

Italy

Opposition proceedings



ITALY OPPOSITION PROCEEDINGS

The Implementing Regulation of the Industrial Property Code published in Decree 33/2010 January 13, 2010 and enacted March 10, 2010, provides a set of rules for opposition proceedings before the Italian Patent and Trademark Office (“the Office”). The Italian opposition procedure has been designed along the lines of the opposition proceedings before the OHIM (European Community Trademark Office), although it does contain some notable differences. The basic structure of this new procedure is described below.

An opposition against an Italian trademark application must be filed within 3 months of its publication in the Trademark Bulletin, available online on the Office’s website. The Bulletin publishes Italian national applications filed on or after 2 May 2011.

An opposition against the Italian designation of an international registration must be filed within 3 months from the first day of the month following the month in which the opposition was published in WIPO’s Official Gazette. Italian designations of international registrations published in the Gazette on or after 1 July 2011 may be opposed irrespective of the date of filing.

The deadline for filing an opposition cannot be extended beyond the 3-month terms described above.

Oppositions may be filed only by:

- owners or the exclusive licensees of an earlier trademark registration or application in effect in Italy against an identical or similar trademark 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 trademark 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

Oppositions cannot be based on:

- unregistered trademarks
- company names
- domain names
- the reputation of an earlier trademark registered or applied for dissimilar goods or services

The above-described rights may be asserted only in Court proceedings.

If the notice of opposition is found admissible, the Office notifies the applicant of the opposition within 2 months from the expiration of the opposition term, after which 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 Office initiates the adversarial part of the proceedings by setting a term for the applicant to reply to the opposition.

The opponent, within the non-extendable term of 2 months from the expiry of the cooling-off period, must file arguments, facts and evidence in support of the opposition.

The applicant may ask the opponent, with its first reply, to prove the use of the trademark registration(s) on which the opposition is based, if granted more than 5 years before the date of the publication of the opposed mark. The opponent then has a term of 60 days from the receipt of the Office’s notification to submit evidence of use. Failure to respond within 60 days will result in the rejection of the opposition.

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

At the end of the adversarial part of the proceedings, the Office issues a decision which includes the apportionment of the costs of the proceedings. A decision must be rendered within 24 months from the filing date of the opposition (not including possible extensions of time).

The Office’s decision on the opposition and on its admissibility may be appealed before the Board of Appeal (“BoA”) within 60 days of the communication of the decision.

The decision of the BoA can be further appealed before the Supreme Court of Italy, but only on points of law.

The above-described trademark opposition procedure offers to trademark owners a less expensive and faster route for the resolution of conflicts between trademarks than an action for invalidity before the Courts of Justice that, until now, has been the only available option to remove from the register a potentially conflicting trademark. The Italian opposition system, however, provides the possibility of opposing only identical or similar trademarks for identical and similar goods/services. Thus, the only route open to the owners of unregistered trademarks, domain names, company names or trademarks having a reputation registered or applied for dissimilar goods and services remains the filing of an action for invalidity in the Courts of Justice.

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