

# MANUAL

FOR THE  
HANDLING OF APPLICATIONS

FOR  
PATENTS,  
DESIGNS AND TRADE MARKS  
THROUGHOUT THE WORLD

*Edited by*

ARNOLD  SIEDSMA



Wolters Kluwer  
Law & Business

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E-mail: [permissions@kluwerlaw.com](mailto:permissions@kluwerlaw.com)

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## ITALY

*EDITED BY*

ARNOLD  SIEDSMA

EUROPEAN PATENT ATTORNEYS  
ATTORNEYS AT LAW  
TRADE MARK ATTORNEYS

The Hague, Munich  
E-mail: [ipmanual@arnold-siedsma.com](mailto:ipmanual@arnold-siedsma.com)  
Website: [www.arnold-siedsma.com](http://www.arnold-siedsma.com)

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*Proprietà intellettuale ed industriale*  
*Intellectual and Industrial Property*  
Roma · Milano · Firenze · Verona 

Roma, Milano, Firenze, Verona  
E-mail: [roma@sib.it](mailto:roma@sib.it)  
Website: [www.sib.com](http://www.sib.com)

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## PART 1 PATENTS

### §1.01 SUMMARY

#### [A] Kinds of Patents

- National patent
- European patent

#### [B] Duration of Patents

- 20 years from the filing date

#### [C] Patentable / Not Patentable

- To be patentable, an invention must meet the novelty, inventive step and industrial application requirements.
- The exceptions of Rule 39 PCT apply. The following are also not patentable: discoveries; computer programs as such; inventions the working of which is contrary to public policy and morality and human dignity, to the defence of health, of the environment, of human and animal life, of plants' preservation, of biodiversity and to the prevention of serious

environmental damages; the human body since conception and at the various stages of its formation and development, and the mere discovery of one of its elements, including the sequence or partial sequence of a gene; technical processes for cloning human beings; processes for modifying the germ line genetic identity of human beings; any use of human embryos, including human embryonic stem cells; any technical process using human embryonic stem cells; processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, as well as animals resulting from such processes; inventions related to genetic screening protocols, which may cause a discrimination of human beings for genetic, pathologic, racial, ethnic, social and economical reasons, i.e., having eugenic and not diagnostic goals; a simple DNA sequence or partial sequence used for the production of a protein or of a partial protein, unless the description provides an industrially applicable function thereof, said function being explicitly claimed.

**[D] Novelty**

- Absolute novelty is required.

**[E] Requirements and Procedure**

- Filing languages: any
- Language of translation: Italian
- Time limit for filing translation: 2 months from the filing date
- A patent application claiming priority is only subject to a check concerning formal requirements, unity of invention and patentability per se. If no priority is claimed, an official search and an examination about possible clear evidence that the subject matter of the invention is not patentable are carried out.

**[F] Specific Aspects of Regional Patents**

- Patent protection in Italy may be obtained through a European patent validated in Italy.

**[G] Specific Aspects of International Patent Applications (PCT)**

- The national phase cannot be entered directly, but only by entering the regional European patent phase.

**[H] Governmental Websites**

- [www.uibm.gov.it](http://www.uibm.gov.it) (Italian Patent and Trademark Office)
- [www.uibm.gov.it/uibm/dati/](http://www.uibm.gov.it/uibm/dati/) (patents database)

## §1.02 DETAILED INFORMATION

### [A] Conventions and Legislation

#### [1] Conventions

- Paris Convention (International Union) 1883–1967 (the Stockholm text is in force in Italy as from 24 April 1977);
- The Hague Convention Abolishing the Requirement of Consular Legalization for Foreign Public Documents 1961;
- International Convention for the Protection of New Varieties of Plants (UPOV Convention) 1961–1978 (the 1978 Act is effective for Italy as from 28 May 1986; the 1991 Act has been ratified by Italy in 1998);
- Convention on the Unification of Certain Points of Substantive Law on Patents for Invention (Convention of Strasbourg) 1963 (effective in Italy as from 18 May 1981);
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967;
- Patent Cooperation Treaty (PCT) 1970 (effective for Italy as from 28 March 1985);
- Strasbourg Agreement Concerning the International Patent Classification (IPC Union) 1971, with the reservation provided for in Article 4(4)(ii);
- European Patent Convention 1973 (effective for Italy as from 1 December 1978), as last revised on 29 November 2000 (EPC 2000 – in force as from 13 December 2007);
- Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure 1977 (ratified with effect as from 23 March 1986);
- TRIPs – Trade-Related Aspects of Intellectual Property Rights 1994;
- EU Regulation No. 1768/92 EC of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products;
- EU Regulation No. 2100/94 EC of 27 July 1994 on Community plant variety rights;
- EU Regulation (EC) 1610/96 of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products;
- EU Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions;
- EU Directive 2004/27/EC of 31 March 2004 amending Directive 2001/83/EC on the Community code relating to medicinal products for human use;
- EU Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights;
- EU Regulation (EC) No. 1901/2006 of 12 December 2006 on medicinal products for paediatric use; and
- Agreement of 19 February 2013 on a Unified Patent Court (not yet in force – signed, but not ratified).

#### [2] Laws

- Industrial Property Code, enacted by Legislative Decree No. 30 of 10 February 2005 and entered into force on 19 March 2005, as amended up to and including Legislative Decree No. 131 of 13 August 2010 and Laws No. 14 of 24 February 2012 and No. 27 of 24 March 2012; and
- Industrial Property Code implementing rules, enacted by Decree of the Minister of Economic Development No. 33 of 13 January 2010, entered into force on 10 March 2010.

The Code consolidated and repealed the provisions of the previous national industrial property laws. After having undergone some amendments in 2006, 2007 and 2009, the Code was further amended by Legislative Decree No. 131 of 13 August 2010, entered into force on 2 September

2010. Further minor amendments were introduced by Laws No. 14 of 24 February 2012 and No. 27 of 24 March 2012. The amendments were mostly aimed at reinforcing industrial property rights, improving their enforcement before the Courts and streamlining the prosecution procedures before the Italian Patent and Trademark Office.

### **[B] Kinds of Patents**

- National patent
- European patent.

### **[C] Duration of Patents**

Twenty years from the filing date of the patent application, subject to the payment of annual fees.

#### *[1] Supplementary protection certificate*

Supplementary protection certificates for medicinal products. European Community Council Regulation No. 1768/92 of 18 June 1992 concerning the creation of a Supplementary Protection Certificate for Medicinal Products which entered into force on 2 January 1993 was repealed with effect from 5 July 2009 by Regulation (EC) No. 469/2009 of 6 May 2009, adopted to take into account the substantial amendments of Regulation No. 1768/92 and the adoption of Regulation (EC) No. 1901/2006 (as modified by Regulation (EC) No. 1902/2006), also known as the Paediatric Regulation.

Regulation (EC) No. 469/2009, like former Regulation No. 1768/92, provides that the duration of protection of a patented pharmaceutical invention may be extended in Italy, for that part of the patent relating to the medicament covered by a marketing authorization, through the grant of a supplementary protection certificate, for a period equal to the period which elapsed between the filing date of the patent application and the date of grant of the first marketing authorization in any of the European Union member countries, less five years. The maximum duration of the supplementary protection certificate is five years.

The foregoing implies that: (i) if the first marketing authorization in the European Union has been granted within five years from the filing date of the patent application, no supplementary protection certificate can be obtained; (ii) if the first marketing authorization in the European Union has been granted between five and ten years from the filing date of the patent application, the duration of the certificate may be between zero and five years, depending on when the authorization was granted; and (iii) if the first marketing authorization in the European Union has been granted between ten and twenty years from the filing date of the patent application, a certificate with the maximum duration of five years may be obtained. The period of validity of the certificate runs from the expiration of the basic patent.

Where Article 36 of Regulation (EC) No. 1901/2006 applies (basically where studies on the paediatric population have been carried out in compliance with an agreed investigation plan), a further six-month extension of the supplementary protection certificate may be obtained.

The possibility of extension applies both to national Italian patents and to European patents validated in Italy. The Regulation is applicable to patent protected products in the territory of a Member State (and thus, in Italy) which, in order to be placed on the market as medicinal products, are subject to an administrative authorization procedure according to European Union Council Directive No. 2001/83/EC and Directive No. 2001/82/EC.

In the context of Regulation No. 469/2009, the following definitions apply:

- ‘Medicinal product’ in this context means: any substance or combination of substances,

presented for treating or preventing disease in human beings or animals, and any substance or combination of substances which may be administered to human beings or animals with a view to making a medical diagnosis or to restoring, correcting or modifying physiological functions in human beings or animals.

- ‘Product’ in this context means: the active ingredient or combination of active ingredients of a medicine.
- ‘Basic patent’ means: a patent which protects a product as such, a process to obtain a product or an application of a product, and which is designated by its holder for the purpose of the procedure for grant of a certificate.

For obtaining a supplementary protection certificate, an application must be filed with the Italian Patent and Trademark Office. Such certificate may be obtained only provided that:

- (1) the product concerned, at the date the certificate is applied for, is protected by a basic patent still in force in Italy;
- (2) a valid authorization to place the product on the market has been granted with effect in Italy in accordance with Directive No. 2001/83/EC or Directive No. 2001/82/EC (as the case may be);
- (3) for the product no earlier supplementary protection certificate has already been obtained; and
- (4) the authorization meant under (2) is the first authorization to place the product on the market in Italy as a medicinal product; otherwise, the first authorization to place the product on the European Union market must also be produced.

A supplementary protection certificate may be applied for by the owner of the basic patent or his/her successor in title. The certificate must be applied for within six months from the date on which the first marketing authorization to place the product concerned on the market as a medicinal product has been obtained. However, if that authorization was issued before grant of the basic patent, the certificate must be applied for within six months from the grant of the patent.

Requirements for filing an application for the grant of a supplementary protection certificate:

- (1) An application stating name, address and nationality of the applicant and name and address of his/her professional representative (if any), number of the basic patent concerned and title of the invention, and number and date of issue of the first marketing authorization with effect for the Italian territory (if this is not the first marketing authorization in the European Union, number and date of issue of the first marketing authorization to place the product on the European Union market must be given as well).
- (2) Copy of the Italian or EMEA marketing authorization, in which the product is identified, and containing at least the number and date of issue of the authorization as well as a summary of the characteristics of the product concerned as listed in Article 11 of Directive 2001/83/EC or Article 14 of Directive 2001/82/EC respectively.
- (3) If the Italian authorization meant under (2) is not the first authorization to place the product on the market as a medicinal product in the European Union, identification of the authorized product and indication of the legal provision under which the authorization procedure has taken place, together with a copy of the official publication in which the grant of said authorization was published.
- (4) Payment of the required filing fee.

If any application for a supplementary protection certificate has been filed in any of the other European Union member countries, this must be mentioned, and all official authorities with which such application(s) has (have) been filed and the number of the application(s) must be indicated.

The protection conferred by a supplementary protection certificate extends, within the limits of the protection conferred by the basic patent, only to the product covered by the marketing

authorization, for any use of the product as a medicine that has been authorized before expiration of the certificate. Within said limits, the certificate confers the same rights as those conferred by the basic patent, and is subject to the same limitations and obligations. As a consequence of the fact that a supplementary protection certificate can be obtained only for one product, for separate products separate certificates are to be applied for and obtained, even if the products are covered by the same patent.

#### Repealed supplementary protection certificate legislation

Regulation (EC) No. 469/2009 repealed EC Council Regulation No. 1768/92 which in turn replaced previous Italian Law No. 349 of 19 October 1991 (effective as from 19 November 1991), the provisions of which on the extension of the duration of protection of patented pharmaceutical products through the grant of supplementary protection certificates were considerably wider than those of the EC Regulation. In particular, the duration of the supplementary protection certificates was equal to the period which elapsed between the filing date of the patent application and the date of grant of the first Italian marketing authorization, for a maximum term of eighteen years from the expiration of the patent (under the EC Regulation the maximum term is five years). Supplementary protection certificates granted under the 1991 law are still governed by the latter except that, as provided by Decree No. 63 of 15 April 2002 as amended on 16 June 2002, their duration has been reduced by six months for each calendar year starting from 1 January 2004, until the duration of the supplementary protection certificate equals the five years provided for by the EC Regulation. Additionally, third parties aiming to manufacture only for exportation of active ingredients covered by supplementary protection certificates granted pursuant to Italian Law No. 349 of 19 October 1991 may start with the owners of the above supplementary protection certificates a procedure for the grant of non-exclusive onerous voluntary licenses. This procedure has to be started with the Italian Ministry of Economic Development and the possibly obtained licenses are valid only for exportation towards countries where patent or supplementary protection has elapsed or where exportation of the active ingredient does not amount to an infringement of the patent or of the supplementary protection certificate and until the patent or the supplementary protection certificate expires.

Also the 2010 amendment to the Industrial Property Code according to which undertakings which intended to manufacture pharmaceuticals after the expiration of the patent or of the supplementary protection certificate were allowed to start the administrative procedure for the marketing authorization of the medicinal product containing the active ingredient not earlier than one year before expiration of the patent or of the supplementary protection certificate, if any, was repealed in 2012. Nevertheless, according to another law enacted in 2012 as well, medicinal products which are equivalent, according to the law, to medicinal products whose patent or supplementary protection certificate is about to expire cannot be classified as reimbursed by the Italian national health service prior to the patent or supplementary protection certificate expiration date, the latter being published by the Italian Ministry of Economic Development.

#### Supplementary protection certificates for plant protection products

The duration of protection of inventions relating to plant protection products may be extended by the grant of a supplementary protection certificate under Regulation (EC) No. 1610/96 of the European Parliament and of the Council of 23 July 1996, concerning the creation of a supplementary protection certificate for plant protection products, which came into force on 8 February 1997. The provisions of this Regulation are similar to those of the EC Council Regulation concerning the extension of protection of pharmaceutical inventions. So, the duration of protection of patented inventions relating to plant protection products may be extended by the grant of a supplementary protection certificate with a period equal to that elapsed between the filing date of the patent application and the date of grant of the first marketing authorization in any of the European Union member countries, less five years. Also in this case, the maximum duration of the supplementary protection certificate is five years. The certificate also in this case must be applied for within six months from the date on which the first marketing authorization to place the product concerned on the market in Italy has

been obtained (provided that, if said authorization was issued before the grant of the basic patent, the certificate must be applied for within six months from the grant of the patent).

The possibility of extension of protection under said Regulation applies to any product protected in Italy by a patent (whether a national Italian patent or a European patent validated in Italy) which is subject, prior to being placed on the market as a plant protection product, to an administrative authorization procedure as laid down in Article 4 of Directive No. 91/414/EEC, or pursuant to an equivalent provision of the national law if being a plant protection product for which the application for authorization was filed before said Directive was implemented by Italy. ‘Plant protection products’ are: active substances and preparations containing one or more active substances, put up in the form in which they are supplied to the user, and intended: (i) to protect plants or plant products against all harmful organisms or prevent the action of such organisms, insofar as such substances or preparations are not otherwise defined hereafter, (ii) to influence the life processes of plants, other than as a nutrient, (iii) to preserve plant products, insofar as such substances or products are not subject to special EC Council or Commission provisions or preservatives, (iv) to destroy undesirable plants, or (v) to destroy parts of plants, check or prevent undesirable growth of plants. ‘Product’ in this context means: the active substance or combination of active substances of a plant protection product. ‘Active substances’ means substances (i.e., chemical elements and their compounds as they occur in nature or by manufacture, including any impurity inevitably resulting from the manufacturing process) or micro-organisms including viruses, having general or specific action: (i) against harmful organisms, or (ii) on plants, parts of plants or plant products. The inventions the protection of which may be extended as aforesaid, are those covered by a basic patent for a product as such (defined as the active substance or combination of active substances of a plant protection product), or by a basic patent for a preparation (defined as a mixture or solution composed of two or more substances, of which at least one is an active substance, intended for use as plant protection product), or by a basic patent for a process for obtaining such product, or by a basic patent for an application of such product.

#### Paediatric extension

Regulation (EC) No. 1901/2006 (amended by Regulation No. 1902/2006), referred to as Paediatric Regulation, concerns products for paediatric use. These Regulations provide for a number of amendments of Regulation No. 1768/92 (successively repealed by Regulation No. 469/2009), Directive No. 2001/20/EC, Directive No. 2001/83/EC and Regulation (EC) No. 726/2004. The Paediatric Regulation aims to enhance the development and accessibility of medicinal products for use in the paediatric population and provide for specific reward for the owners of supplementary protection certificates who complete an agreed Paediatric Investigation Plan (PIP) using the active ingredient covered by the supplementary protection certificate. This reward concerns a further six-month extension of the original duration of the supplementary protection certificate or patent which qualifies for the granting of a supplementary protection certificate. The extension is granted upon completion of the PIP even if it does not lead to the authorization of a paediatric indication, but the results of the studies conducted are reflected in the summary of characteristics. However, the six-month extension will be granted only if the product is authorized in all European Union Member States. The Paediatric Regulation also provides that the six-month term extension will not be granted to medicinal products designated as orphan medicinal products pursuant to Regulation (EC) No. 141/2000 and if the owner has already obtained a one-year extension of the period of marketing protection for the medicinal product concerned on the grounds that the new paediatric indication brings a significant clinical benefit in comparison with existing therapies in accordance with Article 14(11) of Regulation (EC) No. 726/2004 or the fourth subparagraph of Article 10(1) of Directive No. 2001/83/EC. The application for the extension is to be filed with the national competent authorities of the Member State and, in addition to the reference to the previous supplementary protection certificate, it should contain:

- (1) a copy of the statement indicating compliance with an agreed completed paediatric investigation plan as referred to in Article 16(1) of Regulation No. 1901/2006; and
- (2) where necessary, in addition to the copy of the authorization to place the product on the

market, proof of possession of authorizations to place the product on the market of all other Member States as referred to in Article 36(3) of Regulation No. 1901/2006.

The application for an extension of the duration of a supplementary protection certificate already granted shall be lodged not later than two years before the expiry of the certificate. Notwithstanding this, for five years following the entry into force of Regulation (EC) No. 1901/2006, i.e., until 27 January 2012, the application for an extension of the duration of a certificate already granted shall be lodged not later than six months before the expiry of the certificate.

#### **[D] Requirements for Renewal**

A patent is to be maintained through the payment of annual fees.

The annual fees (starting with the fifth annual fee) are to be paid yearly in advance within the end of the anniversary month (starting with the fourth anniversary month) of the filing date. If they become due while the application is still pending, they may also be paid subsequently within the end of the fourth month running from the grant date of the patent.

Term for late payment: six months, provided a fine is paid. As to restoration of failure to pay the maintenance fee within the grace period, see under the heading 'Restoration'.

In respect of European patents validated in Italy, the first annual fee due in Italy is the one concerning the year following the year in which the mention of the grant of the patent was published in the European Patent Bulletin.

An annual fee is to be paid to keep a supplementary protection certificate in force for each year starting from the expiration of the term of the basic patent.

#### **[E] Patentable / Not Patentable**

An invention, in order to be patentable, in addition to be new (see under the heading 'Novelty') must involve an inventive activity (inventive step), and be susceptible of industrial application.

An invention is considered to involve an inventive activity if it is not obvious for a person skilled in the art in the relevant field. An invention is considered to be susceptible of use or application in industry, if its subject matter can be manufactured or used in any field of industry, including agriculture.

The following are not patentable:

- Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body.
- Computer programs as such.
- Discoveries, scientific theories and mathematical methods as such.
- Schemes, rules and methods for performing mental acts, playing games or doing business, and presentation of information as such.
- Aesthetic creations.
- Inventions the working of which is contrary to public policy or morality. The working of an invention is, however, not deemed to be contrary to public policy or morality only because it is prohibited by law or regulation.
- Inventions the working of which is contrary to human dignity, to the defence of health, of the environment, of human and animal life, of plants' preservation, of biodiversity and to the prevention of serious environmental damages.
- Plant or animal varieties or essentially biological processes for the production of plants or animals, it being understood, however, that microbiological processes and the products obtained thereby are not excluded from patentability. New plant varieties obtained by genetic modification of a pre-existing plant variety even if the modification is obtained by genetic engineering are also not patentable.

*[1] Chemical compositions*

Chemical compositions are patentable.

*[2] Pharmaceuticals*

Pharmaceuticals are patentable.

*[3] Second use*

The first medical or veterinary use of a substance or composition already known per se (first medical indication) may be patented (as may be another new use or application of a substance or composition already known). The second or a subsequent medical use of a substance or composition already known as a medicament (second medical indication) may also be patented through purpose-limited product claims (substance X... for use in therapy Y...). Yet, Swiss-type claims are at present not excluded. Also the second or a subsequent non-medical use of a compound already known for another use (second non-medical indication) may be patented.

*[4] Treatment of the human body*

Methods for treatment of the human body by surgery or therapy and diagnostic methods practised on the human body are not patentable.

*[5] Biological materials*

Biotechnological inventions are patentable in accordance with Directive No. 98/44/EC of 6 July 1998 of the European Parliament and of the Council on the protection of biotechnological inventions implemented in Italy by Law No. 78 of 22 February 2006. The latter, however, includes additional requirements, limitations and sanctions not provided for by the EC Directive. Notwithstanding the limitations on the patentability of ethical sensitive biotechnological matters, inventions concerning microbiological or other technical processes or products obtained by said processes comprising biological and natural material and elements isolated from the human body or produced by means of technical processes, including sequences or partial sequences of genes, may constitute patentable inventions. Microbiological processes and the products thereof, and micro-organisms per se may be patented.

However, the following are not patentable:

- The human body since conception and at the various stages of its formation and development, and the mere discovery of one of its elements, including the sequence or partial sequence of a gene.
- Processes for cloning human beings.
- Processes for modifying the germ line genetic identity of human beings.
- Any use of human embryos, including human embryonic stem cells.
- Any technical process using human embryonic stem cells.
- Processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, as well as animals resulting from such processes.
- Inventions related to genetic screening protocols, which may cause a discrimination of human beings for genetic, pathologic, racial, ethnic, social and economical reasons, i.e., having eugenic and not diagnostic goals.

- A simple DNA sequence or partial sequence used for the production of a protein or of a partial protein, unless the description provides an industrially applicable function thereof, said function being explicitly claimed.

#### *[6] Plant varieties*

A plant variety is a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of breeder's rights are met, may be defined by the characteristics resulting from a given genotype or combination of genotypes, may be distinguished from any other plant grouping by the expression of at least one of those characteristics, and may be considered a unit with regard to its suitability for being propagated unchanged.

In principle, protection can be obtained for all plant genera and species, provided the conditions for protection are complied with. In order to be eligible for protection by a breeder's right granted under the Industrial Property Code, a plant variety must be new, distinct, uniform (homogeneous) and stable.

A variety is deemed new if, on the filing date of the application, propagating or harvested material thereof has not been sold or otherwise disposed of to others by or with the consent of the breeder for the purpose of exploitation of the variety in Italy earlier than one year, or in any other country earlier than four years (in the case of trees or vines: earlier than six years) before that date. A variety is deemed to be distinct if it can be clearly distinguished from any other variety the existence of which is a matter of common knowledge at the time of filing the application (another variety is in particular considered to be a matter of common knowledge, if: (i) an application has been filed in any country for the grant of breeder's rights for that other variety or for the entry of that variety in the official register of varieties, provided that the application leads to grant of breeder's rights or to the entry of the other variety in the official register; or (ii) the variety can be found in public collections). A variety is deemed to be uniform if, subject to the variations that may be expected due to the particular features of its sexual reproduction and vegetative propagation, it is sufficiently uniform in those characteristics that are relevant to its protection. Finally, a variety is deemed to be stable if those characteristics that are relevant to its protection remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.

The duration of protection is twenty years from grant, but in case of vines and trees thirty years from grant. Annual maintenance fees are due for each year from the date of grant.

Since 27 April 1995, protection for new plant varieties in Italy may also be obtained under European Community Council Regulation No. 2100/94 of 27 July 1994, relating to the protection through a single right of new plant varieties in the territory of the European Union.

#### *[7] Software-related inventions*

Computer programs as such are not patentable. However, inventions involving the use of a computer program (computer-related inventions) may be patentable even if the most important part of the invention consists of the program, provided they involve a technical result.

Computer software may be protected by copyright. The Copyright Act of 1941 as amended by Decree No. 518 of 29 December 1992 (implementing the European Union Council Directive No. 91/250 of 14 May 1991 on the legal protection of computer programs) and as further amended by Decree No. 205 of 15 March 1996, expressly provides for the protection of computer programs as literary works within the meaning of the Berne Convention.

A computer program may be protected if it is original in the sense that it is the author's own intellectual creation. Protection applies to the expression in any form of a computer program, and the term 'computer program' includes its preparatory design material (however, the ideas and principles underlying the elements of a computer program are not protected). In case of a computer program created by an employee in the execution of his/her task or

following the instructions given by the employer, the employer is exclusively entitled to exercise all economic rights in the program, unless provided for otherwise by contract. Copyright protection at present lasts until seventy years after the death of the author or seventy years from the first publication respectively. Under the amended copyright law, the illegal copying of computer software may be punished with a fine and/or imprisonment (three months up to three years). Criminal provisions also apply to putting into circulation, or possessing for commercial purposes, means the only intended purpose of which is to facilitate the unauthorized removal or circumvention of any technical devices which have been applied to protect a computer program. Before the 1992 amendment of the copyright law according to which computer programs may be protected, it had already been held in several Court decisions (among which a decision of the Supreme Court) that computer programs could be protected by copyright (as scientific works), provided that they are original, i.e., the result of individual creative effort.

Registration is not required for obtaining copyright in a computer program. Protection would start from the publication date. However, registering a computer program with the SIAE (Società Italiana Autori ed Editori, i.e., the Italian Society of Authors and Publishers) in the special public Register of computer programs kept by this body is recommended, as it may provide prima facie evidence of ownership and publication date; such registration is open also to foreigners.

*[8] Business methods*

Methods for doing business as such are not patentable.

*[9] Immoral inventions or inventions contrary to public order*

Inventions the working of which is contrary to public policy or morality are not patentable. The working of an invention is, however, not deemed to be contrary to public policy or morality only because it is prohibited by law or regulation.

*[10] Semiconductors*

A semiconductor product is defined by the law as any finished or intermediate product: (i) consisting of a body of material which includes a layer of semiconducting material, (ii) containing one or more layers composed of conducting, insulating or semiconducting material, arranged in accordance with a predetermined three-dimensional pattern, (iii) intended to perform, exclusively or together with other functions, an electronic function. A topography of a semiconductor product is defined by the law as series of related designs, however fixed or encoded: (i) representing the three-dimensional pattern of the layers of which a semiconductor product is composed, (ii) in which series each image reproduces in total or in part a surface of the semiconductor product at any stage of its manufacture.

Those topographies are eligible for protection which are the result of creative intellectual effort of the creator(s), and are not commonplace or ordinary in the semiconductor product industry. Also topographies resulting from a combination of commonplace or ordinary elements may be protected if, taken in their entirety, they comply with the requirements mentioned in the preceding sentence. The protection of a topography does not extend to any concept, process, system, technique or encoded information embodied in the topography.

The topography can be protected through registration with the Italian Patent and Trademark Office. Registration must be applied for at the latest within two years from the date of the first commercial exploitation of the topography anywhere in the world. The duration of the protection runs from the first commercial exploitation or registration until ten years from the end of the calendar year in which the topography or the semiconductor product embodying

the topography has been first commercially exploited anywhere in the world, or ten years from the end of the calendar year in which the application for registration was filed, whichever period expires first. The right to apply for registration lapses on expiration of fifteen years from the date on which the topography was for the first time fixed or encoded if by then it has not yet been commercially exploited anywhere in the world.

#### **[F] Novelty**

An invention shall be considered to be new if it is not comprised in the state of the art. The state of the art comprises everything made available to the public anywhere in the world before the filing date of the Italian application (or, if priority is claimed, before the priority date), by oral or written description, by use, or by any other means (absolute novelty).

The state of the art furthermore comprises the contents of national Italian patent or utility model applications, or European patent applications designating Italy, as filed, which applications have a filing date or priority date preceding that of the Italian application, but which have been published or made available to the public on or after the filing date or priority date of the Italian application. Since patent protection in Italy can also be obtained through an international application filed under the PCT, the contents of an earlier PCT international application designating the European Patent Office for a patent with effect for Italy are also comprised in the state of the art, provided that the regional phase of such application before the European Patent Office is properly entered into and the European designation fee is timely paid. The contents of prior applications as meant here are only to be considered in determining the novelty of the invention, but not in deciding whether the invention implies inventive activity.

#### *[1] Grace period*

A prior disclosure of an invention is not taken into account in considering its novelty if such disclosure occurred not more than six months prior to the date of filing of the application due to the direct or indirect consequences of an evident abuse in relation to the applicant or his/her legal predecessor, or due to the fact that the applicant or his/her legal predecessor displayed the invention at an official or officially recognized international exhibition under the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928, and its later revisions.

#### **[G] Applicant**

A patent application may be filed by whoever is entitled thereto. The right to the patent belongs to the inventor or to his/her successor in title (natural or legal person). If an application is filed in the name of more than one person, said co-ownership is governed by the provisions of the Italian Civil Code on co-ownership as long as they are applicable and unless there is a different agreement between the co-owners. If the right to the patent belongs to two or more persons, the filing of the patent application and the prosecution of the application before the Italian Patent and Trademark Office can be carried out by each of the co-owners in the interest of all the others, unless differently agreed upon by the parties.

It is presumed before the Italian Patent and Trademark Office that the applicant is entitled to the invention.

Nationals of States which are parties to the Paris Convention or to the World Trade Organization (WTO) as well as nationals of States which are not parties to the Paris Convention or to the World Trade Organization but who are domiciled or who have a real and effective industrial or commercial establishment within the territory of a State which is party to the Paris Convention may apply for and obtain patents to the same extent as nationals of Italy.

Nationals of other States may apply for and obtain patents in Italy, provided their home country grants reciprocity to nationals of Italy.

If it is established by a final decision that the invention belongs to another person than the one who filed the application, such other person has, within three months following such decision and provided that the patent has not yet been granted, the following options:

- (a) to prosecute the patent application in his/her own name, assuming for all purposes the quality of the applicant;
- (b) to file a new patent application, which, provided its contents do not extend beyond those of the first application, shall be effective as of the filing date, or the priority date, of the original application, which shall in any case cease to produce effects; and
- (c) to cause the application to be refused.

If the patent has already been granted to a person other than the one entitled to it, the latter may, at his/her discretion:

- (a) cause the patent to be transferred to his/her name by a decision having retroactive effect;  
or
- (b) obtain that the patent granted to a person not entitled to it is declared null and void.

After two years from the date of publication of the patent grant (applicable also to topographies and new plant varieties), if the person entitled to the patent has failed to exercise any of the rights provided for in the preceding paragraph, any interested person may claim the nullity of the patent granted to a person not entitled to it.

An invention made in the performance or fulfilment of a work or employment contract belongs to the employer, provided that the inventive activity by the employee is foreseen by the contract, and the activity is compensated accordingly. The inventor is, however, entitled to be recognized as the author of the invention. In case no compensation is provided for the inventive activity, the employer is still entitled to the invention, but the inventor is entitled, if the employer obtains a patent for the invention or makes use of the invention under secrecy, in addition to his/her right to be recognized as the author of the invention, to a fair remuneration, to be determined taking into consideration the importance of the invention, the duties performed by and the remuneration paid to the inventor, as well as the contribution that the inventor has received from the employer's organization.

In the absence of the above conditions, where the invention made by an employee falls within the field of activity of the employer, the latter has an option right for the exclusive or non-exclusive use of the invention or for purchasing the patent granted in respect of the invention, as well as for applying for or obtaining patents in respect of the invention in foreign countries. In such cases, the inventor has the right to a royalty or a price, to be fixed after deduction of an amount equivalent to the value of the assistance that the inventor might have received from the employer in developing the invention. The option right by the employer in such cases is to be exercised within three months from the receipt of the notice that the patent application has been filed.

If in any of the above-mentioned cases no agreement is reached, the fair remuneration, royalty or price to be paid to the employee-inventor is established by arbitration.

An invention is still considered as having been made in the performance of a work or employment contract if the relevant patent is applied for within one year after the inventor left the employment with the private undertaking or public administration in whose field of activity the invention falls.

The Italian Law No. 383 of 18 October 2001 and later on the Industrial Property Code enacted in 2005 provide that, as an exception to the general rule, when the employer is a University or a research public organization or entity, the invention belongs to the researcher/inventor, who has the right to file a patent application in his/her own name. The University or research entity has the right to receive part of the royalties received by the inventor for the exploitation of his/her invention by any third party. However, in the case of

research which is wholly or partially financed by private natural or legal persons or which is carried out within a specific research project financed by public entities other than the University or the research organization employing the inventor, the standard provisions relating to employer-employee relationship on inventions apply.

### **[H] Assignment**

The recordal of an assignment concerning a patent or a patent application requires:

- An application for recordal of the assignment.
- A notarized and legalized assignment deed or an assignment declaration simply signed by both the assignor and the assignee. The assignment deed or declaration must include full details of the transferred patent application or granted patent. The fiscal registration of the assignment is required before the assignment is recorded with the Italian Patent and Trademark Office and to this purpose the assignment consideration, if it is not provided for in the assignment deed or declaration, is to be stated. The fiscal registration of the assignment with the Italian Registry Office can be carried out directly by the local professional representative.
- A sworn translation of the assignment deed or declaration if drafted in another language than Italian.
- A power of attorney, signed by the party requesting the recordal of the assignment (usually the assignee, but also the assignor is entitled to apply for the recordal of the assignment), if the application is to be filed with the Italian Patent and Trademark Office by a local professional representative.

Since March 2005, the Italian Patent and Trademark Office also accepts instead of assignment deeds assignment declarations that do not require notarization/legalization and which only need to be signed by both parties and then registered with the competent fiscal authorities (i.e., the Italian Registry Office). Using the assignment declaration instead of the assignment deed among others allows saving the burden and costs of having an Italian notary public entering the assignment deed in his/her files.

Unrecorded assignments are valid between the parties but ineffective against third parties who in bona fide have lawfully acquired the rights in the patent or patent application.

### **[I] Requirements for Filing**

#### *[1] Obligation to file first with national office*

A 2010 amendment to the Industrial Property Code provides that residents in Italy cannot file a first patent application outside Italy if such first application concerns items which could be useful for the military defence of the country. In the latter case, a specific authorization for a first foreign filing is to be requested.

However, it is still unclear whether the applicant is allowed to take by himself/herself the decision whether the invention could or could not be useful for the country's military defence. While waiting for an official position by the Italian authorities, it is suggested to proceed as in the past, i.e., either to file a first application in Italy (and after ninety days to proceed with the filing abroad), or to request the authorization to file directly abroad. Violation of these rules may be punished with a fine or with imprisonment (for not less than one year, if violation took place after the authorization was denied).

*[2] Minimum requirements for obtaining filing date / Provisional applications*

In order to obtain a filing date, the patent application shall contain: information identifying the applicant or allowing the applicant to be contacted; a description of the invention or the reference to a previously filed application indicating its number, filing date, country and applicant.

Application fees must be paid before filing: evidence showing the payment of the prescribed fees is to be enclosed with the patent application.

If the specification is filed in a language other than Italian, a translation must be filed within two months from the date of filing of the Italian patent application. If the translation is not filed in due time, the application shall be deemed as not admissible.

*[3] Request for grant*

A request for grant must include the name, address and nationality of the applicant and of the professional representative, if any, contain the title of the invention, and, if priority is claimed, the indication of the country, serial number and filing date of the first foreign application the priority of which is claimed.

*[4] Appointment of Representative*

Applicants residing or established abroad must elect an address for service in Italy, usually c/o a local professional representative, to whom communications by the Italian Patent and Trademark Office and deeds originating from Courts are served. It is recommended to maintain the address for service after the grant of the patent during its whole life (and, if applicable, the whole life of the supplementary protection certificate in the case of pharmaceutical or agrochemical inventions), as otherwise possible official communications would not be received.

Representation before the Italian Patent and Trademark Office may only take place through professional representatives admitted to practice before the Office or through attorneys-at-law.

*[5] Power of Attorney / Designation of inventor / Other documents*

A power of attorney (*Lettera di Incarico*), not legalized, on standard form, is required to empower a local professional representative. The power of attorney may be filed within two months from the filing date of the application. An extension of time may be granted on request.

If the power of attorney is executed as a 'general power', it is also valid for all subsequent applications for patents, trademarks, utility models, designs and models in the name of the same applicant.

The inventor(s) must be designated and such a designation may be filed within two months from the filing date of the patent application. An extension of time may be granted on request.

Rectification of the inventor's designation (the correctness of which is not verified by the Italian Patent and Trademark Office) is possible only on request accompanied by a written approval of the previously designated person(s) and, if the request is not made by the applicant or patentee, accompanied by a written approval of the latter. Final Court decisions, whereby the applicant or patentee is ordered to designate a third party as the inventor, are recorded by the Italian Patent and Trademark Office if lodged by such third party.

*[6] Priority*

The right of priority with respect to a prior patent application filed within the previous twelve

months in a State party of the Paris Convention for the Protection of Industrial Property, or of the World Trade Organization, is recognized.

The priority claim must refer to the patent application which is considered to be the first application under the international conventions. It must indicate the country, date and number of the basic foreign application.

If the priority has not been claimed on filing the subsequent patent application, it can still be claimed within sixteen months from the filing date of the earliest priority. Within the same term corrections of the priority claim details are admitted. As to restoration of the priority right, see 'Restoration'.

Multiple priorities may be claimed in one Italian application, provided there exists unity of invention (if the Italian Patent and Trademark Office considers that this is not the case, divisional applications, retaining the original filing date, may be filed).

Partial priorities are admissible.

As of 13 August 2009, an 'internal priority' may be claimed.

A certified non-legalized copy of the earlier applications must be filed within the non-extendible term of six months from the date of the Italian application or, alternatively sixteen months from the earlier application if the latter term is more favourable to the applicant. A certified Italian translation of the priority application is also required within six months from the filing date or sixteen months from the earlier application.

If the application for a patent in Italy is filed by a party other than the applicant of the first patent application the priority of which is claimed, a deed or declaration of assignment of the priority rights is required. There is no statutory term for its filing. The Italian Patent and Trademark Office could request said deed or declaration at any time during the prosecution of the application. It is, however, advisable that the deed or declaration be lodged within six months like the priority document. If the original applicant(s) applies jointly with another party no assignment is required.

#### *[7] Allowable language(s) upon filing / Language(s) of procedure*

Description and claims may be filed in any language, provided that an Italian translation is filed within two months from the filing date. If the translation is not filed in due time, the application shall be deemed as not admissible. The request for grant, however, must be drafted in Italian.

All the documents drawn up in a foreign language, as well as their legalization, where required, are to be translated into Italian and the translation certified as true to the original by a qualified Italian professional representative or by a sworn translator.

As from 1 July 2008, for the purpose of prior art searches first Italian patent applications, i.e., patent applications that do not claim a Convention priority, must be accompanied by an English translation of the claims, which may also be submitted within two months from the filing date of the patent application. If no English translation of the claims is produced, a fee is required and the translation is provided by the Italian Patent and Trademark Office which, however, does not guarantee its quality.

#### *[8] Description*

The description is to be printed or type-written on sheets of white paper of international size A4, i.e., 21 cm × 29.7 cm, one and one-half spaced, in black, indelible colour, using typefaces, the capital letters of which should be 0.21 cm high. The minimum margins (top, bottom, left and right) to be observed are 2.5 cm.

The specification shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

If an invention concerns biological material which is not accessible to the public and cannot be described in such a way as to enable the invention to be carried out by a person skilled in

the art, that invention will be considered sufficiently described if a sample of said biological material has been deposited, at least on the filing (or priority) date, with an authorized depositary authority under the Budapest Treaty.

The application shall contain all relevant information on the characteristics of the biological material, the name of the depositary institution and the deposit number. However, the name of the depositary institution and the deposit number of the biological material can be provided within a period of sixteen months from the filing date or before the date of an earlier publication (e.g., if priority is claimed) or before notifying the unpublished application text to a third party. Authorized depositary authorities with whom deposits may be made are the depositary authorities having acquired the status of International Depositary Authority under the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure of 1977. As to the depositary authorities having acquired the status of International Depositary Authority under the Budapest Treaty, see Part II, 'International Laws and Regulations', 'Budapest Treaty'.

#### *[9] Claims*

The claims are to be printed or type-written on sheets of white paper of international size A4, i.e., 21 cm × 29.7 cm, one and one-half spaced, in black, indelible colour, using typefaces, the capital letters of which should be 0.21 cm high. The minimum margins (top, bottom, left and right) to be observed are 2.5 cm.

The following categories of claims are allowed:

- Device (apparatus/product) claims.
- Composition (chemical compound) claims.
- Method (process) claims.
- Product by process claims.
- Use claims.

An application may contain several independent claims, directed to different inventions, if they are linked by a single inventive concept (a special technical connection between all of them).

For each claim exceeding ten, an additional claim fee is to be paid. This requirement is not applicable to applications claiming priority.

Multiple dependent claims are allowed.

#### *[10] Abstract*

The abstract is to be printed or type-written on a sheet of white paper of international size A4, i.e., 21 cm × 29.7 cm, one and one-half spaced, in black, indelible colour, using typefaces, the capital letters of which should be 0.21 cm high. The minimum margins (top, bottom, left and right) to be observed are 2.5 cm.

The specification must begin with an abstract serving for technical information purposes only.

#### *[11] Drawings*

To be executed in indelible black ink on strong white paper of good quality. The sheets of the drawings must be of international size A4, i.e., 21 cm × 29.7 cm; there must be a margin of 2.5 cm on all sides.

Text in the drawings is not allowed, with the exception of necessary indications and scale indication. The sheets of the drawings are to be numbered consecutively. The figures are to

be executed separate from each other, and in such a way that the details remain clearly distinguishable also after photographic reproduction with a linear reduction in size to two-thirds. The separate figures are to be numbered consecutively, independent from the numbering of the sheets. The numbers of the figures as well as the numbers and letters identifying the various parts must be referred to in the description. In case of a paper application, each sheet of the drawings is to be signed by the applicant or his/her professional representative.

#### *[12] Payment of fees*

Evidence showing the payment of the prescribed fees is to be enclosed with the patent application.

### **[J] Procedure**

#### *[1] Filing Authority*

The patent authority is the Italian Patent and Trademark Office (*Ufficio Italiano Brevetti e Marchi*), operating within the Ministry of the Economic Development (*Ministero dello Sviluppo Economico*), in Rome. The receiving office of the Italian Patent and Trademark Office is the Chamber of Commerce.

#### *[2] Online filing*

The application may be filed via the online system WebTelemaco (<http://webtelemaco.infocamere.it/>), managed by the association of the Italian Chambers of Commerce (InfoCamere). The filing documents must be prepared in .xml format (the application form) and in .pdf format (description, claims and drawings, power of attorney, priority documents, etc.). The signature is carried out electronically, via a special smart-card and the relevant hardware and software that can be obtained upon request from any Chamber of Commerce. The online filing involves reduced fees. The stamp duties are paid via a deposit account that can be established with the system.

#### *[3] Formal Examination*

Patent applications are examined as to formal requirements, unity of invention, the title (which must correspond to the invention) and to patentability per se.

Objections from the Office are notified to the applicant with the indication of the term for reply which cannot be less than two months from the date of receipt of the notification. This term may, on a reasoned request, be extended to a maximum of six months from the date of receipt of the Office's notification. However, said term expires two months after receipt of the Office's communication concerning the grant of the extension required or of its rejection, if this term is more favourable to the applicant. Should no reply to the objections have been sent in time, the application is rejected, and the applicant is notified accordingly. However, if the objections raised merely concern the claiming of a priority right, the lack of reply only causes the loss of the priority right(s) claimed.

#### *[4] Search*

As from 1 July 2008 prior art searches are carried out only for first Italian patent filings, i.e., for patent applications that do not claim priority. Pursuant to an agreement with the Italian

Patent and Trademark Office, prior art searches are performed by the European Patent Office which issues a standard ‘Extended European Search Report’ and a patentability opinion (in English). In principle, the search is conducted within nine months from the filing date of the patent application and it should be promptly transmitted to the applicant. While prior art searches are not subject to the payment of any specific or additional fee, the patent application is to be accompanied by an English translation of the claims, which may also be submitted within two months as of the filing date. If no English translation of the claims is produced, a fee of Euros (EUR) 200.00 is required and the translation is provided by the Italian Patent and Trademark Office which, however, does not guarantee its quality. A fee of EUR 45.00 is also required for each claim in excess of ten. If the Italian patent application becomes the basis for a corresponding European or international PCT application, the search fee is partially refunded by the EPO to the applicant.

*[5] Obligation to submit corresponding foreign search results and/or application numbers*

Not applicable in this jurisdiction.

*[6] Substantive examination*

Only for first Italian patent filings, the applicant will be invited by the Italian Patent and Trademark Office to comment on all the indications of the patentability opinion raising an insufficiency objection regarding the patent application and, if possible, to amend the description or claims in order to overcome said objections. An examination is carried out about possible clear evidence that the subject matter of the invention is not patentable. If priority is claimed, no substantive examination is carried out.

*[7] Accelerated examination*

Despite the lack of any specific law provision for requesting an accelerated examination, it is a common practice of the Italian Patent and Trademark Office to proceed, on request, with an accelerated examination in case of Court actions being based on the patent application concerned.

The PPH agreements are not applicable in this jurisdiction.

*[8] Amendments and corrections*

Amendments not adding subject matter to the contents of the application as originally filed are allowed; if said requirement is met, even new examples may be added. New matter added after filing is a ground for voiding the patent.

*[9] Third party observations*

Not applicable in this jurisdiction.

*[10] Grant*

The average processing time from filing to grant is three years. Patent certificates are drawn up in one original and are progressively numbered in accordance with the date of grant. The

originals of the certificates are gathered in the Patent Register. A certified true copy of the certificate is sent to the patentee or his/her professional representative.

*[11] Re-examination*

Not applicable in this jurisdiction.

*[12] Opposition*

Not applicable in this jurisdiction.

*[13] Appeal*

Within sixty days after notification of the decision of the Italian Patent and Trademark Office totally or partially rejecting an application, the applicant may lodge an appeal. Appeals are decided by a special Board of Appeals which consists of a president, an associate president and eight members. The Board of Appeals hears the interested parties or their professional representatives. The decisions of the Board of Appeals may be further appealed for reasons of law only before the Supreme Court.

*[14] Continuation applications*

Not applicable in this jurisdiction.

*[15] Unity of invention / Divisional applications*

Each patent application must refer to one invention only. If an application comprises more than one invention, the Italian Patent and Trademark Office may require that it be restricted to a single invention, and the applicant is entitled to file, within a term set forth by the Office, as many divisional applications as there are inventions left, each of these retaining the original filing (and priority, if any) date.

The division of a patent application can also be requested by the applicant.

*[16] Conversion*

A patent application which contains subject matter which could be validly protected only by a utility model right may be converted on request by the Italian Patent and Trademark Office into an application for the grant of a utility model patent. On filing an application for a patent, it is also possible to simultaneously file a utility model application relating to the same invention. The latter will come into consideration in case the patent application is refused.

Conversely, an application for a utility model containing subject matter which is qualified for protection by a patent of invention may be converted into an application for a patent of invention if from the contents of the application it is clear that a patent of invention should have been applied for. The Italian Patent and Trademark Office may request the applicant to convert his/her application accordingly during the examination procedure.

*[17] Publication / Public File Inspection*

Presently, no official publication is made.

Patent applications are, however, made available and laid open to public inspection after eighteen months from the filing date or priority date where a Convention priority is claimed. The applicant when filing the patent application may require that it be open to public inspection beforehand, i.e., ninety days after the filing date.

The main details of patents and patent application can be viewed at the online register of the Italian Patent and Trademark Office.

If an invention concerns a biological material, and a culture of said biological material has been deposited with an authorized depositary authority, after the patent application has been made available to the public, third parties can obtain samples of the biological material. A request for a sample must be filed with the depositary authority where the culture was deposited, and must indicate: (a) name and address of the submitter; (b) undertaking by the submitter vis-à-vis the applicant or patentee not to make sample of the biological material available to any third party; and (c) undertaking by the submitter to use the material for experimental purposes only, unless the applicant or the proprietor of the patent expressly waives such an undertaking.

On the depositor's request, the sample of the biological material may be released, once the patent application has been made available, only through the intermediary of an independent expert, whose name must be specified in the request, until the date that the patent is granted or for twenty years from the filing date of the patent application, in case the patent application is rejected or withdrawn. The expert designated for the use of the culture is jointly liable for any abuse committed by the submitter of the request for a sample.

As soon as filed, all patent applications are examined by an ad hoc department of the Ministry of Defence. Within ninety days from the date of filing of the patent application, the Ministry of Defence can request the deferment of the grant procedure and impose a secrecy order so that any disclosure of the invention applied for will be forbidden. If an expropriation order is not issued within eight months, the grant procedure is regularly carried out. If instead a further deferment order is issued, the owner of the patent application would receive an indemnity.

*[18] Withdrawal to prevent publication*

If an application is withdrawn before eighteen months from the filing or priority date or ninety days from the filing date if early publication has been requested, such withdrawal prevents the application from becoming open to public inspection.

**[K] Nullity and Lapse**

A patent may be declared null and void (totally or partially) by a competent Court, in a nullity or counter-claim action, on any of the following grounds:

- (a) the invention is not patentable because of lack of novelty or inventive step or industrial application and/or because it is contrary to public policy or morality;
- (b) the invention is not described in a manner sufficiently clear and complete for enabling a person skilled in the art to carry it out;
- (c) the subject matter of the patent extends beyond the content of the application as filed or the protection of the patent has been extended; or
- (d) the patentee was not entitled to the patent.

Nullity on any of the grounds mentioned under (a), (b) or (c) may be requested by any interested party. Nullity on the ground mentioned under (d) may be requested by the person being entitled

to the patent; should that person not have taken action after two years from the grant, any interested person may request the nullity of the patent on this ground as well. The burden of proof of the nullity of a patent is on the party claiming said nullity. A nullity action is to be brought before the competent Court. The Public Prosecutor may bring action *ex officio* on any of the grounds under (a), (b) or (c).

The declaration of nullity of a patent has retroactive effect, but does not affect:

- (1) decisions in infringement proceedings which have become final and have been executed before the nullity final decision; and
- (2) agreements concerning the invention concluded and executed before the nullity final decision; in the latter case, however, refund of payments made under such agreements may be ordered on equity grounds, and taking into consideration the circumstances.

Conversion avoiding nullity: a patent for an industrial invention which is declared null and void but which contains subject matter which could be validly protected by a utility model patent may be converted by the Court into a utility model patent on request.

Renunciation: a patent owner may renounce his/her patent. Such renunciation, however, has no effect if there are rights of third parties recorded under the patent and the above renunciation took place without their prior written consent.

Limitation, as a kind of partial renunciation, is possible on request of the patent owner, accompanied by the amended specification.

In Court proceedings, an amendment of the claims which limits the scope of the patent protection can be made.

Depending on ratification of the Agreement on a Unified Patent Court, the Unified Patent Court will have jurisdiction concerning the validity of European patents registered in the EU Member States that ratify or adopt the Agreement (which is currently expected to be the whole of the EU except Spain and Poland, and possibly Italy). During a transitional period of at least seven years, patentees will however have the option to file an ‘opt-out’ notice that nationally registered European patents do not fall under the jurisdiction of the Unified Patent Court, but under the jurisdiction of the respective national courts. See for more details the chapters ‘European Union’ and ‘European Patent System’ in the section ‘Patents’ under ‘Conventions and Legislation’.

### **[L] Use Requirement**

Patents must be worked in Italy to an extent not seriously disproportionate to the needs of the State within three years from the date of grant or within four years from the filing date, whichever term expires later; thereafter the patent may not remain non-worked for longer than three consecutive years. In case of non-working, the patent becomes subject to the grant of compulsory licenses, unless the failure to work the invention is due to causes beyond the control of the owner of the patent; lack of financial means or, if the product is widely circulated in foreign countries, lack of demand on the Italian market for the patented product (or for the product obtained by the patented process), do not constitute grounds for excusing an insufficient working.

Following the amendment of the law which came into effect on 16 April 1996, not only the importation into or sale in Italy of goods manufactured in one of the other European Economic Area member countries constitutes working under the law, but also the importation into or sale in Italy of goods manufactured in any other WTO member country. Only importation into or sale in Italy of items manufactured in a State not being a WTO member country does not constitute relevant working.

Nominal working (by direct offers, advertisements and/or token sales) does not comply with the working requirements and is hardly of use.

Inventions relating to items shown for the first time at an official or officially recognized exhibition in Italy are considered to be worked as from the day they have been exhibited up

to the closure of the exhibition, provided they have been exhibited for at least ten days or, in the case of an exhibition of a shorter duration, for the whole period thereof. However, this applies only to the first three-year period running from the date of grant of the patent. The patented product itself must be exhibited; the mere display of drawings or photographs is not sufficient.

Under the compulsory license provisions, a patent lapses owing to non-working or insufficient working only after expiry of a two-year period running from the date of grant of the first compulsory license. Consequently, if no compulsory license has been requested and granted, a non-worked patent does not lapse.

### **[M] Marking**

Marking is advisable, but not compulsory. Possible marking: ‘Brevettato’, or ‘Brevetto’, or ‘Brev.’, which may also be followed by the patent number, or ‘Brevetto depositato’, or ‘Brev. Dep.’, which may also be followed by the patent application number. False marking is punishable with a fine.

### **[N] Licenses**

Exclusive and non-exclusive contractual licenses under a granted patent or a pending patent application may be granted.

License agreements must be recorded with the Italian Patent and Trademark Office in order to be effective against third parties who in bona fide have lawfully acquired rights in the patent or patent application; the requirements for recordal are as in the case of assignments.

In case the foreign owner of an Italian patent or patent application grants a license under such patent to an Italian licensee, the following may be mentioned. Payments from Italy to other countries need to comply with the applicable currency control provisions. For several payments, among which the payments under license agreements, Italian banks are authorized to effect remittances within certain limits, against submission of the documentation concerning the license agreement in question, and, if necessary for the calculation of the amounts due, of copies of the invoices relating to the sales of the products under license.

Non-exclusive compulsory licenses may be granted in the following cases:

- Non-working: A compulsory license may be granted if, on expiry of three years from the date of grant of the patent or four years from the filing date of the application, whichever term expires later, the patented invention has not been worked, by the owner of the patent or his/her successor in title or by one or more licensees, either by manufacturing within the Italian territory or by importation of items manufactured in a European Economic Area Member State or in a State member of the WTO, or has been worked but to an extent which is seriously disproportionate to the needs of the State. Furthermore, a compulsory license may be granted if working of the invention is interrupted or reduced to an extent which is seriously disproportionate to the needs of the State during more than three consecutive years. No compulsory license is granted if the failure to work or insufficient working is due to causes beyond the control of the owner of the patent.
- Dependent patents: The owner of a patent which cannot be worked without prejudice to the rights originating from a patent granted on the basis of an earlier application may obtain a compulsory license under the earlier patent, but only to the extent necessary to work the invention covered by the later patent, and provided that the invention of the later patent, as compared with the subject matter of the earlier patent, represents an important technical progress of considerable economic importance. The compulsory license may be assigned only together with the later patent. The owner of the earlier

patent is entitled in turn to the grant of a compulsory license on reasonable conditions under the later patent.

The applicant for a compulsory license in any of the above-mentioned cases must submit evidence showing that he/she has first addressed the owner of the patent concerned but could not succeed in obtaining from him/her a contractual license on reasonable conditions. Compulsory licenses must always be granted against payment of an adequate consideration, and on condition that the party applying for its grant provides the necessary guarantees that the invention will be worked satisfactorily in accordance with the conditions of the license. A compulsory license may be granted only if the working of the invention is mainly intended to supply the domestic market. No compulsory license may be granted to an infringer of the patent.

A petition for a compulsory license must be filed with the Italian Patent and Trademark Office. A compulsory license is granted by a decree issued by the Ministry of the Economic Development; in this decree the scope, duration, manner of exploitation, guarantees and other conditions of the grant are determined, as well as the amount of the consideration and the payment conditions. The conditions of the license may, upon request by a party, be modified by decree of the same Ministry if there are valid reasons. The term of a compulsory license may not exceed the remaining term of the patent. A compulsory license may be transferred only together with the business of the grantee, or with the particular part of the business in which the license is used, except if the owner of the patent would consent to another transfer. The grant of a compulsory license does not prevent the institution of legal proceedings relating to the validity of the patent concerned or the rights deriving from that patent, including actions instituted by the grantee of the license.

In case a voluntary license is granted by the owner of the patent to a third party, on more favourable conditions than those of the compulsory license(s), the latter will be modified accordingly on request of the grantee(s) of the compulsory license(s). A compulsory license may be revoked by the Ministry of the Economic Development, if the conditions relating to the working of the invention have not been complied with, or if the grantee of the license has not paid the consideration in the amount and way as prescribed. A compulsory license may furthermore be revoked by said Ministry if the circumstances leading to its grant no longer exist and it is unlikely that they will occur again. The grantee after revocation is allowed to work the invention on the same conditions, within the limits of the prior use or within the limits that result from serious and real preparations.

Apart from the above general rules, in respect of inventions related to nuclear energy the Government may also grant non-exclusive compulsory licenses under Law No. 1860 of 31 December 1962.

License of right: As long as no exclusive license has been recorded with the Italian Patent and Trademark Office in respect of an invention being the subject of a patent application or a granted patent, the applicant or patentee may (in the patent application or in a written statement addressed to the Italian Patent and Trademark Office) offer to the public a non-exclusive license; such license is effective as from the notification of acceptance, and irrespective whether any agreement has been reached on the remuneration. If no agreement on the remuneration is reached, the remuneration is determined by arbitration. The patentee or applicant having offered a license of right enjoys a reduction of 50% on the annual fees, until revocation of the offer.

### **[O] Pledge and Seizure**

Security interests in respect of granted patents or pending patent applications may be established and recorded with the Italian Patent and Trademark Office in order to be effective against third parties who have in bona fide lawfully acquired rights in the patent or patent application; the requirements for recordal are as in the case of assignments.

**[P] Infringement***[1] Infringing acts / Non-infringing acts*

Provided the patent is granted, the legal effects of it run from the date on which the corresponding application has been made available to the public or as regards an alleged infringer, from such earlier date on which the application with the specification and the drawings (if any) has been served upon him/her. The scope of protection conferred by a patent is determined by the claims. However, the description and the drawings are used for interpreting the claims, so as to balance a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties. The owner of a patent has the exclusive right to work the invention and to profit from it in the territory of Italy.

The following acts done within the territory of Italy by a third party without the consent of the owner of the patent are considered as patent infringement:

- In case of a patented product, the manufacture, use, placing on the market, sale, or importation for any of these purposes of the patented product.
- In case of a patented process, the use of that process, and furthermore the use, placing on the market, sale, or importation for any of these purposes of the product directly obtained by the patented process.

The protection conferred by a patent for a process extends to the product directly obtained by that process.

Reversal of burden of proof. Until the contrary has been proved, any product identical to a product produced by a patented process is deemed to have been obtained by the patented process: (i) if the product obtained by the patented process is new, or (ii) if there is a substantial likelihood that the identical product was made by the patented process and the owner of the patent, although he/she has made reasonable efforts to determine the process actually used in the production of the product, was unable to so determine. When proof to the contrary is to be produced by the defendant, the legitimate interests of the latter in protecting his/her manufacturing and business secrets are to be taken into consideration.

The following acts are not considered as an infringement:

- Use for personal and non-commercial purposes, and use of experimental character.
- Conducting studies and trials with a view to obtain, in Italy or abroad, a marketing authorization of a medicinal product including use of an active ingredient (Bolar provision).
- Preparation of medicinal products in pharmacies on an individual medical prescription and pharmaceuticals so prepared, provided industrially produced active ingredients are not involved in said preparation.
- Any other use concerning products having been put on the market in Italy or in a member country of the European Economic Area by the owner of the patent or with his/her consent.

If the owner of a patent for a new industrial method or process provides other persons with the means unambiguously intended to carry out the subject matter of the patent, he/she is presumed to have granted such other persons an authorization to use the patented method or process, unless agreed upon otherwise.

*[2] Prior user rights*

A person having been using an invention in his/her own undertaking within a twelve-month period preceding the filing (or the priority date) by a third party of a patent application concerning the same invention, may continue to use it within the limits of such prior use. A

right of prior use may only be transferred together with the undertaking in which the invention is being used. The burden of proving the prior use rests with the prior user.

*[3] Remedies*

Infringement actions are to be brought as of 21 September 2012 before the specialized so-called business Courts (in the cities of Ancona, Bari, Bologna, Brescia, Cagliari, Campobasso, Catania, Catanzaro, Florence, Genoa, Milan, Naples, Palermo, Perugia, Potenza, Rome, Trento, Trieste, Turin and Venice). Previously, starting from 2003 infringement actions were brought before specialized industrial property Courts in twelve Italian cities. Such Courts have exclusive jurisdiction for infringement actions concerning patents, plant varieties, utility models, industrial designs and models, trademarks, copyright and unfair competition related to industrial property rights. The specialized Court having jurisdiction over the case is the specialized Court having geographical jurisdiction over the domicile of the defendant, or if the defendant has no domicile in Italy, the specialized Court having geographical jurisdiction over the domicile of the plaintiff, or, if neither party has a domicile in Italy, the Court of Rome; infringement actions may also be brought before the specialized Court having geographical jurisdiction over the place where the allegedly infringing acts have taken place.

The Court, if it deems it necessary, appoints a technical expert, normally a patent attorney, to assist in evaluating technical aspects as to the possible nullity of the patent or its infringement.

Measures which could be granted by the Court, prior to or during the infringement proceedings, or at the end of the proceedings, include:

- Injunction: the patent owner may apply to the Court for an injunction prohibiting the manufacture, marketing and use of anything constituting an infringement of his/her patent. The Court when ordering the injunction may set a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order.
- Judicial inspection or seizure: the owner of a patent may request that a judicial inspection (description) and/or seizure be ordered of some or all of the infringing articles and of any means used in their manufacture, as well as of the proof evidence concerning the alleged infringement. In the latter case, appropriate measures are to be taken to ensure the protection of confidential information. Judicial inspection and seizure may also relate to articles belonging to parties other than the alleged infringer if these articles are not for personal use and were manufactured, offered, imported, exported or put on the market by the party against whom the order was issued. Judicial inspection only, but not seizure, is possible in respect of goods exhibited at an official or officially recognized exhibition in Italy (or which are in transit to or from such exhibition). Judicial inspection and seizure are carried out by a Court official, who may, if necessary, be assisted by one or more experts; said official may make use of technical means of investigations (including photographic means). The parties may be authorized to attend the judicial inspection or seizure, and to be accompanied by technical assistants of their choice.

The Court may also decide that the infringing items and the means for their manufacture be transferred to the owner of the patent, without prejudice to his/her right to award of damages. At the request of the owner of the items mentioned in the preceding sentence, and having regard to the remaining term of the patent or to the particular circumstances of the case, the Court may also order the seizure of these items and of means of production until expiration of the patent, at the infringing party's expense. In this case, the owner of the patent may request that the seized items be assigned to him/her at a price to be established, in the absence of an agreement between the parties, by the judge appointed for the carrying out of the measure.

If a party has provided serious evidence of the grounds of his/her claims and has identified documents, data or information in the possession of the other party in support of such evidence, that party may request the Court to order that said evidence be produced or that said information

be requested from the other party; that party may also request the Court to order that the data be provided that are necessary for the identification of the persons involved in the manufacture and distribution of the infringing products. The Court, after having heard the other party, when issuing these orders must take the appropriate measures to ensure the protection of confidential information.

Where the infringement can be qualified as a systematic counterfeiting of the plaintiff right, the Court may order the exhibition of bank, financial or commercial documentation of the defendant concerning the counterfeiting activity.

The Court may also award damages either in the infringement proceedings or in separate proceedings. An action to recover damages must be brought within five years from the date of the infringement. In assessing the damages the Court must also evaluate lost revenues, the profits made in the infringement activity as well as the possible moral damages. At the request of the interested party, damages may be awarded in a lump sum on the basis of the records of the judicial proceedings and of the presumptions which derive from them. In this case, the amount to be considered should at least be equal to the royalties due had a license been granted.

The Court may order that the decision in an infringement proceeding be published, integrally or in summary form, in one or more newspapers as specified by it, at the expense of the losing party.

First Instance Court decisions are in principle provisionally enforceable.

Depending on ratification of the Agreement on a Unified Patent Court, a European patent granted after the entry into force may, at the applicant's choice, alternatively be registered as a European patent with unitary effect for the whole of the European Union except (as currently expected) Spain and Poland, and possibly Italy (EU patent). The Unified Patent Court will have jurisdiction concerning the infringement (and validity) of EU patents, as well as European patents registered in the EU Member States that ratify or adopt the Agreement. During a transitional period of at least seven years, patentees will however have the option to file an 'opt-out' notice that nationally registered European patents do not fall under the jurisdiction of the Unified Patent Court, but under the jurisdiction of the respective national courts. See for more details the chapters 'European Union' and 'European Patent System' in the section 'Patents' under 'Conventions and Legislation'.

#### *[4] Penal provisions*

Patent infringement may be, under given conditions, sanctionable as a criminal offence.

#### *[5] Enforcement and Customs*

EC Regulation No. 1383/2003 and EC Regulation No. 1891/2004, concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, are being applied in Italy. 'Parallel imported' goods, i.e., goods bearing a trademark with the consent of the right holder, or manufactured with the consent of the holder of a patent, utility model, design, are excluded from the application of the Regulations, even if they are introduced, exported, re-exported, etc. without the right holder's consent.

The application to the customs authorities to suspend the release of the goods and detain them if suspected to infringe an intellectual property right can be lodged by the right holder or any person authorized to use the industrial property right or an authorized representative. The application is to be accompanied by a declaration of the right holder, accepting liability towards third parties involved in the introduction of the allegedly infringing products in the event the procedure initiated be discontinued due to an act or omission of the right holder or if the goods are subsequently found not to infringe the industrial property right. In the declaration the right holder undertakes to bear all costs incurred in keeping the goods under Customs' control.

#### Procedure ‘ex officio’

When Customs have grounds for suspecting that goods might infringe an industrial property right, although no application has been filed, they may suspend the release of the goods or detain them, informing the right holder who is given three working days to submit an application requiring the Customs to take action. In the negative, the goods will be released. If the application is lodged, the ordinary procedure will be followed.

#### Procedure following an application

Once Customs find goods suspected of infringing an industrial property right they suspend the release of the goods and detain them. They then inform the right holder about their intervention and may inform it about the names and addresses of the consignee, the consignor, the origin and provenience of the goods. The right holder subsequently has the opportunity to inspect the goods, also by means of digital photos provided for by the Customs. The suspension of the release of goods may last ten working days (extendible to twenty). If within such a term Customs have not been notified that proceedings to determine the infringement have been initiated, they release the goods. Customs usually require a declaration from the right holder that the goods are indeed infringing the industrial property rights. The law in force in the Member State where the goods are delivered shall apply when deciding whether an industrial property right has been infringed.

#### Penal proceedings

Since infringement of an industrial property right may also fall under criminal law, once confirmed with the cooperation of the right holder that the goods infringe the industrial property right, Customs inform the competent criminal judicial authority. Although scarcely applied, goods violating industrial property rights, which are seized by the Customs, can be destroyed (with the judicial authority authorization) after three months from the date of the seizure save the retention of samples to be used as evidence for judicial purposes. The Penal Code provides for destruction (with the judicial authority authorization) of counterfeited goods if it is difficult or burdensome to store them or (with communications to the judicial authority) of counterfeited goods for which it is impossible to locate the responsible party.

### [Q] Restoration

Restoration can be obtained through two different ways, namely further processing and re-establishment of rights.

#### Further processing

If a party to proceedings before the Italian Patent and Trademark Office has failed to observe a term, he/she may, upon request and payment of a fee, obtain the continuation of proceedings, provided that at the time the request is made the non-accomplished act has been completed. The request for continuation of proceedings is to be presented within two months following the expiry of the non-observed term. Continuation of proceedings is not applicable to the non-observance of the following terms: terms for claiming priority and for filing the priority document; term for filing an appeal to the Board of Appeals; term for completing a patent application with missing documents or for filing the Italian translation of documents submitted in a foreign language; term for submitting the English translation of the claims for the novelty search; term for late payment of the annual fees within the six-month grace period; term for filing the request for re-establishment of rights.

#### Re-establishment of rights

If an applicant or patentee, in spite of all due care required by the circumstances taken, has not been able to observe a term, and the consequence thereof is the lapse of a right or the rejection of an application or request, he/she may be restored in his/her rights if due care is proved. Within two months after the cause impeding the observance of the term has ceased, the non-accomplished act is to be completed and a request for restoration is to be filed stating the reasons for the non-observance and accompanied by the appropriate evidence. No restoration is possible after one year from the lapse of the non-observed term (in case of non-payment of an annual fee, this one-year period runs from the last due date for the payment

of the fee concerned, i.e., from the end of the six-month grace period within which the annual fee can still be paid with a fine; such fine is also due for restoration of the non-paid annual fee). Against refusal of restoration an appeal may be lodged with the Board of Appeals within sixty days from the date of the notice concerned.

Failure to observe a priority term may be restored under the above-mentioned conditions within two months after its expiration. The same provision applies in case of non-observance of the term for submitting the priority document.

Persons who, in the period between the lapse of a patent or patent application and the re-establishment of rights, have in good faith made serious and effective preparations for the use of the invention, or have actually commenced such use, have the right to use the invention free within the limits of the prior use or within the limits that result from the preparations.

Re-establishment of rights does not apply to the following terms: term for requesting the re-establishment of rights; term for filing divisional applications.

### **[R] Specific Aspects of Regional Patents**

#### *[1] Filing Authority*

Applications for the grant of a European patent may be filed either with the Italian Patent and Trademark Office, or directly with the European Patent Office (in Munich, The Hague or Berlin). However, applicants having their residence or registered office in Italy must in principle file such applications with the Italian Patent and Trademark Office. As an exception, such applicants may file applications directly with the European Patent Office if priority is claimed from an earlier Italian patent application filed more than ninety days before, and provided that said earlier Italian patent application has not been made subject to a secrecy order.

European patent applications can be filed in any language, provided that a translation into one of the official languages of the EPO (English, French or German) is filed within two months as of the filing date. However, if filed with the Italian Patent and Trademark Office by an applicant residing in Italy, a summary of the specification in Italian must be filed as well, except if priority is claimed from an application filed in Italy more than ninety days earlier and the earlier application has not been made subject to a secrecy order.

#### *[2] Appointment of Representative*

The owner of a European patent to be validated in Italy, who resides or is established abroad, must elect an address for service in Italy, usually c/o a local professional representative, to whom communications by the Italian Patent and Trademark Office and deeds originating from Courts are served.

#### *[3] Validation*

Italy has not ratified the London Agreement on the application of Article 65 of the Convention on the Grant of European Patents. Therefore, in order to validate in Italy a European patent, an Italian translation of the entire patent must be filed with the Italian Patent and Trademark Office within three months from the publication of the mention of the grant of the European patent in the European Patent Bulletin. Along with the translation of the European patent, a written and signed declaration is to be provided (in principle on the last page of the translation) stating that the translation is entirely in conformity with the original text. If a European patent in opposition proceedings is maintained in an amended form, or limited in a limitation proceeding, an Italian translation of the amended patent must be filed (with the declaration

mentioned in the preceding sentence) within three months from the publication of the decision on the opposition or limitation.

The formal requirements for filing the translation of European patents to be validated in Italy are essentially the same as those applicable to national patent applications.

*[4] Authentic text*

The authentic text of a European patent application or of a European patent is the text in the language of the proceedings before the European Patent Office. If the translation into Italian of a European patent confers a protection which is narrower than that conferred by the authentic text, the Italian translation is regarded as the authentic text for determining the scope of protection conferred by the patent.

*[5] Amendments and corrections*

The translation of a European patent may be corrected, and a corrected translation becomes effective after it has been filed with the Italian Patent and Trademark Office and made available to the public; anyone having in good faith started to use an invention being the subject of a European patent, or having in good faith made serious and real preparations for such use, where the use or intended use would not constitute an infringement of the patent in the version of the original Italian translation but would constitute an infringement of the patent in the version of the corrected translation, may continue (or start) such use in or for his/her own undertaking free of charge after the corrected translation has become effective (i.e., after the corrected translation has been filed with the Italian Patent and Trademark Office).

*[6] Publication*

The Italian Patent and Trademark Office keeps a special Register of European Patents. The text of the translations is made available upon request, but no official publication occurs.

*[7] Provisional protection*

Protection in Italy conferred by a European patent application designating Italy starts as from the day on which the European patent application has been made available to the public, provided that an Italian translation of the claims is filed with the Italian Patent and Trademark Office and made available to the public or, as regards an alleged infringer, is served directly upon him/her (for the filing of said translation accompanied by an official form, applicants residing or established abroad must elect an address for service in Italy, usually c/o a local professional representative).

*[8] Simultaneous protection*

If a national Italian patent and a European patent designating Italy are granted in respect of the same invention belonging to the same inventor or his/her assignee or successor in title, and both patents have the same filing date or priority date, the European patent automatically prevails over the Italian patent (to the extent the protection conferred by both patents is the same) at the expiry of the opposition period (nine months from the publication of the mention of the grant of the European patent in the European Patent Bulletin) or, if opposition proceedings have been started and the European patent is maintained, after the date on which such proceedings are definitively terminated. If the national Italian patent is granted after said

dates, its effects cease on the date on which it is granted. If, subsequently, the European patent becomes ineffective, for whatever reason, this does not revive the national Italian patent.

#### *[9] Conversion*

A European patent application may be converted into a national Italian patent application: (a) if the application filed with the Office of a contracting State has not reached the European Patent Office within fourteen months from the filing (or priority) date, or (b) if the application was originally filed in Italian language, and the translation into the language of the proceedings before the EPO has not been filed within the term prescribed by Rule 6(1) EPC (European Patent Convention).

Furthermore, a rejected, withdrawn or deemed to be withdrawn European patent application, or a revoked European Patent, the subject matter of which qualifies for protection by an Italian utility model patent, may be converted into an Italian utility model application having the maximum duration of ten years from the original filing date of the converted patent application.

#### *[10] Payment of fees*

Annual fees are due in respect of European patents validated in Italy and are to be paid for each patent year starting with the year following that in which the mention of the grant of the European patent has been published in the European Patent Bulletin. However, no annual fees are due for the patent years preceding the fifth one.

### **[S] Specific Aspects of International Patent Applications (PCT)**

#### *[1] Receiving Office*

The Italian Patent and Trademark Office acts as a Receiving Office for international patent applications filed by Italian residents, and also for such applications filed by natural or legal persons having their domicile or being established in Italy.

International patent applications can be filed with the Italian Patent and Trademark Office as Receiving Office in French, English or German. The application may be filed also in the Italian language, and in that case a translation into French, English or German must be provided within one month after the filing of the international application.

For the purpose of establishing whether the application by an Italian resident concerns an invention which may be useful for the national defence, a summary of the specification in the Italian language must also be filed if no priority of an earlier Italian application is claimed or, where such priority is claimed, if the international application is filed before ninety days have expired since the filing of the Italian application the priority of which is claimed.

The Ministry of Defence may issue a secrecy order with regard to an international patent application filed with the Italian Patent and Trademark Office. If such order is issued, the Office notifies the applicant who may apply for the conversion of his/her international application into a national Italian application during ninety days, failing which the application is deemed to be withdrawn.

#### *[2] International Searching Authority*

The competent International Searching Authority for international patent applications filed with the Italian Patent and Trademark Office is the European Patent Office.

*[3] International Preliminary Examining Authority*

The competent International Preliminary Examining Authority for international patent applications filed with the Italian Patent and Trademark Office is the European Patent Office.

*[4] National phase / Regional phase*

Patent protection for Italy applied for in a PCT international application can be obtained only via a European patent valid in Italy. It is the European Patent Office that acts as Designated Office in respect of such international application (and, if applicable, as Elected Office under PCT Chapter II). Therefore, the provisions relating to entering the ‘regional phase’ of such application before the EPO apply (including the rule that the regional phase before the EPO must be entered into within thirty-one months from the filing, or priority, if any, date).

Renunciation to enter the ‘regional phase’ before the EPO is equivalent to a withdrawal of the European patent application. In such case, if the subject matter of the application qualifies for protection by an Italian utility model patent, the PCT application may be converted into an Italian utility model application having the maximum duration of ten years from the original filing date of the converted patent application.

Requirements for conversion: conversion request, election of address for service in Italy (if applicable), payment of the prescribed fee, Italian translation of the application (if not yet in that language) and of the priority document (if any).

*[5] Payment of fees*

Not applicable in this jurisdiction.

**[T] Fees***[1] Table of official fees*

Fees in Euros (EUR), as from April 2007.

	EUR
Filing fee for online patent applications.....	50.00
Filing fee for patent applications not filed online:	
– a specification of up to 10 pages (including drawings).....	120.00
– a specification of up to 20 pages (including drawings).....	160.00
– a specification of up to 50 pages (including drawings).....	400.00
– a specification of more than 50 pages (including drawings).....	600.00
Each claim in excess of 10 (for patent applications that do not claim a Convention priority).....	45.00
Translation fee (for prior art searches in respect of patent applications that do not claim a Convention priority, if no English translation of the claims is provided by the applicant).....	200.00
Registering an assignment or license (for each patent involved).....	50.00

Increased by fiscal registration fee: approximately 3% on the amount of the consideration; if the consideration is up to EUR 5,600.00, a fixed registration fee of EUR 200.00 is levied

## Compulsory license:

– application fee.....	500.00
– granting fee.....	1,400.00
Appeal fee (for appeals with the Board of Appeals), basic fee.....	340.00
Continuation of proceedings fee.....	300.00

In addition to the above official fees, the following are due: EUR 40.00 for the fee to be paid for patent applications not filed online to the receiving office of the Italian Patent and Trademark Office, i.e., the Chamber of Commerce, and EUR 10.00 for registering an assignment or license (EUR 15.00 for online patent applications and EUR 5.00 for registering an assignment or license); EUR 16.00 for each stamp duty which is due (for online patent applications stamp duties are paid in a lump sum of EUR 20.00; for online applications for registering an assignment or license stamp duties are paid in a lump sum of EUR 85.00); EUR 1.30 for postal fees for each payment. For the validation of European patents a fee of EUR 40.00 plus EUR 1.30 for postal fees is to be paid to the receiving office.

Annual fees are as follows:

Year	5	6	7	8
Fees	60.00	90.00	120.00	170.00
9	10	11	12	
200.00	230.00	310.00	410.00	
13	14	15	16	
530.00	600.00	650.00	650.00	
17	18	19	20	
650.00	650.00	650.00	650.00	

Fine within six-month grace period.....	100.00
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In addition, EUR 1.30 for postal fees are due.

Annual fees according to the above schedule must also be paid in respect of European patents validated in Italy.

Annual fees may be paid prior to the month in which they become due; in case of increase of fees supplemental payments must be made with respect to fees paid in advance at the old rates.

For supplementary protection certificates, the following fees are due:

Filing fee.....	404.00
Annual fees (for each year).....	1,011.00
Fine for late payment of the annual fee.....	361.52
Registering an assignment or license (for each supplementary protection certificate involved).....	67.00

Increased by fiscal registration fee: approximately 3% on the amount of the consideration; if the consideration is up to EUR 5,600.00, a fixed registration fee of EUR 200.00 is levied.

**[U] Transitional Provisions**

Not applicable in this jurisdiction.

**[V] Specific Patent Issues**

Expropriation is possible in the interest of the military defence of the State or for other reasons of public utility and may also concern pending applications. Expropriation may be restricted to the right to use the patent for the needs of the State.

Expropriation is granted by a decree of the President of the Republic which also sets forth the consideration on the basis of the market value of the patent. If expropriation takes place in the interest of the military defence of the State and it concerns pending applications, it may also impose a secrecy obligation along with the relevant duration.

Protection of undisclosed information is provided for in accordance with the TRIPs Agreement. Therefore, the disclosure to any third party of business information, including commercial information within the legitimate control of a party, or the acquisition or use of such information by a third party in a manner contrary to honest commercial practices, is deemed an act of unfair competition, provided the information: (i) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known or readily accessible to the experts and operators in the sector concerned, (ii) has commercial value because it is secret, and (iii) is subject to steps, to be considered as reasonably adequate to keep it secret, taken by the person(s) lawfully in control of the information. The same protection also applies to undisclosed test data or other secret data the origination of which involves a considerable effort and the submission of which is a condition of marketing approval for chemical, pharmaceutical or agricultural products which utilize new chemical entities.

Terms expiring on Saturdays, Sundays or official holidays are automatically extended to the next working day.

**[W] Governmental Websites**

- [www.uibm.gov.it](http://www.uibm.gov.it) (Italian Patent and Trademark Office)
- [www.uibm.gov.it/uibm/dati/](http://www.uibm.gov.it/uibm/dati/) (patents database)

**PART 2 TRADEMARKS****§2.01 SUMMARY****[A] Duration of Registration**

- 10 years from the filing date of the application, indefinitely renewable for further periods of 10 years.

**[B] Registrable / Not Registrable**

- Any sign is registrable as a trademark that is capable of being represented graphically, provided that it is capable of distinguishing the goods or services of one undertaking from those of other undertakings.
- The following may in particular be registered as a trademark: words, including personal names, designs, letters, numerals, sounds, the shape of goods or of their packaging, colour combinations or shades.

**[C] Procedure**

- A trademark is registered after examination as to form, absolute grounds and lack of consent by the entitled party where the trademark consists of that party's portrait, or personal name, or of a well-known personal name or sign used in the artistic, literary, scientific, political or sports field, or of a well-known name or initial of shows and events or of non-profit bodies and associations, or of their characteristic emblems. Once approved after examination, a trademark is published and open to third parties' oppositions.

**[D] Governmental Websites**

- [www.uibm.gov.it](http://www.uibm.gov.it) (Italian Patent and Trademark Office)
- [www.uibm.gov.it/uibm/dati/](http://www.uibm.gov.it/uibm/dati/) (trademarks database)

**§2.02 DETAILED INFORMATION****[A] Conventions and Legislation***[1] Conventions*

- Paris Convention (International Union) 1883–1967 (the Stockholm text is in force in Italy as from 24 April 1977);
- Madrid Agreement Concerning the International Registration of Marks (Madrid Union) 1891–1967 (Italy is a member since 15 October 1894 and the Stockholm text is effective as from 24 April 1977);
- Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods 1891–1967;
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Union) 1957–1977;
- Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (Lisbon Union) 1958–1967;
- The Hague Convention Abolishing the Requirement of Consular Legalization for Foreign Public Documents 1961;
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967 (effective for Italy as from 31 January 1975);
- Vienna Agreement regarding the International Classification of the Figurative Elements of Marks 1973 (signed, not yet ratified);
- TRIPs – Trade-Related Aspects of Intellectual Property Rights 1994;
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) 1989 (effective as from 17 April 2000);
- Singapore Treaty on the Law of Trademarks 2006 (in force as from 21 September 2010);
- EU Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trademarks;
- EU Council Regulation (EC) No. 40/94 of 20 December 1993, on the Community Trademark, as amended by Regulation (EC) No. 3288/94, Council Regulation (EC) No. 1653/2003 of 18 June 2003 and Council Regulation (EC) No. 422/2004 of 19 February 2004;
- EU Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community Trademark, entered into force on 13 April 2009; and
- EU Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights.

*[2] Laws*

- Industrial Property Code, enacted by Legislative Decree No. 30 of 10 February 2005 and entered into force on 19 March 2005, as amended up to and including Legislative Decree No. 131 of 13 August 2010, Decree of the Minister of Economic Development of 11 May 2011 and Laws No. 14 of 24 February 2012 and No. 27 of 24 March 2012; and
- Industrial Property Code implementing rules, enacted by Decree of the Minister of Economic Development No. 33 of 13 January 2010, entered into force on 10 March 2010.

The Code consolidated and repealed the provisions of the previous national industrial property laws. After having undergone some amendments in 2006, 2007 and 2009, the Code was further amended by Legislative Decree No. 131 of 13 August 2010, entered into force on 2 September 2010. Further minor amendments were introduced by Laws No. 14 of 24 February 2012 and No. 27 of 24 March 2012. The amendments were mostly aimed at reinforcing industrial

property rights, improving their enforcement before the Courts and streamlining the prosecution procedures before the Italian Patent and Trademark Office. By Decree of the Minister of Economic Development of 11 May 2011 trademark opposition procedure became operational.

### **[B] Duration of Registration**

Ten years from the filing date of the application, indefinitely renewable for further ten-year periods (starting from the previous expiration date).

### **[C] Requirements for Renewal**

Applications for renewal can be filed in the twelve months preceding the last day of the expiration month of the registration, or in the following six months upon payment of an additional fee. As to restoration of failure to pay the renewal fee within the six-month grace period, see 'Restoration'.

For renewals, the requirements are in principle the same as for applications for registration. Renewal cannot be obtained by payment of the renewal fee only, it being necessary to file a renewal application (online renewal applications are possible). Renewals are issued bearing a renewal registration number different from the number of the original registration or of the previous renewal registration. Under the Industrial Property Code in force since 19 March 2005, it is possible to renew the trademark registration in respect of only some of the goods or services or in respect of only some of the classes originally covered.

In case a registration has been split up by partial assignment, renewal is to be applied for separately for each part into which the registration has been split, and each owner thereafter receives a renewal registration certificate.

Under the previous Trademark Law, no longer in force as from 19 March 2005, on renewal minor changes not affecting the distinctive features of the trademark were accepted; if renewal was requested for a trademark, the distinctive features of which were different from those of the previously registered (or renewed) trademark, the Italian Patent and Trademark Office required the application for renewal to be converted into an application for first registration running from the filing date of the renewal application.

### **[D] Registrable / Not Registrable**

Registrable are any signs capable of being represented graphically provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings; particularly words, including personal names, designs, letters, numerals, sounds, the shape of goods or of their packaging, colour combinations or shades may be registered as trademarks.

Personal names other than the name of the applicant may be registered, provided their use may not prejudice the reputation, credit or dignity of the person entitled to bear that name; the consent of the person (or, after the death of such person, the consent of the nearest relatives) whose name is applied for as a trademark in the name of another party may be required by the Italian Patent and Trademark Office. Registration of a name does not prevent a person entitled to that name to use it in the course of trade, provided that the use is in accordance with the principles of professional fairness (honest practices), and also, even though with certain limits, in his/her trade name.

Well-known personal names, well-known signs used in the artistic, literary, scientific, political or sports field and well-known names and initials of shows and events and of non-profit bodies and associations and their characteristic emblems may only be registered (and used) as trademarks by the parties entitled thereto or with their consent (or, after the death of such parties, with the consent of the nearest relatives).

The portrait of a person may be registered only with such person's consent (or, after the death of such person, with the consent of the nearest relatives). As a rule, objections in respect of trademarks consisting of a person's portrait are raised during examination of the trademark application and the person's consent is required.

The following are not registrable as a trademark on absolute grounds (and, as a rule, are the subject of objections during examination of the trademark application):

- (a) Signs not capable of being represented graphically.
- (b) Signs consisting exclusively of indications which have become customary in the current language or in the established practices of the trade; however, if such signs, prior to the filing date of the application for registration, have acquired a distinctive character through the use made thereof (secondary meaning), they may be registered.
- (c) Signs which are devoid of any distinctive character, particularly signs which consist exclusively of generic denominations of goods or services or of descriptive indications relating thereto, such as the signs which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, or other characteristics of the goods or services; however, signs having acquired a 'secondary meaning' can be registered. Signs which may serve in commerce to indicate the geographical origin of goods or services may be registered as a collective trademark.
- (d) Signs consisting exclusively of the shape resulting from the nature of the goods, or of the shape of goods which is necessary to obtain a technical result, or of the shape which gives substantial value to the goods.
- (e) Coats-of-arms, badges, symbols, emblems and all other signs provided for by international conventions in force or which are of public interest, unless their registration has been authorized by the competent authorities.
- (f) Signs contrary to the law, to public policy or to morality.
- (g) Signs which may deceive the public, in particular as to the geographical origin, nature or quality of the goods or services.

The following are not registrable as a trademark on relative grounds (they are not subject to official examination; the relevant issues may only be raised in nullity proceedings before the Courts and to a limited extent in opposition proceedings (see under 'Procedure', 'Opposition')):

- (a) Signs which are identical with or similar to a sign which is already known as a trademark or distinctive sign of goods or services manufactured, marketed or rendered by another party for identical or similar goods or services, if because of the identity or similarity between the signs and the identity or similarity of the goods or services a likelihood of confusion may arise on the part of the public, which may also consist of a likelihood of association between the two signs (thus the owner of a non-registered *de facto* used trademark which has acquired a not mere local reputation, i.e., a nation-wide reputation, is entitled to challenge the registration of a later trademark). A well-known trademark pursuant to Article *6bis* of the Paris Convention is considered known under this provision, even if its notoriety has been obtained in Italy through the promotion of the trademark. If a sign has been previously used by another party as a trademark but enjoys no reputation or it enjoys a mere local reputation, it is not a bar for the registration of a later identical or similar mark. Prior use of the sign by the applicant or by its predecessor in title is not a bar to its registration as a trademark.
- (b) Signs which are identical with or similar to a sign already known as a trade name, company name, signboard or as a domain name used in an economic activity of another party, if because of the identity or similarity between the signs and the identity or similarity between the business activity carried out by such party and the goods or services for which the trademark is (sought to be) registered a likelihood of confusion may arise on the part of the public, which may also consist of a likelihood of association between the two signs. If a sign has been previously used by another party as a trade name,

company name, signboard or as a domain name without obtaining notoriety, or when it has obtained local notoriety only, it is not a bar for the registration of a later identical or similar mark. Prior use of the sign by the applicant or by its predecessor in title is not a bar to its registration as a trademark.

- (c) Signs which are identical with a trademark already registered (or applied for, subject to its registration) by another party in Italy or with effect in Italy (i.e., under an international trademark registration in accordance with the Madrid Agreement or Protocol or under an EU trademark) for identical goods or services, if the registration has an earlier filing or priority date or, in the case of an EU trademark, is effective from an earlier date as a consequence of a valid seniority claim.
- (d) Signs which are identical with or similar to a trademark already registered (or applied for, subject to its registration) by another party in Italy or with effect in Italy (i.e., under an international trademark registration in accordance with the Madrid Agreement or Protocol or under an EU trademark) for identical or similar goods or services, if the registration has an earlier filing or priority date or, in the case of an EU trademark, is effective from an earlier date as a consequence of a valid seniority claim, if because of the identity or similarity between the trademarks and of the identity or similarity between the goods or services a likelihood of confusion may arise on the part of the public, which may also consist of a likelihood of association between the two trademarks.
- (e) Signs which are identical with or similar to a trademark already registered (or applied for, subject to its registration) by another party in Italy or with effect in Italy (i.e., under an international trademark registration in accordance with the Madrid Agreement or Protocol or under an EU trademark), even for non-similar goods or services, if the registration has an earlier filing or priority date or, in the case of an EU trademark, is effective from an earlier date as a consequence of a valid seniority claim, where the earlier trademark enjoys a reputation in Italy or in the European Union, in the case of an EU trademark, and where the use without due cause of the later trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.
- (f) Signs which are identical with or similar to a trademark which is already well-known pursuant to Article 6*bis* of the Paris Convention, even for non-similar goods or services, where the use without due cause of the later trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.
- (g) Signs the use of which would infringe a copyright, industrial property right or any other exclusive right of a third party.

The signs which are identical with an earlier trademark for identical goods or services as referred to under (c) above, and the signs which are identical with or similar to an earlier trademark for identical or similar goods or services as referred to under (d) above are registrable if the registration of the earlier trademark has expired for more than two years (or, if the earlier trademark is a collective trademark, for more than three years) or may be regarded as having lapsed on account of non-use at the time on which the nullity of the later trademark is applied for or the validity of the later trademark is challenged in a Court action. The same applies to the signs which are identical with or similar to an earlier trademark which enjoys a reputation in Italy or in the European Union as referred to under (e) above.

[1] *Colour marks*

Trademarks consisting of colour combinations or shades may be registered, provided the requirement of distinctiveness is met. A single colour could be registrable as a trademark, if the connection between the colour and the goods or services to be covered is arbitrary.

*[2] Three-dimensional marks*

Three-dimensional trademarks, including trademarks consisting of the shape of goods or of their packaging are registrable; however, three-dimensional signs consisting exclusively of the shape resulting from the nature of the goods, or being necessary to obtain a technical result, or giving a substantial value to the goods concerned, cannot be registered as a trademark.

*[3] Collective marks*

Collective marks per se, i.e., marks distinguishing the goods or services of members of an association owning the mark from those of other undertakings, are not provided for in Italy. However, the Industrial Property Code in force since 19 March 2005 (but also the previous Trademark Law) provides for the possibility to register certification marks as 'collective marks' by natural or legal persons who carry out the duty of guaranteeing the origin, nature or quality of certain goods or services and who may allow such marks to be used by manufacturers and traders. Within this meaning, the regulations governing the use of a collective trademark, the controls and the relevant sanctions for its misuse must be filed along with the application for registration of a collective trademark. The owner of the collective trademark is responsible for ensuring that the regulations are observed by all the users of the collective trademark. The owner of the collective trademark must submit to the Italian Patent and Trademark Office any modifications in the regulations of use in order that they be included among the documents that accompany the trademark application. Foreign collective trademarks which are registered in the home country may be registered in Italy under the same conditions. Signs or indications which may serve in commerce to indicate the geographical origin of goods or services may be registered as a collective trademark; however, the Italian Patent and Trademark Office may refuse registration thereof as a collective trademark if this would create unjustified privileges or could be harmful for the development of similar initiatives in the territory concerned. The registration of a geographical name as a collective trademark does not entitle the owner to prevent third parties to use that name in commerce, if such use is in accordance with honest practices and consequently is limited to the function as an indication of origin.

*[4] Certification marks*

Certification marks may be registered as 'collective marks'.

*[5] Associated marks*

Not applicable in this jurisdiction.

*[6] Series of marks*

Not applicable in this jurisdiction.

*[7] Other marks*

Sounds may be registered as trademarks, provided they comply with the requirement of distinctiveness and can be represented graphically. Fragrance marks (scent marks) might be registrable, provided they are distinctive and can be represented graphically; the same could

apply for tactile marks, although there is no case law on this matter yet. It is to be assumed that taste marks at present cannot be registered.

Defensive marks are provided for in the sense that lapse for lack of use does not apply in respect of a non-used registered trademark if its owner also owns one or more similar registered trademarks still in force, of which at least one is being genuinely used for the same goods or services. This is an old provision which has been maintained in the Industrial Property Code even though there is no corresponding provision in the EEC Directive No. 89/104 of 21 December 1988 on the approximation of the trademark laws in the European Union member countries.

### **[E] Applicant**

Registration of a trademark may be obtained by any natural or legal person who makes use of the trademark or has the intention to use the trademark in the manufacture or trade of goods or in the provision of services in its own undertaking or by controlled undertakings or by undertakings that make use of the trademark with its consent. The requirement that the applicant be directly acting in the field for which the trademark is applied for having been dropped in 1992, registration may also be requested and obtained by any applicant who intends to have the mark used by a licensee or by a related company, including by a holding company. Registration of a trademark may also be applied for by the administration of the State, regions, provinces or municipalities. Registrations applied for in bad faith (e.g., applied for by an agent or licensee without the consent of the owner of the trademark) are not considered valid.

If a trademark application is filed in the name of more than one person, said co-ownership is governed by the provisions of the Italian Civil Code on co-ownership as long as they are applicable and unless there is a different agreement between the co-owners. If the right to the trademark belongs to two or more persons, the filing of the trademark application, the prosecution of the application before the Italian Patent and Trademark Office and the renewal of the trademark registration can be carried out by each of the co-owners in the interest of all the others, unless differently agreed upon by the parties.

Nationals of States which are parties to the Paris Convention or to the World Trade Organization, as well as nationals of States which are not parties to the Paris Convention or to the World Trade Organization but who are domiciled or who have a real and effective industrial or commercial establishment within the territory of a State which is party to the Paris Convention are entitled to registration in the same way as nationals of Italy. Nationals of other States may apply for and obtain trademark registrations in Italy, provided their home country grants reciprocity to nationals of Italy.

Natural or legal persons who carry out the duty of guaranteeing the origin, nature or quality of certain goods or services may obtain the registration of a 'collective trademark'. Foreign collective trademarks registered in their country of origin may also be registered in Italy (see under 'Registrable / Not Registrable', 'Collective marks').

If an application for registration was filed by a person not entitled thereto and the registration has not yet been granted, the entitled person may, as a result of a favourable decision given by a Court, within three months from the date on which said decision became final either prosecute the application as the applicant in his/her own name, or file a new application in his/her own name having the same filing date of the application filed by the non-entitled person (the latter application shall then cease to have effect), or obtain the rejection of the application of the non-entitled person. If, on the contrary, the registration has already been granted, the entitled person may have the registration either transferred to his/her own name or declared null and void.

### **[F] Assignment**

Following the amended law in force from 31 December 1992, a trademark may be assigned

with or without the business or the branch of the business pertaining to the trademark. Assignment may be for all or part of the goods or services for which the trademark is registered. Assignment is not allowed if there would be deceit in those features of the goods or services which are essential for the appraisal by the public. Consequently, the assignee should maintain the same quality of the goods or services covered by the trademark. Furthermore, although by an assignment the registration of a trademark could be split up even within the same class, a registration may not be split up for similar goods and/or services, so that the control of the exclusive rights to use such trademark would pass on to different parties. If an assigned trademark is used by the assignee in such way as to mislead the public with regard to the quality of the goods or services concerned, the registration of the trademark may lapse.

The recordal of an assignment concerning a trademark registration or application requires:

- An application for recordal of the assignment.
- A notarized and legalized assignment deed or an assignment declaration simply signed by both the assignor and the assignee. The assignment deed or declaration must include full details of the transferred trademark application or registration. The fiscal registration of the assignment is required before the assignment is recorded with the Italian Patent and Trademark Office and to this purpose the assignment consideration, if it is not provided for in the assignment deed or declaration, is to be stated. The fiscal registration of the assignment with the Italian Registry Office can be carried out directly by the local professional representative.
- A sworn translation of the assignment deed or declaration if drafted in another language than Italian.
- A power of attorney, signed by the party requesting the recordal of the assignment (usually the assignee, but also the assignor is entitled to apply for the recordal of the assignment), if the application is to be filed with the Italian Patent and Trademark Office by a local professional representative.

Since March 2005, the Italian Patent and Trademark Office also accepts instead of assignment deeds assignment declarations that do not require notarization/legalization and which only need to be signed by both parties and then registered with the competent fiscal authorities (i.e., the Italian Registry Office). Using the assignment declaration instead of the assignment deed among others allows saving the burden and costs of having an Italian notary public entering the assignment deed in his/her files.

Unrecorded assignments are valid between the parties but ineffective against third parties who in bona fide have lawfully acquired the rights in the trademark registration or application.

## **[G] Requirements for Filing**

### *[1] Request for registration*

The following are required:

- Application (may be filled in and signed by the applicant's professional representative), stating full name, address and nationality of the applicant (and also full name and address of the professional representative, if any), and containing a representation of the trademark, the colour or colours claim, if any, including the international code of the colour or colours for trademarks consisting exclusively of colour combinations or shades, and the specification of the goods or services to be covered along with the indication of the relevant class or classes (the whole heading of a class may be claimed).
- Power of attorney (*Lettera di Incarico*), not legalized, on standard form, required to empower a local professional representative.
- If priority is claimed: statement of country, serial number and filing date of the first

foreign application the priority of which is claimed, priority document and assignment of priority rights.

- In case of an application for registration of a sound as a trademark, its graphical representation in music notes must be filed (recordings are not accepted).
- For trademark applications deriving from the conversion of earlier EU trademark applications or registrations or of earlier international trademark registrations under the Madrid Protocol, the relevant details must be provided.
- For collective trademark applications, the regulations governing the use of the trademark, the controls and the relevant sanctions (in Italian or accompanied by an Italian translation) must be filed.

One application may relate to goods or services of more than one class of the applicable classification (i.e., the International Classification under the Nice Agreement), provided that an additional fee is to be paid for each class of goods or services over the first.

#### *[2] Appointment of Representative*

Applicants residing or established abroad must elect an address for service in Italy, usually c/o a local professional representative, to whom communications by the Italian Patent and Trademark Office and deeds originating from Courts are served.

Representation before the Italian Patent and Trademark Office may only take place through professional representatives admitted to practice before the Office or through attorneys-at-law.

#### *[3] Power of Attorney*

A power of attorney (*Lettera di Incarico*), not legalized, on standard form is required to empower a local professional representative. The power of attorney may be filed within two months from the filing date of the application. An extension of time may be granted on request.

If the power of attorney is executed as a 'general power', it is also valid for all subsequent applications for trademarks, patents, utility models and industrial designs and models in the name of the same applicant.

#### *[4] Priority*

The right of priority with respect to a prior trademark application filed within the previous six months in a State party of the Paris Convention for the Protection of Industrial Property, or of the World Trade Organization, is recognized.

The priority claim must refer to the trademark application which is considered to be the first application under the international conventions.

If the priority has not been claimed on filing the subsequent trademark application, it can still be claimed within two months from the filing date of the trademark application in Italy.

Multiple priorities may be claimed in one Italian application, provided they concern the same trademark; also partial priorities are admissible, i.e., for some classes or for some goods or services only.

Exhibition priority may also be claimed for trademarks used for the first time with goods or with materials relating to the rendering of services which are shown at official or officially recognized national or international exhibitions held in the State territory or in the territory of a foreign State that accords reciprocity of treatment, provided a decree by the Italian Minister of the Economic Development grants a temporary protection to such trademarks. The non-extendible priority term is six months from the date on which the goods or the materials relating to the rendering of services were delivered for the exhibition and in any case it cannot extend beyond six months from the opening date of the exhibition.

A certified non-legalized copy of the earlier applications must be filed within the non-extendible term of six months from the date of the Italian application. An Italian translation of the priority application is also required.

If the Italian application is filed by a party other than the applicant of the first trademark application the priority of which is claimed, a deed or declaration of assignment of the priority rights is required. There is no statutory term for its filing. The Italian Patent and Trademark Office could request said deed or declaration at any time during the prosecution of the application. It is, however, advisable that the deed or declaration be lodged within six months like the priority document. If the original applicant applies jointly with another party, or a foreign co-applicant applies alone, no assignment is required.

#### *[5] Graphical representations*

A representation of the trademark must always be included in the application. In case of an application for registration of a sound as a trademark, its graphical representation in music notes must be filed. For three-dimensional trademarks, their two-dimension graphical representation or photographic reproduction must be submitted, which may also be accompanied by up to a maximum of five additional perspectives of the mark.

### **[H] Procedure**

#### *[1] Filing Authority*

The trademark authority is the Italian Patent and Trademark Office (*Ufficio Italiano Brevetti e Marchi*), operating within the Ministry of the Economic Development (*Ministero dello Sviluppo Economico*), in Rome. The receiving office of the Italian Patent and Trademark Office is the Chamber of Commerce.

#### *[2] Online filing*

The application may be filed also via the online system WebTelemaco <http://webtelemaco.infocamere.it/>, managed by the association of the Italian Chambers of Commerce (InfoCamere). The filing documents must be prepared in .xml format (the application form) and in .pdf format (trademark representation, power of attorney, priority documents, regulations of use of collective trademarks, etc.). The signature is carried out electronically, via a special smart-card and the relevant hardware and software that can be obtained upon request from any Chamber of Commerce. The online filing involves reduced fees. The stamp duties are paid via a deposit account that can be established with the system.

Trademark renewals may also be filed online.

#### *[3] Classification*

The trademark classification applicable in Italy is the International Classification of Goods and Services under the Nice Agreement (10th edition, in force since 1 January 2012), which at present comprises forty-five classes, classes 1–34 for goods and classes 35–45 for services.

#### *[4] Search*

No search as to earlier trademarks is carried out by the Italian Patent and Trademark Office.

*[5] Examination*

Applications are examined as to form, registrability on absolute grounds, conflict with third parties' personal names (when their use without consent may prejudice the reputation, credit or dignity of the person entitled to bear that name), with third parties' portraits (whose consent is required) and with (non-registered) well-known personal names or signs used in the artistic, literary, scientific, political or sports field and well-known names, initials and emblems of shows and events and of non-profit bodies and associations (whose consent is required). No examination is carried out as to the other relative grounds which may only be raised in Court proceedings.

If objections are raised by the Italian Patent and Trademark Office, a deadline of not less than two months is granted for response, which may be extended up to a maximum of six months from the receipt of the official action.

*[6] Registration*

If there are no outstanding objections and no third parties' oppositions are filed, the trademark is registered.

*[7] Opposition*

Opposition proceedings before the Italian Patent and Trademark Office have been introduced by Legislative Decree No. 447 of 8 October 1999 and have become operational by Decree of the Minister of Economic Development of 11 May 2011, applying to Italian trademark applications filed as of 1 May 2011 and to Italian designations of international trademark registrations under the Madrid system, irrespective of their registration (or subsequent designation) date, published on WIPO's Gazette as of July 2011. Oppositions must be filed within three months from the publication of the application. Oppositions against Italian designations of international trademark registrations under the Madrid system must be filed within three months from the first day of the month subsequent to their publication on WIPO's Gazette. Only the owner of a trademark already registered or applied for in Italy or with effect in Italy (i.e., under an international trademark registration in accordance with the Madrid Agreement or Protocol or under an EU trademark), if the registration or application has an earlier filing or priority date or, in the case of an EU trademark, is effective from an earlier date as a consequence of a valid seniority claim, may oppose as well as the exclusive licensee of such trademark, and the persons, bodies or associations whose consent is required for the registration of a trademark as mentioned under the heading 'Registrable / Not Registrable'. No opposition can be filed on the basis of unregistered trademark rights or copyrights, nor on company names or domain names. It is also not possible to invoke bad faith or the reputation of an earlier mark registered or applied for dissimilar goods/services. 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 Italian Patent and Trademark Office. Supporting documents (registration 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 trademarks on which the opposition is based that were registered more than five years prior to the date of publication of the opposed application. The Italian Patent and Trademark Office forwards this request to the Opponent setting an extendible sixty-day term for filing proof of use. Opposition decisions are rendered within twenty-four months from the filing date of the opposition (without taking into account the cooling-off period and the period during which proceedings may have been suspended). The Italian Patent and Trademark Office may award costs to the winning party for a maximum of EUR 300.00 in professional fees and the refund of the official opposition fee of EUR 250.00.

Any interested party may submit written observations (and documents) in respect of a

trademark application indicating possible grounds for its rejection, limited, however, to the grounds on which the Italian Patent and Trademark Office carries out its examination, i.e., absolute grounds. Observations referring to relative grounds such as earlier rights of a third party are not taken into consideration. The Italian Patent and Trademark Office is not obliged to keep the party who has filed observations informed about the proceedings, to which it does not become a party. The Office must examine the observations and if it deems them grounded they are communicated to the applicant who has an extendible deadline of thirty days to submit its response. Observations may be filed at any time before the trademark matures into registration. In practice, third parties' observations are in most cases not at all taken into consideration by the Italian Patent and Trademark Office.

#### *[8] Appeal*

The final refusal of the trademark application or of the priority claimed or of an opposition may be appealed before the Board of Appeals within the deadline of two months, and the decision of the Board of Appeals may be further appealed for reasons of law only before the Supreme Court.

#### *[9] Alteration after Registration*

Alterations in registered marks are not allowed. However, it is possible to renew the trademark registration in respect of only some of the goods or services or in respect of only some of the classes originally covered. Under the previous trademark law, no longer in force as from 19 March 2005, minor changes not affecting the distinctive features of the trademark were accepted on renewal.

#### *[10] Publication / Public File Inspection*

Applications are open to public inspection immediately after filing, and anybody may inspect the files of the applications and obtain a copy of the application as well as all relevant information. Once examined, trademark applications are published on the Italian Official Trademark Bulletin for third parties' possible oppositions (see under 'Procedure', 'Opposition').

The registered trademarks and trademark applications can also be viewed at the online register of the Italian Patent and Trademark Office.

### **[I] Nullity and Lapse**

Any interested party may bring a Court action to request the registration of a trademark to be declared null and void or lapsed. Nullity or lapse of the trademark registration may also be requested ex officio by the Public Prosecutor, except for nullity on relative grounds, or on the ground that the trademark infringes another party's right to the name or portrait, or on the ground that the registrant was not entitled to registration. Partial nullity or lapse (i.e., for only some of the goods or services covered by the registration) is possible. The Court's final decision declaring a trademark registration null and void or lapsed is effective against everybody and is recorded with the Italian Patent and Trademark Office. Use by any party of a trademark the registration of which has been declared null and void is prohibited if the ground of the nullity declaration involves that the use of the trademark is unlawful. Nullity actions may be brought on the ground that the trademark was not registrable. Since the law as amended with effect from 16 December 1999, nullity of a trademark registration on relative grounds, or on the ground that the trademark infringes another party's right to the name or portrait, or on the ground that the registrant was not entitled to registration may be requested

only by the party that owns the earlier right concerned or by his/her successor in title. A trademark registration cannot be declared null and void on the ground of an earlier trademark the registration of which has expired for more than two years (or, if the earlier trademark is a collective trademark, for more than three years) or has lapsed on account of non-use at the time on which the nullity of the trademark registration is applied for.

Owners of earlier trademarks registered in or with effect in Italy (i.e., under an international trademark registration in accordance with the Madrid Agreement or Protocol or under an EU trademark) and owners of earlier non-registered *de facto* used trademarks which have acquired a not mere local reputation, i.e., a nation-wide reputation, who have tolerated use of a later identical or similar registered trademark during a period of five consecutive years, while being aware of such use, cannot request the registration of the later trademark to be declared null and void nor oppose the use of the later trademark for the goods or services for which that trademark has been used, except where registration of the later trademark was applied for in bad faith (forfeiture of rights through acquiescence). In this case, the owner of the later trademark is not entitled to oppose the use of the earlier trademark or the continuation of use of the earlier non-registered *de facto* used trademark. The right to request the nullity of the registration of a trademark which infringes another party's copyright, industrial property right or other exclusive rights, or which has been registered without the required consent of another party (where it consists of another party's portrait, or personal name, or well-known personal name or sign used in the artistic, literary, scientific, political or sports field, or of well-known names or initials of shows and events or of non-profit bodies and associations, or of their characteristic emblems) likewise forfeits under the same conditions. A trademark registration cannot be declared null and void for lack of distinctiveness if at the time on which the nullity of the trademark registration is applied for the trademark has acquired a distinctive character through the use made thereof (secondary meaning).

Court actions to request the registration of a trademark to be declared lapsed may be brought on the ground: (a) of non-use of the trademark; (b) that the trademark has become liable to deceive the public, in particular as to the nature, quality or origin of the goods or services, because of the manner and context in which the trademark is used by its owner or with his/her consent for the goods or services for which it is registered; (c) that, because of the owner's acts or inactivity, the trademark has become the common name in the trade of the product or service in respect of which it is registered or has lost its distinctive character; (d) that the trademark has become contrary to the law, to public policy or to morality. Lapse of a collective trademark registration may furthermore be declared if the owner does not carry out the controls provided for by the regulations of use.

Renunciation: A trademark registration may be surrendered in respect of some or all of the goods or services covered. The surrender becomes effective upon its recordal with the Italian Patent and Trademark Office.

### **[J] Use Requirement**

A registered trademark must be used in Italy for the goods or services for which it is registered. The registration lapses (lapse for lack of use must be declared in Court proceedings) for all or part of the goods/services covered if the trademark is not genuinely used by the registrant or with his/her consent, within five years from the registration date, or if use is discontinued for five consecutive years, unless the lack of use is due to legitimate reasons, such as force majeure reasons (financial difficulties, however, are not considered to constitute legitimate reasons). Full validity of the registration is recovered in case genuine use of the trademark is commenced or resumed before the filing of a judicial lapse claim or counter-claim. However, if the owner of the trademark makes preparations for the commencement or resumption of use of the trademark only after having become aware that a lapse claim or counter-claim is about to be filed, such commencement or resumption is not taken into consideration if it did not occur after the expiry of the five-year period of non-use and at least three months prior to the filing of the lapse claim or counter-claim. Furthermore, late use of a registered trademark

does not remedy the lapse of the registration if rights in the trademark have been acquired by a third party through an application for registration or use (no corresponding provision, however, exists in EEC Directive No. 89/104 of 21 December 1988 on the approximation of the trademark laws in the European Union member countries).

Use of the trademark in a modified form not altering its distinctive character as well as affixing the trademark in Italy to goods or their packaging for export purposes constitute use of the trademark. Lapse of the trademark registration does furthermore not occur if the owner of the non-used trademark at the same time also owns one or more similar trademarks still in force of which at least one is being genuinely used for the same goods or services (see under the subheading ‘Other marks’).

The burden of proof to have the lapse of a trademark registration declared on account of non-use lies on the party which claims the lapse. The proof may be furnished by any means, including simple presumptive evidence.

### **[K] Marking**

Marking is advisable, but not compulsory. Possible marking: ‘Marchio registrato’, or ‘Marchio reg.’, which may also be followed by the trademark registration number, or ‘®’, or ‘Marchio depositato’, or ‘Marchio dep.’, which may also be followed by the trademark application number. False marking is punishable with a fine.

### **[L] Licenses and Registered Users**

Following the amended law in force from 31 December 1992, exclusive and non-exclusive licenses under a registered trademark or even a pending trademark application may be granted. Licenses may be for all or part of the goods or services for which the trademark is registered, and may be for all or part of the Italian territory. In case of a non-exclusive license, the licensee is obliged to expressly undertake to provide goods or services of the same kind as those provided under the same trademark by the licensor and/or by other licensees. License agreements entered into prior to 31 December 1992 might still be invalidated if in contravention to the provisions of the former law; in this connection it might be recommendable to re-stipulate such agreements so that they may benefit from the amended law. A license agreement may not lead to deceit in those features of the goods or services which are essential for the appraisal by the public. If a trademark through the use made of it by a licensee (or by the licensor) would become misleading as to the nature, quality or origin of the goods or services, its registration may lapse. The owner of a licensed registered trademark may sue for infringement (and not only sue for breach of the license agreement) a licensee who acts in contravention of any provision of the license agreement with regard to the duration of the license, the form in which the trademark may be used, the goods or services for which the license was granted, the territory in which the trademark may be used, or the quality standards applicable to the goods manufactured or the services rendered by the licensee. License agreements must be recorded with the Italian Patent and Trademark Office in order to be effective against third parties who in bona fide have lawfully acquired rights in the trademark; the requirements are as in the case of assignments.

In case the foreign owner of an Italian trademark registration or trademark application grants a license under such trademark to an Italian licensee, the following may be mentioned. Payments from Italy to other countries need to comply with the applicable currency control provisions. For several payments, among which the payments under license agreements, Italian banks are authorized to effect remittances within certain limits, against submission of the documentation concerning the license agreement in question, and, if necessary for the calculation of the amounts due, of copies of the invoices relating to the sales of the products under license.

Licenses of right are not provided for by the Italian law in respect of trademarks.

**[M] Pledge and Seizure**

Following the amended law in force from 31 December 1992, it is possible to establish security interests in respect of registered trademarks or even pending trademark applications and to record them with the Italian Patent and Trademark Office in order to be effective against third parties who have in bona fide lawfully acquired rights in the trademark registration or trademark application; the requirements are as in the case of assignments.

**[N] Infringement***[1] Infringing acts / Non-infringing acts*

The registration confers on the owner the exclusive right to use the trademark. The effects of the trademark registration start from the filing date of the application and, with the exception of trademarks enjoying a reputation in Italy, are limited to the goods or services listed in the registration and to similar goods or services.

Exclusive rights are also enjoyed by a non-registered de facto used trademark which has acquired a not mere local reputation, i.e., a nation-wide reputation, as well as by a well-known trademark under Article *6bis* of the Paris Convention. On the contrary, the prior user of a non-registered trademark which enjoys no reputation or a mere local reputation has the right to continue the use of the trademark (including use in advertisement) after the registration of an identical or similar mark by another party, within the (territorial and other) limits determined by the prior use, but is not entitled to challenge the registration of the later trademark.

The following acts carried out by a third party in the course of trade without the consent of the owner of an earlier exclusive trademark right amount to an infringement thereof and may be prohibited: (a) use of a sign identical with the earlier trademark for goods or services which are identical with those for which the earlier trademark is registered; (b) use of a sign identical with or similar to the earlier trademark for identical or similar goods or services if because of the identity or similarity between the signs and of the identity or similarity between the goods or services a likelihood of confusion may arise on the part of the public, which may also consist of a likelihood of association between the two signs; (c) use of a sign identical with or similar to the earlier trademark even for non-similar goods or services, if the earlier registered trademark enjoys a reputation in Italy and the use without due cause of the sign allows to take unfair advantage of the distinctive character or the repute of the earlier trademark, or is detrimental thereto. (The right to the exclusive use of a trademark registered prior to 31 December 1992 and which enjoys a reputation does not entitle its owner to oppose the further use in the course of trade of an identical or similar sign for goods or services which are not similar to those for which it was registered.)

In particular the following acts carried out by a third party under any of the conditions mentioned in the preceding paragraph are considered as amounting to an infringement: affixing the sign to the goods or to their packaging; offering the goods, putting them on the market or stocking them for these purposes, or offering or supplying services under the sign; importing or exporting the goods under that sign; using the sign on business papers and in advertising. Traders may affix their trademarks on the goods they market but are not allowed to suppress the trademark of the manufacturer or of the trader from whom they received the goods.

A licensee who acts in contravention of the provisions of the license agreement is considered as an infringer, and an infringement action can be taken against him/her.

The following acts carried out by a third party in the course of trade, provided that they are in accordance with the principles of professional fairness (honest practices), do not amount to an infringement of an earlier exclusive trademark right and cannot be prohibited by its owner:

- (a) Use by the third party of his/her name and address.
- (b) Use of indications concerning the kind, quality, quantity, intended purpose, value,

geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service.

- (c) Use of the trademark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

Exhaustion: the owner of an exclusive trademark right cannot prohibit a third party to use the trademark in relation to goods which have been put on the market by him/her or with his/her consent in the Italian territory or in the territory of any of the European Economic Area member countries, except if there exist legitimate reasons for the trademark owner to oppose the further commercialization of the goods, in particular where the condition of the goods is changed or impaired after they have been put on the market. Hence, the so-called intra-Community parallel imports into Italy of marked goods legitimately put on the market in any of the European Economic Area member countries may be allowed.

## *[2] Remedies*

Infringement actions are to be brought as of 21 September 2012 before the specialized so-called business Courts (in the cities of Ancona, Bari, Bologna, Brescia, Cagliari, Campobasso, Catania, Catanzaro, Florence, Genoa, Milan, Naples, Palermo, Perugia, Potenza, Rome, Trento, Trieste, Turin and Venice). Previously, starting from 2003, infringement actions were brought before specialized industrial property Courts in twelve Italian cities. Such Courts have exclusive jurisdiction for infringement actions concerning trademarks, patents, plant varieties, utility models, industrial designs and models, copyright and unfair competition related to industrial property rights. The specialized Court having jurisdiction over the case is the specialized Court having geographical jurisdiction over the domicile of the defendant, or if the defendant has no domicile in Italy, the specialized Court having geographical jurisdiction over the domicile of the plaintiff, or, if neither party has a domicile in Italy, the Court of Rome; infringement actions may also be brought before the specialized Court having geographical jurisdiction over the place where the allegedly infringing acts have taken place.

First Instance Court decisions are in principle provisionally enforceable.

Infringement relating to a pending trademark application may be pursued and the same remedies apply as for registered trademarks.

Available remedies in case of infringement include: an injunction prohibiting the use of the infringing trademark and the manufacture and trade of the goods or the rendering of the services bearing the infringing trademark; a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order; the destruction of the infringing trademark and even of the packaging of the goods and (if deemed appropriate) of the goods themselves or of the materials relating to the rendering of the services bearing the infringing trademark (however, no order for removal or destruction may be issued if the infringing items belong to persons who use them for personal or domestic purposes); the assignment of the infringing goods manufactured, imported or sold to the owner of the trademark right, together with those specific means univocally devoted to their manufacture, or, under certain circumstances, their seizure at the infringing party's expense; the publication of the Court decision; the award of damages (which may also be determined in separate Court proceedings). Recovery of damages becomes statute barred within five years from the date of the infringement. In assessing the damages, the Court must also evaluate lost revenues, the profits made by the infringement activity as well as the possible moral damages. At the request of the interested party, damages may be awarded in a lump sum on the basis of the records of the judicial proceedings and of the deriving presumptions. In this case, the amount to be considered should at least be equal to the royalties due, had a license been granted.

The party who has provided serious evidence of the grounds of his/her claims and has identified documents, data or information in the possession of the other party in support of such evidence, may request the Court to order that said evidence be produced by, or that said information be requested from the other party; he/she may also request the Court to order that

the data that are necessary for the identification of the persons involved in the manufacture and distribution of the infringing goods or services be provided. The Court, after having heard the other party, when issuing these orders must take the appropriate measures to ensure the protection of confidential information.

Where the infringement can be qualified as a systematic counterfeiting of the plaintiff right, the Court may order the exhibition of bank, financial or commercial documentation of the defendant concerning the counterfeiting activity.

Prior to or during infringement proceedings, the trademark owner may request a preliminary injunction prohibiting the manufacture and trade of anything constituting an infringement of his/her trademark. The Court when ordering the preliminary injunction may set a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order. The trademark owner may also request that a judicial inspection (description) and/or seizure be ordered of some or all of the infringing goods as well as of the means used in their manufacture and of the proof of evidence concerning the alleged infringement. In the latter case, appropriate measures must be taken to ensure the protection of confidential information. Judicial inspection and seizure may also relate to goods belonging to parties other than the alleged infringer, if these goods are not for personal use and were manufactured, offered, imported, exported or put on the market by the party against whom the order was issued. Judicial inspection only, but not seizure, is possible in respect of goods exhibited at an official or officially recognized exhibition in Italy (or which are in transit to or from such exhibition). Judicial inspection and seizure are carried out by a Court official who may, if necessary, be assisted by one or more experts; said official may make use of technical means of investigations (including photographic means). The parties may be authorized to attend the judicial inspection or seizure and to be accompanied by technical assistants of their choice.

### *[3] Penal provisions*

Trademark infringement may be, under given conditions, sanctionable as a criminal offence.

### *[4] Enforcement and Customs*

EC Regulation No. 1383/2003 and EC Regulation No. 1891/2004, concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, are being applied in Italy. 'Parallel imported' goods, i.e., goods bearing a trademark with the consent of the right holder, or manufactured with the consent of the holder of a patent, utility model, design, are excluded from the application of the Regulations, even if they are introduced, exported, re-exported, etc. without the right holder's consent.

The application to the customs authorities to suspend the release of the goods and detain them if suspected to infringe an intellectual property right can be lodged by the right holder or any person authorized to use the industrial property right or an authorized representative. The application is to be accompanied by a declaration of the right holder, accepting liability towards third parties involved in the introduction of the allegedly infringing products in the event the procedure initiated be discontinued due to an act or omission of the right holder or if the goods are subsequently found not to infringe the industrial property right. In the declaration the right holder undertakes to bear all costs incurred in keeping the goods under Customs' control.

#### Procedure 'ex officio'

When Customs have grounds for suspecting that goods might infringe an industrial property right, although no application has been filed, they may suspend the release of the goods or detain them, informing the right holder who is given three working days to submit an application requiring the Customs to take action. In the negative, the goods will be released. If the application is lodged, the ordinary procedure will be followed.

#### Procedure following an application

Once Customs find goods suspected of infringing an industrial property right they suspend the release of the goods and detain them. They then inform the right holder about their intervention and may inform it about the names and addresses of the consignee, the consignor, the origin and provenience of the goods. The right holder subsequently has the opportunity to inspect the goods, also by means of digital photos provided for by the Customs. The suspension of the release of goods may last ten working days (extendible to twenty). If within such a term Customs have not been notified that proceedings to determine the infringement have been initiated, they release the goods. Customs usually require a declaration from the right holder that the goods are indeed infringing the industrial property rights. The law in force in the Member State where the goods are delivered shall apply when deciding whether an industrial property right has been infringed.

#### Penal proceedings

Since infringement of an industrial property right may also fall under criminal law, once confirmed with the cooperation of the right holder that the goods infringe the industrial property right, Customs inform the competent criminal judicial authority. Although scarcely applied, goods violating industrial property rights, which are seized by the Customs, can be destroyed (with the judicial authority authorization) after three months from the date of the seizure save the retention of samples to be used as evidence for judicial purposes. The Penal Code provides for destruction (with the judicial authority authorization) of counterfeited goods if it is difficult or burdensome to store them or (with communications to the judicial authority) of counterfeited goods for which it is impossible to locate the responsible party.

### **[O] Well-known and Reputed Marks**

A registered trademark enjoying a reputation in Italy is protected against use without the consent of its owner of a third party's identical or similar trademark in respect of goods or services not identical or similar to those for which the reputed trademark is registered, if the use of the later trademark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark. The same provision applies to well-known trademarks under Article *6bis* of the Paris Convention.

### **[P] Trademarks and Trade Names**

Adoption of a trade name, denomination or company name, or of a signboard identical with or similar to another party's earlier trademark is not allowed if, because of the identity or similarity between the business activities of their owners and the goods or services covered by the earlier trademark, a likelihood of confusion may arise on the part of the public, which may also consist of a likelihood of association. Furthermore, adoption of a trade name, denomination or company name, or of a signboard identical with or similar to another party's earlier registered trademark is not allowed even if the earlier registered trademark covers non-similar goods or services, if it enjoys a reputation in Italy and the use without due cause of the later trade name, denomination or company name, or of the later signboard would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.

### **[Q] Trademarks and Domain Names**

The 'Registro del ccTLD "it"' (www.nic.it) is responsible for the registration and management of domain names in Italy under the country code top-level domain '.it', as well as for dispute resolutions in respect of ccTLD 'it' domain names. Domain names under the ccTLD 'it' may be applied for and registered only by natural or legal persons who are nationals of, or reside

or have a registered office in, a European Union member country. Ownership of a trademark application or registration in Italy or with effect in Italy is not required for acquiring a domain name registration. Registration is made on a first-come first-served basis. The duration of the domain registration is one year, renewable for further one-year periods.

Adoption of the domain name of a site used in the economic activity identical with or similar to another party's earlier trademark is not allowed if, because of the identity or similarity between the business activity of its owner and the goods or services covered by the trademark, a likelihood of confusion may arise on the part of the public, which may also consist of a likelihood of association. Furthermore, adoption of the domain name of a site used in the economic activity identical with or similar to another party's earlier registered trademark is not allowed even if the earlier registered trademark covers non-similar goods or services, if it enjoys a reputation in Italy and the use without due cause of the later domain name would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.

Conflicts between a domain name and an earlier trademark may be resolved by submitting them to the 'Registro del ccTLD "it"' and/or through Court proceedings.

### **[R] Trademarks and Appellations of Origin / Trademarks and Geographical Indications**

Geographical indications and appellations of origin which identify a country, a region or a locality are protected in general (and not only geographical indications and appellations of origin in the areas of agricultural products and food products) when they are adopted to designate a good originating from that country, region or locality and the quality, reputation or other characteristic of the good is exclusively or essentially attributable to its geographical origin. Use of a geographical indication and of an appellation of origin which may deceive the public or which takes unfair advantage of the repute of the protected appellation of origin is prohibited. It is likewise prohibited to use any means which in the designation or presentation of a good indicate or suggest that the good originates from a locality other than the true place of origin, or that the good has the quality of the goods originating from a locality designated by a geographical indication.

### **[S] Restoration**

Restoration can be obtained through two different ways, namely further processing and re-establishment of rights.

#### Further processing

If a party to proceedings before the Italian Patent and Trademark Office has failed to observe a term, he/she may, upon request and payment of a fee, obtain the continuation of proceedings, provided that at the time the request is made the non-accomplished act has been completed. The request for continuation of proceedings is to be presented within two months following the expiry of the non-observed term. Continuation of proceedings is not applicable to the non-observance of the following terms: terms for claiming priority and for filing the priority document; terms related to opposition proceedings; term for filing an appeal to the Board of Appeals; term for late renewal of the trademark registration within the six-month grace period; term for filing the request for re-establishment of rights.

#### Re-establishment of rights

If an applicant or trademark owner, in spite of all due care required by the circumstances taken, has not been able to observe a term, and the consequence thereof is the lapse of a right or the rejection of an application or request, he/she may be restored in his/her rights if due

care is proved. Within two months after the cause impeding the observance of the term has ceased, the non-accomplished act is to be completed and a request for restoration is to be filed stating the reasons for the non-observance and accompanied by the appropriate evidence. No restoration is possible after one year from the lapse of the non-observed term (in case of non-renewal, this one-year period runs from the last due date for the renewal, i.e., from the end of the six-month grace period within which the renewal can still be applied for with a fine; such fine is also due for restoration of the non-renewal). Against refusal of restoration, an appeal may be lodged with the Board of Appeals within sixty days from the date of the notice concerned.

Persons who, in the period between the lapse of a trademark registration or trademark application and the re-establishment of rights, have in good faith made serious and effective preparations for the use of the trademark, or have actually commenced such use, have the right to be refunded the costs they incurred.

Re-establishment of rights does not apply to the following terms: term for requesting the re-establishment of rights; term for dividing a trademark application and for filing divisional applications; opposition term. Failure to observe a priority term is restored under the above-mentioned conditions within two months after its expiration. The same provision applies in case of non-observance of the term for submitting the priority document.

#### **[T] Specific Aspects of Regional Trademark Registration**

Protection of trademarks in Italy may be obtained not only through a national registration or an international registration under the Madrid Agreement 1891–1967 or the Protocol of Madrid of 1989 designating Italy, but also through registration of an EU trademark under the European Union trademark system which is in operation as from 1 April 1996. Under this system, registration of EU trademarks (and of EU collective trademarks) effective in all European Union member countries, including Italy, may be obtained. Applications for registration of EU trademarks are to be filed (either directly or through the Italian Patent and Trademark Office) with the Office for Harmonization in the Internal Market (OHIM) at Alicante, Spain.

The owner of a trademark registered in Italy or of an international trademark registration designating Italy under the Madrid Agreement or Protocol, when applying for the registration of the same trademark as an EU trademark for the same goods or services (or for goods or services contained within those for which the trademark is registered in or with effect in Italy) may claim the seniority of the earlier trademark in respect of Italy. The effect of such seniority is that if the owner of the trademark after registration of the EU trademark surrenders the earlier national or international registration thereof or allows it to lapse or expire, he/she is deemed for the goods or services for which the EU trademark is registered to continue to have the same rights as he/she would have had if the earlier registration was still maintained. Seniority may also be claimed by the owner of a registered EU trademark who owns an earlier identical mark registered in or with effect in Italy for identical goods or services.

The EU trademark system exists in addition to the national systems of the European Union member countries, and in addition to the international registration systems under the Madrid Agreement and under the Madrid Protocol, and therefore does not replace those systems. For further details with regard to the EU trademark system, see the Chapter ‘European Union’.

#### **[U] Specific Aspects of International Trademark Registration**

Italy is a member of the Madrid Union for the international registration of trademarks, and it is a party to both the Madrid Agreement Concerning the International Registration of Marks 1891–1967, and the Madrid Protocol of 1989. Hence, parties having a real and effective industrial or commercial establishment in a country member of the Madrid Agreement or Protocol, other than Italy, or having their domicile in, or being national of such country may obtain trademark protection for Italy through an international trademark registration designating

Italy, which has the same effects in Italy as a national registration. The Italian Patent and Trademark Office may, however, refuse protection under such international registration for Italy if it finds that the requirements for registration in Italy are not met. The refusal of protection is to be notified by the Italian Office within one year from the date of the international registration or from the date of the extension of the international registration to Italy for international registrations under the Madrid Agreement and within eighteen months from the notification by the International Bureau of the extension of the international registration to Italy for international registrations under the Protocol. For international registrations under the Protocol, where a refusal of protection results from a third party's opposition to the granting of protection, such refusal may be notified even after the expiry of the eighteen-month time limit.

When the Italian Office receives from the International Bureau the notification of an international trademark registration designating Italy, it carries out the same examination as for national trademark applications and in case of objections it sends to the International Bureau a notice of provisional refusal stating the grounds. The owner of the international registration may then submit a response within the non-extendible term set in the notice of provisional refusal, and if this is found insufficient to remove the objections (or if no response is submitted) the Office issues a final refusal and the international registration does not have effect in Italy. The decision of the Office which is unfavourable for the applicant may be appealed to the Board of Appeals of the Italian Office. If an opposition is filed against the Italian designation of an international trademark registration, the Italian Patent and Trademark Office sends to the International Bureau a notice of provisional refusal setting a non-extendible term within which the owner of the international registration may request a copy of the opposition notice, failing which a final refusal is issued. Otherwise the opposition procedure is the same as for national trademark applications. In case of a provisional refusal resulting either from the Italian Patent and Trademark Office's examination or from a third party's opposition, the owner of the international trademark registration can deal with the Italian Patent and Trademark Office through a local professional representative only.

Legislative Decree No. 131 of 13 August 2010 has specified that the five-year term concerning the use requirement for international trademark registrations having effect in Italy runs alternatively as of one of the following: (a) the date on which the Italian Patent and Trademark Office has confirmed the protection in Italy after a provisional refusal has been issued; (b) the term as specified above within which that provisional refusal might have been issued, but was not issued.

As to international registrations of trademarks under the Madrid Agreement and/or under the Protocol of Madrid, see further Part II, 'Trademarks', 'Madrid Agreement'.

## [V] Fees

### [1] Table of official fees

Fees in Euros (EUR), as from 1 January 2006.

	EUR
Application for first registration of a trademark, including granting fee for 10 years in one class.....	101.00
Renewal of a trademark registration for 10 years in one class.....	67.00
Each additional class in addition to the first (for applications for first registration and for renewals of trademark registrations).....	34.00
Application for first registration of a collective trademark, including granting fee for 10 years (irrespective of the number of classes).....	337.00

Renewal of a collective trademark registration for 10 years (irrespective of the number of classes).....	202.00
Power of attorney fee.....	34.00
Fine for late renewal, during the 6-month grace period.....	34.00
Registering an assignment or license (for each trademark involved).....	81.00

Increased by fiscal registration fee: approximately 3% on the amount of the assignment or license consideration; if the consideration is up to EUR 5,600.00, a fixed registration fee of EUR 200.00 is levied.

Opposition fee.....	250.00
Appeal fee (for appeals with the Board of Appeals), basic fee.....	340.00
Continuation of proceedings fee.....	300.00
National fee for application for international registration (under Madrid Agreement and/or Protocol of Madrid).....	135.00

In addition to the above official fees, the following are due: EUR 40.00 for the fee to be paid for trademark applications and renewals to the receiving office of the Italian Patent and Trademark Office, i.e., the Chamber of Commerce, and EUR 10.00 for recording an assignment or license (EUR 15.00 for online trademark applications and renewals and EUR 5.00 for recording an assignment or license); EUR 16.00 for each stamp duty to be affixed to the application and to the accompanying papers (for online trademark applications and renewals stamp duties are paid in a lump sum of EUR 42.00; for online applications for recording an assignment or license stamp duties are paid in a lump sum of EUR 85.00); EUR 1.30 for postal fees for each payment.

### **[W] Transitional Provisions**

Nullity actions in respect of trademark registrations granted prior to 31 December 1992 may be brought only on the grounds provided for by the former law.

The provisions allowing a trademark registration to recover full validity in case of late genuine use of the trademark do not apply to trademark registrations lapsed for lack of use under the former law in force until 31 December 1992.

The provisions of the former law still apply to assignments and license agreements entered into before 31 December 1992.

### **[X] Specific Trademark Issues**

It is not allowed to use a trademark in a way contrary to the law, and in particular in such a way that a likelihood of confusion in the market may arise with other signs that are known as distinctive signs for third parties' undertakings, goods or services, or in such a way as to deceive the public, particularly as to the nature, quality or origin of the goods or services, because of the manner and context in which the trademark is used, or in such a way that a third party's copyright, industrial property right or another exclusive right is infringed.

Terms expiring on Saturdays, Sundays or official holidays are automatically extended to the next working day.

**[Y] Governmental Websites**

- [www.uibm.gov.it](http://www.uibm.gov.it) (Italian Patent and Trademark Office)
- [www.uibm.gov.it/uibm/dati/](http://www.uibm.gov.it/uibm/dati/) (trademarks database)

**PART 3 UTILITY MODELS****§3.01 SUMMARY****[A] Duration of Registration**

- 5 years from the filing date, extendible for a 5-year period.

**[B] Registrable / Not Registrable**

- Registrable are new and inventive conformations or shapes, arrangements, configurations, or combinations of parts, conferring a particular effectiveness or convenience of application or use to machines or to their parts, to instruments, tools, or implements. The level of inventiveness may be lower than that required for patents.

**[C] Novelty**

- Absolute novelty is required.

**[D] Requirements and Procedure**

- Filing languages: any
- Language of translation: Italian
- Time limit for filing translation: 2 months from the filing date
- A utility model patent is granted after formal examination of the application and examination as to registrability per se.

**[E] Governmental Websites**

- [www.uibm.gov.it](http://www.uibm.gov.it) (Italian Patent and Trademark Office)
- [www.uibm.gov.it/uibm/dati/](http://www.uibm.gov.it/uibm/dati/) (utility models database)

### §3.02 DETAILED INFORMATION

#### [A] Conventions and Legislation

##### [1] Conventions

- Paris Convention (International Union) 1883–1967 (the Stockholm text is in force in Italy as from 24 April 1977);
- The Hague Convention Abolishing the Requirement of Consular Legalization for Foreign Public Documents 1961;
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967;
- Patent Cooperation Treaty (PCT) 1970 (effective for Italy as from 28 March 1985);
- Strasbourg Agreement Concerning the International Patent Classification (IPC Union) 1971, with the reservation provided for in Article 4(4)(ii); and
- TRIPs – Trade-Related Aspects of Intellectual Property Rights 1994.

##### [2] Laws

- Industrial Property Code, enacted by Legislative Decree No. 30 of 10 February 2005 and entered into force on 19 March 2005, as amended up to and including Legislative Decree No. 131 of 13 August 2010 and Laws No. 14 of 24 February 2012 and No. 27 of 24 March 2012; and
- Industrial Property Code implementing rules, enacted by Decree of the Minister of Economic Development No. 33 of 13 January 2010, entered into force on 10 March 2010.

The Code consolidated and repealed the provisions of the previous national industrial property laws. After having undergone some amendments in 2006, 2007 and 2009, the Code was further amended by Legislative Decree No. 131 of 13 August 2010, entered into force on 2 September 2010. Further minor amendments were introduced by Laws No. 14 of 24 February 2012 and No. 27 of 24 March 2012. The amendments were mostly aimed at reinforcing industrial property rights, improving their enforcement before the Courts and streamlining the prosecution procedures before the Italian Patent and Trademark Office.

#### [B] Duration of Registration

Five years from the filing date, extendible for a five-year period, so that the maximum duration is ten years from the filing date.

#### [C] Requirements for Renewal

To maintain utility model patents, a maintenance fee for the second five-year period is due. The second five-year period maintenance fee is to be paid in advance at the expiry of the first five-year period within the end of the anniversary month of the filing date. If it becomes due while the application is still pending, it may also be paid subsequently within the end of the fourth month running from the grant date of the utility model patent. Term for late payment: six months provided a fine is paid. As to restoration of failure to pay the maintenance fee within the grace period, see ‘Restoration’.

**[D] Registrable / Not Registrable**

New models capable of conferring a particular effectiveness or convenience of application or use to machines or to their parts, to instruments, tools, or implements may be protected through a utility model, such as new models consisting of a particular conformation or shape, arrangement, configuration, or combination of parts. Therefore, pharmaceuticals, chemical products, methods or processes, computer-related inventions cannot be protected through a utility model.

The exceptions to patentability provided for patents of invention apply to utility models as well.

A utility model, in order to be registrable, must be new, involve an inventive activity, and be susceptible of industrial application.

A utility model is considered to involve an inventive activity if it is not obvious for a person skilled in the art in the relevant field. However, the level of inventiveness may be lower than that required for a patent of invention. A utility model is considered to be susceptible of use or application in industry, if its subject matter can be manufactured or used in any field of industry, including agriculture.

**[E] Novelty**

A utility model shall be considered to be new if it is not comprised in the state of the art. The state of the art comprises everything made available to the public anywhere in the world before the filing date of the Italian application (or, if priority is claimed, before the priority date), by oral or written description, by use, or by any other means (absolute novelty).

The state of the art, furthermore, comprises the contents of national Italian patent or utility model applications, or European patent applications designating Italy, as filed, which applications have a filing date or priority date preceding that of the Italian application, but which have been published or made available to the public on or after the filing date or priority date of the Italian application. Since patent protection in Italy can also be obtained through an international application filed under the PCT, the contents of an earlier PCT international application designating the European Patent Office for a patent with effect for Italy are also comprised in the state of the art, provided that the regional phase of such application before the European Patent Office is properly entered into and the European designation fee is timely paid. The contents of prior applications as meant here are only to be considered in determining the novelty of the utility model, but not in deciding whether the utility model implies inventive activity.

*[1] Grace period*

A prior disclosure of a utility model is not taken into account in considering its novelty if such disclosure occurred not more than six months prior to the date of filing of the application due to the direct or indirect consequences of an evident abuse in relation to the applicant or his/her legal predecessor, or due to the fact that the applicant or his/her legal predecessor displayed the utility model at an official or officially recognized international exhibition under the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928, and its later revisions.

**[F] Applicant**

A utility model application may be filed by whoever is entitled thereto. The right to the utility model belongs to the creator or to his/her successor in title (natural or legal person).

If an application is filed in the name of more than one person, said co-ownership is governed

by the provisions of the Italian Civil Code on co-ownership as long as they are applicable and unless there is a different agreement between the co-owners. If the right to the utility model belongs to two or more persons, the filing of the utility model application and the prosecution of the application before the Italian Patent and Trademark Office can be carried out by each of the co-owners in the interest of all the others, unless differently agreed upon by the parties.

It is presumed before the Italian Patent and Trademark Office that the applicant is entitled to the utility model.

Nationals of States which are parties to the Paris Convention or to the World Trade Organization (WTO) as well as nationals of States which are not parties to the Paris Convention or to the World Trade Organization but who are domiciled or who have a real and effective industrial or commercial establishment within the territory of a State which is party to the Paris Convention may apply for and obtain utility model patents to the same extent as nationals of Italy. Nationals of other States may apply for and obtain utility model patents in Italy provided their home country grants reciprocity to nationals of Italy.

If it is established by a final decision that the utility model belongs to another person than the one who filed the application, such other person has, within three months following such decision and provided that the utility model patent has not yet been granted, the following options:

- (a) to prosecute the utility model application in his/her own name, assuming for all purposes the quality of the applicant;
- (b) to file a new utility model application, which, provided its contents do not extend beyond those of the first application, shall be effective as of the filing date, or the priority date, of the original application, which shall in any case cease to produce effects; and
- (c) to cause the application to be refused.

If the utility model has already been granted to a person other than the one entitled to it, the latter may, at his/her discretion:

- (a) cause the utility model patent to be transferred to his/her name by a decision having retroactive effect; or
- (b) obtain that the utility model patent granted to a person not entitled to it is declared null and void.

After two years from the date of publication of the utility model grant, if the person entitled to the utility model has failed to exercise any of the rights provided for in the preceding paragraph, any interested person may claim the nullity of the utility model granted to a person not entitled to it.

A utility model made in the performance or fulfilment of a work or employment contract belongs to the employer, provided that the inventive activity by the employee is foreseen by the contract, and the activity is compensated accordingly. The creator is, however, entitled to be recognized as the author of the utility model. In case no compensation is provided for the inventive activity, the employer is still entitled to the utility model, but the creator is entitled, if the employer obtains a utility model patent or makes use of the utility model under secrecy, in addition to his/her right to be recognized as the author of the utility model, to a fair remuneration, to be determined taking into consideration the importance of the utility model, the duties performed by and the remuneration paid to the creator, as well as the contribution that the creator has received from the employer's organization.

In the absence of the above conditions, where the utility model made by an employee falls within the field of activity of the employer, the latter has an option right for the exclusive or non-exclusive use of the utility model or for purchasing the granted utility model patent, as well as for applying for or obtaining utility model patents in foreign countries. In such cases, the creator has the right to a royalty or a price, to be fixed after deduction of an amount equivalent to the value of the assistance that the creator might have received from the employer in developing the utility model. The option right by the employer in such cases is to be

exercised within three months from the receipt of the notice that the utility model application has been filed.

If in any of the above-mentioned cases no agreement is reached, the fair remuneration, royalty or price to be paid to the employee-creator is established by arbitration.

A utility model is still considered as having been made in the performance of a work or employment contract if the relevant patent is applied for within one year after the creator left the employment with the private undertaking or public administration in whose field of activity the utility model falls.

The Italian Law No. 383 of 18 October 2001 and later on the Industrial Property Code enacted in 2005 provide that, as an exception to the general rule, when the employer is a University or a research public organization or entity, the utility model belongs to the researcher/creator, who has the right to file a utility model application in his/her own name. The University or research entity has the right to receive part of the royalties received by the creator for the exploitation of his/her utility model by any third party. However, in the case of research which is wholly or partially financed by private natural or legal persons or which is carried out within a specific research project financed by public entities other than the University or the research organization employing the creator, the standard provisions relating to employer–employee relationship on utility models apply.

### **[G] Assignment**

The recordal of an assignment concerning a utility model patent or a utility model application requires:

- An application for recordal of the assignment.
- A notarized and legalized assignment deed or an assignment declaration simply signed by both the assignor and the assignee. The assignment deed or declaration must include full details of the transferred utility model application or granted utility model. The fiscal registration of the assignment is required before the assignment is recorded with the Italian Patent and Trademark Office and to this purpose the assignment consideration, if it is not provided for in the assignment deed or declaration, is to be stated. The fiscal registration of the assignment with the Italian Registry Office can be carried out directly by the local professional representative.
- A sworn translation of the assignment deed or declaration if drafted in another language than Italian.
- A power of attorney, signed by the party requesting the recordal of the assignment (usually the assignee, but also the assignor is entitled to apply for the recordal of the assignment), if the application is to be filed with the Italian Patent and Trademark Office by a local professional representative.

Since March 2005, the Italian Patent and Trademark Office also accepts instead of assignment deeds assignment declarations that do not require notarization/legalization and which only need to be signed by both parties and then registered with the competent fiscal authorities (i.e., the Italian Registry Office). Using the assignment declaration instead of the assignment deed among others allows saving the burden and costs of having an Italian notary public entering the assignment deed in his/her files.

Unrecorded assignments are valid between the parties but ineffective against third parties who in bona fide have lawfully acquired the rights in the utility model patent or utility model application.

**[H] Requirements for Filing***[1] Obligation to file first with national office*

A 2010 amendment to the Industrial Property Code provides that residents in Italy cannot file a first utility model application outside Italy if such first application concerns items which could be useful for the military defence of the country. In the latter case, a specific authorization for a first foreign filing is to be requested.

However, it is still unclear whether the applicant is allowed to take by himself/herself the decision whether the utility model could or could not be useful for the country's military defence. While waiting for an official position by the Italian authorities, it is suggested to proceed as in the past, i.e., either to file a first application in Italy (and after ninety days to proceed with the filing abroad), or to request the authorization to file directly abroad. Violation of these rules may be punished with a fine or with imprisonment (for not less than one year, if violation took place after the authorization was denied).

*[2] Minimum requirements for obtaining filing date*

In order to obtain a filing date, the utility model application shall contain: information identifying the applicant or allowing the applicant to be contacted; a description of the utility model or the reference to a previously filed application indicating its number, filing date, country and applicant.

Application fees must be paid before filing; evidence showing the payment of the prescribed fees is to be enclosed with the utility model application.

If the specification is filed in a language other than Italian, a translation must be filed within two months from the date of filing of the Italian utility model application. If the translation is not filed in due time, the application shall be deemed as not admissible.

*[3] Request for registration*

A request for registration must include the name, address and nationality of the applicant and of the professional representative, if any, contain the title of the utility model, and, if priority is claimed, the indication of the country, serial number and filing date of the first foreign application the priority of which is claimed.

*[4] Appointment of Representative*

Applicants residing or established abroad must elect an address for service in Italy, usually c/o a local professional representative, to whom communications by the Italian Patent and Trademark Office and deeds originating from Courts are served. It is recommended to maintain the address for service after the grant of the utility model patent during its whole life, as otherwise possible official communications would not be received.

Representation before the Italian Patent and Trademark Office may only take place through professional representatives admitted to practice before the Office or through attorneys-at-law.

*[5] Power of Attorney / Designation of creator / Other documents*

A power of attorney (*Lettera di Incarico*), not legalized, on standard form, is required to empower a local professional representative. The power of attorney may be filed within two months from the filing date of the application. An extension of time may be granted on request.

If the power of attorney is executed as a 'general power', it is also valid for all subsequent

applications for utility models, patents, trademarks, designs and models in the name of the same applicant.

The creator(s) must be designated and such a designation may be filed within two months from the filing date of the utility model application. An extension of time may be granted on request.

Rectification of the creator's designation (the correctness of which is not verified by the Italian Patent and Trademark Office) is possible only on request accompanied by a written approval of the previously designated person(s) and, if the request is not made by the applicant or patentee, accompanied by a written approval of the latter. Final Court decisions whereby the applicant or patentee is ordered to designate a third party as the creator, are recorded by the Italian Patent and Trademark Office if lodged by such third party.

#### *[6] Priority*

The right of priority with respect to a prior application filed within the previous twelve months in a State party of the Paris Convention for the Protection of Industrial Property, or of the World Trade Organization, is recognized.

The priority claim must refer to the application which is considered to be the first application under the international conventions. It must indicate the country, date and number of the basic foreign application.

If the priority has not been claimed on filing the subsequent utility model application, it can still be claimed within sixteen months from the filing date of the earliest priority. Within the same term, corrections of the priority claim details are admitted. As to possibilities for restoration of priority right, see 'Restoration'.

Multiple priorities may be claimed in one Italian application, provided there exists unity of invention (if the Italian Patent and Trademark Office considers that this is not the case, divisional applications, retaining the original filing date, may be filed).

Partial priorities are admissible.

As of 13 August 2009, an 'internal priority' may be claimed.

A certified non-legalized copy of the earlier applications must be filed within the non-extendible term of six months from the date of the Italian application or, alternatively sixteen months from the earlier application if the latter term is more favourable to the applicant. A certified Italian translation of the priority application is also required within six months from the application date or sixteen months from the earlier application.

If the application for a utility model in Italy is filed by a party other than the applicant of the first application the priority of which is claimed, a deed or declaration of assignment of the priority rights is required. There is no statutory term for its filing. The Italian Patent and Trademark Office could request said deed or declaration at any time during the prosecution of the application. It is, however, advisable that the deed or declaration be lodged within six months like the priority document. If the original applicant applies jointly with another party, or a foreign co-applicant applies alone, no assignment is required.

#### *[7] Allowable language(s) upon filing / Language(s) of procedure*

Description and claims may be filed in any language, provided that an Italian translation is filed within two months from the filing date. If the translation is not filed in due time, the application shall be deemed as not admissible. The request for registration, however, must be drafted in Italian.

All the documents drawn up in a foreign language, as well as their legalization, where required, are to be translated into Italian and the translation certified as true to the original by a qualified Italian professional representative or by a sworn translator.

*[8] Description*

The description is to be printed or type-written on sheets of white paper of international size A4, i.e., 21 cm × 29.7 cm, one and one-half spaced, in black, indelible colour, using typefaces, the capital letters of which should be 0.21 cm high. The minimum margins (top, bottom, left and right) to be observed are 2.5 cm.

The specification shall disclose the utility model in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

*[9] Claims*

The claims are to be printed or type-written on sheets of white paper of international size A4, i.e., 21 cm × 29.7 cm, one and one-half spaced, in black, indelible colour, using typefaces, the capital letters of which should be 0.21 cm high. The minimum margins (top, bottom, left and right) to be observed are 2.5 cm.

The following category of claims is allowed:

- Device (apparatus/product) claims.

An application may contain several independent claims, if they are linked by a single inventive concept (a special technical connection between all of them).

Multiple dependent claims are allowed.

*[10] Abstract*

The abstract is to be printed or type-written on a sheet of white paper of international size A4, i.e., 21 cm × 29.7 cm, one and one-half spaced, in black, indelible colour, using typefaces, the capital letters of which should be 0.21 cm high. The minimum margins (top, bottom, left and right) to be observed are 2.5 cm.

The specification must begin with an abstract serving for technical information purposes only.

*[11] Drawings*

To be executed in indelible black ink on strong white paper of good quality. The sheets of the drawings must be of international size A4, i.e., 21 cm × 29.7 cm; there must be a margin of 2.5 cm on all sides.

Text in the drawings is not allowed, with the exception of necessary indications and scale indication. The sheets of the drawings are to be numbered consecutively. The figures must be executed separate from each other, and in such way that the details remain clearly distinguishable also after photographic reproduction with a linear reduction in size to two-thirds. The separate figures must be numbered consecutively, independent from the numbering of the sheets. The numbers of the figures as well as the numbers and letters identifying the various parts must be referred to in the description. In case of a paper application, each sheet of the drawings is to be signed by the applicant or his/her professional representative.

*[12] Payment of fees*

Evidence showing the payment of the prescribed fees is to be enclosed with the utility model application.

**[I] Procedure***[1] Filing Authority*

The filing authority for utility models is the Italian Patent and Trademark Office (Ufficio Italiano Brevetti e Marchi), operating within the Ministry of the Economic Development (Ministero dello Sviluppo Economico), in Rome. The receiving office of the Italian Patent and Trademark Office is the Chamber of Commerce.

*[2] Online filing*

The application may be filed via the online system WebTelemaco (<http://webtelemaco.infocamere.it/>), managed by the association of the Italian Chambers of Commerce (InfoCamere). The filing documents must be prepared in .xml format (the application form) and in .pdf format (description, claims and drawings, power of attorney, priority documents, etc.). The signature is carried out electronically, via a special smart-card and the relevant hardware and software that can be obtained upon request from any Chamber of Commerce. The online filing involves reduced fees. The stamp duties are paid via a deposit account that can be established with the system.

*[3] Examination*

Applications are only examined as to formal requirements and as to whether the subject matter can be protected under a utility model and it cannot be considered against public policy or morality.

*[4] Amendments and corrections*

Amendments not adding subject matter to the contents of the application as originally filed are allowed; if said requirement is met, even new examples may be added. New matter added after filing is a ground for voiding the utility model.

*[5] Registration*

Utility model certificates are drawn up in one original and are progressively numbered in accordance with the date of grant. The originals of the certificates are gathered in the Utility Model Register. A certified true copy of the certificate is sent to the patentee or his/her professional representative.

*[6] Accelerated registration*

Despite the lack of any specific law provision for requesting an accelerated examination, it is a common practice of the Italian Patent and Trademark Office to proceed, on request, with an accelerated examination in case of Court actions being based on the utility model application concerned.

*[7] Opposition*

Not applicable in this jurisdiction.

*[8] Appeal*

Within sixty days after notification of the decision of the Italian Patent and Trademark Office totally or partially rejecting an application, the applicant may lodge an appeal. Appeals are decided by a special Board of Appeals which consists of a president, an associate president and eight members. The Board of Appeals hears the interested parties or their professional representatives. The decision of the Board of Appeals may be further appealed for reasons of law only before the Supreme Court.

*[9] Unity of creation / Divisional applications*

Each utility model application must refer to one invention only. If an application comprises more than one invention, the Italian Patent and Trademark Office may require that it be restricted to a single invention, and the applicant is entitled to file, within a term set forth by the Office, as many divisional applications as there are inventions left, each of these retaining the original filing (and priority, if any) date.

The division of a utility model application can also be requested by the applicant.

*[10] Branched-off applications*

Not applicable in this jurisdiction.

*[11] Conversion*

An application for a utility model containing subject matter which is qualified for protection by a patent of invention may be converted into an application for a patent of invention if from the contents of the application it is clear that a patent of invention should have been applied for. The Italian Patent and Trademark Office may request the applicant to convert his/her application accordingly during the examination procedure.

A patent application which contains subject matter which could be validly protected only by a utility model right may be converted on request by the Italian Patent and Trademark Office into an application for the grant of a utility model patent.

A rejected or withdrawn European patent application, the subject matter of which qualifies for protection by an Italian utility model, may be converted into an Italian utility model application. Requirements for conversion: conversion request, election of an address for service in Italy (if applicable), payment of the prescribed fee, translation into Italian of the application (if not yet in that language) and of the priority document (if any).

*[12] Publication / Public File Inspection*

Presently, no official publication is made.

Utility model applications are, however, made available and laid open to public inspection after eighteen months from the filing date or priority date where a Convention priority is claimed. The applicant when filing the utility model application may require that it be open to public inspection beforehand, i.e., ninety days after the filing date.

The main details of utility models and utility model applications can also be viewed at the online register of the Italian Patent and Trademark Office.

As soon as filed, all utility model applications are examined by an ad hoc department of the Ministry of Defence. Within ninety days from the date of filing of the utility model application, the Ministry of Defence can request the deferment of the grant procedure and impose a secrecy order so that any disclosure of the utility model applied for will be forbidden.

If an expropriation order is not issued within eight months, the grant procedure is regularly carried out. If instead a further deferment order is issued, the owner of the utility model application would receive an indemnity.

*[13] Withdrawal to prevent publication*

If an application is withdrawn before eighteen months from the filing or priority date or ninety days from the filing date if early publication has been requested, such withdrawal prevents the application from becoming open to public inspection.

**[J] Nullity and Lapse**

A utility model patent may be declared null and void (totally or partially) by a competent Court, in a nullity or counter-claim action, on any of the following grounds:

- (a) the utility model is not patentable because of lack of novelty or inventive step or industrial application and/or because it is contrary to public policy or morality;
- (b) the utility model is not described in a manner sufficiently clear and complete for enabling a person skilled in the art to carry it out;
- (c) the subject matter of the utility model patent extends beyond the content of the application as filed or the protection of the utility model patent has been extended; or
- (d) the patentee was not entitled to the utility model patent.

Nullity on any of the grounds mentioned under (a), (b) or (c) may be requested by any interested party. Nullity on the ground mentioned under (d) may be requested by the person being entitled to the utility model patent; should that person not have taken action after two years from the grant, any interested person may request the nullity of the utility model patent on this ground as well. The burden of proof of the nullity of a utility model patent is on the party claiming said nullity. A nullity action is to be brought before the competent Court. The Public Prosecutor may bring action ex officio on any of the grounds under (a), (b) or (c).

The declaration of nullity of a utility model patent has retroactive effect, but does not affect:

- (1) decisions in infringement proceedings which have become final and have been executed before the nullity final decision; and
- (2) agreements concerning the utility model concluded and executed before the nullity final decision; in the latter case, however, refund of payments made under such agreements may be ordered on equity grounds, and taking into consideration the circumstances.

Renunciation: A utility model owner may renounce his/her utility model. Such renunciation, however, has no effect if there are rights of third parties recorded under the utility model patent and the above renunciation took place without their prior written consent.

Limitation, as a kind of partial renunciation, is possible on request of the utility model owner, accompanied by the amended specification.

**[K] Use Requirement**

Utility model patents must be worked in Italy to an extent not seriously disproportionate to the needs of the State within three years from the date of grant or within four years from the filing date, whichever term expires later; thereafter the utility model patent may not remain non-worked for longer than three consecutive years. In case of non-working, the utility model patent becomes subject to the grant of compulsory licenses, unless the failure to work the utility model is due to causes beyond the control of the owner of the utility model patent; lack

of financial means or, if the product is widely circulated in foreign countries, lack of demand on the Italian market for the patented product, do not constitute grounds for excusing an insufficient working.

Following the amendment of the law which came into effect on 16 April 1996, not only the importation into or sale in Italy of goods manufactured in one of the other European Economic Area member countries constitutes working under the law, but also the importation into or sale in Italy of goods manufactured in any other WTO member country. Only importation into or sale in Italy of items manufactured in a State not being a WTO member country does not constitute relevant working.

Nominal working (by direct offers, advertisements and/or token sales) does not comply with the working requirements and is hardly of use.

Utility models shown for the first time at an official or officially recognized exhibition in Italy are considered to be worked as from the day they have been exhibited up to the closure of the exhibition, provided they have been exhibited for at least ten days or, in the case of an exhibition of a shorter duration, for the whole period thereof. However, this applies only to the first three-year period running from the date of grant of the utility model patent. The patented product itself must be exhibited; the mere display of drawings or photographs is not sufficient.

Under the compulsory license provisions, a utility model patent lapses owing to non-working or insufficient working only after expiry of a two-year period running from the date of grant of the first compulsory license. Consequently, if no compulsory license has been requested and granted, a non-worked utility model patent does not lapse.

### **[L] Marking**

Marking is advisable, but not compulsory. Possible marking: ‘Modello Utilità Brevettato’, or ‘Mod. Ut. Brev.’, which may also be followed by the utility model patent number, or ‘Modello utilità depositato’, or ‘Mod. Ut. Dep.’, which may also be followed by the utility model application number. False marking is punishable with a fine.

### **[M] Licenses**

Exclusive and non-exclusive contractual licenses under a granted utility model or a pending utility model application may be granted.

License agreements must be recorded with the Italian Patent and Trademark Office in order to be effective against third parties who in bona fide have lawfully acquired rights in the utility model patent or utility model application; the requirements for recordal are as in the case of assignments.

In case the foreign owner of an Italian utility model patent or utility model application grants a license under such utility model to an Italian licensee, the following may be mentioned. Payments from Italy to other countries need to comply with the applicable currency control provisions. For several payments, among which the payments under license agreements, Italian banks are authorized to effect remittances within certain limits, against submission of the documentation concerning the license agreement in question, and, if necessary for the calculation of the amounts due, of copies of the invoices relating to the sales of the products under license.

Non-exclusive compulsory licenses may be granted in the following cases:

- Non-working. A compulsory license may be granted if, on expiry of three years from the date of grant of the utility model or four years from the filing date of the application, whichever term expires later, the patented utility model has not been worked, by its owner or his/her successor in title or by one or more licensees, either by manufacturing within the Italian territory or by importation of items manufactured in a European

Economic Area Member State or in a State member of the World Trade Organization (WTO), or has been worked but to an extent which is seriously disproportionate to the needs of the State. Furthermore, a compulsory license may be granted if working of the utility model is interrupted or reduced to an extent which is seriously disproportionate to the needs of the State during more than three consecutive years. No compulsory license is granted if the failure to work or insufficient working is due to causes beyond the control of the owner of the utility model.

- Dependent utility models. The owner of a utility model which cannot be worked without prejudice to the rights originating from a utility model or patent of invention granted on the basis of an earlier application may obtain a compulsory license under the earlier utility model or patent of invention, but only to the extent necessary to work the later utility model, and provided that the later utility model, as compared with the subject matter of the earlier utility model or patent of invention, represents an important technical progress of considerable economic importance. The compulsory license may be assigned only together with the later utility model. The owner of the earlier utility model or patent of invention is entitled in turn to the grant of a compulsory license on reasonable conditions under the later utility model.

The applicant for a compulsory license in any of the above-mentioned cases must submit evidence showing that he/she has first addressed the owner of the utility model concerned but could not succeed in obtaining from him/her a contractual license on reasonable conditions. Compulsory licenses must always be granted against payment of an adequate consideration, and on condition that the party applying for its grant provides the necessary guarantees that the utility model will be worked satisfactorily in accordance with the conditions of the license. A compulsory license may be granted only if the working of the utility model is mainly intended to supply the domestic market. No compulsory license may be granted to an infringer of the utility model.

A petition for a compulsory license must be filed with the Italian Patent and Trademark Office. A compulsory license is granted by a decree issued by the Ministry of the Economic Development; in this decree, the scope, duration, manner of exploitation, guarantees and other conditions of the grant are determined, as well as the amount of the consideration and the payment conditions. The conditions of the license may, upon request by a party, be modified by decree of the same Ministry if there are valid reasons.

The term of a compulsory license may not exceed the remaining term of the utility model. A compulsory license may be transferred only together with the business of the grantee, or with the particular part of the business in which the license is used, except if the owner of the utility model would consent to another transfer. The grant of a compulsory license does not prevent the institution of legal proceedings relating to the validity of the utility model concerned or the rights deriving from that utility model, including actions instituted by the grantee of the license.

In case a voluntary license is granted by the owner of the utility model to a third party, on more favourable conditions than those of the compulsory license(s), the latter will be modified accordingly on request of the grantee(s) of the compulsory license(s). A compulsory license may be revoked by the Ministry of the Economic Development, if the conditions relating to the working of the utility model have not been complied with, or if the grantee of the license has not paid the consideration in the amount and way as prescribed. A compulsory license may furthermore be revoked by said Ministry if the circumstances leading to its grant no longer exist and it is unlikely that they will occur again. The grantee after revocation is allowed to work the utility model on the same conditions, within the limits of the prior use or within the limits that result from serious and real preparations.

Apart from the above general rules, in respect of utility models related to nuclear energy the Government may also grant non-exclusive compulsory licenses under Law No. 1860 of 31 December 1962.

License of right: As long as no exclusive license has been recorded with the Italian Patent and Trademark Office in respect of a utility model application or patent, the applicant or

patentee may (in the utility model application or in a written statement addressed to the Italian Patent and Trademark Office) offer to the public a non-exclusive license; such license is effective as from the notification of acceptance, and irrespective of whether any agreement has been reached on the remuneration. If no agreement on the remuneration is reached, the remuneration is determined by arbitration.

#### **[N] Pledge and Seizure**

Security interests in respect of granted utility models or pending utility model applications may be established and recorded with the Italian Patent and Trademark Office in order to be effective against third parties who have in bona fide lawfully acquired rights in the utility model patent or utility model application; the requirements for recordal are as in the case of assignments.

#### **[O] Infringement**

##### *[1] Infringing acts / Non-infringing acts*

Provided the utility model is granted, the legal effects of it run from the date on which the corresponding application has been made available to the public or as regards an alleged infringer, from such earlier date on which the application with the specification has been served upon him/her. The scope of protection conferred by a utility model patent is determined by the claims. However, the description and the drawings are used for interpreting the claims, so as to balance a fair protection for the utility model owner with a reasonable degree of legal certainty for third parties. The owner of a utility model has the exclusive right to work the utility model and to profit from it in the territory of Italy.

The manufacture, use, placing on the market, sale, or importation for any of these purposes of the patented product done within the territory of Italy by a third party without the consent of the owner of the utility model are considered as infringement.

The following acts are not considered as an infringement:

- (1) Use for personal and non-commercial purposes, and use of experimental character.
- (2) Any other use concerning products having been put on the market in the territory of Italy or in a member country of the European Economic Area by the owner of the utility model or with his/her consent.

##### *[2] Prior user rights*

A person having been using a utility model in his/her own undertaking within a twelve-month period preceding the filing (or the priority date) by a third party of an application concerning the same utility model, may continue to use it within the limits of such prior use. A right of prior use may only be transferred together with the undertaking in which the utility model is being used. The burden of proving the prior use rests with the prior user.

##### *[3] Remedies*

Infringement actions are to be brought as of 21 September 2012 before the specialized so-called business Courts (in the cities of Ancona, Bari, Bologna, Brescia, Cagliari, Campobasso, Catania, Catanzaro, Florence, Genoa, Milan, Naples, Palermo, Perugia, Potenza, Rome, Trento, Trieste, Turin and Venice). Previously, starting from 2003, infringement actions were brought before specialized industrial property Courts in twelve Italian cities. Such Courts have exclusive

jurisdiction for infringement actions concerning utility models, patents, plant varieties, industrial designs and models, trademarks, copyright and unfair competition related to industrial property rights. The specialized Court having jurisdiction over the case is the specialized Court having geographical jurisdiction over the domicile of the defendant, or if the defendant has no domicile in Italy, the specialized Court having geographical jurisdiction over the domicile of the plaintiff, or, if neither party has a domicile in Italy, the Court of Rome; infringement actions may also be brought before the specialized Court having geographical jurisdiction over the place where the allegedly infringing acts have taken place.

The Court, if it deems it necessary, appoints a technical expert, normally a patent attorney, to assist in evaluating technical aspects as to the possible nullity of the utility model or its infringement.

Measures which could be granted by the Court, prior to or during the infringement proceedings, or at the end of the proceedings, include:

- Injunction: the utility model owner may apply to the Court for an injunction prohibiting the manufacture, marketing and use of anything constituting an infringement of his/her utility model. The Court when ordering the injunction may set a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order.
- Judicial inspection or seizure: the owner of a utility model may request that a judicial inspection (description) and/or seizure be ordered of some or all of the infringing articles and of any means used in their manufacture, as well as of the proof evidence concerning the alleged infringement. In the latter case, appropriate measures are to be taken to ensure the protection of confidential information. Judicial inspection and seizure may also relate to articles belonging to parties other than the alleged infringer, if these articles are not for personal use and were manufactured, offered, imported, exported or put on the market by the party against whom the order was issued. Judicial inspection only, but not seizure, is possible in respect of goods exhibited at an official or officially recognized exhibition in Italy (or which are in transit to or from such exhibition). Judicial inspection and seizure are carried out by a Court official, who may, if necessary, be assisted by one or more experts; said official may make use of technical means of investigations (including photographic means). The parties may be authorized to attend the judicial inspection or seizure, and to be accompanied by technical assistants of their choice.

The Court may also decide that the infringing items and the means for their manufacture be transferred to the owner of the utility model, without prejudice to his/her right to award of damages. At the request of the owner of the items mentioned in the preceding sentence, and having regard to the remaining term of the utility model or to the particular circumstances of the case, the Court may also order the seizure of these items and of means of production until expiration of the utility model, at the infringing party's expense. In this case, the owner of the utility model may request that the seized items be assigned to him/her at a price to be established, in the absence of an agreement between the parties, by the judge appointed for the carrying out of the measure.

If a party has provided serious evidence of the grounds of his/her claims and has identified documents, data or information in the possession of the other party in support of such evidence, that party may request the Court to order that said evidence be produced or that said information be requested from the other party; that party may also request the Court to order that the data be provided that are necessary for the identification of the persons involved in the manufacture and distribution of the infringing products. The Court, after having heard the other party, when issuing these orders must take the appropriate measures to ensure the protection of confidential information.

Where the infringement can be qualified as a systematic counterfeiting of the plaintiff right, the Court may order the exhibition of bank, financial or commercial documentation of the defendant concerning the counterfeiting activity.

The Court may also award damages either in the infringement proceedings or in separate proceedings. An action to recover damages must be brought within five years from the date

of the infringement. In assessing the damages, the Court must also evaluate lost revenues, the profits made in the infringement activity as well as the possible moral damages. At the request of the interested party, damages may be awarded in a lump sum on the basis of the records of the judicial proceedings and of the presumptions which derive from them. In this case the amount to be considered should at least be equal to the royalties due had a license been granted.

The Court may order that the decision in an infringement proceeding be published, integrally or in summary form, in one or more newspapers as specified by it, at the expense of the losing party.

First Instance Court decisions are in principle provisionally enforceable.

#### *[4] Penal provisions*

Infringement may be, under given conditions, sanctionable as a criminal offence.

#### *[5] Enforcement and Customs*

EC Regulation No. 1383/2003 and EC Regulation No. 1891/2004, concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, are being applied in Italy. ‘Parallel imported’ goods, i.e., goods bearing a trademark with the consent of the right holder, or manufactured with the consent of the holder of a patent, utility model, design, are excluded from the application of the Regulations, even if they are introduced, exported, re-exported, etc. without the right holder’s consent.

The application to the customs authorities to suspend the release of the goods and detain them if suspected to infringe an intellectual property right can be lodged by the right holder or any person authorized to use the industrial property right or an authorized representative. The application is to be accompanied by a declaration of the right holder, accepting liability towards third parties involved in the introduction of the allegedly infringing products in the event the procedure initiated be discontinued due to an act or omission of the right holder or if the goods are subsequently found not to infringe the industrial property right. In the declaration, the right holder undertakes to bear all costs incurred in keeping the goods under Customs’ control.

#### Procedure ‘ex officio’

When Customs have grounds for suspecting that goods might infringe an industrial property right, although no application has been filed, they may suspend the release of the goods or detain them, informing the right holder who is given three working days to submit an application requiring the Customs to take action. In the negative, the goods will be released. If the application is lodged, the ordinary procedure will be followed.

#### Procedure following an application

Once Customs find goods suspected of infringing an industrial property right, they suspend the release of the goods and detain them. They then inform the right holder about their intervention and may inform it about the names and addresses of the consignee, the consignor, the origin and provenience of the goods. The right holder subsequently has the opportunity to inspect the goods, also by means of digital photos provided for by the Customs. The suspension of the release of goods may last ten working days (extendible to twenty). If within such a term Customs have not been notified that proceedings to determine the infringement have been initiated, they release the goods. Customs usually require a declaration from the right holder that the goods are indeed infringing the industrial property rights. The law in

force in the Member State where the goods are delivered shall apply when deciding whether an industrial property right has been infringed.

#### Penal proceedings

Since infringement of an industrial property right may also fall under criminal law, once confirmed with the cooperation of the right holder that the goods infringe the industrial property right, Customs inform the competent criminal judicial authority. Although scarcely applied, goods violating industrial property rights, which are seized by the Customs, can be destroyed (with the judicial authority authorization) after three months from the date of the seizure save the retention of samples to be used as evidence for judicial purposes. The Penal Code provides for destruction (with the judicial authority authorization) of counterfeited goods if it is difficult or burdensome to store them or (with communications to the judicial authority) of counterfeited goods for which it is impossible to locate the responsible party.

#### [P] Restoration

Restoration can be obtained through two different ways, namely further processing and re-establishment of rights.

##### Further processing

If a party to proceedings before the Italian Patent and Trademark Office has failed to observe a term, he/she may, upon request and payment of a fee, obtain the continuation of proceedings, provided that at the time the request is made the non-accomplished act has been completed. The request for continuation of proceedings is to be presented within two months following the expiry of the non-observed term. Continuation of proceedings is not applicable to the non-observance of the following terms: terms for claiming priority and for filing the priority document; term for filing an appeal to the Board of Appeals; term for completing a utility model application with missing documents or for filing the Italian translation of documents submitted in a foreign language; term for late payment of the maintenance fee for the second five-year period within the six-month grace period; term for filing the request for re-establishment of rights.

##### Re-establishment of rights

If an applicant or patentee, in spite of all due care required by the circumstances taken, has not been able to observe a term, and the consequence thereof is the lapse of a right or the rejection of an application or request, he/she may be restored in his/her rights if due care is proved. Within two months after the cause impeding the observance of the term has ceased, the non-accomplished act is to be completed and a request for restoration is to be filed stating the reasons for the non-observance and accompanied by the appropriate evidence. No restoration is possible after one year from the lapse of the non-observed term (in case of non-payment of the maintenance fee, this one-year period runs from the last due date for the payment of the fee concerned, i.e., from the end of the six-month grace period within which the maintenance fee can still be paid with a fine; such fine is also due for restoration of the non-paid maintenance fee). Against refusal of restoration, an appeal may be lodged with the Board of Appeals within sixty days from the date of the notice concerned.

Failure to observe a priority term is restored under the above-mentioned conditions within two months after its expiration. The same provision applies in case of non-observance of the term for submitting the priority document.

Persons who, in the period between the lapse of a utility model patent or utility model application and the re-establishment of rights, have in good faith made serious and effective preparations for the use of the utility model, or have actually commenced such use, have the right to use the utility model free within the limits of the prior use or within the limits that result from the preparations.

Re-establishment of rights does not apply to the following terms: term for requesting the re-establishment of rights; term for filing divisional applications.

**[Q] Utility Model Application Based on International Patent Application (PCT)**

It is not possible to apply for utility model protection in Italy through a PCT international application.

**[R] Fees***[1] Table of official fees*

Fees in Euros (EUR), as from April 2007.

	EUR
Filing fee for online utility model applications.....	50.00
Filing fee for utility model applications not filed online.....	120.00
Registering an assignment or license (for each utility model involved)....	50.00

Increased by fiscal registration fee: approximately 3% on the amount of the consideration; if the consideration is up to EUR 5,600.00, a fixed registration fee of EUR 200.00 is levied.

## Compulsory license:

– application fee.....	250.00
– granting fee.....	1,000.00
Appeal fee (for appeals with the Board of Appeals), basic fee.....	340.00
Continuation of proceedings fee.....	300.00

In addition to the above official fees, the following are due: EUR 40.00 for the fee to be paid for utility model applications not filed online to the receiving office of the Italian Patent and Trademark Office, i.e., the Chamber of Commerce, and EUR 10.00 for registering an assignment or license (EUR 15.00 for online utility model applications and EUR 5.00 for registering an assignment or license); EUR 16.00 for each stamp duty which is due (for online utility model applications stamp duties are paid in a lump sum of EUR 20.00); EUR 1.30 for postal fees for each payment.

Maintenance fee for second five-year period.....	500.00
Fine within six-month grace period.....	100.00
Postal fees.....	1.30

The maintenance fee may be paid prior to the time in which it becomes due; in case of increase of fees, supplemental payments must be made with respect to fees paid in advance at the old rates.

**[S] Transitional Provisions**

Not applicable in this jurisdiction.

**[T] Specific Utility Model Issues**

Expropriation is possible in the interest of the military defence of the State or for other reasons

of public utility and may also concern pending applications. Expropriation may be restricted to the right to use the utility model for the needs of the State.

Expropriation is granted by a decree of the President of the Republic which also sets forth the consideration on the basis of the market value of the utility model. If expropriation takes place in the interest of the military defence of the State and it concerns pending applications, it may also impose a secrecy obligation along with the relevant duration.

On filing an application for a patent, it is also possible to simultaneously file an application for a utility model relating to the same invention. The latter will come into consideration if the patent of invention is refused.

If because of its shape or pattern an item is eligible for design registration and also for protection as a utility model, simultaneous applications for a design registration and for a utility model patent may be filed by the same applicant. However, these two kinds of protection cannot be combined to a single protection right.

Terms expiring on Saturdays, Sundays or official holidays are automatically extended to the next working day.

#### **[U] Governmental Websites**

- [www.uibm.gov.it](http://www.uibm.gov.it) (Italian Patent and Trademark Office)
- [www.uibm.gov.it/uibm/dati/](http://www.uibm.gov.it/uibm/dati/) (utility models database)

## **PART 4 INDUSTRIAL DESIGNS AND MODELS**

### **§4.01 SUMMARY**

#### **[A] Duration of Registration**

- 5 years from the filing date, renewable in periods of 5 years up to a maximum of 25 years.

#### **[B] Registrable / Not Registrable**

- Registrable: designs and models which are new and have individual character.
- Registrable is the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of a product itself and/or its ornamentation.

#### **[C] Novelty**

- For the purpose of determining the novelty and individual character, a design will be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the filing or priority date, except where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union.
- A grace period of 12 months before the filing/priority date applies.

#### **[D] Procedure**

- A design is registered after examination as to registrability per se.

#### **[E] Governmental Websites**

- [www.uibm.gov.it](http://www.uibm.gov.it) (Italian Patent and Trademark Office)
- [www.uibm.gov.it/uibm/dati/](http://www.uibm.gov.it/uibm/dati/) (industrial designs and models database)

**§4.02 DETAILED INFORMATION****[A] Conventions and Legislation***[1] Conventions*

- Paris Convention (International Union) 1883–1967 (the Stockholm text is in force in Italy as from 24 April 1977);
- The Hague Agreement Concerning the International Registration of Industrial Designs (the Hague Act of 1960) (effective in Italy as of 13 June 1987); and Complementary Act of Stockholm of 14 July 1967 (effective in Italy as of 13 August 1987). Italy is bound neither by the London Act of 1934, nor by the Geneva Act of 1999. As of 1 January 2008, an international application under the Hague system can designate the European Union with effect in Italy;
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967;
- The Hague Convention Abolishing the Requirement of Consular Legalization for Foreign Public Documents 1961;
- Locarno Agreement Establishing an International Classification for Industrial Designs (Locarno Union) 1968;
- Vienna Agreement for the Protection of Type Faces 1973, with additional Protocol (signed, but not yet ratified and not yet in force);
- TRIPs – Trade-Related Aspects of Intellectual Property Rights 1994;
- EU Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community Designs, in force since 6 March 2002;
- EU Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights; and
- EU Directive 98/71/EC of 13 October 1998 on the legal protection of designs.

*[2] Laws*

- Industrial Property Code, enacted by Legislative Decree No. 30 of 10 February 2005 and entered into force on 19 March 2005, as amended up to and including Legislative Decree No. 131 of 13 August 2010 and Laws No. 14 of 24 February 2012 and No. 27 of 24 March 2012; and
- Industrial Property Code implementing rules, enacted by Decree of the Minister of Economic Development No. 33 of 13 January 2010, entered into force on 10 March 2010.

The Code consolidated and repealed the provisions of the previous national industrial property laws. After having undergone some amendments in 2006, 2007 and 2009, the Code was further amended by Legislative Decree No. 131 of 13 August 2010, entered into force on 2 September 2010. Further minor amendments were introduced by Laws No. 14 of 24 February 2012 and No. 27 of 24 March 2012. The amendments were mostly aimed at reinforcing industrial property rights, improving their enforcement before the Courts and streamlining the prosecution procedures before the Italian Patent and Trademark Office.

**[B] Duration of Registration**

Five years from the filing date of the design application, renewable for one or more periods of five years each up to the maximum duration of the registration of twenty-five years from the filing date of the application.

### **[C] Requirements for Renewal**

To maintain design registrations a fee for each five-year period is due, starting from the second one. The five-year maintenance fees are to be paid in advance at the expiry of the previous five-year period within the end of the anniversary month of the filing date. If the maintenance fee becomes due while the application is pending, it may be paid within the end of the fourth month running from the registration date. Term for late payment: six months, provided a fine is paid. As to restoration of failure to pay the maintenance fee within the grace period, see 'Restoration'.

### **[D] Registrable / Not Registrable**

A design is the appearance of the whole or a part of a product resulting from its features, in particular, from the lines, contours, colours, shape, texture and/or materials and/or its ornamentation. Product means any industrial or handicraft item, including, among others, parts intended to be assembled into a complex product provided they remain visible, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs. Complex products are products composed of multiple components which may be disassembled and reassembled.

In order to be registrable, a design must be new and have individual character.

A design is not registrable if:

- it does not comply with the definition of design;
- it lacks the novelty requirement;
- it lacks the individual character requirement; or
- it is contrary to public order or to morality.

No design registration may be obtained for those features of appearance of a product which are solely dictated by its technical function, or those features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function. However, a design is registrable if new and having individual character, when it serves the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.

A design is considered to have individual character if the overall impression that it produces on the informed user differs from the overall impression produced on such user by any design made available to the public before the filing date of the application for registration or, if priority is claimed, before the priority date. For the assessment of the individual character, the degree of freedom of the designer in developing the design is taken into consideration.

A design applied to or incorporated in a product which constitutes a component part of a complex product is considered to be new and to have individual character only if:

- (a) the component part, once it has been incorporated into the complex product, remains visible during normal use of that product by the end user thereof (whereby maintenance, servicing or repair work are not considered 'normal use'); and
- (b) the visible features of the component part in themselves meet the requirements of novelty and individual character.

### **[E] Novelty**

A design is considered to be new if, before the filing date of the application for its registration or, if priority is claimed, before the priority date, no identical design has been made available

to the public. Designs are considered identical if their characteristics differ in immaterial details only.

For the purpose of determining the novelty and individual character, a design is deemed to have been made available to the public if it has been made available to the public following registration or in another way, or exhibited, brought into trade or otherwise disclosed, before the filing or priority date, except where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the European Union, before the filing or priority date. A design is, however, not deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit condition of confidentiality.

*[1] Grace period*

A disclosure, for the purpose of applying the novelty and the individual character requirements, shall not be taken into consideration if:

- (a) the design, during the twelve months preceding the filing date or, if priority is claimed, during the twelve months preceding the priority date, has been made available to the public by the author or his/her successor in title, or by a third party as a result of information provided or action by the author or his/her successor in title; and
- (b) the design, during the twelve months preceding the filing date or, if priority is claimed, during the twelve months preceding the priority date, has been made available to the public as the direct or indirect consequence of an abuse in relation to the author or his/her successor in title.

With respect to design registrations granted on the grounds of the Italian law applicable until 19 April 2001, the disclosure of the design shall also not be taken into consideration if it took place in the six months preceding the filing (or priority) date, at an official or officially recognized exhibition held in Italy or held in a foreign country granting reciprocity to Italian nationals.

**[F] Applicant**

A design application can be filed by whoever is entitled thereto. The right to the design registration belongs to the author or to his/her successor in title (natural or legal person). In case the design is created by an employee in the performance of his/her duties, the employer is entitled to the registration, except otherwise agreed upon between the parties. However, the employee is entitled to be recognized as the author.

If an application is filed in the name of more than one person, said co-ownership is governed by the provisions of the Italian Civil Code on co-ownership as long as they are applicable and unless there is a different agreement between the co-owners. If the right to the design belongs to two or more persons, the filing of the design application and the prosecution of the application before the Italian Patent and Trademark Office can be carried out by each of the co-owners in the interest of all the others, unless differently agreed upon by the parties.

Nationals of States which are parties to the Paris Convention or to the World Trade Organization as well as nationals of States which are not parties to the Paris Convention or to the World Trade Organization but who are domiciled or who have a real and effective industrial or commercial establishment within the territory of a State which is party to the Paris Convention may apply for and obtain a design registration to the same extent as nationals of Italy. Nationals of other States may apply for and obtain a design registration in Italy provided their home country grants reciprocity to nationals of Italy.

If it is established by a final decision that the design belongs to another person than the one

who filed the application, such other person has, within three months following such decision and provided that the design has not yet been granted, the following options:

- (a) to prosecute the design application in his/her own name, assuming for all purposes the quality of the applicant;
- (b) to file a new design application, which, provided its contents do not extend beyond those of the first application, shall be effective as of the filing date, or the priority date, of the original application, which shall in any case cease to produce effects; and
- (c) to cause the application to be refused.

If the design has already been granted to a person other than the one entitled to it, the latter may, at his/her discretion:

- (a) cause the design to be transferred to his/her name by a decision having retroactive effect;  
or
- (b) obtain that the design registration granted to a person not entitled to it is declared null and void.

#### **[G] Assignment**

The recordal of an assignment concerning a design registration or a design application requires:

- An application for recordal of the assignment.
- A notarized and legalized assignment deed or an assignment declaration simply signed by both the assignor and the assignee. The assignment deed or declaration must include full details of the transferred design application or design registration. The fiscal registration of the assignment is required before the assignment is recorded with the Italian Patent and Trademark Office and to this purpose the assignment consideration, if it is not provided for in the assignment deed or declaration, is to be stated. The fiscal registration of the assignment with the Italian Registry Office can be carried out directly by the local professional representative.
- A sworn translation of the assignment deed or declaration if drafted in another language than Italian.
- A power of attorney, signed by the party requesting the recordal of the assignment (usually the assignee, but also the assignor is entitled to apply for the recordal of the assignment), if the application is to be filed with the Italian Patent and Trademark Office by a local professional representative.

Since March 2005, the Italian Patent and Trademark Office also accepts instead of assignment deeds assignment declarations that do not require notarization/legalization and which only need to be signed by both parties and then registered with the competent fiscal authorities (i.e., the Italian Registry Office). Using the assignment declaration instead of the assignment deed among others allows saving the burden and costs of having an Italian notary public entering the assignment deed in his/her files.

Unrecorded assignments are valid between the parties but ineffective against third parties who in bona fide have lawfully acquired the rights in the design registration or design application.

**[H] Requirements for Filing***[1] Request for registration*

A design application must identify the applicant, indicate the title of the design and include the drawings. It may also include a description.

The application fees must be paid before filing; evidence showing the payment of the prescribed fees is to be enclosed with the design application.

*[2] Appointment of Representative*

Applicants residing or established abroad must elect an address for service in Italy, usually c/o a local professional representative, to whom communications by the Italian Patent and Trademark Office and deeds originating from Courts are served. It is recommended to maintain the address for service after the grant of the design registration during its whole life, as otherwise possible official communications would not be received.

Representation before the Italian Patent and Trademark Office may only take place through professional representatives admitted to practice before the Office or through attorneys-at-law.

*[3] Power of Attorney*

A power of attorney (*Lettera di Incarico*), not legalized, on standard form, is required to empower a local professional representative. The power of attorney may be filed within two months from the filing date of the application. An extension of time may be granted on request.

If the power of attorney is executed as a ‘general power’, it is also valid for all subsequent applications for designs and models, patents, trademarks and utility models in the name of the same applicant.

*[4] Priority*

The right of priority with respect to a prior design application filed within the previous six months in a State party of the Paris Convention for the Protection of Industrial Property, or of the World Trade Organization, is recognized.

The priority claim must refer to the design application which is considered to be the first application under the international conventions. It must indicate the country, date and number of the basic foreign application.

If the priority has not been claimed on filing the subsequent design application, it can still be claimed within one month from the subsequent design application date. As to the possibilities of restoration of the priority term, see ‘Restoration’.

A certified non-legalized copy of the earlier applications must be filed within the non-extendible term of six months from the date of the Italian application. An Italian translation of the priority application is also required.

If the application for a design in Italy is filed by a party other than the applicant of the first design application the priority of which is claimed, a deed or declaration of assignment of the priority rights is required. There is no statutory term for its filing. The Italian Patent and Trademark Office could request said deed or declaration at any time during the prosecution of the application. It is, however, advisable that the deed or declaration be lodged within six months like the priority document. If the original applicant applies jointly with another party, or a foreign co-applicant applies alone, no assignment is required.

*[5] Description*

A description may be filed, if useful for the better understanding of the design.

*[6] Graphical representations*

A drawing or drawings or photographs of the design or of the product or products to which the design applies, or a sample of the product in the case of ‘two-dimension articles’ (such as fabrics), must be filed; the reproductions must be in colours, if the colours constitute a characteristic feature. Where representations are filed, they should be of a size of 21 cm × 29.7 cm, with a free margin of 2.5 cm on each side; in the case of photographs they may be of smaller size and are then to be pasted on sheets of the required size.

*[7] Multiple deposits*

An unlimited number of designs may be included in one application, provided that they all belong to the same class of the International Classification under the Locarno Agreement. A fixed fee is payable irrespective of the number of designs included in the application.

If a multiple application includes designs that do not belong to the same class of the International Classification under the Locarno Agreement, the Office requires the applicant, setting a time limit, to limit the application, allowing him/her to present, for the remaining designs, new independent applications the effects of which run from the filing date of the basic application.

A multiple design registration can be limited, upon request of the owner, to one or more of the designs originally filed. If only one design is maintained, the applicable renewal fee will be the one established for a single registration instead of the one established for a multiple design registration.

**[I] Procedure**

*[1] Filing Authority*

The registration authority is the Italian Patent and Trademark Office (Ufficio Italiano Brevetti e Marchi), operating within the Ministry of the Economic Development (Ministero dello Sviluppo Economico), in Rome. The receiving office of the Italian Patent and Trademark Office is the Chamber of Commerce.

*[2] Online filing*

The application may be filed also via the online system WebTelemaco (<http://webtelemaco.infocamere.it/>), managed by the association of the Italian Chambers of Commerce (InfoCamere). The filing documents must be prepared in .xml format (the application form) and in .pdf format (description and drawings, power of attorney, priority documents, etc.). The signature is carried out electronically, via a special smart-card and the relevant hardware and software that can be obtained upon request from any Chamber of Commerce. The online filing involves reduced fees. The stamp duties are paid via a deposit account that can be established with the system.

*[3] Classification*

Locarno Agreement Establishing an International Classification for Industrial Designs.

*[4] Search*

Not applicable in this jurisdiction.

*[5] Examination*

The examination carried out by the Italian Patent and Trademark Office is only directed to ascertain whether the design falls into the definition of registrable designs and it cannot be considered against the public order and/or morality.

*[6] Registration*

Unless the application is rejected, a certificate of registration is issued by the Italian Patent and Trademark Office at the end of the examination procedure. No grant fees are due.

*[7] Opposition*

Not applicable in this jurisdiction.

*[8] Appeal*

On rejection of an application, an appeal to the Board of Appeals may be lodged within sixty days after notification of the relevant decision taken by the Italian Patent and Trademark Office, and the decision of the Board of Appeals may be further appealed, for reasons of law only, before the Supreme Court.

*[9] Publication / Deferred Publication / Public File Inspection*

Design applications are made available immediately after filing, unless the applicant, on filing, requests a postponement of their availability to public inspection for maximum thirty months from the filing date or, if priority is claimed, from the priority date. However, no official publication takes place.

The main details of designs and design applications can also be viewed at the online register of the Italian Patent and Trademark Office.

**[J] Nullity and Lapse**

The registration of a design may be declared null and void by a competent Court upon request by an interested party, in a nullity or counter-claim action, on any of the following grounds:

- (a) the design does not qualify as a design;
- (b) the design does not fulfil the novelty or the individual character requirements;
- (c) the design is contrary to public order or morality;

- (d) the owner of the registration of the design is not entitled to the registration, and the party actually entitled has not requested that the registration is placed in his/her name;
- (e) the design conflicts with third parties' rights to an earlier design which has been made available to the public after the filing date of the application for registration or (if priority is claimed) after the priority date, and which is protected from a date prior to said date by a registration for an EU design or an Italian design, or an international design registration designating Italy or by an application for the above rights;
- (f) the use of the design infringes a third party's copyright or a third party's right to a distinctive sign; and
- (g) the design constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention or of symbolic signs, flags or escutcheons not covered by that Article but which are of particular public interest in Italy.

Nullity on the grounds mentioned under (e) and (f) may be invoked only by the holder of the conflicting right; nullity on the ground mentioned under (g) may be requested only by the person concerned by the use. The Public Prosecutor may ex officio bring a nullity action on grounds different from those under (d), (e), (f) and (g) mentioned above.

#### **[K] Use Requirement**

Working is not compulsory.

#### **[L] Marking**

Marking is advisable, but not compulsory. Possible marking: 'Modello registrato', or 'Mod. reg.', which may also be followed by the design registration number, or 'Modello depositato', or 'Mod. dep.', which may also be followed by the design application number. False marking is punishable with a fine.

#### **[M] Licenses**

Exclusive and non-exclusive contractual licenses under a design registration or a pending design application may be granted.

License agreements must be recorded with the Italian Patent and Trademark Office in order to be effective against third parties who in bona fide have lawfully acquired rights in the design registration or design application; the requirements for recordal are as in the case of assignments.

In case the foreign owner of an Italian design registration or design application grants a license under such design to an Italian licensee, the following may be mentioned. Payments from Italy to other countries need to comply with the applicable currency control provisions. For several payments, among which the payments under license agreements, Italian banks are authorized to effect remittances within certain limits, against submission of the documentation concerning the license agreement in question, and, if necessary for the calculation of the amounts due, of copies of the invoices relating to the sales of the products under license.

License of right: As long as no exclusive license has been recorded with the Italian Patent and Trademark Office in respect of a creation being the subject of a design application or a registered design, the applicant or owner may (in the design application or in a written statement addressed to the Italian Patent and Trademark Office) offer to the public a non-exclusive license; such license is effective as from the notification of acceptance, and irrespective whether any agreement has been reached on the remuneration. If no agreement on the remuneration is reached, the remuneration is determined by arbitration.

Compulsory licenses are not provided for.

### **[N] Pledge and Seizure**

Security interests in respect of designs registrations or pending design applications may be established and recorded with the Italian Patent and Trademark Office in order to be effective against third parties who have in bona fide lawfully acquired rights in the design registration or design application; the requirements for recordal are as in the case of assignments.

### **[O] Infringement**

#### *[1] Infringing acts / Non-infringing acts*

The registration of a design confers on its owner the exclusive right to use the design and to prevent any third party not having his/her consent from using it. However, provided the design registration is granted, the legal effects of the registration run from the date on which the corresponding application is laid open to public inspection or, as regards an alleged infringer, from such earlier date on which the application has been served upon him/her. In assessing the scope of protection, the degree of freedom of the designer in developing his/her design is taken into consideration.

In particular, the following acts done without the consent of the owner of a registered design are considered infringement: manufacturing, offering, putting on the market, importing, exporting or using a product in which the design, or a design which does not produce on the informed user a different overall impression, is incorporated or to which it is applied, or stocking such a product for those purposes.

The following acts are not considered infringement:

- Acts done privately and for non-commercial purposes.
- Acts done for experimental purposes.
- Acts of reproduction for citation or teaching purposes, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and provided further that mention is made of the source.
- Acts done in relation to a product in which a design protected by registration is incorporated or to which it has been applied, after the product has been put on the market in the European Economic Area by the owner of the design right or with his/her consent.

The rights conferred by a design cannot be exercised in respect of the equipment on ships and aircraft registered in other countries and temporarily entering in Italy, as well as in respect of their repairs and spare parts necessary to effect such repairs.

#### *[2] Prior user rights*

Not applicable in this jurisdiction.

#### *[3] Remedies*

Infringement actions are to be brought as of 21 September 2012 before the specialized so-called business Courts (in the cities of Ancona, Bari, Bologna, Brescia, Cagliari, Campobasso, Catania, Catanzaro, Florence, Genoa, Milan, Naples, Palermo, Perugia, Potenza, Rome, Trento, Trieste, Turin and Venice). Previously, starting from 2003, infringement actions were brought before specialized industrial property Courts in twelve Italian cities. Such Courts have exclusive

jurisdiction for infringement actions concerning patents, plant varieties, utility models, industrial designs and models, trademarks, copyright and unfair competition related to industrial property rights. The specialized Court having jurisdiction over the case is the specialized Court having geographical jurisdiction over the domicile of the defendant, or if the defendant has no domicile in Italy, the specialized Court having geographical jurisdiction over the domicile of the plaintiff, or, if neither party has a domicile in Italy, the Court of Rome; infringement actions may also be brought before the specialized Court having geographical jurisdiction over the place where the allegedly infringing acts have taken place.

Measures which could be granted by the Court, prior to or during the infringement proceedings, or at the end of the proceedings, include:

- Injunction: the design owner may apply to the Court for an injunction prohibiting the manufacture, marketing and use of anything constituting an infringement of his/her design. The Court when ordering the injunction may set a penalty for any subsequent infringement or non-compliance or delay in the compliance with the injunction order.
- Judicial inspection or seizure: the owner of a design may request that a judicial inspection (description) and/or seizure be ordered of some or all of the infringing articles and of any means used in their manufacture, as well as of the proof evidence concerning the alleged infringement. In the latter case, appropriate measures are to be taken to ensure the protection of confidential information. Judicial inspection and seizure may also relate to articles belonging to parties other than the alleged infringer if these articles are not for personal use and were manufactured, offered, imported, exported or put on the market by the party against whom the order was issued. Judicial inspection only, but not seizure, is possible in respect of goods exhibited at an official or officially recognized exhibition in Italy (or which are in transit to or from such exhibition). Judicial inspection and seizure are carried out by a Court official, who may, if necessary, be assisted by one or more experts; said official may make use of technical means of investigations (including photographic means). The parties may be authorized to attend the judicial inspection or seizure, and to be accompanied by technical assistants of their choice.

The Court may also decide that the infringing items and the means for their manufacture be transferred to the owner of the design, without prejudice to his/her right to award of damages. At the request of the owner of the items mentioned in the preceding sentence, and having regard to the remaining term of the design or to the particular circumstances of the case, the Court may also order the seizure of these items and of means of production until expiration of the design, at the infringing party's expense. In this case, the owner of the design may request that the seized items be assigned to him/her at a price to be established, in the absence of an agreement between the parties, by the judge appointed for the carrying out of the measure.

If a party has provided serious evidence of the grounds of his/her claims and has identified documents, data or information in the possession of the other party in support of such evidence, that party may request the Court to order that said evidence be produced or that said information be requested from the other party; that party may also request the Court to order that the data be provided that are necessary for the identification of the persons involved in the manufacture and distribution of the infringing products. The Court, after having heard the other party, when issuing these orders must take the appropriate measures to ensure the protection of confidential information.

Where the infringement can be qualified as a systematic counterfeiting of the plaintiff right, the Court may order the exhibition of bank, financial or commercial documentation of the defendant concerning the counterfeiting activity.

The Court may also award damages either in the infringement proceedings or in separate proceedings. An action to recover damages must be brought within five years from the date of the infringement. In assessing the damages, the Court must also evaluate lost revenues, the profits made in the infringement activity as well as the possible moral damages. At the request of the interested party, damages may be awarded in a lump sum on the basis of the records

of the judicial proceedings and of the presumptions which derive from them. In this case, the amount to be considered should at least be equal to the royalties due had a license been granted.

The Court may order that the decision in an infringement proceeding be published, integrally or in summary form, in one or more newspapers as specified by it, at the expense of the losing party.

First Instance Court decisions are in principle provisionally enforceable.

#### *[4] Penal provisions*

Design infringement may be, under given conditions, sanctionable as a criminal offence.

#### *[5] Enforcement and Customs*

EC Regulation No. 1383/2003 and EC Regulation No. 1891/2004, concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, are being applied in Italy. ‘Parallel imported’ goods, i.e., goods bearing a trademark with the consent of the right holder, or manufactured with the consent of the holder of a patent, utility model, design, are excluded from the application of the Regulations, even if they are introduced, exported, re-exported, etc. without the right holder’s consent.

The application to the customs authorities to suspend the release of the goods and detain them if suspected to infringe an intellectual property right can be lodged by the right holder or any person authorized to use the industrial property right or an authorized representative. The application is to be accompanied by a declaration of the right holder, accepting liability towards third parties involved in the introduction of the allegedly infringing products in the event the procedure initiated be discontinued due to an act or omission of the right holder or if the goods are subsequently found not to infringe the industrial property right. In the declaration the right holder undertakes to bear all costs incurred in keeping the goods under Customs’ control.

#### Procedure ‘ex officio’

When Customs have grounds for suspecting that goods might infringe an industrial property right, although no application has been filed, they may suspend the release of the goods or detain them, informing the right holder who is given three working days to submit an application requiring the Customs to take action. In the negative, the goods will be released. If the application is lodged, the ordinary procedure will be followed.

#### Procedure following an application

Once Customs find goods suspected of infringing an industrial property right they suspend the release of the goods and detain them. They then inform the right holder about their intervention and may inform it about the names and addresses of the consignee, the consignor, the origin and provenience of the goods. The right holder subsequently has the opportunity to inspect the goods, also by means of digital photos provided for by the Customs. The suspension of the release of goods may last ten working days (extendible to twenty). If within such a term Customs have not been notified that proceedings to determine the infringement have been initiated, they release the goods. Customs usually require a declaration from the right holder that the goods are indeed infringing the industrial property rights. The law in force in the Member State where the goods are delivered shall apply when deciding whether an industrial property right has been infringed.

#### Penal proceedings

Since infringement of an industrial property right may also fall under criminal law, once confirmed with the cooperation of the right holder that the goods infringe the industrial property right, Customs inform the competent criminal judicial authority. Although scarcely applied, goods violating industrial property rights, which are seized by the Customs, can be destroyed (with the judicial authority authorization) after three months from the date of the seizure save the retention of samples to be used as evidence for judicial purposes. The Penal Code provides for destruction (with the judicial authority authorization) of counterfeited goods if it is difficult or burdensome to store them or (with communications to the judicial authority) of counterfeited goods for which it is impossible to locate the responsible party.

### **[P] Restoration**

Restoration can be obtained through two different ways, namely further processing and re-establishment of rights.

#### Further processing

If a party to proceedings before the Italian Patent and Trademark Office has failed to observe a term, he/she may, upon request and payment of a fee, obtain the continuation of proceedings, provided that at the time the request is made the non-accomplished act has been completed. The request for continuation of proceedings is to be presented within two months following the expiry of the non-observed term. Continuation of proceedings is not applicable to the non-observance of the following terms: terms for claiming priority and for filing the priority document; term for filing an appeal to the Board of Appeals; term for completing a design application with missing documents or for filing the Italian translation of documents submitted in a foreign language; term for late payment of the five-year maintenance fees within the six-month grace period; term for filing the request for re-establishment of rights.

#### Re-establishment of rights

If an applicant or registrant, in spite of all due care required by the circumstances taken, has not been able to observe a term, and the consequence thereof is the lapse of a right or the rejection of an application or request, he/she may be restored in his/her rights if due care is proved. Within two months after the cause impeding the observance of the term has ceased, the non-accomplished act is to be completed and a request for restoration be filed stating the reasons for the non-observance and accompanied by the appropriate evidence. No restoration is possible after one year from the lapse of the non-observed term (in case of non-payment of a maintenance fee, this one-year period runs from the last due date for the payment of the fee concerned, i.e., from the end of the six-month grace period within which the maintenance fee can still be paid with a fine; such fine is also due for restoration of the non-paid maintenance fee). Against refusal of restoration an appeal may be lodged with the Board of Appeals within sixty days from the date of the notice concerned.

Failure to observe a priority term is restored under the above-mentioned conditions within two months after its expiration. The same provision applies in case of non-observance of the term for submitting the priority document.

Persons who, in the period between the lapse of a design registration or design application and the re-establishment of rights, have in good faith made serious and effective preparations for the use of the creation, or have actually commenced such use, have the right to use the creation free within the limits of the prior use or within the limits that result from the preparations.

Re-establishment of rights does not apply to the term for requesting the re-establishment of rights.

### **[Q] Specific Aspects of Regional Design Registration**

A design can be protected in Italy through an EU design registration under the European

Union design protection system. In addition, the protection offered by the unregistered EU design, for a period of three years from the date on which the design is first made available to the public within the European Union, applies. An EU design (whether registered or unregistered) extends to all European Union member countries.

### **[R] Specific Aspects of International Design Registration**

Italy has ratified the Hague Act of 1960 of the Hague Agreement Concerning the International Registration of Industrial Designs with effect from 13 June 1987. Consequently, design protection extending to Italy may be obtained by applicants entitled to benefit from said 1960 Hague Act by filing an international design application. At present Italy is bound neither by the London Act of 1934 nor by the Geneva Act of 1999. As of 1 January 2008, an international application under the Hague system can designate the European Union with effect in Italy.

### **[S] Design and Copyright Protection**

As of 19 April 2001, industrial designs which have a creative character and an artistic value may be protected by copyright as well. Simultaneous protection of a design-by-design registration and copyright may therefore be possible. This supersedes the previous provision according to which works of art applied to industry could be protected by copyright only if the artistic value of the work was separable from the industrial (commercial) character of the products in which they were incorporated.

### **[T] Fees**

*[1] Table of official fees*

Fees in Euros (EUR), as from April 2007.

	EUR
Filing fee for online design applications.....	50.00
Filing fee for online multiple design applications.....	100.00
Filing fee for design applications not filed online.....	100.00
Filing fee for multiple design applications not filed online.....	200.00
Registering an assignment or license (for each design involved).....	50.00

Increased by fiscal registration fee: approximately 3% on the amount of the consideration; if the consideration is up to EUR 5,600.00, a fixed registration fee of EUR 200.00 is levied.

Appeal fee (for appeals with the Board of Appeals), basic fee.....	340.00
Continuation of proceedings fee.....	300.00

In addition to the above official fees, the following are due: EUR 40.00 for the fee to be paid for design applications not filed online to the receiving office of the Italian Patent and Trademark Office, i.e., the Chamber of Commerce, and EUR 10.00 for registering an assignment or license (EUR 15.00 for online design applications and EUR 5.00 for registering an assignment or license); EUR 16.00 for each stamp duty which is due (for online design applications stamp duties are paid in a lump sum of EUR 20.00); EUR 1.30 for postal fees for each payment.

Maintenance fees are as follows:

– second five-year period.....	30.00
– third five-year period.....	50.00
– fourth five-year period.....	70.00
– fifth five-year period.....	80.00
Fine within six-month grace period.....	100.00

In addition EUR 1.30 for postal fees are due.

The maintenance fee may be paid prior to the time in which it becomes due; in case of increase of fees, supplemental payments must be made with respect to fees paid in advance at the old rates.

#### **[U] Transitional Provisions**

The law which implemented in Italy, as of 19 April 2001, the EU Directive 98/71/EC extended the duration of domestic registrations from fifteen to twenty-five years from the filing date of the application. The new duration was made applicable to all pending applications at the above-mentioned date and to all already granted registrations provided the renewal fees were paid.

#### **[V] Specific Industrial Design and Model Issues**

Expropriation is possible in the interest of the military defence of the State or for other reasons of public utility and may also concern pending applications. Expropriation may be restricted to the right to use the design for the needs of the State.

Expropriation is granted by a decree of the President of the Republic which also sets forth the consideration on the basis of the market value of the design. If expropriation takes place in the interest of the military defence of the State and it concerns pending applications, it may also impose a secrecy obligation along with the relevant duration.

If the shape or pattern of an item is eligible for design registration, and at the same time increases the utility thereof, simultaneous applications for a design registration and for a utility model patent may be filed by the same applicant. However, these two kinds of protection cannot be combined to a single protection right.

Terms expiring on Saturdays, Sundays or official holidays are automatically extended to the next working day.

#### **[W] Governmental Websites**

- [www.uibm.gov.it](http://www.uibm.gov.it) (Italian Patent and Trademark Office)
- [www.uibm.gov.it/uibm/dati/](http://www.uibm.gov.it/uibm/dati/) (industrial designs and models database)

