

ITALY: NEW TRADEMARK REVOCATION AND INVALIDITY PROCEEDINGS

Legal basis and opportunities

INTRODUCTION

The Ministerial Decree No. 180/2022 has introduced the possibility to file:

- Revocation actions
 - Invalidation actions
- } Before the Italian Trademark Office (UIBM) (double track)

Rights owners now have the opportunity to file **a revocation or invalidation action** against an Italian registered trademark via:

- administrative procedure before UIBM
- or before the Courts

LEGAL BASIS/1

1. REVOCATION

- the trademark has become **misleading**;
- the trademark has become a **common name**;
- the trademark **has not been put in genuine use** within the period of 5 years following the registration (without justified reasons)

LEGAL BASIS/2

2. INVALIDITY

(These actions cannot be based on unregistered rights or bad faith)

Request based on third parties earlier rights:

- identical trademark(s) valid in Italy for identical goods/services
- identical or similar trademark(s) valid in Italy for identical/similar goods/services
- identical or similar trademark(s) valid in Italy that enjoy reputation in EU or in Italy
- identical or similar trademark(s) well known in Italy according to art. 6 bis CUP
- **Trademark application** filed by the agent or representative **without the owner's consent**

LEGAL BASIS/3

2. INVALIDITY/2 (absolute grounds)

- the trademark is **devoid of distinctive character**;
- the trademark is **unlawful** (contrary to law, public order or morality);
- the trademark consists
 - (i) of an **emblem** protected by international conventions,
 - (ii) of a sign containing a **symbol of public interest**
- the trademark cannot be registered according to legislation or international agreements on protection of **designations of origin, protected geographical indications, traditional terms of wine (other)**

PROCEEDINGS

Petitions may be filed:

- In case of revocation and absolute grounds of invalidity, **by any interested party**;
- In case of relative grounds for invalidity, **by the owner of an earlier trademark**;
- In case the trade mark application was filed by the agent or representative without the consent of the proprietor or a justified reason, by the trademark owner

Proceedings will be considered inadmissible if the petition:

- Does not contain indications of the rights on which the actions are based;
- Does not include the grounds in support;
- is based both on invalidation and revocation grounds

PROCEEDINGS/2

- **Admissibility assessment** of an application for revocation or invalidity (all documentation must be filed when the petition is filed, including the observations in support and the POA);
- If admissible, the trademark Office will grant the parties a **two-month «cooling off» period** (extendible up to 1 year);
- In absence of amicable settlement, the **owner** of the contested trademark will have **60 days**
 - (i) to **file the observations** in reply or
 - (ii) to **request the proof of use**;
- If a request of proof of use is filed, the applicant will have **60 days to file the evidence** attesting a genuine use

PROCEEDINGS/3

- After such exchange, **the Trademark Office issues a decision** (within max 24 months)
- The decision **can be appealed before the Board of Appeal** (and, thereafter, before the Supreme Court but only on points of law)

STRATEGIES/1

Advantages of the administrative proceedings compared to the judicial actions:

- ❖ Faster timeline of the proceedings
- ❖ Lower costs

Judicial actions remain the only available option in case of :

- actions involving claim for **damages**
- actions involving **counterfeiting activities**
- actions involving **unfair competition**
- actions based on **bad faith**
- Actions involving **other rights (i.e. copyright, unregistered rights, company names)**

STRATEGIES/2

Such administrative actions thanks to their not particularly high costs and simplified procedure, can be useful tools in different scenarios:

1. NEW FILINGS:

If a full availability search reveals the presence of earlier similar trademarks (registered for more than 5 years)



REVOCATION ACTION FOR NON USE

STRATEGIES/3

2. PREVENTING THE RISK OF DILUTION OF THE TRADEMARK

In Italy no novelty exam → The Italian register is overcrowded of similar trademarks which may jeopardize a trademark's distinctiveness.

The owner may consider «clearing» the register by bringing a series of:

- REVOCATION ACTION FOR NON-USE (if the trademarks have been registered for over 5 years)
- INVALIDATION ACTIONS (if the trademarks have been registered for less than 5 years)

STRATEGIES/4

What to suggest to clients (practical advice):

- If the trademark (of our client) has never been under surveillance or the surveillance has not been active for long time → there will likely be similar trademarks to attack through invalidation or revocation actions
- Contesting the trademarks registered for more than 5 years, against which an opposition had been filed with a negative outcome → revocation action for non use
- Contesting similar/identical trademarks claiming different goods/services (to a certain extent) that were not contestable before 2019 → invalidation action based on earlier rights with reputation

RISKS

- due to the reduced costs and shorter duration of the invalidation actions, the central attack of a trademark basis of an International registration will become even more effective

- Increased vulnerability of registered trademarks if
 - Not particularly distinctive
 - Not used

Importance of collecting and cataloging evidence of the trademark ready to be submitted in the event of an attack



Speaker

pviscuso@jacobacci.com

<https://www.jacobacci.com/en/professionals/paolo-viscuso>

<https://www.linkedin.com/in/paolo-viscuso-0bbb3b4b/>

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