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TRADEMARKS AND PATENTS: THE ITALIAN INTELLECTUAL PROPERTY CODE STRENGTHENED

The Italian Intellectual Property Code (IPC) has just been updated to extend the protection conferred by trademarks and patents and to harmonize the IPC with European legislation, thereby strengthening the IPC's provisions.

Here are some of the most important changes:

TRADEMARKS

Abolition of requirement for a graphic representation of the mark: now it is possible to file new types of “unconventional” trademarks, for example olfactory, auditory or luminous marks, if they can be reproduced in the trademark register so that the subject matter of protection can be clearly determined;

Administrative procedures for forfeiture and invalidity of registered trademarks: these new procedures before the Italian Patent and Trademark Office offer a helpful and simpler alternative to filing lawsuits for forfeiture and invalidity with the courts;

Certification mark: finally introduced to Italy, this type of mark certifies certain characteristics of products or services (such as quality, nature or origin). It can be applied for both by natural and legal persons, including institutions, authorities and accredited certifying bodies, on condition that they do not themselves provide certified products or services;

Protection of marks that enjoy renown: this protection is strengthened by the possibility of prohibiting even non-distinctive uses of a mark that is identical or similar to the mark that enjoys renown, and which in any case is able to determine a parasitic leveraging of it or to cause a prejudice to its distinctiveness or renown;

Seizure at the border of infringing goods: it is now possible to have infringing goods seized at the border even if the goods are in external transit through customs;

Prohibition against activities preparatory to infringement: it is now possible to stop and seize material (for example labels, packaging or promotional material) that bears copies of trademarks, even if the marks are not affixed on the product, when there is the risk that such material could be used for infringing purposes;

Burden of proof in trademark forfeiture proceedings: whereas before, the burden of proving non-use lay with the party attacking the the validity of the trademark, now it will be the responsibility of the trademark owner to provide evidence that a use has been made. It will therefore be important for trademark owners to keep evidence of use over time.

PATENTS

Protection conferred by a European patent: the European patent will also prohibit an unauthorized third party from storing (for example stocking or warehousing in any way) the patented product, or the product directly produced using the patented process, if it is stored in order to later offer it for sale, place it on the market or use it in the country where the patent is in force;



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Experimental use: an unauthorized third party will be able to carry out experiments on the patented invention only if these experiments relate to the invention itself (research on), and not if the invention is used to enable the experiments to be carried out (research with).

In addition, in view of the possible advent of the unitary patent and of the Unified Patent Court:

Validation in Italy: if the request to obtain unitary protection when the patent is granted by the European Patent Office is rejected, revoked or withdrawn, it will be possible to validate the patent in Italy, as already happens for currently existing European patents;

Conversion to Italian utility model: this conversion will now also be possible if the unitary patent is revoked, as is already possible for currently existing European patents;

Preeminence of the unitary patent: if an Italian patent and a unitary patent are granted to the same owner for the same invention, the unitary patent will prevail over the Italian one - for the part of the invention that will be claimed by both - as already happens for currently existing European patents;

Pending and future Italian lawsuits relating to European patents: Italian law will continue to apply to these lawsuits, including for a certain period after the unitary patent comes into force and the Unified Patent Court begins operations.

With these changes, the Italian IPC has become stronger and more complete, and its enforcement simpler, with clear benefits for all businesses that decide to protect their trademarks and inventions in Italy.