a third party and covering similar goods or services, if a risk of confusion for the public can occur. Moreover, lack of consent of the holders of the right will be an additional cause of opposition if the opposed trademark is in the form of a portrait of an individual, a personal name, or a well-known sign.

The opposition is deemed withdrawn if the opponent does not provide evidence of the payment of the opposition fee, amounting to €250,00.

TERMS AND DEADLINES

The deadline to file an opposition before the IPTO is three months starting from the date of publication of the trademark in the Official Bulletin ("Bulletin") and, in the case of Italian portions of international trademarks, from the first day of the month subsequent to the publication on the World Intellectual Property Organization's ("WIPO") Gazette. Such deadlines may not be extended.

The trademark publication in the Bulletin is an essential and unavoidable condition to start the opposition procedure. To this end, the Bulletin is published monthly on the web site of the IPTO. The legislator decided to make the Bulletin available online, for practical reasons and to comply with the recent trend of simplifying administrative procedures.

DETAILS OF THE PROCEDURE

Within two months from expiration of the three-month term for filing the opposition, the IPTO gives notice of the same to the applicant for registration of the trademark. The IPTO informs the applicant and the opponent of the possibility to achieve a conciliation. In case an agreement between the parties cannot be reached, the applicant for the registration can submit his objections against the opposition. During the opposition proceeding, the IPTO can invite the parties to submit further documents, objections, and observations with respect to the remarks, objections, and observations of the other parties.

Upon request of the applicant, the opponent who has owned the previously registered trademark for at least five years shall provide evidence that such trademark has been used for the goods and services for which it was registered, or that there are proper reasons for not using it. The lack of such evidence will result in the opposition being rejected. Evidence required may consist of the submission of documents, packaging samples, tags, list prices, catalogues, invoices, shipping or export documents, photographs, advertisements, written statements, or similar evidence.

At the end of the opposition proceeding, the IPTO can reject or accept the opposition. If the opposition is accepted, the application will be invalidated in whole or in part if it appears that the trademark cannot be validly registered, respectively, for all or for only a part of products and services mentioned in the application. If the opposition has been filed against an application for the Italian portion of an international trademark, the Office shall give notice of its decision to WIPO.

The opposition proceeding can be interrupted in particular circumstances, for example: (i) during the period granted to the parties to reach a settlement; or (ii) if a proceeding for invalidity of the trademark on which the opposition is based is pending; or (iii) if the opposition is based on a mere application for a trademark, until such trademark is actually registered.

The proceeding terminates if: (i) the trademark(s) on which it is based has (have) been declared invalid or expired; (ii) the parties have reached a settlement; (iii) the opposition is withdrawn; (iv) the opposed application has been withdrawn or rejected with final decision; or (v) the opponent ceases to be entitled to the opposition.

Notice of the decision of the IPTO on the opposition is given to the parties who, within 60 days, can lodge an appeal to the Recourse Commission pursuant to the article 135 of the Intellectual Property Code. Upon request of the parties, the Italian Supreme Court (*Corte di Cassazione*) may carry out a further review of the decision adopted by the Recourse Commission but only for assessing the valid application of law provisions and not for the merit of the case, which falls out of its competence.

NEW OPPORTUNITY

The opposition before the IPTO will obviate the need of a court proceeding, with all its advantages concerning reduced costs and time spent. The grounds of a trademark opposition in Italy are, however, reduced if compared to those that may be operated at the European level, where an opposition may be grounded on signs already in use in the commercial practice such as nonregistered trademarks or company names. In those cases, the opposition procedure will not be available, and a civil suit before IP sections of the ordinary courts will be necessary.

At least in principle, the new opposition procedure can be deemed an upgrade of the Italian trademarks legislation to the European standards and allows savings for opponents in terms of costs, timing, and complexity. This innovation enhances the effectiveness of the Italian IP law and is a further step in the modernization that started in 2003 with the introduction of the sections of the civil courts specializing in intellectual property. The progress continued with the introduction of the IP Code, subsequently modernized in 2010 with the implementing regulation that took into account the experience of the first five years of application.

LAWYER CONTACT

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