

The administrative procedure for opposition against Italian and International trademark applications

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The Ministerial Decree of the Italian Minister for the Economic Development dated May 11, 2011 (the “Decree”) has at long last implemented in Italy the administrative procedure for opposition against Italian and International trademark applications.

The opposition procedure was already provided for by the Italian Intellectual Property Code (“CPI”) and also regulated by its implementation rules, but it has been inactive so far due to the failure to implement a Trademarks Official Bulletin.

Pursuant to the provisions of the Decree, the opposition procedure shall apply from July 2011, upon publication – on a monthly basis – of the Trademarks Official Bulletin on the website of the Italian Patents and Trademarks Office (“UIBM”), with reference to Italian trademark applications filed from May 1, 2011 and with reference to International trademark applications published starting from July 1, 2011 edition of the *Gazette de l’Organisation Mondiale de la Propriété Intellectuelle des Marques Internationales*.

1. The procedure

A notice for opposition against a trademark application may be filed with the UIBM within **3 months** from the publication date of the relevant application on the Trademarks Official Bulletin (or, with reference to an International trademark application designating Italy, from the first day of the month following the publication of the relevant application on the *Gazette*) by either the owner of an earlier Italian trademark registration or application (or by the owner of a trademark registration or application effective in Italy from an earlier date), or the exclusive licensee, or the rights owner on portraits, names and well-known signs under section 8 of the CPI.

It is worth noting that the grounds on which the opposition may be based cannot simply consist of rights deriving from trademarks with a reputation or trademarks which are well known pursuant to section 6-*bis* of the Paris Convention, or deriving from distinctive signs other than registered trademarks, including non-registered trademarks.

Upon filing of a notice for opposition, the procedure will be as follows:

- during the **preliminary** phase, the UIBM shall assess whether the opposition is receivable and admissible; such phase shall end within 2 months from the deadline for the filing of the opposition;
- once the admissibility of the opposition has been assessed by the UIBM, and in any case no later than the above-mentioned 2 months period, the UIBM shall notify the opposition to the applicant of the challenged trademark and shall inform both parties of the possibility to reach a **settlement agreement** within 2 months from such notification (this term can be repeatedly extended up to one year upon joint request of both parties);

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- should this settlement agreement not be reached, the UIBM shall grant the applicant a 60 days-period to file written **defence brief** and, within the same deadline – and in any case not later than the filing of such defence brief –, a petition claiming the **proof of actual use** of the opponent's earlier trademark which has been registered for 5 years or more. Further to such applicant's request, should the opponent not be able to provide evidence of such use, or to offer valid reasons justifying the non-use, the opposition will be entirely rejected or decided only with reference to the goods or services for which evidence has been provided;
- during the phase on the **merits** of the opposition, the UIBM may ask the parties, at any time, to provide further documents, arguments and comments and grant each party a proper term to answer;
- at the end of the proceeding, the UIBM shall decide on the opposition within 24 months from the filing date of the notice of opposition, awarding or rejecting it. The UIBM's decision may be **appealed** by the unsuccessful party with the Board of Appeal of the UIBM within 60 days from the communication of the decision of the UIBM to be appealed. Should the opposition procedure end up with the granting of the challenged trademark, the unsuccessful opponent shall have in any case the right to autonomously file a claim for the invalidity of the trademark with the Specialized Sections of the competent Civil Court.

2. The advantages and practical consequences of the procedure

One of the advantages of the new opposition procedure is the possibility to prevent the registration of a trademark infringing earlier trademark rights through an administrative proceeding which is less time-consuming and more cost-effective compared to an ordinary proceeding for invalidity of the trademark with the Specialized Sections of the competent Civil Court.

On the other hand, further to the implementation of such procedure, it is advisable to activate a service of surveillance over the new Italian and International trademark applications as they are published, in order to monitor and promptly detect such applications which may infringe earlier rights and to timely file an administrative opposition to their registration.

Finally, from a different point of view, further to the introduction of the opposition procedure it is even more suitable to carry out, prior to file an application for registration of any new trademark, proper priority researches in order to assess the risks connected with a possible administrative opposition to their registration.