



Francesco Bonini

# Trademarks in Italy: latest developments about filing and oppositions

Italy has implemented substantial changes in TM filing and prosecution in the last years: Francesco Bonini of Studio Bonini, Vicenza, Italy reports.

**T**he Italian Government has implemented substantial changes in the trademark, patent, and design application system, from May 2015 onwards. As it has now been about three years since the changes were made, an overall assessment can now be carried out.

## Simplification, e-filing, new database

Reducing the collecting places from over 100 (all the provincial Chamber of Commerce) to one (the Italian PTO or "UIBM") has generated the benefit of standardizing and simplifying the numeration system and, above all, improving the update time of application data.

The compulsory e-filing for all the applications of IP rights and their renewals has given the possibility of collecting and ordering them in a new database.

On March 29th 2018, UIBM has launched a new database, containing all bibliographic data of IP national rights, as well as notices of renewals and annuity payments (for patents); although full documents of patents and designs are sometimes difficult to retrieve, this is an important improvement.

In regards to trademarks, the available details about fresh applications and renewals are complete: filing number and date, owner name and address, list of goods/services,

image, name and address of representative, publication data and status data (i.e. the progress in examining the file).

Data is updated once a week, but by an additional database on the UIBM website: a daily check of applications is also available.

The National Trademark Bulletin is published once a month, with details of applications, registrations and oppositions.

Trademark national fees are "user friendly": just €177 for one class and €34 each additional class of goods and services for a fresh trademark application; renewal fees are €34 less than these.

At present the payment system is a bit burdensome, but the prosecution is now going with a good timeliness.



## Timeliness of applications

At present, UIBM carries out the examination of fresh TM applications within 1 or 2 months. It then publishes them for the 3-month period of opposition.

Due to the need to recover some backlog, because of previous IT problems, it extends the overall period for completing the TM registration process from 5 to 8 months.

Renewals have been given a separate track because their procedure is different and easier, and this helped a lot of the timeliness of the TM examination division of UIBM.

Registration certificates are sent electronically by certified e-mail to the representatives within 10-12 months from the filing date.

This is a far different situation from that of some years ago, when the Italian trademark applications were notorious for taking 3-4 years to be registered.

## Trends and composition of Italian TM applications

In 2017, UIBM received 58,850 trademark applications, either for registration and for renewal. 65% of them were applications for registration and 35% were for renewal.

## Résumé

**Mr. Francesco Bonini, EU Trademark Attorney, Studio Bonini**

Francesco has 20 years of experience in Italian and EU trademark and design prosecution. He had successful cases in oppositions, appeals and cancellations both before the EUIPO and the Italian PTO. Studio Bonini, established in 1980, has its head office in Vicenza, in the North-East of Italy. It has helped several companies of the Venetian area to protect their IP rights, dealing with IP prosecution. IP Litigation assistance is also provided with a 20-year cooperation with Studio Alberti & Fontana, a specialized law firm (IP and company rights) with successful cases before the Italian IP courts.



Italian trademark applications			
Year	Applications	Renewals	Total
2014	36,886	17,813	54,699
2015	37,056	18,306	55,362
2016	38,463	18,691	57,154
2017	38,841	20,009	58,850

As this table shows, the ratio between applications for registration and renewals has been stable during the last years (two thirds/one third).

Therefore, we can draw some conclusions as follows:

- The electronic and simplified system has encouraged more applicants, either individuals or companies, to file their trademarks;
- The seniority claim option, within the EUTM system, has not decreased the number of national renewals, on the contrary.
- The Italian trademark system **coexists peacefully** with the EUTM system, differently from the Italian designs, which have decreased, due to the unbeatable advantage of the Registered Community Design.

This fact confirms the statement, included in the recitals of the EU Trademark regulations, which says that it is not necessary to abolish national trademark systems in the EU member States and replace them with the EUTM, because the applicant should be free to choose either the national registrations or the EU one, according to their business needs.

### Opposition: procedure and timeliness

Regarding the Italian opposition system, in 2017 the UIBM received and published 2,606 oppositions on 38,841 fresh applications, that is 6.7% of them.

The opposition fee is €250 and must be paid before filing. The opponent can base its notice on more than one trademark right (either applications or registrations; non-registered trademarks or other distinctive signs are not allowed for opposing).

A cooling-off period is provided for, as well as its extension for up to one year, upon request of both parties; indeed, around 80% of opposition proceedings are solved without decision of UIBM (i.e. by a coexistence agreement or by withdrawal of the opposed application).

Should the procedure go on, the parties are allowed to file one set of grounds and documents in support of opposition and against it. In this case, the decision, issued by the opposition division, usually takes around 30 months from the publication date and yet, many attorneys agree that their quality is good.

### Opposition: figures and conclusions

Interestingly, on 2606 opposition (2017), just 916 have been filed by Italian individuals or companies, i.e. only 35% of them.

65% of all oppositions have been filed by foreign individuals or companies. This fact leads to different explanations:

- Italian TM owners are less proactive to defend their rights by oppositions than foreign owners, but it is more likely that
- Foreign companies are more familiar with opposition procedures, which have been provided for many more years in their countries.
- In any case, the striking majority of foreign opponents means also that they are confident with the reliability and consistency of the TM opposition system in Italy.

Despite the long period for a decision to be issued, the opposition system has a good feedback by foreign users.