

Trademarks

In 54 jurisdictions worldwide

Contributing editor
Michelle Mancino Marsh



2015

GETTING THE
DEAL THROUGH 

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Trademarks 2015

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1 Ownership of marks

Who may apply?

Any natural and legal entity may file applications for trademarks that are already used or are intended to be used either directly by the applicant or by third parties with the applicant's consent.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

Any signs that can be reproduced graphically (words, including personal names, designs, letters, numerals, sounds, the shape of the goods or of their packaging, colour combinations or tonalities), provided that they are capable of distinguishing goods or services, can be registered as trademarks. However, the following cannot be registered:

- signs consisting exclusively of a shape imposed by the very nature of the goods, a shape of goods that is necessary to obtain a technical result or a shape that gives substantial value to the goods;
- signs that lack distinctive character;
- signs contrary to the law, public policy or accepted principles of morality;
- signs capable of deceiving the public, in particular as to the geographic origin, nature or quality of the goods or services; and
- signs that would by their use constitute infringement of a copyright, industrial property right or any other third parties' exclusive rights.

In addition, portraits of persons, personal names different from the applicant's name and names or signs used in artistic, literary, scientific, political or sports fields, denominations and abbreviations of exhibitions and events, and not-for-profit bodies and associations, as well as the characteristic emblems thereof, if well known, may be registered – and used (see 'Update and trends') – as trademarks only by those entitled to them or with their consent.

3 Common law trademarks

Can trademark rights be established without registration?

The Italian system affords protection not only to registered trademarks but also to de facto-use trademarks.

Rights on a de facto use trademark are acquired through 'qualified use' of the trademark, that is, to the point that it has attained a certain degree of consumer recognition throughout the country. The main differences between de facto use trademarks in relation to registered trademarks is that the former do not afford protection in the absence of a likelihood of confusion and, generally speaking, do not afford the same degree of protection under criminal law.

4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

The timing for registration of non-opposed trademark applications may now last about six months, while for opposed applications, if not finally rejected, may approximately run from 18 to 24 months unless the opposing mark is still pending (in which case the time for its final registration must be added). It should be noted, however, that protection of an Italian trademark runs from its filing date so that pending applications can be enforced in court against a later infringing trademark.

The official fee for the application is €158 for one class, plus €34 for each additional class inclusive of stamp and secretariat fees, but excluding the official fees (€34) for the power of attorney, if required.

5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

Italy strictly follows the Nice (International) Classification of Goods and Services. Any goods and services falling in one of the 45 classes established by the Nice Classification may be claimed. Multi-class applications are accepted provided a fee is paid for each additional class (see questions 4 and 10).

It should be noted that since 20 May 2014, the Italian Patent Office joined the practice of the Community Trademark Office (OHIM) and of most of the member countries of the European Union whereby the mere indication of the class 'headings' will not provide protection for all goods or services of that class. In fact, the goods and services listed in the trademark application will be protected only according to what they mean. This new practice agreed upon between OHIM and national EU PTOs is a consequence of the decision issued by the Court of Justice on 19 June 2012, under No. C-307/10 and commonly known as the 'IP Translator' decision. In addition, Italy, as OHIM and most of the EU national PTOs, considers a number of terms in some of the class headings of the Nice Classification as deprived of the necessary clarity and so those terms will not be accepted. It appears therefore that the preparation of a good list of goods and/or services to be included in the trademark application now requires a substantial expertise in order to make such list acceptable and at the same time appropriate for the applicant's needs.

6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

Once the PTO receives a trademark application, it primarily checks that all formal requirements of the application procedure are satisfied. Then it

examines the application on absolute grounds for refusal. PTO's remarks to a trademark application are communicated to the applicant who is given not less than two months to file observations. If, despite the applicant's observations, the PTO rejects the application, the applicant has 60 days from the receipt of the PTO's communication to appeal the decision before an appeal board.

On the contrary, the PTO does not carry out an examination on relative grounds, namely, as to prior trademark rights.

7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Applications can be made either for trademarks that are already in use or for trademarks that the applicant intends to use. There is no need to submit any evidence of use of a trademark. However, if a trademark is not used for five years from the date of registration, or if its use is suspended for five consecutive years, it may be subject to a revocation action before the competent court and/or it would not be considered as a valid right in opposition proceedings against junior applications for identical or similar marks covering identical or similar goods.

Foreign registrations are not granted any right of priority unless they are well known within the meaning of article 6-bis of the Paris Convention (see question 30).

8 Appealing a denied application

Is there an appeal process if the application is denied?

When the PTO definitely rejects the application, the applicant has 60 days from the receipt of the communication to appeal the decision of the PTO before an appeal board.

9 Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

An opposition procedure before the PTO is provided by the law.

Both Italian trademark applications and Italian designations of international trademarks are subject to opposition. The official fee for filing an opposition is €250.

Opposition can be grounded on:

- earlier trademark registrations or applications in force in Italy concerning trademarks that are identical to the trademark in the application to be opposed and covering identical goods or services or identical or similar to the trademark in the application to be opposed and covering identical or similar goods or services when there exists a likelihood of confusion on the part of the public;
- image rights if the trademark in the application to be opposed consists of a portrait of a person;
- personal names if use of the trademark in the application to be opposed can be detrimental to the reputation, credit or dignity of the person entitled to the name; and
- well-known personal names, signs used in artistic, literary, scientific, political or sports fields, denominations and abbreviations of exhibitions or events and of non-profit bodies or associations as well as their emblems.

Additional grounds including bad faith applications can be invoked only in invalidity actions.

An opposition should be filed within three months from the publication of the trademark application and the parties are assigned a two-month cooling-off period which may be extended, with both parties' consent, by up to a year from the first communication of the Office.

Supporting documents (registrations certificates, translations and the like) may be filed also after the expiration of the cooling-off period. Applicants may request proof of use of the marks on which the opposition is based that were registered more than five years prior to the date of publication of the opposed application. The Office forwards this request to the opponent, setting a 60-day term for filing proof of use.

The Office may award costs to the winning party for a maximum of €300 in professional fees and €250 in official fees. According to the implementing regulations, decisions shall be rendered within 24 months starting from the opposition date. Any decision may be appealed before the Board of Appeals within a non-extendable term of 60 days from the communication of the decision. It is worth noting that the Board of Appeals can award up to a considerable amount (eg, €4,000–€5,000) of costs to the winning party. It may also simply compensate costs between the parties.

Cancellation actions are also available and take the form of civil proceedings that must be brought before the specialised sections of 21 Italian courts.

10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

Registrations last 10 years from their application date. All that is required for their renewal is the filing of an application and the payment of a fee, which is currently €124 for one class plus €34 for each additional class, inclusive of stamp and secretariat fees, but excluding the official fees for the power of attorney, if required.

There is no need to submit evidence of use of a trademark, even upon renewal. However, if a trademark is not put to genuine use by its owner or with his authorisation for five years from the date of registration, or if its use is suspended for five consecutive years, it may be subject to a revocation action.

Opponents, in the opposition procedure, may be required to prove use of their prior registration. In this case, generally speaking, sales invoices and advertising is the evidence most frequently submitted to prove that a trademark has been used.

11 The benefits of registration

What are the benefits of registration?

Under civil law the owner of a registered trademark can claim prima facie validity of its title, which is obviously an advantage from an evidentiary standpoint.

Under criminal law, the scope of protection of registered trademarks as opposed to de facto use trademarks is broader.

In addition to this, trademark applications or registrations can be recorded with the Italian customs authorities.

An Italian registration is also recognised by the state of San Marino and can be enforced against infringements in that country.

12 Licences

May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?

Licences can be recorded against Italian marks. Recordal is not compulsory but it is advisable. The recordal has essentially the aim of making public the rights acquired by the licensee through the licence. In addition, if the trademark owner makes more than one licence agreement with different parties concerning the same rights on the same trademark (eg, exclusive rights), the licensee who first makes the recordal can oppose the rights so acquired to any third party who at an earlier or later date has acquired the same or conflicting rights on the trademark in case the acquisition is not recorded at all or is recorded at a subsequent date.

13 Assignment**What can be assigned?**

Trademarks can be assigned in Italy with or without goodwill. This, in particular, may be done for all or some of the goods or services for which the trademark is registered. The only requirement is that the assignment does not cause any deceptiveness in those features of the goods or services that are essential for the appreciation of the public. Assigned goods or services should therefore be sufficiently different from those still owned by the assignor.

14 Assignment documentation**What documents are required for assignment and what form must they take?**

Italian law does not request any special documentation for the validity of assignments that, theoretically, would not even need to be in writing. However, the assignee should be able to prove that the transfer of ownership took place. For recordal purposes, a simple declaration, executed by both parties, that the trademark registration has been transferred is required. If instead the deed of transfer is filed, the deed should be notarised and legalised.

15 Validity of assignment**Must the assignment be recorded for purposes of its validity?**

As a general rule, assignments do not need to be recorded with the PTO to be valid. However, if a dispute arises among bona fide assignees, the first one to record the assignment will prevail. In addition, the record would identify the new owner in case he or she needs to enforce the mark or to base any administrative proceedings on the mark.

16 Security interests**Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?**

Security interests are recognised, provided that the trademark is given as collateral for money credits and, in order to be valid, they need to be recorded with the PTO. A notarised and apostilled deed is required bearing the signature of all parties.

17 Markings**What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?**

In Italy, there is no special marking requirement, nor does any provision exist regarding proper marking to be used with registered or pending trademarks. The use of the “®” marking, or of the wording *marchio registrato* (registered trademark), should, however, be used only with marks that have been registered.

18 Trademark enforcement proceedings**What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?**

Trademark owners whose rights have been infringed can resort to either civil or criminal proceedings. These two avenues have partially different prerequisites and, of course, under criminal law only wilful infringements can be prosecuted.

All civil trademark disputes are attributed to the exclusive jurisdiction of the specialised sections of 21 Italian courts, which also act as European Community trademark courts. Criminal proceedings, however, are not handled by specialised courts.

Thanks to the introduction of these specialised sections back in 2003 (at that time and until 2012 their number was limited to 12), the level of expertise of Italian civil courts in trademarks matters has significantly improved and it is likely to continue to improve in the years to come.

From an administrative standpoint, trademark applications and registrations may form the basis of an application to Italian customs for suspension of goods suspected of being counterfeit.

19 Procedural format and timing**What is the format of the infringement proceeding?**

Civil actions are instituted by serving a complaint on the defendant and, after the exchange of written briefs, and several hearings, the case is decided by a board composed of three judges.

Italian law does not have discovery as is understood by common-law countries; however, through the implementation of European Directive 48/2004, trademark owners are now given effective discovery tools to acquire information on the nature and extent of infringements and to access infringers' financial and commercial documents, which are essential both to discover the extent of the infringement and to obtain a suitable damages award. Live testimony is certainly admissible and, thanks to a recent amendment of our Civil Procedure Code, so are written affidavits.

Interim protective measures can be obtained either before or pending litigation on the merits in a matter of weeks or even days, depending on whether the court's orders are granted ex parte or not.

The prerequisites for obtaining interim measures are the *fumus boni juris* (prima facie evidence of the IP right and of its infringement) and the *periculum in mora* (the danger of imminent and irreparable harm).

Under criminal law, proceedings are instituted by the public prosecutor either ex officio (for certain crimes) or upon the filing of a criminal complaint by an injured party. Criminal proceedings consist of a first pretrial investigation phase, occurring in secrecy, during which the public prosecutor carries out all the appropriate investigations to decide whether the case should proceed to trial or be dismissed. If the case goes to trial, the right holder has the possibility of joining the proceedings as an aggrieved party.

20 Burden of proof**What is the burden of proof to establish infringement or dilution?**

In trademark infringement claims, the trademark owner has the burden of proving that its mark has been infringed. A mark is infringed by the use in the course of business of an identical sign for identical goods or services, or of an identical or similar sign for identical or similar goods or services provided that the risk of confusion may arise on the part of the public, which may also consist in a risk of association. If it is proved that the mark that is allegedly infringed enjoys a reputation, infringement is established, irrespective of any likelihood of confusion or association, when use of an identical or similar sign without due cause permits any unfair advantage to be taken of, or is detrimental to, the distinctive character or reputation of the registered mark.

21 Standing**Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?**

Trademark owners and their exclusive licensees (unless otherwise provided in the licence agreement) have standing to bring an infringement action under civil law.

Under criminal law, proceedings are instituted by the public prosecutor either ex officio (for certain crimes) or upon the filing of a criminal complaint by an injured party.

22 Foreign activities**Can activities that take place outside the country of registration support a charge of infringement or dilution?**

No. Both from a civil and criminal standpoint, only activities that take place in the Italian territory may be taken into account to determine whether there has been an infringement.

23 Discovery**What discovery/disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?**

Through the implementation of European Directive 48/2004, trademark owners are now given effective discovery/disclosure tools to acquire information on the nature and extent of infringements and to access infringers' financial and commercial documents. In particular, courts can request information concerning the origin and distribution networks of the infringing goods, either from the infringer or from those found in possession of such goods. This information can include the names and addresses of the manufacturers, distributors and suppliers and other previous holders of the goods, as well as wholesalers and retailers. Most importantly, the quantities manufactured and the price applied to infringing goods can be the object of such a request. If the infringers do not comply with these requests, criminal sanctions may follow.

Furthermore, courts can now order the disclosure of accounting books and financial documents revealing the extent of the infringement.

24 Timing**What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?**

Among the most significant drawbacks that have traditionally plagued intellectual property civil litigation in Italy is the length of proceedings. Thanks to various amendments of our Civil Procedure Code, the situation seems to be getting better and now, at least before the most experienced courts, it takes approximately two years to reach a first instance decision. Sometimes, however, it still takes about 10 years to go through all three levels of jurisdiction.

As bad as the problem has been, the length of civil proceedings has not reflected very negatively in the field of trademarks, where the main concern for the trademark owner is always to stop infringements as quickly as possible. The Italian system, in fact, has always offered a wide range of interim measures that are very effective and obtainable in a short time, sometimes in a matter of weeks or even days.

Under criminal law, it takes around one to two years until the pretrial investigation phase is over and the trial begins. However, it could still take nine or 10 years for the decision to become *res judicata*.

25 Litigation costs**What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?**

The costs of a civil action depend on the complexity of the case and, of course, the appointed counsel. At the end of an action, the court generally awards attorneys' fees to the prevailing party unless there are special circumstances that may induce the court to decide that each party bears its own attorneys' fees. However, even when legal fees are awarded to the prevailing party, the sums that can be recovered do not cover the actual fees incurred, but simply a percentage of the same, often one-third to one-quarter of the actual costs.

Criminal actions are usually less expensive than civil actions for the simple reason that governmental authorities will perform part of the work, including all investigations. However, for criminal actions to be effective, there is still a great deal of work that needs to be performed by counsel.

Overall, the costs of litigation in Italy are not exorbitant and can certainly be afforded, even by small enterprises.

26 Appeals**What avenues of appeal are available?**

First instance decisions may be appealed before the Court of Appeal. Cases can then be further appealed before the Italian Supreme Court only for errors in law.

27 Defences**What defences are available to a charge of infringement or dilution, or any related action?**

Countless defences and counterclaims may be brought against an infringement charge. Obviously, the most common defences are that there is no infringement or that the allegedly infringed trademark is invalid or has lapsed due to non-use.

28 Remedies**What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?**

Interim protective measures include restraining orders (almost always accompanied by a penalty to secure compliance with the order), seizures of goods, orders to recall the goods from the marketplace, destruction of goods bearing the infringing mark (after the litigation on the merits) and publication of courts' decisions in newspapers or magazines.

Interim measures cease to be effective if litigation is not instituted within 20 working days or 31 calendar days, whichever is longer.

However, a peculiarity of the Italian system is that an exception is made for temporary restraining orders, which remain in place even when litigation on the merits is not instituted. The same measures can be obtained, on a permanent basis, at the end of an action. In addition to this, damages may be awarded to the trademark owner at the end of a litigation. Damages are awarded, taking into consideration the infringers' profits or the royalties that the same would have had to pay had they requested the authorisation to use the infringed trademark. In addition to this, trademark owners can seek the disgorgement of the infringers' profits, which is a totally separate remedy.

Under criminal law, the most effective remedies are without doubt search and seizure orders. Seizure allows Italian enforcement authorities to intervene very quickly, often within one to two days from the public prosecutor's consent to the search and seizure, and sometimes, if reasons of urgency exist, even without the prior consent of the public prosecutor, who will validate the search and seizure within the following 48 hours.

At the end of the trial, the judge orders the confiscation and destruction of the infringing goods in addition to the publication of the decision in a newspaper. Technically, aggrieved parties can also obtain an award for damages in criminal proceedings. However, this occurs extremely rarely.

29 ADR**Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?**

Although in the Italian system it is possible to resort to arbitration as an alternative to court proceedings, ADR has not traditionally enjoyed a great deal of success in trademark disputes in Italy, except for domain name disputes.

30 Famous foreign trademarks**Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?**

The Italian system affords protection to trademarks that are well known within the meaning of article 6-bis of the Paris Convention (as interpreted and expanded in its scope of application by articles 16(2) and (3) of the TRIPS Agreement). To qualify as 'well known within the meaning of article 6-bis' a mark needs to be well known in Italy where its reputation will come as a result of its use or promotion in international trade. The protection afforded consists of the power to cancel the registration of identical or similar trademarks registered for identical or similar goods or services when a risk of confusion may arise on the part of the public, which may also include a risk of association of the two signs, and the possibility of cancelling the registration of identical or similar trademarks registered also for dissimilar goods or services when use of the later mark would take an unfair advantage of, or be detrimental to, the distinctive character or the repute of the well-known mark.

Update and trends

One of the main changes in Italy in the past year involves the jurisdiction rules for IP civil litigations involving foreign companies.

On 21 February 2014, the Italian parliament enacted Decree No. 145/2013, which introduces a number of provisions aimed, at least in theory, at facilitating foreign investments in Italy.

According to article 10 of the Decree only 11 specialised IP courts – among the total of 22 courts – have jurisdiction over civil IP proceedings involving foreign companies.

The supposed aim of this rule is to offer foreign investors more certainty in contentious IP matters by having a limited number of judges that are more used to deal with issues involving international companies. Disputes should therefore be faster and more predictable in their outcome.

Doubts have been raised, however, about the effectiveness of such rule. In particular it is not clear if the foreign company, as a plaintiff, would have the possibility to renounce exclusive jurisdiction and initiate civil proceedings according to the general rules of IP civil procedure.

It will be necessary to wait for the first cases to see how courts will interpret the new set of rules.

On the contrary, there is no provision that expressly affords protection to unregistered well-known marks within the meaning of article 6-bis of the Paris Convention against the unauthorised use of conflicting signs by third parties. Therefore, in practical terms, to prevent the unauthorised use of the conflicting mark, the owner of a well known mark within the meaning of article 6-bis of the Paris Convention will have the very light burden of filing an application in Italy before taking action. In any event, it should be remembered that article 6-bis of the Paris Convention and, consequently, articles 16(2) and (3) of the TRIPS Agreement, are automatically applicable in countries that are signatories to these agreements in the absence of a specific, more favourable national provision.



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