

Royal Decree No. 929 of June 21 1942, as last amended by Legislative Decree No. 499 of October 8 1999

Trademark law

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Title I

TRADE MARK RIGHTS AND USE

Subtitle I

TRADE MARK RIGHTS

Art. 1

1. The rights of the proprietor of a registered trade mark consist in the right to make exclusive use of the mark. The proprietor has the right to prohibit third parties, not having his authorisation, from using:

- a) a sign identical with the trade mark for goods or services identical with those in respect of which the trade mark is registered;¹
- b) a sign identical with or similar to the registered mark, for identical or similar goods or services if, by virtue of the identity or similarity of the signs and the identity or similarity of the goods or services, a risk of confusion may arise on the part of the public, which may also consist in a risk of association of the two signs;
- c) a sign identical with or similar to a mark registered for dissimilar goods or services, if the registered mark enjoys a reputation in the Country and if use of the sign without due cause permits the taking of unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark.

2. In the cases referred to in paragraph 1, the proprietor of the mark may in particular prohibit third parties 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 said purposes, or from offering or supplying services under the sign; from importing or exporting goods under the sign, from using the sign in business correspondence and in advertising.

Art. 1 bis

1. The rights to a registered trade mark do not entitle its proprietor to prohibit third parties from using in their economical activity:

- a) their name and address;
- b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the product or rendering of the service or other characteristics of the product or service;
- c) a trade mark when it is necessary to indicate 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 practice and therefore is not in a trade mark sense, but only in a descriptive sense.

2. The rights to a registered trade mark furthermore do not entitle its proprietor to prohibit use of the mark for goods put on the market in the European Economic Community under the mark by the

¹ Added by Legislative Decree No. 198 of March 19 1996.

proprietor or with his authorisation. This limitation of the powers of the proprietor however does not apply when there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, in particular when their condition is changed or impaired after they have been put on the market.

Art. 2

1. The persons who perform the duties of guaranteeing the origin, nature or quality of certain goods or services, may obtain a registration for special marks as collective marks, and have the right to authorise manufacturers or merchants to use said marks.
2. The regulations governing the use of collective marks, the control thereof and the relevant sanctions must be attached to the application for registration; any amendment to these regulations must be communicated by the proprietors to the Italian Patent and Trade Mark Office, referred to in article 52 below, so that they may be included among the documents attached to the application.
3. The provisions of paragraphs 1 and 2 are also applicable to foreign collective marks registered in the Country of origin, provided that the latter grants reciprocity of treatment to Italy.
4. By derogation from article 18, paragraph 1, letter b), a collective mark may consist of signs or indications which may serve in trade as a designation of the geographical origin of the goods or services. In this case, however, the Office may (by means of a grounded decision), refuse the registration when the marks applied for could create situations of unjustified privilege, or be otherwise detrimental to the development of other similar initiatives in the area. In this regard, the above mentioned Office may solicit the opinion of governmental bodies and interested or competent agencies and bodies. Once granted, the registration of a collective mark consisting of a geographical name does not entitle the proprietor to prohibit third parties from using the same name in the course of trade, provided that such use is in accordance with the principles of honest practice and is therefore limited to the function of indicating the origin.
5. Collective marks are subject to any other provision of the present Law, as long as it does not contrast with the nature of said marks.

Art. 3

1. The renewal of the first registration of a mark or in any case of a registered mark belonging to the same proprietor, or to his assign, in accordance with article 5, takes place by a registration for renewal.

Art. 4

1. The exclusive rights considered in this Decree are granted with registration.
2. The effects of a first registration subsist from the filing date of the application. In the case of renewal, the effects subsist from the expiry of the prior registration.
3. Save for the provision of article 1, paragraph 1, letter c), a registration is effective only with regard to the goods or services listed in the registration and to similar goods or services.²
4. A registration has a duration of ten years from the above date, except in the case of renunciation by the proprietor.
5. A renunciation becomes effective upon its recordal in the register of trade marks referred to in article 10 of Presidential Decree No. 540 of 30 June 1972, and notice thereof must be published in the Bulletin referred to in article 80 of the present Decree.

Art. 5

² Amended by Legislative Decree No. 198 of March 19 1996.

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 15 June 1957 and subsequent amendments.
2. However, modifications of non distinctive elements which do not substantially alter the identity of the mark originally registered are permitted.
3. Renewal is effected for ten year terms.
4. Renewal of the registration of a mark which has been transferred for some of the goods or services is effected by each proprietor separately.
5. The initiation and duration of the effects of registration remain unchanged for marks registered with the World Intellectual Property Organisation in Geneva.

Art. 6

Subject to the limits and conditions set forth in the following article, the Ministry of Industry and Commerce may grant, by special decree, a temporary protection to new marks affixed to goods or materials relative to the rendering of services displayed in official or officially recognised national or International exhibitions, held in the State territory or in a foreign Country granting reciprocity of treatment.

Art. 7

1. The temporary protection dates back the priority of the registration in favour of the proprietor or his assign to the date of delivery of the product or material relative to the rendering of services for the exhibition and is effective provided that an application for registration is filed within six months from the date of delivery and in any case not later than six months from the opening of the exhibition.
2. In the case of an exhibition held in a foreign Country, if a shorter term is provided, an application for registration must be filed within that term.
3. Among marks for goods or services delivered for the exhibition on the same date, the mark for which an application for registration has been filed first has priority.
4. The aforesaid dates must be indicated by the interested party and cited in the certificate of registration, upon their verification by the Italian Patent and Trade Mark Office.

Art. 8

[1.] With respect to the registration of marks with the World Intellectual Property Organisation in Geneva - WIPO - the provisions of the International Conventions in force remain effective.

[2.] International trademarks registered with the World Intellectual Property Organisation (WIPO) in Geneva - under the Madrid Agreement concerning the international registration of marks and the Protocol relating thereto adopted in Madrid on June 27, 1989 - designating Italy as a country in which protection is sought, must meet the requirements provided for by this decree in respect of national trademarks.

[3.] The Italian Patent and Trade Mark Office carries out the examination of international trademarks designating Italy, in accordance with article 29, paragraph 1, numbers 1) and 2).³

Art. 8 bis⁴

1. International trademarks designating Italy may be the object of observations and of oppositions in

³ Second and third paragraph added by Legislative Decree No. 499 of October 8 1999.

⁴ Art. 8 bis to Art. 8 quinquies added by Legislative Decree No. 499 of October 8 1999.

accordance with the provisions of articles 32 to 33 *bis* .

2. Observations and oppositions against an International trademark designating Italy under the Madrid Agreement and the Protocol relating thereto are submitted to the Italian Patent and Trade Mark Office and their respective filing periods run from the first day of the month following that of the publication in the "Gazette OMPI des marques internationales".

Art. 8 ter

1. The Italian Patent and Trade Mark Office shall, if it considers the mark unsuitable for registration in whole or in part, or if an opposition thereto has been filed by a third party, issue a provisional refusal of the International registration and notify the WIPO, as provided for by article 5 of the Madrid Agreement and the Protocol relating thereto.

2. The provisional refusal provided for by paragraph 1 is issued within one year for International registrations based on the Madrid Agreement and eighteen months for those based on the Protocol relating thereto. The periods run from the dates respectively indicated in the cited international conventions.

3. In the case of a provisional refusal, the trademark is afforded the same protection as that of a trademark filed with the Italian Patent and Trade Mark Office.

Art. 8 quater

1. The proprietor of an International registration against which the provisional refusal mentioned in paragraph 1 of article 8 *ter* has been notified to the WIPO may, within the deadline fixed by the Italian Patent and Trade Mark Office and through an agent as provided for by article 77, paragraphs 4^a and 5, file his own arguments or request a copy of the notice of opposition on the basis of which the provisional refusal has been issued. In the latter case, the Italian Patent and Trade Mark Office shall fix a further period for filing the arguments.

2. In case the proprietor of the International registration does not file his arguments in the prescribed manner within the period indicated in paragraph 1, the Italian Patent and Trade Mark Office issues the final refusal and notifies the WIPO.

3. The Italian Patent and Trade Mark Office notifies the WIPO any final decision concerning International trademarks designating Italy.

Art. 8 quinquies

1. In the event of a trademark designating Italy on the basis of the Madrid Protocol being subsequently cancelled, in whole or in part, upon request of the Industrial Property Office of origin, its proprietor may file an application for registration for the same sign with the Italian Patent and Trade Mark Office. The said application takes effect from the date of the International registration and shall enjoy any recognised priority, or from that of the recordal of the territorial extension concerning Italy.

2. The application shall be filed within a period of three months running from the date on which the International registration is cancelled and may concern only the goods and services contained therein in respect of Italy.

3. The application is governed by the current provisions for national applications.

Subtitle II TRADE MARK USE

Art. 9

1. In the case of prior use by third parties of an unregistered mark which is not known or is known only locally, said third parties are entitled to continue to use the mark, also in advertising, within the limits of the local use notwithstanding the registration of the mark.

Art. 10

1. Use of a registered mark after the relevant registration has been declared null is prohibited, when the grounds of nullity make use of the mark 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 other parties' enterprises, goods or services, 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 third party's copyright, industrial property right or any other exclusive right.

Art. 12

[1.] A merchant may affix his mark to the goods he sells but he may not suppress the mark of the manufacturer or dealer from whom he has received the products or goods.

Art. 13

1. The adoption as a firm, business or corporate name and as a signboard of a sign identical with or similar to another party's mark is prohibited if, by virtue of the identity or similarity 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 of the two signs.

2. The prohibition referred to in paragraph 1 extends to the adoption as a firm, business or corporate name and 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 Country if use of the sign without due cause permits the taking of 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 licensed, even not exclusively, for all or some of the goods or services for which it has been registered and for the whole or a part of the State territory, 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 put on the market or rendered under the same mark in the State territory by the proprietor or other licensees.

3. The proprietor of a trade mark may enforce the right to the exclusive use of the mark against the 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 rendered by the licensee.

4. In any case, the transfer and license of the mark must not cause any deceptiveness in those features

of the goods or services which are essential for appreciation by the public.

Title II
TRADE MARK SUBJECT MATTER AND PROPRIETOR

Subtitle 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 the goods or their packaging, colour combinations or tonalities, provided that they are capable of distinguishing the goods or services of one enterprise from those of other enterprises and save for the provisions of articles 18 and 21, may be registered as a trade mark.

Art. 17⁵

1. According to the preceding article 16, signs are not new if, on the filing date of the application:

- a) they consist exclusively of signs which have become customary in the current language or in the established practices of the trade;
- b) they are identical with or similar to a sign already known as a mark or distinctive sign of goods or services manufactured, put on the market or rendered by other parties for identical or similar goods or services, if by virtue of the identity or similarity of the signs and the identity or similarity of the goods or services, a risk of confusion may arise on the part of the public, which may also consist in a risk of association of the two signs. Marks which in accordance with article 6 bis of the Paris Union Convention (Stockholm text, July 14, 1967) are well-known by the concerned public, also by virtue of the knowledge obtained in the Country as a result of the promotion of the mark, are likewise considered known. Prior use of the sign, when it is not known or it is known only locally, does not prejudice novelty. Prior use of the sign by the applicant or his assignor is not a bar to registration;
- c) they are identical with or similar to a sign already known as a firm, business or corporate name and as a signboard adopted by other parties if, by virtue of the identity or similarity of the signs and the identity or similarity of the business they carry out and the goods or services for which the mark has been registered, a risk of confusion may arise on the part of the public, which may also consist in a risk of association of the two signs. Prior use of the sign, when it is not known or it is known only locally, does not prejudice novelty. Prior use of the sign by the applicant or his assignor is not a bar to registration;
- d) they are identical with a mark already registered in the Country by other parties or having effect in the Country pursuant to an application filed at an earlier date or having effect from an earlier date on the basis of a priority right or a valid seniority claim, for identical goods or services;
- e) they are identical with or similar to a mark already registered in the Country by other parties or having effect in the Country pursuant to an application filed at an earlier date or having effect from an earlier date on the basis of a priority right or a valid seniority claim, for identical or similar goods or services, if by virtue of the identity or similarity of the signs and the identity or similarity of the goods and services, a risk of confusion may arise on the part of the public, which may also consist in a risk

⁵ Article amended by Legislative Decree No. 198 of March 19 1996 and subsequently by Legislative Decree No. 499 of October 8 1999.

of association of the two signs;

f) in the cases referred to in letters d) and e), an earlier mark which has expired by more than two years, or three in the case of a collective mark, or which can be considered forfeited for non-use in accordance with article 42 below at the time of the filing of a claim or counterclaim for nullity does not prejudice novelty;

g) they are identical with or similar to a mark already registered in the Country by other parties or having effect in the Country pursuant to an application filed at an earlier date or having effect from an earlier date on the basis of a priority right or a valid seniority claim, for dissimilar goods or services, when the earlier mark enjoys a reputation in the Community, if it is a Community mark, or in the Country and when 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;

h) they are identical with or similar to a mark which is already well-known in accordance with article 6 bis of the Paris Union Convention (Stockholm text, July 14, 1967), for dissimilar goods or services, when the conditions referred to in letter g) exist.

2. For the purposes of paragraph 1, letters d), e) and g), earlier applications are assimilated to prior registrations provided their consequent registration.

Art. 18

1. In addition to signs different from those set forth in article 16, the following may not be the subject of a trade mark registration:

a) signs contrary to the law, public policy or accepted principles of morality;

b) signs consisting exclusively of generic denominations of goods or services or descriptive indications relating thereto, such as signs which may serve, in trade, as a designation of the kind, quality, quantity, intended purpose, value, geographical origin, or time of production of the goods or of the rendering of the service, or other characteristics of the product or service;

c) signs consisting exclusively of a shape imposed by the very nature of the goods, of a shape of goods which is necessary to obtain a technical result or of a shape which gives substantial value to the goods;

d) escutcheons and other signs referred to in the pertinent International Conventions in force, 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 authorised 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 constitute infringement of a third party's copyright, industrial property right or any other exclusive right belonging to a third party.

Art. 19

1. By derogation from articles 17, paragraph 1, letter a) and 18, paragraph 1, letter b), those signs which, by virtue of the use which has been made of them, have acquired a distinctive character, prior to the date of application for registration, may be the subject of a trade mark registration.

Art. 20

repealed

Art. 21

[1.] Portraits of persons may not be registered as marks without their authorisation and, after their death, without the authorisation of their spouse and children; in their absence or after their death, of

their parents or other ascendants; and, in the absence or after the death also of the latter, of the other relatives up to the fourth degree inclusive.

[2.] Personal names different from the applicant's may be registered as marks provided that use thereof does not injure the reputation, credit or dignity of those who are entitled to bear such names. The Italian Patent and Trade Mark Office has however the power to subordinate registration to the authorisation set forth in paragraph 1 of the present article. In any case, registration shall not prevent those entitled to the name from using it in the firm name of their choice.

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

Subtitle II TRADE MARK PROPRIETOR

Art. 22

1. A trade mark registration may be obtained by anyone who is using, or intends to use the mark in connection with the manufacture or trade of goods or the rendering of services in his undertaking or subsidiary undertakings or undertakings using it with his authorisation.
2. A trade mark registration may not be obtained by anyone who has made the application in bad faith.
3. Trade mark registrations may be obtained also by State, Regional, Provincial and Municipal Administrations.

Art. 23 ⁶

1. A trade mark registration may be granted to foreigners not having in the State territory the enterprises from which the goods or services distinguished by said mark originate, if the applicants' Countries grant reciprocity of treatment to Italian citizens.
2. Citizens of the Countries which have ratified and made the Agreement on Trade-related aspects of Intellectual Property rights effective, which was adopted in Marrakech on April 15, 1994, are accorded the same treatment provided for Italian citizens.
3. All benefits in trade mark matters which are, have been or will be recognised in the State territory in favour of foreigners by international Conventions are to be considered extended to Italian citizens.

Art. 24

1. The proprietor of a foreign mark or his assign is entitled to obtain, in accordance with 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

⁶ Added by Legislative Decree No. 198 of March 19 1996.

Art. 25

1. An application for registration of a trade mark must be made by the person entitled to obtain the same in accordance with this Decree or with International Conventions, or by his assign.
2. When a final judgement establishes that a person other than the applicant is entitled to the registration of the mark, such person, if the registration has not yet been granted and within three months from the final judgement, may at his choice:
 - a) take over the application for registration in his own name and assume the capacity of applicant in every respect;
 - b) file a new application for registration which, provided that its subject mark is substantially identical with that of the original application, has effect from the filing or priority date of the original application, which in any case ceases 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 one entitled to it, the latter may at his choice:
 - a) obtain a court judgement, having retroactive effects, ordering the transfer to his name of the certificate of registration;
 - b) enforce the nullity of the registration granted in the name of the person not entitled to it.

Art. 26

- [1.] The application must be accompanied by a specimen of the mark and must indicate 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 Conventions in force.
- [3.] In the case of a priority claim deriving from an application filed abroad, or from the display of the goods or materials relative to the rendering of services, the applicant shall file documents and information proving the existence of the priority with the Italian Patent and Trade Mark Office.

Art. 27

- [1.] Each application may cover only one mark.
- [2.] If the application covers more than one mark, the Italian Patent and Trade Mark Office shall request, assigning a term, the party concerned to limit his application to a single mark, with permission to file separate applications for the remaining marks, having effect from the date of the first application.
- [3.] An appeal to the Board of Appeals referred to in article 53 below, suspends the term assigned 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 Trade Mark 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 apply.

Art. 29

- [1.] The examination of an application, the formal regularity of which has been recognised, is directed

to ascertain:

- 1) whether, in the case of collective marks, article 2 of this Decree can apply;
- 2) whether the word, design or sign, can be registered as a mark in accordance with articles 16, 17, paragraph 1, letter a), 18, paragraph 1, letters a), b), c), d), e) and 21;
- 3) whether the conditions referred to in article 23 are met;
- 4) in the case referred to in article 24, whether the conditions set forth in International Conventions are met.

[2.] If the above mentioned conditions are not met, the Italian Patent and Trade Mark Office rejects the application.

Art. 30

[1.] In the case of a mark including words, designs or signs having a political significance or a highly symbolic value, or including heraldic elements, the Office shall forward, prior to registration, a specimen of the mark and whatever else may be required, to the interested or competent governmental bodies in order to hear their opinion, in accordance with the provision of the following article.

[2.] The Office has the power 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 interested or competent body referred to in the preceding article issues an opinion contrary to the registration of the mark, the Office rejects the application.

Art. 32⁷

1. Within sixty days following the publication of the trade mark application as provided for by article 35, paragraph 1, any interested party may, without thereby becoming a party to the registration proceedings, address the Italian Patent and Trade Mark Office written observations, explaining the grounds on which the mark should not be registered ex officio.

2. If they are deemed pertinent and relevant, the observations shall be notified by the Italian Patent and Trade Mark Office to the applicant, who may file his own arguments within a period of thirty days from the notification.

Art. 32 bis

1. Within three months following the publication of the trade mark application provided for by article 35, paragraph 1, notice of opposition to the registration of the trade mark may be entered: In order to be admissible, the said opposition must be in writing, must specify the grounds on which it is made and must be documented.

2. Those legitimated to enter an opposition are the proprietor of an earlier registered trade mark; whoever has applied to register a mark on an earlier date or which claims a priority or seniority; the exclusive licensee of the trade mark; the persons, bodies and associations referred to in article 21.

3. The grounds for refusal that can be raised by opposition against the registration of the mark are those provided for by article 17, paragraph 1, letters d) and e), insofar as all or a part of the goods or services in respect of which registration has been applied are concerned, as well as the lack of consent to registration on the part of those entitled to the right, mentioned in article 21.

Art. 32 ter

⁷ Art. 32 to Art. 32 quinques added by Legislative Decree No. 499 of October 8 1999.

1. Within thirty days from expiry of the period mentioned in article 32 *bis*, paragraph 1, the Italian Patent and Trade Mark Office notifies the opposition to the applicant, who may file his written arguments within the period set by the Office itself.

2. In the course of the opposition proceedings, the Italian Patent and Trade Mark Office may at any time invite the parties to file within the peremptory period of thirty days any additional documents, arguments or observations in respect of the allegations, arguments and observations of the other parties.

3. On request of the applicant, the opponent who is the proprietor of an earlier trade mark registered for at least five years, shall furnish suitable documents to prove that the said trade mark has been the object of effective use by him or with his consent in connection with the goods or services in respect of which the trade mark has been registered and on which the opposition is based, or that there are legitimate reasons for non-use. In the absence of proof to this effect, which must be furnished within thirty days from the notification of the request by the Italian Patent and Trade Mark Office, the opposition shall be rejected. If the effective use is proved for a part only of the goods or services in respect of which the earlier trade mark has been registered the trade mark shall, for the sole purpose of the examination of the opposition, be deemed to be registered in respect of that part only of the goods or services.

4. At the end of the opposition proceedings the Italian Patent and Trade Mark Office shall either reject the application, in whole or in part, if it results the mark may not be registered for all or a part only of the goods or services indicated in the application, or shall reject the opposition.

Art. 32 quater

1. The proceedings of an opposition entered on the basis of article 32 *bis*, paragraph 2, by the proprietor of a trademark application is suspended until the said mark is registered. Equally, the proceeding of an opposition based on an International trade mark is suspended until the period for refusal or for entering opposition against the said trade mark has expired or the relevant examination or opposition proceedings have been concluded.

2. The opposition proceeding may be suspended, on request of the applicant, if a decision is pending on the nullity or revocation of the trade mark on which the opposition is based, or in connection with the ownership of the right to registration under article 25, until a final decision is rendered. On request of the applicant, the suspension may subsequently be revoked.

3. In the event of multiple oppositions against the same mark, those following the first opposition are joined with the latter.

Art. 32 quinquies

[1.] If the applicant intends gaining protection of the trade mark abroad under the Madrid Agreement, the Italian Patent and Trade Mark Office shall proceed to its registration and carry out the relevant inscriptions even if an opposition has been entered.

[2.] If the trade mark application has not yet been published as provided for by article 35, paragraph 1, the publication of its registration pursuant to paragraph 1 is accompanied by a notice that such publication is the starting period for opposition provided for by articles 32 *bis* and following.

[3.] Acceptance of the opposition determines the total or partial cancellation of the trade mark.

Art. 33⁸

[1.] The decision by which the Italian Patent and Trade Mark Office rejects a trade mark application in

⁸ Amended by Legislative Decree No. 499 of October 8 1999.

whole or in part, or declares an opposition inadmissible or rejects it, is notified to the parties who, within thirty days from the date of the notification, have the possibility of entering an appeal before the Commission mentioned in article 71, paragraphs 1 and 2, of Royal Decree No. 1127 of June 29 1939 and subsequent modifications.

Art. 33 bis⁹

1. The opposition proceedings are concluded if:
 - a) the mark on which the opposition is based has been declared null or revoked by a final decision;
 - b) the opposition is withdrawn;
 - c) the trade mark application which is being opposed is withdrawn or is rejected by a final decision;
 - d) whoever has entered the opposition ceases to be legitimised pursuant to article 32 bis, paragraph 2.

Art. 34

1. The registration does not preclude the exercise of judicial actions concerning the validity or proprietorship of the mark.

Art. 35

1. The Office publishes a notice of applications and registrations effected and a specimen of the marks in the Bulletin referred to in article 80 of the present Decree.
2. Once the application has been filed, the specimens of the mark and, in general, the documents relative thereto are made available for public inspection.

Title IV
REGISTRATION FEES

Art. 36

1. The registration of a trade mark is subject to the following fees:
 - a) application fee for first registration;
 - b) first registration fee to be computed on the basis of the number of classes referred to in the International classification of goods and services under the Nice Agreement of 15 June 1957 and subsequent amendments;
 - c) renewal fee, also to be computed on the basis of the number of classes referred to in said International classification.
2. For the International registration of a mark the application fee must be paid in addition to the fees established by the International Conventions.

Art. 37
repealed

Art. 38

1. The application fee and the first registration fee must be paid prior to the filing of the application.

⁹ Added by Legislative Decree No. 499 of October 8 1999.

2. Likewise, the renewal fee must be paid prior to the filing of the relevant application.
3. If an application is rejected or voluntarily renounced before the registration is granted, the fees paid, except the application fee, are refunded.

Art. 39
repealed

Art. 40

1. When, due to an evident error or any other excusable reasons, a fee has been paid incompletely or in any case irregularly, the Italian and Patent Trade Mark Office may also accept the belated balance of the payment.

Title V
REGISTRATIONS FORFEITURE AND NULLITY

Art. 41

1. A trade mark becomes forfeited 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, by virtue of the manner and context in which it is used by its proprietor or with his authorisation for the goods or services for which it is registered, the mark becomes capable of misleading the public, in particular as to the nature, quality or origin of the goods or services;
 - c) if the mark has become contrary to the law, public policy or accepted principles of morality.

Art. 42

1. A mark furthermore becomes forfeited if it has not been put to genuine use by the proprietor or with his authorisation, for the goods or services for which it has been registered, within five years from registration or if such use has been suspended for a continuous period of five years, unless the non-use is justified by a legitimate cause.
2. Both use of the mark in a modified form not altering its distinctive character and affixing in the Country the mark to goods or their packaging for export purposes constitute use of the mark within the meaning of the present article.
3. Except for the case of rights to a mark acquired by third parties through application or use, forfeiture cannot be enforced when, between the expiry of the five year period of non-use and the filing of a claim or counterclaim for forfeiture, 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 forfeiture is about to be filed, such commencement or resumption are disregarded if they did not occur at least three months prior to the filing of the claim or counterclaim for forfeiture; such period however is relevant only if it has elapsed after the expiry of the five year period of non-use.
4. Furthermore, forfeiture for non-use shall not occur if the proprietor of a 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 furthermore becomes forfeited if the proprietor omits the controls set forth in the

regulations governing the use of a collective mark.

Art. 44
repealed

Art. 45
repealed

Art. 46
repealed

Art. 47

1. Save for the provisions of the following article, a mark is null:

- a) if it lacks any of the requisites set forth in article 16 or if there exist any of the bars set forth in article 17;
- b) if it is in contrast with the provisions of articles 18 and 22, paragraph 2;
- c) if it is in contrast with the provisions of article 21;
- d) in the case set forth in article 25, paragraph 3, letter b).

Art. 47 bis

1. By derogation from article 47, paragraph 1, letters a) and b), in connection with articles 17, paragraph 1, letter a) and 18, paragraph 1, letter b), a mark cannot be declared null if, prior to the filing of a claim or counterclaim for nullity, the sign has acquired a distinctive character by virtue of the use which has been made of it.

Art. 47 ter

1. If the grounds for forfeiture or nullity of a trade mark exist in respect of only some of the goods or services for which the mark has been registered, the forfeiture or nullity affects only those goods or services.

Art. 48

1. The proprietor of an earlier trade mark according to article 17, paragraph 1, letters d), e), g) and h),¹⁰ and the proprietor of a right of prior use which is known not only locally, who have tolerated for five consecutive years use of a later identical or similar registered mark, while being aware of it, are not entitled, on the basis of their earlier mark or prior use, either to apply for the declaration of nullity of the later mark or to oppose use of such mark for the goods or services for which said mark has been used, unless the later mark has been applied for in bad faith. The proprietor of the later mark may not oppose use of the earlier one or the continuation of the prior use.

2. The preclusion of the claim for nullity referred to in paragraph 1 extends also to third parties.

3. The provision of paragraph 1 also applies to the case of a mark registered in violation of articles 18, paragraph 1, letter f) and 21.

Title VI RECORDALS

¹⁰ Added by Legislative Decree No. 198 of March 19 1996.

Art. 49

[1.] Save for the provisions of article 15 above, the following must be made public by recordal with the Italian Patent and Trade Mark Office:

- 1) deeds inter vivos, with or without consideration, constituting, modifying or transferring personal or property beneficial uses or security interests concerning national marks;
- 2) deeds of partition, company deeds, deeds of settlement, deeds of surrender relative to the rights considered in the preceding number;
- 3) judgements establishing the existence of the deeds set forth in the preceding numbers, when such deeds have not been previously recorded.

Judgements establishing the nullity, annulment, termination, rescission, revocation of a recorded deed must be noted in the margin of the recordal of the deed to which they refer.

Furthermore, judicial claims to obtain the judgements referred to in the present article may be recorded; in such a case, the effects of the recordal of the judgement date back to the date of recordal of the judicial claim;

- 4) wills and deeds proving the intestate succession and the judgements relative thereto.

Art. 50

[1.] The recordal is subject to the payment of a prescribed fee.

[2.] In order to obtain a recordal, the applicant must file a proper application for recordal, enclosing a certified copy of the public deed, or either the original or a certified copy of the private deed, duly authenticated. Whenever authentication is not possible, the Italian Patent and Trade Mark Office has the power to allow the recordal of non-authenticated private deeds.

[3.] The Office, having examined the formal regularity of the deeds, proceeds, without delay, to the recordal which has effect from the filing date of the application.

[4.] The applicant, within 30 days, may appeal to the Board of Appeals against a rejection issued by the Office.

[5.] The order of the recordals is determined by the order in which the applications are filed.

[6.] Omissions or inaccuracies not inducing absolute uncertainty with respect to the deed which is to be recorded or with respect to the mark to which the deed refers, do not affect the validity of the recordal.

Art. 51

[1.] The deeds and judgements referred to in article 49 above, except the wills and the other deeds and judgements set forth in number 4, until they are recorded, are ineffective against third parties who have by any title acquired and legally maintained rights to a mark.

[2.] In the concurrence of more than one assignee of the same right from the same proprietor, the one who has recorded his title first prevails.

[3.] Wills and deeds proving the intestate succession and the judgements relative thereto are recorded for the sole purpose of establishing the continuity of transfers.

Title VII ADMINISTRATIVE AND JURISDICTIONAL SYSTEM

Art. 52

[1.] The Italian Patent and Trade Mark Office within the Ministry of Industry and Commerce, referred

to in article 70, paragraph 1, of Royal Decree no. 1127 of 29 June 1939 concerning patents for industrial inventions, performs the services pertaining to the matters governed by this Decree.

[2.] With respect to the procedures set forth in said article 70, paragraph 2 (no longer in force), the powers of said Office with respect to the matters governed by this Decree shall also be taken into account.

Art. 53

[1.] Those appeals allowed by this Decree against actions taken by the Italian Patent and Trade Mark Office shall be decided by the Board of Appeals referred to in article 71, paragraphs 1 and 2 of Royal Decree No. 1127 of 29 June 1939, concerning patents for industrial inventions.

[2.] The members of said Board, as well as technical experts, may be selected among both officials actively serving and retired officials, provided that the categories of officials from which the selection is to be made are those set forth in said article 71 and any other provision of such article is complied with.

[3.] The Board issues its judgements and the grounds thereof, after having heard the interested parties or their representatives or agents and having considered their written arguments.

[4.] The remaining provisions of said article 71 and those of articles 72 and 73 of Royal Decree No. 1127 of 29 June 1939 are likewise applicable to trade mark matters.

Art. 54

[1.] The Board of Appeals referred to in the preceding article acts also as an advisory office for the Ministry of Industry and Commerce¹¹ not only in matters of patents for industrial inventions and in matters of industrial utility and ornamental models, but also in matters of trade marks.

Art. 55

[1.] Legal actions in trade mark matters have the nature of personal property actions.

Art. 56

[1.] Actions concerning marks already registered or in the course of being registered and actions concerning marks registered with the World Intellectual Property Organisation in Geneva, in so far as their effects in the State territory are involved, are brought before the judicial authorities of the Country, irrespective of the citizenship, domicile or residence of the parties.

[2.] Such actions are brought before the judicial authority of the defendant's domicile; however, when the defendant does not have his residence, home or elected domicile in the State territory, said actions are brought before the judicial authority where the plaintiff has his domicile or residence; when neither the plaintiff nor the defendant has an actual or an elected domicile in the State territory, the judicial authority of Rome has jurisdiction.

[3.] The indication of domicile entered in the original certificate of registration constitutes election of domicile for the purposes of determining the jurisdiction and for any administrative and judicial notification.

Art. 57

¹¹ Renamed "Ministry of Productive Activities".

[1.] Whenever actions are based on facts which allegedly injure the plaintiff's rights, these actions may be brought before the judicial authority having jurisdiction in the place where the facts have been committed.

Art. 58

1. The burden of proving the nullity or forfeiture of a registered mark lies in any case on the party contesting it.
2. Proof of forfeiture for non-use may be provided by any means, including presumptions of facts.
3. When established in a final judgement, forfeiture and nullity of a mark have effects erga omnes.

Art. 58 bis¹²

1. Where a party has presented serious indications to support his claims and has specified documents, evidence or information possessed by the adverse party which may confirm said indications, he may obtain that the judge order this evidence to be produced or that the judge acquires the information through interrogatory of the adverse party. The party may also obtain that the judge orders the adverse party to provide the information aimed at identifying those persons involved with the manufacture and distribution of the infringing goods or services.
2. The judge, in granting the orders above described, shall adopt the appropriate measures to protect reserved information, having heard the defendant.

Art. 59¹³

1. Actions directed at obtaining a declaration of revocation or nullity of a trade mark may be brought by any interested party and initiated ex officio by the public prosecutor. Nevertheless, actions directed at obtaining a declaration of nullity of a trade mark on the basis of one of the grounds provided for by article 17, paragraph 1, letters b), c), d), e), g) and h), or for the mark being in contrast with the provisions of articles 18, paragraph 1, letter f) or with the provisions of article 21, and in the case of article 25, paragraph 3, letter b), may be brought only by the proprietors of earlier rights mentioned in the said articles.
2. Actions for revocation or nullity of a trade mark must be brought against all those who are entered in the original certificate of registration as having a right in the mark.
3. The relevant judgements shall be entered in the original certificate of registration by the Italian Patent and Trade Mark Office.

Art. 60

1. A copy of the Statement of claims of every civil action in matters of registered marks must be communicated to the Italian and Patent Trade Mark Office by the claimant.
2. Whenever the aforesaid communication has not been effected, the judicial authorities, at any stage of the proceedings and prior to deciding on the merits, order that such a communication be effected.
3. The clerk of the court must transmit a copy of the relative judgements to said Office.

Art. 61¹⁴

[1.] The owner of trade mark rights for trade marks which have been registered or are in the course of

¹² Added by Legislative Decree No. 198 of March 19 1996.

¹³ Amended by Legislative Decree No. 499 of October 8 1999

¹⁴ Amended by Legislative Decree No. 198 of March 19 1996.

being registered may request the description or seizure of some or all the articles produced in violation of these rights as well as the means employed in the production of such articles and of the elements of proof concerning the reported violation. Suitable means are in the last case adopted to guarantee the protection of confidential information.

Art. 62¹⁵

1. Unless differently provided in the subsequent paragraphs, the proceedings provided for under Art. 61 are ruled by the rules of the Civil Procedure Code concerning the provisional measures of description and seizure.
2. The description and the seizure shall be carried out by a law officer with the assistance, where needed, of one or several experts and with the help of whatever photographic or other technical means may be required for the investigation.
3. The interested persons, or their representatives, may be authorised to attend the operations or to be assisted by technicians of their choice.
4. Paragraphs 2 and 3 of sect. 693, Civil Procedure Code, do not apply to the description. In the meaning of sect. 697 of the Civil Procedure Code, the character of exceptional urgency has to be evaluated in the sense of not prejudicing the working of the measure. Sections 669-octies, 669-novies, 669-undecies and 675 of the Civil Procedure Code are also applied to the description.
5. After expiration of the term of sect. 675 Civil Procedure Code, the description and seizure operations already begun may be completed, but other operations based on the same measure can not be started; it is in any case possible to request the judge to dispose further measures of description or seizure during the proceeding on the merits.
6. Description and seizure may concern articles owing to subjects even not identified in the request, provided they concern articles manufactured, offered, imported or put on the market by the party against which the aforementioned actions have been issued and provided that such articles are not intended for personal use. The report of the seizure and description operations, with the request and the action, must be served on the third whom belong the articles on which the description and the seizure were issued, within 15 days from the conclusion of the above operations, otherwise they shall lose their effects.

Art. 63¹⁶

1. The owner of trade mark rights for trade marks which have been registered or are in the course of being registered can request an injunction to be issued against the manufacture, the marketing or the use of what constitutes infringement, according to the rules of the Civil Procedure Code concerning the provisional measures.
2. By pronouncing the injunction, the judge can fix an amount due for each violation, or each case of non-compliance that may be found in the future or for any delay in the execution of the order.

Art. 64

1. By derogation from the provisions of articles 61 and 62 and save for the requirements of criminal law, the articles recognised to be an infringement of a registered mark cannot be subject to seizure but only to description as long as they remain within the precincts of an official or officially recognised exhibition held in the State territory or are in transit to or from the same.
2. When the articles come from abroad, in order to obtain the description, the petitioner must prove that he is the proprietor of the mark in Italy and in the Country of origin of the articles.

¹⁵ Amended by Legislative Decree No. 198 of March 19 1996.

¹⁶ Amended by Legislative Decree No. 198 of March 19 1996.

Art. 65

[1.] The judicial authorities may order that the judgement 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 judgement only, in one or more newspapers indicated by said authorities, at the expense of the losing party.

Art. 66

[1.] The judgement establishing an infringement of a mark or an injury of the rights deriving therefrom, may order the destruction of the words, designs or signs whereby such infringement or injury has been committed. Destruction may include the packaging and, when the judicial authorities deem it appropriate, also the product or the material relative to the rendering of services, should this be necessary to suppress the infringing mark.

[2.] The judgement providing for compensatory damages, at the request of a party, may liquidate them in a lump sum quantified on the basis of the records of the proceedings and of the presumptions deriving therefrom. It may also fix a sum due for each violation or non-observance subsequently established and for any delay in the execution of the orders set forth in the judgement.

[3.] Neither an order for removal or destruction of the things constituting infringement of the rights to the mark nor an order to restrain use thereof may be issued, when 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 is decided, with a final order, by the President of the court or by the judge who issued the judgement setting forth the aforesaid orders, having heard the parties and having obtained summary information.

Art. 67

1. Anyone affixing false words or indications to an article tending to give the impression that the mark distinguishing it has been registered, or that the article bearing it has been patented, is punished with an administrative fine of one hundred thousand to one million lira.

2. Anyone contravening the provisions of articles 10 and 12 is punished, even if there has not been damage to third parties, with an administrative fine of up to four million lira, unless the fact constitutes a criminal offence.

Title VIII
PROVISIONS FOR ITALIAN TERRITORIES OVERSEAS

Articles 68-72
omissis

Title IX
GENERAL AND TRANSITORY PROVISIONS

Subtitle I
GENERAL PROVISIONS

Art. 73
repealed

Art. 74

[1.] The applications referred to in this Decree must be addressed to the Italian Patent and Trade Mark Office.

[2.] They must, along with the documents attached thereto, be drawn up in Italian. An Italian translation must accompany all documents in languages other than Italian.

Art. 75
repealed

Art. 76

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

2. In the absence of indication 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 Country is communicated, the aforesaid communications and notifications are made by affixing a copy of the deed, or a notice of its contents, on the notice board of the Italian Patent and Trade Mark Office.

3. Changes of the name of the proprietor of a mark must be communicated to the Office, along with supporting documents, so that they may be entered in the original certificate of registration.

Art. 77

1. No one is required to be represented by a qualified agent in procedures before the Italian Patent and Trade Mark Office; individuals and legal entities may act through their employees, even if not qualified, or through employees of another affiliated company.

2. The appointment of one or more agents, when it is not done by a separate deed, authenticated or not, may be made by a special letter of appointment, subject to payment of a prescribed fee.

3. The appointment of agent conferred with a letter of appointment is valid only for the purpose indicated therein and is limited to relations with the Italian Patent and Trade Mark Office.

4. The appointment of agent may only be conferred to agents registered in the roll kept for this purpose by the Italian Patent and Trade Mark Office.

5. The appointment of agent may also be conferred to an attorney at law registered in the pertinent bar.

Art. 78

1. An application to obtain an action, for which the payment of a fee is required, cannot be accepted when it is not accompanied by a document certifying that such a payment has been made.

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

Art. 78 bis

1. The applicant or the proprietor of a mark who, though having used the utmost diligence, was not able to meet a deadline with the Italian Patent and Trade Mark Office or with the Board of Appeals, is reinstated in his rights if the impediment has, as a direct consequence, the rejection of an application for registration or of a petition relative thereto, or forfeiture of a registration or loss of any other right or the right to appeal.

2. Within a period of two months from the cessation of the impediment, the omitted act must be carried out and a petition for reinstatement, along with the indication of the facts and justifications as well as supporting documents, must be filed. The petition cannot be accepted if a year has elapsed since the expiry of the term which was not observed.

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

4. The provisions of this article are not applicable:

to the term referred to in paragraph 2, to the term to claim priority rights, to the term the observance of which affects the application of article 4, paragraph 3 of Presidential Decree no. 540 of 30 June 1972, to the term set in accordance with article 27, paragraph 2 of the present Decree.

Art. 78 ter

1. Anyone who has made serious and genuine preparations or has commenced use of the mark in the period between the loss of the exclusive right, or of the right to acquire it, and the reinstatement in accordance with article 67 bis, may request reimbursement for the expenses borne unless said preparations or use occurred in bad faith.

Art. 79

1. The register of applications, that of original certificates and the relative documents are available for public inspection.

2. Anyone may inspect and obtain information on registrations, records and annotations, as well as copies of applications and relative documents, by means of a certificate or extract.

3. Such certificates and extracts, as well as the authentication of copies of deeds and documents, are subject to the payment of the prescribed fees.

Art. 80

1. Publications set forth in this Decree are made in the "Bulletin of Patents of Inventions, Models and Trade Marks" referred to in article 97 of Royal Decree no. 1127 of 29 June 1939 concerning patents for industrial inventions.

1 *bis*. The Italian Patent and Trade Mark Office may edit the Bulletin also by means of computer supported programs.¹⁷

Subtitle II TRANSITORY PROVISIONS

Articles 81-86

omissis

These articles, even though not officially repealed, are no longer relevant and therefore been omitted.

Schedules A, B, C attached to Royal Decree no. 929 of June 21 1942 have been abolished.

¹⁷ Added by Legislative Decree No. 499 of October 8 1999.