

Bugnion SpA

Filling the gap

The Italian Patent and Trademark Office is taking great strides in its aim to make its offerings more efficient and effective, not least through the introduction of an oppositions procedure

In the past, the Italian Patent and Trademark Office (UIBM) could hardly count itself among the world's most efficient industrial property offices. However, the gap that separated it from other national offices in the European Union (and around the world) has largely been closed, albeit with a few exceptions.

All remedies available to rights holders and trademark applicants under the EU Trademarks Directive (89/104/EEC) are now in force in Italy. The rate of registration and renewal is now at a competent level, and although red tape still exists, registration and recording activities have been greatly simplified.

The Italian trademark prosecution system was the only system in Europe without an opposition procedure. This has been remedied: a new opposition system is now in force and is proving to be an effective tool for defending trademarks on an administrative level, with affordable costs and guaranteed procedures.

The UIBM has received more than 1,000 oppositions since May 2011. However, it is likely that the majority of them will never be resolved. While no official data exists at present, experience suggests that, as at EU level, a large number of cases will be settled during the cooling-off period by way of a settlement agreement between the parties. To date, the UIBM has issued only three decisions (discussed below).

The procedure in force in Italy closely follows the Community trademark opposition procedure. When a notice of opposition is filed, the UIBM issues a notification to the parties, assigning them a two-month cooling-off period (extendable up to a maximum of one year) in which to resolve the dispute amicably. There then follows a two-month deadline for the

opponent to submit its brief and another two months for the opposed applicant to submit a request for proof of use or its own brief. After this exchange of briefs, the case is ready to proceed to the decision stage. In theory, the decision should be issued within two years of the opposition being filed, but failure to meet this deadline attracts no penalties and, at present, it is unknown whether the UIBM will be able to comply with the deadline.

The opposition system has enabled the UIBM to introduce communication via certified electronic mail. A notice of opposition (including proof of rights, letter of appointment of an agent and proof of payment of the fees (€284)) must be sent to the UIBM within three months of publication in the *Official Bulletin* of the opposed trademark in a single set of electronic files attached to a certified email. The UIBM will respond, allotting an opposition number, and will subsequently communicate via the same medium.

The UIBM will communicate by registered letter whenever it does not have a certified email address on file. Trademark agents must notify the UIBM of their certified email address, but for parties which file applications or oppositions directly, communication will take place through traditional registered mail.

The following rights can be used as the basis of opposition:

- identical or similar trademarks for identical or similar goods or services; and
- marks under Article 8 of the Industrial Property Code – namely, portraits of people, names, well-known marks and all marks that cannot be registered as trademarks unless certain conditions exist or in the absence of the rights holder's consent.

There is no scope of protection for reputations, unregistered signs, company names, domain names or emblems referring to denominations of origin. If rights holders wish to enforce such rights against a later trademark, they must file an action under the old system with the courts.

The Italian opposition system lacks a true suspension period by agreement of the parties regulated by law. Proceedings can be suspended, but agreements between parties are not provided for. If the parties wish to continue negotiations after the cooling-off period, they must submit briefs and hope that a withdrawal of opposition does not arrive once the decision process is underway. In such a situation, it is advisable to speed up negotiations rather than following the usual Community trademark opposition timeframes.

Once an agreement provides for limitation to the opposed trademark or withdrawal of the opposition, it is advisable to send notice to the UIBM legal affairs division that is handling the opposition, in order to speed up the conclusion of the proceedings as much as possible.

The official practice is fairly well established up to the exchange of briefs. There is no certainty yet as to what will happen during the decision processes. There are no clear directives regarding either proof of use or the typical evaluations of the opposition process (similarities between trademarks and products). Only few decisions have been issued by the UIBM to date – too few to establish any practice with case law.

The UIBM has issued the following decisions to date:

- Decision 1/2012 (Opposition 7/2011) – the well-known trademark BLUMARINE was asserted in opposition to BLUEMARE in Class 25; the opposition was upheld.

This was the first decision issued by the UIBM.

- Decision 2/2012 (Opposition 196/2011) – the AMALFI trademark for perfumes was asserted in opposition to ACQUA DI AMALFI, also for perfumes; the opposition was upheld.
- Decision 3/2013 (Opposition 80/2011) – the trademark LOZZA 1878 was asserted in opposition to LOIZA for eyewear. The UIBM decided in the opponent's favour. This decision is interesting because it was limited to a comparison between LOZZA and LOIZA; the number 1878 was deemed irrelevant.
- Decision 1/2013 (Opposition 123/2011) – Trademark 911 (Porsche) was asserted in opposition to Figurative mark 911, NOVECENTOUNDICI. In its decision the UIBM commented on the relevance of a claim that a mark has a highly distinctive character. Porsche's mark 911 was described as highly distinctive without any need to provide evidence to the UIBM. The UIBM affirmed that the degree of distinctive character of a mark is one of the factors to be considered in assessing the likelihood of confusion. In the absence of supporting evidence, however, the UIBM need not give the claim due consideration. In this case, the opposition was upheld. The decision is interesting since it represents a way to introduce into opposition proceedings factual elements in relation to the reputation of a mark.

In this regard, even though reputation does not constitute grounds for opposition, Italian case law is much less stringent than Office for Harmonisation in the Internal Market (OHIM) case law with regard to confusion or similarity between products. Therefore, while OHIM case law requires reputation to be proven, it cannot be ruled out that when Italian case law is applied, products might be considered similar and therefore an opposition may be held to be well founded even in the absence of a reputation claim.

The format of the UIBM's decisions closely follows that of OHIM decisions; its decisions are well argued and well articulated. It is too early to make an assessment as to their content, however. The UIBM decision first states the result of the opposition awarding costs (up to a maximum of €550, according to fixed rules) and subsequently lays out its reasoning, comparing the products and then continuing with a phonetic, visual and conceptual comparison between the marks



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in order to evaluate the dominant elements, any distinctive characteristics and the target public. It ends with a global assessment.

It seems that the UIBM is on the right track towards established clear case law and practice.

The UIBM has cleared its huge backlog of trademark examinations; publication of newly filed trademarks now takes place between five and six months after the filing date. In the absence of any opposition over a one-year period, trademarks are registered fairly easily.

Correctly updating an IP portfolio that includes Italian trademarks involves changing the trademark registration number of renewals every 10 years. At the time of renewal, trademarks filed in Italy are assigned a new registration number. New applications now become applications for renewal and a new certificate will be issued on each renewal.

The automatic renewal system currently in use enables renewals to be registered within a short period of time (sometimes within one month).

Progress has been made in registering changes of trademark ownership and recording owner name and address changes, thanks to legislative reforms. However, it is undeniable that the UIBM trademark registration system remains one of the most cumbersome in Europe. This has little to do with UIBM procedures, which have been greatly simplified, but rather is due to the wider legal framework in Italy which deals with contact with the public administration.

At present, recordal of assignment of a trademark at the UIBM involves a visit to the Public Registry Office, and in many cases a further visit to a notary. The processing of applications for change of ownership is slow, with replies from the UIBM often taking one to two years. The situation would be greatly improved if simplification were to be introduced, as has already been done with regard to recordal of changes of company names and addresses, for which the UIBM no longer requires supporting documentation. [WTR](#)