

**Royal Decree No. 929 of June 21, 1942,
as last amended by Legislative Decree No. 480 of December 4, 1992***

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**Title I
Rights in Trademarks and Use of Trademarks**

***Chapter I
Rights in Trademarks***

Art. 1.

1. The rights of a proprietor of a registered trademark shall consist in the faculty of making exclusive use of the mark. The proprietor shall have the right to prohibit other persons, not having his authorization, from using:

- (a) a sign identical with or similar to the registered mark, for identical or related goods or services if, due to the fact that the signs are identical or similar and the goods or services are identical or related, there exists a likelihood of confusion on the part of the public, which may also consist in a likelihood of association between the two signs;
- (b) a sign identical with or similar to a mark registered for goods or services that are not related, if the registered mark enjoys repute in the State and if use of the sign without due cause takes unfair advantage of or is detrimental to the distinctive character or the repute of the mark.

2. In the cases referred to in items (a) and (b) of paragraph 1, the proprietor of the mark may, in particular, prohibit other persons from affixing the sign to the goods or their packaging; from offering the goods, from putting them on the market or from stocking them for such purposes, or from offering or supplying services under the sign; from importing or exporting the goods under the sign, from using the sign on business papers and in advertising.

* Italian title: Testo delle disposizioni legislative in materia di marchi registrati.

Entry into force (of last amending Decree): December 31, 1992.

Source: Communication from the Italian authorities, and in English, from Società Italiana Brevetti, Rome, Italy.

** Added by WIPO.

Art. Ibis.

1. The rights in a registered trademark shall not entitle the proprietor to prohibit another person from using in the course of trade:

- (a) his own name and address;
- (b) references to the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or rendering of the service or other characteristics of the goods or services;
- (c) the trademark, where it is necessary to specify the intended purpose of a product or service, in particular as accessories or spare parts;

provided that the use is in accordance with the principles of honest trading and therefore does not have a trademark function, but only a descriptive function.

2. The rights in a registered trademark shall further not entitle the proprietor to prohibit use of the mark for goods put on the market in the European Economic Community under the mark by the proprietor or with his consent.

However, this limitation of the powers of the proprietor shall not apply where there exist legitimate reasons for the proprietor to oppose further marketing of the goods, in particular where their condition is changed or impaired after they have been put on the market.

Art. 2.

1. The persons who assume the function of guaranteeing the origin, nature or quality of specific goods or services may obtain registration for relevant marks as collective marks and shall have the right to authorize producers and merchants to use such marks.

2. The regulations governing the use of collective marks, their supervision and the relevant sanctions shall be attached to the application for registration; any amendment to such regulations shall be communicated by the proprietors to the Italian Patent and Trademark Office referred to in Article 52, below, for inclusion in the documents attached to the application.

3. The provisions of paragraphs 1 and 2 shall also apply to foreign collective marks registered in their countries of origin, provided that such country affords reciprocal treatment to Italy.

4. By derogation from Article 18.1(b), a collective mark may consist of signs or references which may serve in trade as a designation of the geographic origin of the goods or services. In such case, however, the Office may refuse a registration, by means of a decision stating its grounds, if the marks applied for could create a situation of unjustified privilege or be otherwise detrimental to the development of other similar initiatives in the region. The above-mentioned Office may solicit the opinion in such case of governmental bodies and interested or competent agencies and bodies. Once granted, the registration of a collective mark consisting of a geographic name shall not entitle the proprietor to prohibit others from using the same name in the course of trade, provided that such use is in accordance with honest practice and is therefore limited to the function of an indication of origin.

5. Collective marks are subject to all other provisions of this Law, as long as they do not conflict with the nature of such marks.

Art. 3.

1. The renewal of the first registration of a mark or of a registered mark belonging to the same proprietor or to his successor in title, in accordance with Article 5, shall be effected by registration of the renewal.

Art. 4.

1. The exclusive rights afforded by this Decree shall subsist on registration.

2. The effects of first registration shall subsist as from the filing date of the application. In the case of renewal, the effects shall subsist as from the expiry of the prior registration.

3. Save for the provision of Article 1.1(b), registration shall be effective only with regard to the goods or services listed in the registration and to similar goods or services.

4. Registration shall be valid for 10 years as from the above date, except in the case of renunciation by the proprietor.

5. A renunciation shall become effective on entry in the Trademark Register referred to in Article 10 of Presidential Decree No. 540 of June 30, 1972, and notice thereof shall be published in the Bulletin referred to in Article 80 of this Decree.

Art. 5.

1. A registration may be renewed for the same prior mark, with respect to the same kind of goods or services in accordance with the International Classification of Goods and Services under the Nice Agreement of June 15, 1957, and subsequent amendments.

2. However, modifications of non-distinctive elements which do not substantially alter the identity of the mark originally registered shall be permitted.

3. Renewal shall be effected for 10-year terms.

4. Renewal of the registration of a mark which has been transferred with regard to some of the goods or services shall be effected by each proprietor separately.

5. The initial date and duration of the effects of registration shall remain unchanged for marks registered with the World Intellectual Property Organization in Geneva.

Art. 6.

1. Subject to the limits and conditions set forth in the following Article, the Ministry of Industry, Trade and Craft Trades may grant by special decree temporary protection to new marks affixed to goods or materials relative to the provision of services displayed at official or officially recognized national or international exhibitions held on the territory of the State or in a foreign country that affords reciprocal treatment.

Art. 7.

1. Such temporary protection shall make the priority of the registration in favor of the proprietor or his successor in title retroactive to the date of delivery of the product or material relative to the provision of the services to the exhibition and shall have effect only if an application for registration is filed within six months from the date of delivery and, in any event, not later than six months from the opening of the exhibition.

2. If, in the case of an exhibition held in a foreign country, a shorter term is provided, an application for registration must be filed within that term.

3. In the event of more than one mark for goods or services delivered to the exhibition on the same date, the mark for which an application for registration has been filed first shall have priority.

4. The aforesaid dates shall be stated by the interested party and entered in the certificate of registration, after verification by the Italian Patent and Trademark Office.

Art. 8.

. The provisions of the international conventions in force shall remain effective with respect to the registration of marks with the World Intellectual Property Organization (WIPO) in Geneva.

Refusal of protection for such marks on the territory of the State may be issued within one year of the date of publication of the mark in the bulletin of the World Intellectual Property Organization (WIPO) in Geneva.

Chapter II ***Use of Trademarks***

Art. 9.

1. In the case of prior use by others of an unregistered mark that is not well known or is only known locally, such other persons shall be entitled to continue to use the mark, and also to use it in advertising, within the same locality, notwithstanding the registration of the mark.

Art. 10.

1. It shall be prohibited for any person to use a registered mark after the relevant registration has been declared invalid if the invalidity is based on the fact that use of the mark is unlawful.

Art. 11.

1. A mark may not be used in a manner contrary to law nor, in particular, in a manner likely to create a risk of confusion on the market with other signs known to distinguish the enterprises, goods or services of other persons or, by virtue of the manner and context in which it is used, to mislead the public in any way, in particular as to the nature, quality or origin of the goods or services, or to infringe a copyright, industrial property right or any other exclusive right belonging to another person.

Art. 12.

1. A merchant may affix his own mark to the goods he puts on sale, but may not remove the mark of the producer or merchant from whom he has received the products or goods.

Art. 13.

1. It shall be prohibited to adopt as a trade name, denomination or company name, or as a signboard, a sign identical with or similar to another person's mark if, by reason of the identical or related nature of the business of the proprietors of those signs and the goods or services for which the mark has been adopted, a risk of confusion may arise on the part of the public, which may also consist in a risk of association between the two signs.

2. The prohibition referred to in paragraph 1 shall extend to the adoption as a trade name, denomination or company name, or as a signboard, of a sign identical with or similar to a mark registered for dissimilar goods or services, which enjoys a reputation in the State, if use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark.

Art. 14. [Repealed.]

Art. 15.

1. A mark may be transferred for all or some of the goods or services for which it has been registered.

2. A mark may be the subject of licenses, which may also be non-exclusive, for all or some of the goods or services for which it has been registered and for the whole or a part of the territory of the State, provided that, in the case of a non-exclusive license, the licensee expressly undertakes to use the mark to distinguish goods or services identical to those placed on the market or provided under the same mark in the territory of the State by the proprietor or by other licensees.

3. The proprietor of a trademark may assert the right of exclusive use of his mark against a licensee who contravenes the provisions of the licensing agreement with regard to its duration, the manner of use of the mark, the nature of the goods or services for which the license is granted, the territory in which the mark may be used or the quality of the goods manufactured and of the services provided by the licensee.

4. The transfer and license of a mark may in no event mislead the public as to those features of the goods or services that are essential for judging them.

Title II

Subject Matter and Proprietor of Trademarks

Chapter I

Subject Matter of Registration

Art. 16.

1. Any new sign which can be represented graphically, particularly words, including personal names, designs, letters, numerals, sounds, the shape of goods or of their packaging, color combinations or tonalities, provided that they are capable of distinguishing the goods or services of one enterprise from those of other enterprises may be registered as a trademark, subject to Articles 18 and 21.

Art. 17.

1. Signs shall not be deemed new within the meaning of the preceding Article if, on the filing date of the application:

- (a) they consist exclusively of signs which have become customary in current language or in the established practice of the trade;
- (b) they are identical with or similar to a sign already known as a mark or distinctive sign for goods or services manufactured, put on the market or provided by other persons for identical or related goods or services if, due to the fact that the signs are identical or similar and the goods or services are identical or related, there exists a likelihood of confusion on the part of the public, which may also consist in a likelihood of association between the two signs.

Marks that are “well known” in accordance with Article 6bis of the Paris Convention shall likewise be considered known. Prior use of a sign, when it is not known or is only known locally, shall not prejudice novelty. Prior use of a sign by the applicant or his predecessor in title shall not be a bar to registration;

- (c) they are identical with or similar to a sign already known as a trade name, denomination or company name or as a signboard adopted by others if, by reason of the identical or related nature of the business they pursue and the goods or services for which the mark has been registered, there exists a likelihood of confusion on the part of the public, which may also consist in a likelihood of association between the two signs. Prior use of a sign, when it is not known or is only known locally, shall not prejudice novelty. Prior use of a sign by the applicant or his predecessor in title shall not be a bar to registration;
- (d) they are identical with or similar to a mark already registered in the State by other persons or that has effect in the State pursuant to an application filed at an earlier date or that has effect from an earlier date on the basis of a priority right or, in case of a Community trademark, a valid priority claim, for identical or related goods or services, if by reason of the identical or similar nature of the signs and the identical or related nature of the goods or services, there exists a likelihood of confusion on the part of the public, which may also consist in a likelihood of association between the two signs. An earlier mark which has expired more than two years previously, or three years in the case of a collective mark, or which can be considered forfeited for failure to use in accordance with Article 42, at the time of filing a claim or counterclaim for invalidity, shall not prejudice novelty;
- (e) they are identical with or similar to a mark already registered in the State by other persons or that has effect in the State pursuant to an application filed at an earlier date or that has effect from an earlier date on the basis of a priority right or, in the case of a Community trademark, a valid priority claim, for goods or services that are not related, where the earlier mark enjoys a reputation in the State or, if it is a Community mark, in the European Economic Community, and where use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

2. For the purposes of items (d) and (e) of paragraph 1, earlier applications shall be assimilated to prior registrations provided they are subsequently registered.

Art. 18.

1. In addition to signs differing from those set forth in Article 16, the following shall not be eligible for trademark registration:

- (a) signs contrary to the law, public policy or accepted principles of morality;
- (b) signs consisting exclusively of the generic names of goods or services or descriptive statements relating thereto, such as signs which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or time of production of the goods or of the provision of the service, or other characteristics of the product or service;
- (c) signs consisting exclusively of the shape imposed by the nature of the goods, of the shape necessary to obtain a technical result or of the shape which gives substantial value to the goods;
- (d) escutcheons and other signs referred to in the relevant international conventions, in the cases and under the conditions set forth in such conventions, as well as signs including badges, emblems and escutcheons which are of public interest, unless the competent authority has authorized their registration;
- (e) signs capable of deceiving the public, in particular as to the geographical origin, nature or quality of the goods or services;

- (f) signs the use of which would infringe a copyright, industrial property right or other exclusive right belonging to another person.

Art. 19.

1. By derogation from Articles 17.1(a) and 18.1(b), those signs which, by reason of the use made of them, have acquired a distinctive character prior to the date of application for registration, may be the subject of a trademark registration.

Art. 20. [Repealed.]

Art. 21.

1. Portraits of persons may not be registered as marks without their consent or, after their death, without the consent of their spouse and children or, if there is no spouse or children or after their death, of their parents or other ascendants or, if there are no parents or other ascendants or after their death also, of the other relatives up to the fourth degree inclusive.

2. Personal names other than the name of the person seeking registration may be registered as marks provided that their use does not damage the reputation, credit or dignity of those who are entitled to bear such names. However, the Italian Patent and Trademark Office shall be entitled to subordinate registration to the consent set forth in paragraph 1 of this Article. Registration shall in no case prevent those entitled to such name from using it in the trade name of their choice.

3. If they are well known, the following may be registered as marks only by those entitled to them or with their consent or with the consent of the persons referred to in paragraph 1: personal names, signs used in the artistic, literary, scientific, political or sports fields, names and abbreviations of exhibitions and events, and nonprofit bodies and associations, as well as the characteristic emblems thereof.

Chapter II ***Proprietor of Trademark***

Art. 22.

1. A trademark registration may be obtained by anyone who is using or intends to use the mark in connection with the manufacture of or trade in goods or the provision of services in his own firm or in firms he controls or in firms using the mark with his consent.

2. A trademark registration may not be obtained by anyone who has made the application in bad faith.

3. Trademark registrations may also be obtained by State, regional, provincial and communal administrations.

Art. 23.

1. A trademark registration may be granted to foreigners not having on the State territory the enterprises from which the goods or services distinguished by such mark originate, if the States to which applicants belong afford reciprocity of treatment to Italian citizens.

2. All advantages which are, have been or will be afforded on the territory of the State to foreigners in respect of trademarks by the international conventions shall be considered to extend to Italian citizens.

Art. 24.

1. The proprietor of a foreign mark or his successor in title shall be entitled to obtain, in accordance with the international conventions, the registration of a mark which has been previously registered abroad and to which reference is made in the application.

Title III

Application, Examination and Registration

Art. 25.

1. An application for registration of a trademark shall be filed by the person entitled to obtain registration in accordance with this Decree and with the international conventions, or by his successor in title.

2. Where a final judgment establishes that the right to registration of a mark belongs to a person other than the applicant, such other person shall be entitled, if the registration has not yet been granted and within three months from the final judgment, at his own discretion, to:

- (a) take over the application for registration in his own name and assume the capacity of applicant in all respects;
- (b) file a new application for registration which, provided the mark it contains is substantially identical with that of the original application, shall have effect from the filing or priority date of the original application, which in any case shall cease to be effective;
- (c) obtain the rejection of the application.

3. If the registration has been granted in the name of a person other than the person entitled to it, the latter may, at his discretion:

- (a) obtain a court judgment, having retroactive effect, ordering the transfer to his name of the certificate of registration;
- (b) enforce the invalidity of the registration granted in the name of the person not entitled to it.

Art. 26.

1. The application must be accompanied by a copy of the mark and must state the kind of goods or services to be distinguished by the mark.

2. Regulations may lay down special provisions concerning the information to be supplied in specific cases and the documents to be filed in support of each application, including those for international registrations in accordance with the relevant conventions.

3. In the case of a priority claim deriving from an application filed abroad or from the exhibiting of the goods or materials relative to the provision of services, the applicant shall furnish documents and information proving the existence of the priority to the Italian Patent and Trademark Office.

Art. 27.

1. Each application may concern only one mark.

2. If the application concerns more than one mark, the Italian Patent and Trademark Office shall request, subject to a time limit, the applicant to limit his application to a single mark, with the faculty of filing separate applications for each of the remaining marks, having effect from the date of the initial application.

3. An appeal to the Board of Appeals referred to in Article 53 shall suspend the time limit stipulated by the Office.

Art. 28.

1. If a renewal is applied for a mark consisting of an alteration of the distinctive elements of the prior mark, the Italian Patent and Trademark Office shall request, assigning a term, the party concerned, to amend the application for renewal to an application for first registration having effect from the date of the application for renewal.

2. In the case of an appeal to the Board, the provisions of the preceding Article shall apply.

Art. 29.

1. The examination of an application of which the formal regularity has been acknowledged shall ascertain:

- (1) whether, in the case of collective marks, Article 2 of this Decree applies;

- (2) whether the word, design or sign, can be registered as a mark in accordance with Articles 16, 17.1(a), 18.1(a), (b), (c), (d) and (e) and 21;
- (3) whether the conditions referred to in Article 23 are met;
- (4) whether, in the case referred to in Article 24, the conditions stipulated in the international conventions are met.

2. If the above-mentioned conditions are not met, the Italian Patent and Trademark Office shall reject the application.

Art. 30.

1. In the case of a mark including words, designs or signs having apolitical significance or a highly symbolic value, or including heraldic elements, the Office shall forward, prior to registration, a copy of the mark and whatever else is appropriate, to the concerned or responsible public bodies to obtain their opinions, in accordance with the provisions of the following Article.

2. The Office shall be entitled to proceed in accordance with the preceding paragraph if there exists a doubt as to whether the mark may be contrary to public policy or accepted principles of morality.

Art. 31.

1. If the opinion of the concerned or responsible body referred to in the preceding Article is against the registration of the mark, the Office shall reject the application.

Art. 32. [Repealed.]

Art. 33.

1. The act by which the Italian Patent and Trademark Office rejects an application or does not accept it entirely shall be communicated to the applicant, who shall be entitled to file an appeal within 30 days of the communication.

Art. 34.

1. The registration shall not preclude the exercise of judicial actions concerning the validity or ownership of the mark.

Art. 35.

1. The Office shall publish a notice of applications and registrations effected and a copy of the marks in the Bulletin referred to in Article 80 of this Decree.

2. Once the application has been filed, the copy of the mark and, in general, the documents relative thereto shall be made available for public inspection.

Title IV Registration Fees

Art. 36.

1. The registration of a trademark shall be subject to the following fees:

- (a) an application fee for the initial registration;
- (b) an initial registration fee to be computed on the basis of the number of classes of the International Classification of Goods and Services under the Nice Agreement of June 15, 1957, and subsequent amendments;
- (c) a renewal fee, also to be computed on the basis of the number of classes of that International Classification.

2. For the international registration of a mark, the application fee shall be paid in addition to the fee established by the international conventions.

Art.37. [Repealed.]

Art.38.

1. The application fee and the initial registration fee shall be paid prior to the filing of the application.
2. Likewise, the renewal fee shall be paid prior to the filing of the relevant application.
3. If an application is rejected or withdrawn before the registration is granted, the fees paid shall be refunded, with the exception of the application fee.

Art.39. [Repealed.]

Art.40.

1. If, due to an evident error or for any other excusable reason, a fee has been paid incompletely or in some irregular manner, the Italian Patent and Trademark Office may also accept subsequent payment or regularization.

Title V

Revocation and Invalidity of Trademarks

Art. 41.

1. A trademark shall be revoked in the following cases:

- (a) if, in consequence of acts or inactivity of its proprietor, the mark has become the common name in the trade of the product or service;
- (b) if, in consequence of the manner and context in which it is used by its proprietor or with his consent for the goods or services for which it is registered, the mark has become liable to mislead the public, in particular as to the nature, quality or geographical origin of the goods or services;
- (c) if the mark has become contrary to law, public policy or accepted principles of morality.

Art. 42.

1. A mark shall also be revoked if it has not been put to genuine use by the proprietor, or with his consent, for the goods or services for which it has been registered within five years from registration or if such use has been suspended during an uninterrupted period of five years, unless non-use is justified by a legitimate reason.

2. Use of the mark in a modified form not altering its distinctive character as also affixing the mark in the State to goods or their packaging for export purposes shall constitute use of the mark for the purposes of this Article.

3. Save in the case of rights in a mark acquired by other persons through an application or use, revocation cannot be enforced when, between the expiry of the five-year period of non-use and the filing of a claim or counterclaim for revocation, genuine use of the mark has been started or resumed. However, if the proprietor makes preparations for the commencement or resumption of use of the mark only after having become aware that a claim or counterclaim for revocation is about to be filed, such commencement or resumption shall be disregarded if it did not occur at least three months prior to the filing of the claim or counterclaim for revocation; such period, however, shall be relevant only if it has elapsed after the expiry of the five-year period of non-use.

4. Furthermore, revocation for non-use shall not apply if the proprietor of the non-used mark is at the same time the proprietor of one or more similar marks still in force, of which at least one is being genuinely used to distinguish the same goods or services.

Art. 43.

1. A mark shall also be revoked if the proprietor omits the controls set forth in the regulations governing the use of a collective mark.

Art. 44. to Art. 46. [Repealed.]

Art. 47.

1. A mark shall be invalid save as otherwise provided by the following Article:

- (a) if it fails to meet any of the requirements set forth in Article 16 or if there exist any of the obstacles set forth in Article 17;
- (b) if it does not comply with the provisions of Articles 18 and 22.2;
- (c) if it does not comply with the provisions of Article 21;
- (d) in the case set forth in Article 25.3(b).

Art. 47bis.

1. By derogation from Article 47.1(a) and (b), in conjunction with Articles 17.1(a) and 18.1(b), a mark may not be declared invalid if, prior to the filing of a claim or counterclaim for invalidity, the sign has acquired a distinctive character by reason of the use which has been made of it.

Art. 47ter.

1. Where grounds for revocation or invalidity of a trademark exist in respect of only some of the goods or services for which the mark has been registered, revocation or invalidity shall affect only those goods or services.

Art. 48.

1. The proprietor of an earlier trademark according to Article 17.1(d) and (e), or the proprietor of a right of prior use that is not known or is only known locally, who has tolerated for five consecutive years the use of a later identical or similar registered mark, while being aware of it, shall not be entitled on the basis of the earlier mark or of the prior use either to apply for a declaration of invalidity of the later mark or to oppose use of such mark for the goods or services for which the later mark has been used, unless registration of the later mark was applied for in bad faith. The proprietor of a later mark may not oppose use of an earlier mark or the continuation of prior use.

2. The preclusion of the claim for invalidity referred to in paragraph 1 shall also extend to other persons.

3. The provision in paragraph 1 shall also apply to the case of a mark registered in violation of Articles 18.1(f) and 21.

Title VI Registered Acts

Art. 49.

1. Save as provided by Article 15, the following acts shall be made public by registration with the Italian Patent and Trademark Office:

- (1) deeds *inter vivos*, whether for valuable consideration or not, constituting, modifying or transferring personal or property rights of possession or guarantee rights in respect of national marks;
- (2) deeds of partition, company deeds, deeds of settlement, deeds of release relative to the rights referred to in the preceding item;
- (3) judgments establishing the existence of the acts referred to in the preceding items, where such acts have not been previously registered.

Judgments establishing the invalidity, annulment, termination, rescission, revocation of a registered act must be noted in the margin of the registration of the act to which they refer. Furthermore, judicial claims to obtain the judgments referred to in this Article may be registered; in such case, the effects of the registration of the judgment shall be retroactive to the date of registration of the judicial claim;

- (4) wills and acts proving the intestate succession and the judgments relative thereto.

Art. 50.

1. Registration shall be subject to the payment of a prescribed fee.
2. To obtain a registration, the applicant shall file a proper application for registration, enclosing a certified copy of the public act, or either the original or a certified copy of the private act, duly authenticated. Where authentication is not possible, the Italian Patent and Trademark Office shall be entitled to allow the registration of unauthenticated private acts.
3. The Office, having examined the formal regularity of the acts, shall effect the registration without delay as of the filing date of the application.
4. In the event of refusal by the Office, the applicant may appeal to the Board of Appeals within 30 days.
5. The order of the registrations shall be determined by the order in which the applications are filed.
6. Omissions or inaccuracies not leading to absolute uncertainty with respect to the act which is to be registered or with respect to the mark to which the act refers shall not affect the validity of the registration.

Art. 51.

1. The acts and judgments referred to in Article 49, except for the wills and the other acts and judgments referred to in item (4), shall be ineffective against others who have by any title acquired and legally maintained rights in a mark, until they have been registered.
2. Where more than one person has obtained the same right from the same proprietor, the person who has registered his title first shall have priority.
3. Wills and acts proving intestate succession and the judgments relative thereto shall be registered for the sole purpose of establishing the continuity of the transfers.

Title VII Administration and Jurisdiction

Art. 52.

1. The Italian Patent and Trademark Office of the Ministry of Industry, Trade and Craft Trades, referred to in Article 70, first paragraph, of Royal Decree No. 1127 of June 29, 1939, concerning patents for industrial inventions¹ shall perform the services pertaining to the matters governed by this Decree.
2. The competences of the Office with respect to the matters governed by this Decree shall also be taken into account with respect to the procedures set forth in the aforementioned Article 70, second paragraph.

Art. 53.

1. Appeals under this Decree against actions taken by the Italian Patent and Trademark Office shall be heard by the Board of Appeals referred to in Article 71, first and second paragraphs, of Royal Decree No. 1127 of June 29, 1939, concerning patents for industrial inventions.
2. The members of that Board, as also the technical experts, may be selected from among serving or retired officials, provided that the categories of official from which the selection is to be made are those stipulated in the aforementioned Article 71 and in any other provision of that Article.
3. The Board shall give a reasoned judgment after having heard the parties concerned or their representatives or agents and having considered their written observations.
4. The remaining provisions of the aforementioned Article 71 and those of Articles 72 and 73 of Royal Decree No. 1127 of June 29, 1939, shall likewise apply in trademark matters.

¹ See Industrial Property Laws and Treaties, ITALY – Text 2-001 (*Editor's note*).

Art. 54.

1. The Board of Appeals referred to in the preceding Article shall also act in an advisory capacity to the Ministry of Industry, Trade and Craft Trades not only in matters concerning patents for industrial inventions and industrial utility and ornamental models, but also in matters concerning trademarks.

Art. 55.

1. Legal actions in trademark matters shall constitute personal property actions.

Art. 56.

1. Actions concerning marks already registered or in the course of registration and actions concerning marks registered with the World Intellectual Property Organization in Geneva, insofar as their effects on the territory of the State are involved, shall be heard by the judicial authorities of the State, irrespective of the citizenship, domicile or residence of the parties.

2. Such actions shall be heard by the judicial authority of the defendant's domicile; however, if the defendant does not have residence, home or elected domicile on the territory of the State, such actions shall be heard by the judicial authority of the place where the plaintiff has his domicile or residence; if neither the plaintiff nor the defendant has an actual or an elected domicile on the territory of the State, the judicial authority of Rome shall have jurisdiction.

3. The statement of domicile entered in the original certificate of registration shall constitute an election of domicile for the purposes of determining the jurisdiction and for any administrative and judicial notification.

Art. 57.

1. Where actions are based on acts which allegedly infringe the plaintiff's rights, they may also be instituted before the judicial authority having jurisdiction in the place where the acts have been committed.

Art. 58.

1. The burden of proving the invalidity or revocation of a registered mark shall lie in all cases on the contesting party.

2. Proof of revocation for non-use may be furnished by any means, including presumptions of fact.

3. Revocation and invalidity of a mark shall have effect *erga omnes* when declared in a final judgment.

Art. 59.

1. Actions to obtain a declaration of revocation or invalidity of a trademark may also be instituted by the public prosecutor *ex officio*.

2. Actions for revocation or invalidity shall be instituted against all persons entered in the original certificate of registration as parties having rights in the mark.

3. The relevant judgments shall be entered on the original certificate of registration by the Italian Patent and Trademark Office.

Art. 60.

1. A copy of the statement of claims of every civil action in matters of registered marks shall be communicated to the Italian Patent and Trademark Office by the claimant.

2. If the aforesaid communication has not been made, the judicial authorities may, at any stage of the proceedings and prior to deciding on the merits, order that such a communication be made.

3. The clerk of the court shall transmit a copy of the relevant judgments to the Office.

Art. 61.

1. The proprietor of rights in marks which have been registered or are in the course of registration may request of the President of the court or the judge that description or seizure of the articles be ordered, whether products, goods or packaging, that constitute infringement of such rights, and of the means used for their manufacture.

2. The judicial authority, having obtained summary information and having heard, when it deems appropriate, the person against whom the claim is filed, shall proceed on an urgent basis and may subject the seizure to a judicial bond.

3. Description and seizure shall be carried out by an officer of the court with the assistance, where necessary, of one or more experts and also by the use of technical means of verification, photographic or otherwise. The interested parties may be authorized to be present at the procedures, or to be represented, and also to be assisted by experts of their choice.

4. Description may also concern articles belonging to other persons, provided that they are not for personal use. Seizure may also cover articles belonging to other persons, where they are intended for trade.

Art. 62.

1. Unless otherwise provided for the purposes of criminal justice, description and seizure which have not been ordered in the course of an action, shall cease to be effective whenever, within eight days of their execution:

- (a) a copy of the petition and of the order providing for them are not served on the parties against whom the order was issued;
- (b) an action on the merits has not been instituted;
- (c) those against whom the order was issued have not been summoned in the action on the merits and for confirmation of the seizure.

2. A person against whom there has been ordered a description or a seizure which has become ineffective under the provisions of the preceding paragraph or which has subsequently been recognized as groundless and is therefore revoked shall be entitled to compensatory damages from the party who obtained the description or seizure, if the latter had acted in bad faith.

Art. 63.

1. In the course of an action for infringement of rights in a mark which has been registered or is in the course of registration, an interlocutory judgment may be issued at the request of the interested party, with or without judicial bond, restraining use of the mark until the final judgment on the merits.

2. The restraining order may be revoked in the judgment on the merits.

Art. 64.

1. By derogation from the provisions of Articles 61 and 62 and subject to the requirements of criminal justice, the articles recognized as infringing a registered mark may not be seized, but only subjected to description for as long as they remain within the precincts of an official or officially recognized exhibition held on the territory of the State or are in transit to or from such exhibition.

2. If the articles come from abroad, the petitioner must prove, in order to obtain the description, that he is the proprietor of the mark in Italy and in the country of origin of the articles.

Art. 65.

1. The judicial authorities may order that judgment issued as a consequence of an infringement of a registered mark be published, as a whole or in summary, or in regard to the formal judgment only, in one or more newspapers determined by such authorities, at the expense of the unsuccessful party.

Art. 66.

1. The judgment establishing infringement of a mark or of the rights deriving therefrom, may order the destruction of the words, designs or signs whereby such infringement has been committed.

Destruction may include the packagings and, if the judicial authorities deem appropriate, also the product or the material relative to the provision of services, should this be necessary to suppress the infringing mark.

2. The judgment providing for compensatory damages may, at the request of a party, order their settlement as a lump sum computed on the basis of the records of the proceedings and of the presumptions deriving therefrom. It may also set a sum due for each violation or inobservance subsequently established and for any delay in the execution of the orders set forth in the judgment.

3. No order for removal or destruction of articles constituting infringement of the rights in a mark or order to restrain use of them may be issued where they belong to persons using them in good faith for personal or domestic purposes.

4. Any dispute arising during the execution of the orders mentioned in this Article shall be decided, with a final order, by the President of the court or by the judge who issued the judgment setting forth the aforesaid orders, having heard the parties and having obtained summary information.

Art. 67.

1. Anyone affixing words or statements to an article that are untrue and tend to give the impression that the mark distinguishing it has been registered or that the article bearing it has been patented shall be liable to an administrative fine of between 100,000 and 1,000,000 lire.

2. Anyone contravening the provisions of Articles 10 and 12 shall be liable, even if there has not been damage to other persons, to an administrative fine of up to 4,000,000 lire, unless the act constitutes a criminal offense.

Title VIII Provisions for Italian Territories Overseas

Art. 68. to Art. 72. [Omitted.]

Title IX General and Transitory Provisions

Chapter I General Provisions

Art. 73. [Repealed.]

Art. 74.

1. The applications referred to in this Decree shall be addressed to the Italian Patent and Trademark Office.

2. They shall be written, along with the documents attached thereto, in the Italian language. Any documents in languages other than Italian shall be accompanied by a translation into Italian.

Art. 75. [Repealed.]

Art. 76.

1. The applicant or his agent, if any, shall in each application state or elect his domicile in the State for all communications and notifications to be made in accordance with this Decree. Changes of domicile must be communicated to the Office, which shall note them on the original certificate of registration.

2. In the absence of a statement or election of domicile, or if the Office is notified of the cessation of the elected domicile in accordance with the preceding paragraph, and until a new election of domicile in the State is communicated, the aforesaid communications and notifications shall be made by affixing a copy of the act, or a notice of its contents, on the notice board at the Italian Patent and Trademark Office.

3. Changes of the name of the proprietor of a mark shall be communicated to the Office, along with supporting documents, for entry on the original certificate of registration.

Art. 77.

1. No person shall be required to be represented by a qualified agent in procedures before the Italian Patent and Trademark Office; natural and legal persons may act through their employees, even if not qualified, or through employees of another affiliated company.

2. Where the appointment of one or more agents is not done by a separate act, whether authentic or authenticated, it may be effected by a special letter of appointment, subject to payment of the prescribed fee.

3. The appointment of an agent by means of a letter of appointment shall be valid only for the purpose stated therein and shall be limited to relations with the Italian Patent and Trademark Office.

4. Only agents registered in the roll kept for this purpose by the Italian Patent and Trademark Office may be appointed.

5. A lawyer or *procuratore legale* registered in the appropriate professional roll may also be appointed.

Art. 78.

1. A request for an action, for which the payment of a fee is required, may not be accepted unless accompanied by a document certifying that such payment has been made.

2. Payments may also be made by persons other than the proprietor of the mark.

Art. 78bis.

1. The applicant or the proprietor of a mark who, despite having exercised the utmost diligence requirable, has not been able to meet a deadline with the Italian Patent and Trademark Office or with the Board of Appeals, shall be reinstated in his rights if the direct consequence of such inability has been the rejection of an application for registration, or of a petition relative thereto, or revocation of a registration or loss of any other right or of the right to appeal.

2. Within a period of two months from the cessation of the inability, the omitted act shall be performed and a petition for reinstatement, stating the facts and justifications, together with the supporting documents, filed. The petition may not be accepted if one year has elapsed since the expiry of the deadline which was not complied with.

3. Within 30 days from notification, an appeal to the Board of Appeals may be filed against the rejection of a petition for reinstatement by the Office. The Board of Appeals shall decide on a petition for reinstatement of the right to appeal.

4. The provisions of this Article shall not apply to the time limit referred to in paragraph 2, to the time limit for claiming priority rights, to the time limit to be complied with for the application of Article 4.3 of Presidential Decree No. 540 of June 30, 1972, or to the time limit set in accordance with Article 27.2 of this Decree.

Art. 78ter.

1. Anyone who has made real and effective preparations or has begun to use the mark in the period between loss of the exclusive right, or of the right to acquire it, and reinstatement in accordance with Article 78bis, may request reimbursement of the expenses incurred unless the preparations or use were made in bad faith.

Art. 79.

1. The collection of applications, of original certificates and related documents shall be open to public inspection.

2. Anyone may inspect and obtain information on registrations, entries and annotations, as well as copies of applications and related documents, in the form of a certificate or extract.

3. Such certificates and extracts, as also the authentication of copies of acts and documents, shall be subject to payment of the prescribed fees.

Art. 80.

1. The publications provided for in this Decree shall be made in the Bulletin of Patents for Invention, Designs and Trademarks referred to in Article 97 of Royal Decree No. 1127 of June 29, 1939, concerning patents for industrial inventions.

Chapter II ***Transitional and Final Provisions***

Art.81. to Art. 86. [Omitted.]

Art.87.

1. Applications for trademark patents and applications for registered acts filed prior to the entry into force of this Decree shall be subject to the provisions set forth herein. However, they shall be subject to the earlier provisions with respect to their formal regularity.

Art.88.

1. The right to exclusive use of a mark which enjoys a reputation and is granted prior to the entry into force of this Decree shall not entitle the proprietor to oppose further use in the course of trade of a sign identical with or similar to the mark for goods or services dissimilar to those for which it has been registered.

Art.89.

1. Trademarks granted prior to the entry into force of this Decree shall be subject to the earlier provisions of law with respect to grounds of invalidity.

2. A mark may not be declared invalid if, prior to the filing of a claim or counterclaim for invalidity, the sign has acquired a distinctive character by virtue of the use which has been made of it.

3. A mark may not be declared invalid if an earlier mark has expired more than two years earlier, or three in the case of a collective mark, or if it can be considered revoked for non-use prior to the filing of a claim or counterclaim for invalidity.

4. For purposes of application of Article 48 of Royal Decree No. 929 of June 21, 1942, as amended by this Decree, the five-year term shall begin on the date of entry into force of this Decree.

Art.90.

1. The provisions of this Decree governing the transfer and licensing of a mark shall also apply to marks already granted but not to agreements concluded prior to the date of entry into force of this Decree.

Art.91.

1. The provisions of this Decree governing revocation for non-use shall apply to marks already granted at the date of entry into force of this Decree, provided that they have not already been revoked at that date.

Art.92.

1. The provisions of this Decree governing revocation of a mark for misleading use shall apply to marks already granted at the date of entry into force of this Decree in cases of misleading use occurring after its entry into force.

Art.93.

1. Marks already granted or renewed in respect of which, at the date of entry into force of this Decree, the first 10-year term has already expired, shall be automatically renewed for a 10-year term beginning on the expiry of the first term, provided that the renewal fee, if due, is paid.

2. Likewise, marks in respect of which the first 10-year term expires in the year subsequent to the date of entry into force of this Decree shall be automatically renewed for a 10-year term, provided that the renewal fee, if due, is paid.

Art.94.

1. Within six months of the date of entry into force of this Decree, the Minister for Industry, Trade and Craft Trades, acting in conjunction with the Minister for Justice, shall issue special regulations setting forth the provisions necessary to extend the rules of the Ministerial Decree of April 3, 1981, published in Official Gazette No. 150 of June 3, 1981, concerning the register of qualified agents also to the registration of trademarks. Until the establishment of such register, any person may be appointed as an agent.

Art. 95.

1. Within six months of the date of entry into force of this Decree, the Minister for Industry, Trade and Craft Trades shall issue a decree providing for the revisions to be made to his Decrees of September 25, 1972, and February 22, 1973, respectively, published in Official Gazettes Nos. 260 and 69 of October 4, 1972, and March 15, 1973, respectively, as well as to Regulation No. 320 of July 19, 1989, concerning the procedures for registration of marks, and to any other ministerial decree concerning industrial property, in order to make them consistent with the provisions of this Decree.
