

# ITALIAN CODE OF INDUSTRIAL PROPERTY

Legislative Decree N°30 of 10 February 2005

Text effective as from 2 September 2010,  
as amended by Legislative Decree N°131 August 2010

Published by LES Italy with the assistance of the Chamber of Commerce of Milan and Turin

## Disclaimer

LES Italy strived to achieve the highest possible accuracy in translating the Italian Code of Industrial Property into English.

For the sake of comprehension, some major language option have been adopted. When translating names of institutions and phenomena of Italian substantive and procedural law, descriptions and descriptive phrases in the English language have been adopted, such as to give the reader a reasonably accurate comprehension of them.

LES Italy is aware that due to the complexity of the IP field its efforts may have resulted in adopting language options that might not be shared universally.

If any questions arise related to the accuracy of the information contained in this translation, please refer to the official Italian version of the Industrial Property Code. Any discrepancies or differences created in the translation are not binding and have no legal effect for compliance or enforcement purposes.

## PREFACE

Italy has a long tradition in the field of Industrial and Intellectual Property. One of the earliest official form of protection for Intellectual Property and creativity is represented by the Patent Statute, decreed in 1474 by the Most Serene Republic of Venice.

“There are in this city, and because of its grandeur and virtue there come to us from other places, men of great genius, apt to invent and discover a variety of ingenious devices. And if it were provided that the works and devices discovered by such persons could not be imitated by others who may see them, stealing away the inventor’s honor, such men would exercise their genius and invent and make devices of no small utility and benefit to our commonwealth. Therefore, it is decreed by the authority of this Council that any person in this city who invents any novel and ingenious device, not made previously in our dominion, as soon as it is reduced to perfection, so that it can be used and exercised, shall give notice to the office of our Provisioners. It being forbidden to all others in our land to make any other device which imitates and resembles the invention, without the consent and license of the author, for up to ten years” From the Venetian State Law, dated 1474.

Created with the intention of rewarding and encouraging inventors, a source of pride for the city of Venice, the Statute sets out in a few lines the essential elements that an Industrial Property right, and in particular a patent, must possess. It in fact mentions the requirements of novelty (not made previously in our dominion), originality (any novel and ingenious device) and industrial applicability (of no small utility and benefit) of the invention. It also states that to be officially protected it must follow a registration procedure (shall give notice to the office of our Provisioners). In this way, the inventor acquired the exclusive right to exploit (produce, import/export, sell) within a specific territory a particular asset for a certain period of time (originally 10 years, now extended to a maximum of 20 years), whilst its infringement carried a punishment for the transgressors. The Venetian State Law also takes into account the infringement by equivalents by stating that it shall be forbidden to create objects similar to those registered (which imitates and resembles the invention).

Over the centuries, Italian legislation has evolved with numerous law decrees and regulations. On February 10, 2005 the Legislative Decree n. 30 introduced the Italian Code of Industrial Property. Its purpose was not only to simplify and modernize the subject matter by gathering under one single text the existing IP laws, but also to harmonize the national regulations with Community law and international conventions. In March 2010, the Implementing Regulation of the Industrial Property Code was published to define and simplify the procedures for filing applications, appeals, deeds and petitions specified by the Code itself. Subsequently, in August 2010, Italian Legislative Decree n. 131 was issued with the scope of updating the Industrial Property Code by creating a single legal text with all the laws and provisions issued after the Code came into force

These legal texts provide fundamental support from the Government to increase Italian competitiveness, reinforce the value of IP Rights and incentivize filings at a national, European and international level. The aim of the Industrial Property Code, updated with the reform of 2010, is not only limited to reorganizing and modernizing the national IP laws, but it has the broader objective of promoting the recovery of the Italian economy by rewarding innovators in the context of a more global competition.

As a result of the above, and well aware of the fact that globalization has led to an increasing integration and interdependence of the market, LES Italy has decided to translate the Italian Code of Industrial Property into English to allow a worldwide dissemination and understanding of the national IP laws. The aim of this initiative is to contribute to our Country’s development. It will not only be useful for Italian companies doing business abroad but also for foreign companies wishing to invest in Italy.



CAMERA DI  
COMMERCIO  
MILANO



CAMERA DI COMMERCIO  
INDUSTRIA ARTIGIANATO E AGRICOLTURA  
DI TORINO

I wish to thank the Chambers of Commerce, Industry, Handicraft and Agriculture of Milan and Turin which have always been at the forefront in promoting the development of enterprises through the correct implementation of IP rights. A special thanks goes to all the members of the Executive Committee of the LES Italy, in particular to Mario Traverso, Marco Venturello and Luciano Daffarra for their support and valuable contribution to the project.

I hope that this initiative will have a strong impact on the development of our Country's economy which has always been home to great inventors, but only to small businesses. Industrial and Intellectual Property is the "real engine" of modern economy, the so-called "Knowledge Economy". Patents, trademarks, designs and other IP rights are indeed a driver of success which must be protected and promoted at an international level. The final goal should be not only to find new markets for products, but also to finance a company's growth.

Roberto Dini

President of LES Italy



CAMERA DI  
COMMERCIO  
MILANO



CAMERA DI COMMERCIO  
INDUSTRIA ARTIGIANATO E AGRICOLTURA  
DI TORINO

## SCIENTIFIC COMMITTEE

Giulio Bonadio

Cristiana Brega

Federica Brotto

Giovanni Casucci

Claudio Costa

Gianfranco Crespi

Luciano Daffarra

Roberto Dini

Giovanni Antonio Grippiotti

Monica Nannarelli

Bruno Muraca

Gian Antonio Pancot

Rinaldo Plebani

Luigi Saglietti

Barbara Speranza

Mario Traverso

Marco Venturello

Andrea Vestita



Licensing  
Executives  
Society  
Italy



CAMERA DI  
COMMERCIO  
MILANO



CAMERA DI COMMERCIO  
INDUSTRIA ARTIGIANATO E AGRICOLTURA  
DI TORINO

LEGISLATIVE DECREE NO. 30 OF 10 FEBRUARY 2005.<sup>(1)</sup>

**INDUSTRIAL PROPERTY CODE, PURSUANT TO ARTICLE 15 OF LAW NO. 273 OF 12 DECEMBER 2002.<sup>(2) (3)</sup>**

(1) Published in Official Gazette No. 52 of 4 March 2005, Ordinary Supplement.

(2) For the Implementation Regulation of the Industrial Property Code see Ministerial Decree No. 33 of 13 January 2010.

(3) Paragraph 1 of Article 127, Legislative Decree No. 131 of 13 August 2010, established that in this act any reference to the Ministry or Minister of Productive Activities is intended to refer to the Ministry or Minister of Economic Development. Paragraph 2 of the cited Article 127 established that in this act, any reference to the Ministry or Minister of Agricultural and Forestry Policies is intended to refer to the Ministry or Minister of Agricultural, Food and Forestry Policies.

THE PRESIDENT OF THE REPUBLIC

Considering Articles 76 and 87 of the Constitution;

Considering Law No. 273 of 12 December 2002, containing measures to promote private initiative and the increase of competition, as amended by Article 2(8) of Law No. 186 of 27 July 2004, converted into law, with amendments, by Law Decree No. 136 of 28 May 2004, as further amended by Article 2 of Law No. 306 of 27 December 2004, converted into law, with amendments, by Law Decree No. 266 of 9 November 2004, and in particular Article 15, containing the delegation to the Government for the reorganization of the provisions concerning industrial property;

Considering Article 14 of Law No. 400 of 23 August 1988, containing regulations of Government activities and of the Presidency of the Council of Ministers;

Considering Royal Decree No. 1127 of 29 June 1939;

Considering Royal Decree No. 244 of 5 February 1940;

Considering Royal Decree No. 1411 of 25 August 1940;

Considering Royal Decree No. 1354 of 31 October 1941;

Considering Royal Decree No. 929 of 21 June 1942;

Considering Presidential Decree No. 795 of 8 June 1948;

Considering Presidential Decree No. 540 of 30 June 1972;

Considering Presidential Decree No. 974 of 12 August 1975;

Considering Presidential Decree No. 32 of 8 January 1979;

Considering Presidential Decree No. 338 of 22 June 1979;

Considering Law No. 194 of 3 May 1985;

Considering Law No. 620 of 14 October 1985;

Considering Law No. 60 of 14 February 1987;



Licensing  
Executives  
Society  
Italy



CAMERA DI  
COMMERCIO  
MILANO



CAMERA DI COMMERCIO  
INDUSTRIA ARTIGIANATO E AGRICOLTURA  
DI TORINO

Considering Law No. 70 of 21 February 1989;

Considering Law No. 349 of 19 October 1991;

Considering Presidential Decree No. 595 of 1 December 1993;

Considering Presidential Decree No. 360 of 18 April 1994;

Considering Presidential Decree No. 391 of 18 April 1994;

Considering Law No. 890 of 21 December 1984;

Considering Legislative Decree No. 164 of 12 April 2001;

Considering paragraphs 8, 8-*bis*, 8-*ter* and 8-*quater* of Article 3 of Law Decree No. 63 of 15 April 2002, converted into law, with amendments, by Law No. 112 of 15 June 2002;

Considering the Ministerial Decree of 17 October 2002 of the Ministry of Productive Activities, published in Official Gazette No. 253 of 28 October 2002;

Considering the preliminary resolution of the Council of Ministers, adopted in the meeting of 10 September 2004;

Having received the opinion of the Council of State, expressed in the General Meeting of 25 October 2004;

Having received the opinion of the Joint Conference, pursuant to Article 8 of Legislative Decree No. 281 of 28 August 1997, expressed in the session of 28 October 2004;

Having received the opinions of the Commission of the Chamber of Deputies, expressed on 22 December 2004, and of the Senate of the Republic, expressed on 21 December 2004;

Considering the resolution of the Council of Ministers, adopted in the meeting of 23 December 2004;

On proposal of the Ministry of Productive Activities, in concert with the Ministers of Justice, Economy and Finance, Foreign Affairs and the Public Function;

Hereby issues the following Legislative Decree:

## TITLE I

### General Provisions and Basic Principles

#### 1. Industrial property rights.

1. For the purposes of this Code, the expression “industrial property” includes trademarks and other distinctive marks, geographical indications, designations of origin, designs and models, inventions, utility models, topographies of semiconductor products, confidential business information and new plant varieties.<sup>(4)</sup>

---

<sup>(4)</sup> Paragraph as amended by paragraph 1 of Legislative Decree No. 131 of 13 August 2010.

#### 2. Establishment and acquisition of rights.

1. Industrial property rights are acquired through patenting, registration or the other methods provided for by this Code. Patenting and registration give rise to industrial property titles.

2. Inventions, utility models and new plant varieties may be patented.

3. Trademarks, designs and models, and topographies of semiconductor products may be registered.<sup>(5)</sup>

4. When the requirements of law are met, distinctive marks other than the registered trademark, confidential business information, geographical indications and designations of origin are protected.

5. The administrative activity of patenting and registration represents a declaratory examination and makes the rights subject to a special regime of nullity and revocation based on the provisions contained in this Code.

---

<sup>(5)</sup> Paragraph as amended by paragraph 1 of Article 2, Legislative Decree No. 131 of 13 August 2010.

#### 3. Treatment of foreigners.

1. Nationals of each Country that is a party to the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, or the World Trade Organization, and nationals of Countries not parties to those Conventions, but who are domiciled or have an actual industrial or commercial establishment in the territory of a Country that is a party to the Paris Convention for the Protection of Industrial Property, shall be accorded, for the matters under this Code, the same treatment accorded to nationals of Italy. In matters concerning new plant varieties, the treatment accorded to Italian nationals shall be accorded to nationals of a Country that is a party to the International Union for the Protection of New Varieties of Plants (UPOV), Geneva text of 19 March 1991, ratified by Law No. 110 of 23 March 1998. Concerning topographies of semiconductor products, the treatment accorded to Italian nationals shall be accorded to nationals of another Country only if the protection accorded by that Country to Italian nationals is analogous to that provided for by this Code.<sup>(6)</sup>

2. Nationals of Countries not parties to the Paris Union Convention for the Protection of Industrial Property, or the World Trade Organization, nor, as regards new plant varieties, the International Union for the Protection of New Varieties of Plants, with respect to the matters in this Code, shall be accorded the treatment accorded to



Italian nationals, if the Country to which the national belongs accords Italian nationals reciprocal treatment.

3. All of the benefits that the international conventions signed and ratified by Italy accord to foreigners in the territory of the Country, for the matters under this Code, are understood to be automatically extended to Italian nationals.<sup>(7)</sup>

4. The right pursuant to the international conventions to obtain the registration in Italy of a trademark previously registered abroad, which is referenced in the application for registration, lies with the owner of the trademark abroad, or his/her successor in title.

5. Legal entities of corresponding nationalities are considered equivalent to nationals.

---

<sup>(6)</sup> Paragraph as amended by paragraph 1 of Article 3, Legislative Decree No. 131 of 13 August 2010.

<sup>(7)</sup> Paragraph as amended by paragraph 2 of Article 3, Legislative Decree No. 131 of 13 August 2010.

#### **4. Priority.**

1. A person who has properly filed, in or for a Country party to an international convention ratified by Italy that recognizes the right of priority, a request aimed at obtaining an industrial property title, or his/her successor in title, shall benefit from a right of priority starting at the time of the first application to file a request for a patent application for an invention, utility model, patent on a new plant variety, or registration of a design or model and registration of a trademark, in accordance with the provisions of Article 4 of the Paris Union Convention.

2. The period of priority is twelve months for patents for inventions and utility models and plant varieties, and six months for designs or models and trademarks.

3. Any filing with the value of a regular national filing, i.e. that is suitable to establish the date on which the first application was filed, pursuant to the national legislation of the Country in which it was made, or of bilateral or multilateral agreements, are acknowledged as suitable to give rise to the right of priority, whatever subsequently happens with that request.

#### **5. Exhaustion.**

1. The exclusive rights attributed by this Code to the owner of an industrial property right are exhausted once the products protected by an industrial property right have been put on the market by the owner or with his consent in the territory of the Country or in the territory of a Member State of the European Union or the European Economic Area.

2. This limitation on the powers of the owner does not however apply when there are legitimate grounds for the owner himself to oppose further marketing of the goods, in particular when the condition of the same has been modified or altered after being put on the market.<sup>(8)</sup>

3. The exclusive rights attributed by the patent on a protected variety, on varieties essentially derived from the protected variety when the former is not, in turn, an essentially derived variety, on varieties that are not clearly distinguished from the protected variety and on varieties whose production requires the repeated use of the protected variety, do not extend to acts regarding:

a) plant reproduction or multiplication material, whatever its form may be;

b) the product of the harvest, including whole plants and their parts when that material or product has been

transferred or sold by the same inventor and with his consent in the territory of the Country or of a Member State of the European Union or the European Economic Area, unless it involves acts that imply a new reproduction or multiplication of the protected variety or an exportation of the material of the variety itself that allows for reproducing it in a Country that does not protect that variety, or of the plant species to which it belongs, unless the exported material is for the purpose of final consumption.<sup>(9)</sup>

---

(8) Paragraph as amended by paragraph 1 of Article 4, Legislative Decree No. 131 of 13 August 2010.

(9) Paragraph as substituted by paragraph 2 of Article 4, Legislative Decree No. 131 of 13 August 2010.

## 6. Joint ownership.

1. If an industrial property right belongs to multiple persons, the relevant rights are regulated, except as established by conventions with rules to the contrary, by the provisions of the Civil Code relating to joint ownership to the extent they are compatible.

1-*bis*. In the case of a right belonging to multiple persons, the presentation of the patent or registration request, the execution of the patenting or registration procedure, the presentation of the renewal request, where necessary, the payment of the fees for maintenance, the presentation of the translation into the Italian language of the claims of an application for a European patent or the text of the European patent granted or maintained in a modified form or limited to the other procedures before the Italian Patent and Trademark Office, may be carried out by each of the persons on behalf of all of them.<sup>(10)</sup>

---

(10) Paragraph added by paragraph 1 of Article 5, Legislative Decree No. 131 of 13 August 2010.

## TITLE II

### Provisions Relating to the Existence, Scope and Exercise of Industrial Property Rights

#### Section I

#### Trademarks

#### **7. Subject matter of registration.**

1. A trademark may consist of any signs capable of being represented graphically, and in particular words, including personal names, designs, letters, numerals, sounds, the shape of goods or of their packaging, the color combinations or tones, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

#### **8. Portraits of persons, names and well known signs.**

1. Portraits of persons shall not be registered as trademarks without the persons' consent, and after their death, without the consent of the spouse and children; if there are no such relatives or after their death, of the parents and other ancestors, and if there are no such ancestors or after their death, of the relatives up to and including the fourth degree.

2. The names of persons other than those who apply for registration may be registered as trademarks, provided that their use is not such as to harm the reputation, creditworthiness or dignity of those who have the right to bear those names. The Italian Patent and Trademark Office shall however have the right to make the registration conditional upon the consent as set forth in paragraph 1. In any event, the registration shall not prevent persons having the right to the name to use it in the business chosen by them, if the requirements are met as set forth in Article 21(1).<sup>(11)</sup>

3. If well known, the following may be registered or used as trademarks only by the qualified person, or with the consent of the same, or of the persons indicated in paragraph 1: names of persons, signs used in the fields of art, literature, science, politics or sports, the designations and abbreviations of events and those of entities and associations without economic purposes, as well as the characteristic emblems of the same.<sup>(12)</sup>

---

<sup>(11)</sup> Paragraph as amended by paragraph 1 of Article 6, Legislative Decree No. 131 of 13 August 2010.

<sup>(12)</sup> Paragraph as amended by paragraph 2 of Article 6, Legislative Decree No. 131 of 13 August 2010.

#### **9. Shape trademarks.**

1. Signs shall not be registered as trademarks if they consist solely of the shape dictated by the nature of the product, the shape of the product necessary to obtain a technical result, or the shape that gives substantial value to the product.

## 10. Coats of arms.

1. Coats of arms and other signs considered in existing international conventions on the subject matter, in the cases and at the conditions mentioned therein, as well as the signs containing symbols, emblems and coats of arms which are in the public interest, shall not be registered as trademarks, unless the consent of the appropriate authorities to their registration has been given.

2. If a trademark contains words, figures or signs with political meaning or highly symbolic value, or containing heraldic elements, before registration, the Italian Patent and Trademark Office shall send the copy of the trademark and whatever else may be necessary to the relevant or appropriate public agencies, to receive their opinion, in accordance with the provisions of paragraph 4.

3. The Italian Patent and Trademark Office may act in accordance with the provisions of paragraph 2 in all cases where there is a doubt that the trademark could be contrary to the law, public policy or accepted principles of morality.<sup>(13)</sup>

4. If the relevant or appropriate agency, as per paragraphs 2 and 3, expresses an opinion against the registration of the trademark, the Italian Patent and Trademark Office shall reject the application.

---

<sup>(13)</sup> paragraph as amended by paragraph 1 of Article 7, Legislative Decree No. 131 of 13 August 2010.

## 11. Collective marks.

1. Persons whose function is to guarantee the origin, nature or quality of specific goods or services, may obtain the registration for specific trademarks as collective marks and may grant the use of the marks to producers or traders.

2. The regulations concerning the use of collective marks, the controls and the respective sanctions, must be attached to the application for registration; modifications to the regulations must be communicated by the owners to the Italian Patent and Trademark Office to 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.

4. Notwithstanding the provisions of Article 13(1), signs or indications that in trade may serve to designate the geographical origin of the goods or services may constitute collective marks. In that case, however, the Italian Patent and Trademark Office may refuse the registration, by a grounded decision, when the marks requested could create situations of unjustified privilege or however cause harm to the development of analogous initiatives in the same region. The Italian Patent and Trademark Office may request the opinion of the interested and competent public agencies, categories or bodies. The successful registration of a collective mark consisting of a geographical name does not authorize the owner to prohibit third parties from using that name in trade, provided that the use is consistent with the principles of professional fairness.<sup>(14)</sup>

5. Collective marks are subject to all other provisions of this Code to the extent that they do not contrast with their nature.

---

<sup>(14)</sup> Paragraph as amended by paragraph 1 of Article 8, Legislative Decree No. 131 of 13 August 2010.

## 12. Novelty.

1. Signs shall not be registered as trademarks if as of the date of filing of the application any of the following applies:

a) they are identical with or similar to a sign already known as a trademark or a distinctive sign of goods or services manufactured, put on the market or provided by others for goods or services that are identical or similar, if due to the identity or similarity between the marks and the identity or similarity between the goods or services there exists a likelihood of confusion on the part of the public, that can also consist of a likelihood of association of the two signs. A trademark is also considered to be well known pursuant to Article 6-*bis* of the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, if it is well known by the relevant public, including due to a reputation acquired in the Country through the promotion of the trademark. The previous use of the sign, when it does not lead to a reputation, or a purely local reputation, does not cause the lack of novelty, but a third party previous user may continue to use the trademark, also for advertising purposes, within the limits of local circulation, despite the registration of the trademark itself. The previous use of the sign by the applicant or his assignor is not an obstacle to registration;

b) they are identical or similar to a sign already known as a company name, business designation or name, sign or domain name used in economic activity, or another distinctive sign adopted by others, if due to the identity or similarity between the signs and identity or similarity between the business activity carried out by the same and the goods and services for which the trademark is registered, there exists a likelihood of confusion on the part of the public, that can also consist of a likelihood of association between the two signs. The previous use of the sign, when it does not lead to a reputation, or a purely local reputation, does not cause a lack of novelty. The previous use of the mark by the requesting party or his assignor is not an obstacle to registration;

c) they are identical or similar to a trademark already registered by others in the Country or having effect in the Country following an application filed on an earlier date or having effect from an earlier date due to a right of priority or a valid claim of seniority for identical goods or services;

d) they are identical or similar to a trademark already registered by others in the Country or having effect in the Country, following an application filed on an earlier date or having effect as from an earlier date due to a right of priority or a valid claim of seniority for goods or services that are identical or similar, if due to the identity or similarity between the signs and the identity or similarity between the goods or services there exists a likelihood of confusion on the part of the public, that can also consist of a likelihood of association between the two signs;

e) they are identical or similar to a trademark already registered by others in the Country or having effect in the Country, following an application filed on an earlier date or having effect from an earlier date due to a right of priority or a valid claim of seniority for goods or services even if not similar, when the earlier trademark has a reputation in the Community, in case of a Community trademark, or in the Country, and where the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or the reputation of the earlier trademark;

f) they are identical or similar to a trademark already well known pursuant to Article 6-*bis* of the Paris Convention for the Protection of Industrial Property, for goods or services even that are not similar, when the conditions set forth in letter e) are present.

2. In the cases set forth in letters c), d) and e), an earlier trademark does not cause lack of novelty if it has expired more than two years before or if it is a collective mark or can be considered to be revoked for non-use pursuant to Article 24 at the time the application or claim of nullity is filed.

3. For the purposes identified in paragraph 1, letters c), d) and e), earlier applications are considered as equal to earlier registered trademarks, subject to their subsequent registration.<sup>(15)</sup>

---

(15) Article as substituted by paragraph 1 of Article 9, Legislative Decree No. 131 of 13 August 2010.

### 13. Distinctive character.

1. Signs lacking a distinctive character shall not be registered as trademarks. These include:

a) those consisting only of signs that have become commonly used in current language or in the common practices of the trade;

b) those consisting exclusively of general designations of goods or services or descriptive indications that refer to them, such as signs that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the good or of the rendering of the service or other characteristics of the good or service.<sup>(16)</sup>

2. Notwithstanding paragraph 1, signs that have acquired a distinctive character prior to the application for registration, due to the use that has been made of them, may be registered as trademarks.<sup>(17)</sup>

3. A trademark shall not be declared or considered to be null if prior to the filing of the application or claim of nullity, the sign referred to, due to the use that has been made of the same, has acquired a distinctive character.

4. A trademark is revoked if, due to the activity or lack thereof of its owner, it has become a generic designation of the product or service in trade or has however lost its distinctive character.<sup>(18)</sup>

---

(16) Paragraph as substituted by paragraph 1 of Article 10, Legislative Decree No. 131 of 13 August 2010.

(17) Paragraph as amended by paragraph 2 of Article 10, Legislative Decree No. 131 of 13 August 2010.

(18) Paragraph as amended by paragraph 3 of Article 10, Legislative Decree No. 131 of 13 August 2010.

### 14. Lawfulness and third-party rights.<sup>(19)</sup>

1. The following shall not be registered as trademarks:

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

b) signs that can mislead the public, in particular as to the geographical origin, nature or quality of the goods or services;

c) signs whose use would represent an infringement of another party's copyright or industrial property rights, or of other third party's exclusive rights.

2. A trademark is revoked:

a) if it has become suitable to mislead the public, in particular as to the nature, quality or origin of the goods or services, due to the manner and context in which it is used by the owner or with his consent, for the goods or services for which it is registered;

b) if it has become contrary to the law, public policy or accepted principles of morality;



Licensing  
Executives  
Society  
Italy



CAMERA DI  
COMMERCIO  
MILANO



CAMERA DI COMMERCIO  
INDUSTRIA ARTIGIANATO E AGRICOLTURA  
DI TORINO

c) due to omission by the owner of the controls provided for by regulatory provisions concerning the use of collective marks.

---

(19) Heading as substituted by paragraph 1 of Article 11, Legislative Decree No. 131 of 13 August 2010.

## **15. Effects of registration.**

1. The exclusive rights set forth in this Code are conferred by way of registration.
2. The effects of the first registration begin as of the date the application is filed. For renewals, the effects begin on the date of expiration of the previous registration.
3. Save as provided for in Article 20, paragraph 1, letter c), the effects of registration are limited to the goods and services indicated in the registration itself, and to similar goods or services.
4. Registration has a duration of ten years starting from the date in which the application is filed, unless the owner surrenders his rights.
5. Such a surrender takes effect when it is recorded in the trademarks' register, notification of which must be given in the Official Bulletin.

## **16. Renewal.**

1. A registration may be renewed for the same earlier trademark, with regard to the same type of goods or services in accordance with the international classification of goods and services resulting from the Nice Agreement, Geneva text of 13 May 1977, ratified by Law No. 243 of 27 April 1982.
2. Renewal is made for periods of ten years.
3. The renewal of the registration of a trademark that has been transferred for a part of the goods or services is made separately by the respective owners.
4. The starting date and duration of the effects of registration remain unchanged for trademarks registered with the World Intellectual Property Organization of Geneva.

## **17. International registration.**

1. For the registration of trademarks with the World Intellectual Property Organization (WIPO), the provisions in force pursuant to international conventions shall remain valid.
2. International trademarks registered with the World Intellectual Property Organization (WIPO) of Geneva, based on the Madrid Agreement Concerning the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, and the respective Protocol, adopted in Madrid on 27 June 1989, ratified by Law No. 169 of 12 March 1996, containing the designation of Italy as the country in which protection is requested, must meet the requirements set for national trademarks by this Code.
3. The Italian Patent and Trademark Office carries out the examination of the international trademarks that designate Italy in compliance with the applicable provisions of the applications for national trademarks.



## 18. Temporary protection.

1. Within the limits and at the conditions indicated in paragraph 2, the Ministry of Productive Activities may grant temporary protection to new trademarks affixed on products or materials concerning the rendering of services that appear in national or international exhibitions, that are official or are officially recognized, held in the territory of the Country or in a foreign Country that accords reciprocity.
2. Temporary protection dates the priority of the registration, in favor of the owner or his successor in title, to the date of delivery of the product or material relating to the provision of the service for the exhibition, and has effect provided that the application for registration is filed within six months of the date of delivery, and in any event, not beyond six months from the date of opening of the exhibition.
3. In the event of an exhibition held in a foreign Country, if a shorter term is established there, the application for registration must be filed by that deadline.
4. Among trademarks that are identical or similar for identical or similar goods or services presented for exhibition on the same day, the priority is given to the mark for which the application for registration was filed first.
5. The dates in paragraphs 2, 3 and 4 must be indicated by the interested party and mentioned in the certificate of registration, upon verification by the Italian Patent and Trademark Office.

## 19. Right to registration.

1. A trademark may be registered by someone who uses it or proposes to use it, in the manufacture or trade of goods or in the provision of services for one's undertaking or undertakings under his control, or that make use of it with his consent.
2. A trademark may not be registered if the application has been made in bad faith.
3. Agencies of the Country, regions, provinces and municipalities may also obtain the registration of trademarks, including as regards distinctive graphic elements taken from the cultural, historical, architectural or environmental heritage of their territories; in the latter case, the revenue resulting from the exploitation of the trademark for business purposes, including that carried out through the grant of licenses and for merchandising activities, must be used for financing institutional activities or covering any prior deficits of the entity.<sup>(20)</sup>

---

<sup>(20)</sup>Paragraph as substituted by paragraph 1 of Article 12, Legislative Decree No. 131 of 13 August 2010.

## 20. Rights conferred by registration.

1. The rights of the owner of the registered trademark consist of the authority to make exclusive use of the trademark. The owner has the right to prevent third parties from using in the course of trade, without his consent:

a) any sign which is identical to the trademark for goods or services which are identical to those for which the trademark is registered;

b) any sign that is identical or similar to the registered trademark, for goods or services that are identical or similar, where due to the identity or similarity between the goods or services, there exists likelihood of



confusion on the part of the public, that can also consist of a likelihood of association of the two signs;

c) any sign which is identical with or similar to the registered trademark in relation to goods or services which are not similar, where the registered trademark has a reputation in the Country and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

2. In the cases mentioned in paragraph 1, the owner of the trademark may in particular prohibit third parties from affixing the sign on their products or packages; offering the goods, putting them on the market or stocking them for those purposes, or offering or supplying services under that sign; importing or exporting the goods thereunder; using the sign on business papers and in advertising.

3. The business person may affix his own mark to the goods he puts on the market, but he may not delete the trademark of the manufacturer or business person from whom he received the goods or wares.

## 21. Limitations of trademark rights.

1. The rights resulting from registered trademarks do not permit the owner to prohibit third parties from using the following in economic activity, provided that the use is consistent with the principles of professional propriety:

a) their name and address;

b) indications relating to the species, quality, quantity, intended use, value, geographical origin, period of manufacture of the good or provision of the service and other characteristics of the good or service;

c) the trademark if it is necessary to indicate the intended use of a good or service, in particular as accessories or replacement parts.<sup>(21)</sup>

2. It is not permitted to use the trademark in a manner contrary to law, nor, specifically, in such a manner as to generate a risk of confusion on the market with other signs known as distinctive of enterprises, goods or services of others, or to however mislead the public, in particular concerning the nature, quality or origin of the products or services, due to the manner and context in which it is used, or to harm another's copyright rights, industrial property rights, or other exclusive rights of third parties.

3. No one may use a registered trademark after the respective registration has been declared null, when the cause of nullity makes use of the trademark unlawful.

---

<sup>(21)</sup> Paragraph as substituted by paragraph 1 of Article 13, Legislative Decree No. 131 of 13 August 2010.

## 22. Unity of distinctive signs.

1. It is prohibited to adopt as an undertaking, company designation or name, sign or domain name of a site used in economic activity or another distinctive sign, a trademark that is identical with or similar to another trademark, where due to the identity or similarity between the business activities of the owners of those signs and the goods or services for which the mark is adopted, there exists a likelihood of confusion on the part of the public, that can also consist of a likelihood of association between the two signs.<sup>(22)</sup>

2. The prohibition in paragraph 1 extends to the adoption as an undertaking, company designation or name, sign or domain name of a site used in economic activity or another distinctive sign of a trademark identical or similar to a trademark registered even for goods and services that may not be similar, that has a reputation in the Country if the use of the sign without just cause allows for obtaining an undue advantage from the

distinctive character or the reputation of the mark or causes harm to the same.<sup>(23)</sup>

---

<sup>(22)</sup> Paragraph as amended by paragraph 1 of Article 14, Legislative Decree No. 131 of 13 August 2010.

<sup>(23)</sup> Paragraph as amended by paragraph 1 of Article 14, Legislative Decree No. 131 of 13 August 2010.

### 23. Transfer of trademark.

1. A trademark may be transferred in respect of all or part of the goods or services for which it was registered.
2. A trademark may be licensed, also on a non-exclusive basis, for all or part of the goods or services for which it was registered and for all or part of the territory of the Country, on provided that, in the case of a non-exclusive license, the licensee expressly agrees to use the trademark to identify goods or services identical with the corresponding goods and services put on the market or provided in the territory of the Country with the same trademark by the owner or by other licensees.
3. The owner of the trademark may invoke the right to the exclusive use of the trademark against a licensee who violates the provision of the license agreement as to the duration, the manner of use of the trademark, the nature of the goods or services for which the license is granted, the territory in which the trademark may be used or the quality of the goods manufactured and the services provided by the licensee.
4. In any event, the transfer and licensing of the trademark must not be cause for misleading the public as to those characteristics of the goods and services that are essential in the public's appreciation for the same.

### 24. Use of trademark.

1. On penalty of revocation, a trademark must be actually used by the owner or with his consent, for the goods and services in respect of which it is registered, within five years following registration, and such use must not be discontinued for a continuous period of five years, unless there are proper reasons for non-use.

*1-bis.* In the event of an international trademark designating Italy and registered pursuant to the Madrid Agreement Concerning the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, or the respective Protocol of 27 June 1989, ratified by Law No. 169 of 12 March 1996, the term indicated in paragraph 1 starts on the date on which the deadline expires for the Italian Patent and Trademark Office to formulate the provisional refusal pursuant to Article 171, or if the registration has been subject to provisional refusal, from the date on which the Italian Patent and Trademark Office confirms the protection in Italy of the international registration in a final manner.<sup>(24)</sup>

2. For the purposes of this article, the use of a trademark in a modified form that does not alter its distinctive character, as well as affixing a trademark on products or their packages in a Country for the purposes of exporting them, are considered identical to the use of a mark.
3. Except in the case of rights purchased on the trademark by third parties with filing or use, revocation shall not be claimed if between the expiration of the five-year period of non-use and the filing of the application or claim for revocation the actual use of the mark has begun or resumed. However, if the owner makes preparations for the initiation or resumption of the use of the trademark only after learning that an application or claim for revocation is about to be filed, that initiation or resumption will not be taken into consideration if not made at least three months before the filing of the application or claim for revocation; in addition, that period shall only be valid if it passes after the expiration of the five-year period of non-use.
4. Moreover, revocation for non-use shall also not be valid if the owner of the unused trademark is at the same time the owner of another or other similar trademarks that are valid at the time, and he makes actual



use of at least one of them to distinguish those goods or services.

---

(24) Paragraph added by paragraph 1 of Article 15, Legislative Decree No. 131 of 13 August 2010.

## 25. Nullity.

1. A trademark shall be considered null:

- a) if it lacks one of the requirements set forth in Article 7 or if one of the grounds for refusal established by Article 12 is present;
- b) if it conflicts with the provisions set forth in Articles 9, 10, 13, 14(1), and 19(2);
- c) if it conflicts with the provisions set forth in Article 8;
- d) in the case identified in Article 118(3)(b).

## 26. Revocation.

1. A trademark shall be revoked:

- a) due to genericization pursuant to Article 13(4);
- b) due to its becoming unlawful pursuant to Article 14(2);
- c) due to non-use pursuant to Article 24.

## 27. Partial revocation and nullity.

1. If the reasons for revocation or nullity of a trademark are present only for a part of the goods or services for which the mark is registered, the revocation or nullity shall regard only that part of the goods or services.

## 28. Acquiescence.

1. The owner of an earlier trademark pursuant to Article 12 and the owner of a right to previous use that is well known not merely at a local level, who during five consecutive years has been aware of and tolerated the use of an identical or similar later registered trademark, may not request a declaration of nullity of the later trademark or oppose the use of the same for the goods or services in relation to which that trademark was used based on his own earlier trademark or previous use, unless registration of the later trademark was applied for in bad faith. The owner of the later trademark may not oppose the use of the earlier trademark or the continuation of the previous use.

2. The rules set forth in paragraph 1 shall also apply to cases of trademarks registered in violation of Articles 8 and 14, paragraph 1, letter c).

## Section II

### Geographical Indications

#### **29. Subject matter of protection.**

1. Protection is granted to geographical indications and designations of origin identifying a country, region or locality, when adopted to designate a product originating from that place and whose qualities, reputation or characteristics are due exclusively or essentially to the geographical environment of its origin, including natural and human factors and traditions.

#### **30. Protection.**

1. Subject to the provisions concerning unfair competition, and international conventions on the subject, and save the rights to trademarks previously acquired in good faith, the use of geographical indications and designations of origin is prohibited, when it is eligible to mislead the public and entails undue exploitation of the reputation of the protected designation, as is the use of any means of designation or presentation of a product that indicates or suggests that the same product originates from a locality different than its true place of origin, or that the product has qualities that belong to the products originating from a locality designated by a geographical indication.<sup>(25)</sup>

2. The protection indicated in paragraph 1 does not allow to prohibit third parties from using their own name or the name of their assignor in their business activity, unless that name is used in such a manner so as to mislead the public.

---

<sup>(25)</sup> Paragraph as amended by paragraph 1 of Article 16, Legislative Decree No. 131 of 13 August 2010.

## Section III

### Designs and Models

#### **31. Subject matter of registration.**

1. Registrations as designs and models may be granted to the appearance of the whole or a part of the product, resulting in particular from the features of the lines, contours, colors, shape, texture or materials of the product or its ornamentation, provided that the same are new and have an individual character.

2. Product means any industrial or handicraft item, including inter alia, the components that must be assembled to form a complex product, packaging, presentations, graphic symbols and typographic fonts, excluding computer programs.

3. Complex product means a product formed by multiple components that can be replaced, allowing disassembly and re-assembly of the product.

#### **32. Novelty.<sup>(26)</sup>**

1. A design or model shall be considered to be new if no identical design or model has been made available to the public before the date of filing of the application for registration, or, if priority is claimed, prior to the date

of the same. Designs or models are considered identical when their features differ only in immaterial details.

---

(26) Heading as substituted by paragraph 1 of Article 17, Legislative Decree No. 131 of 13 August 2010.

### 33. Individual character.

1. A design or model shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on that user by any design or model that has been made available to the public prior to the date of filing of the application for registration, or if priority is claimed, prior to the date of the same.

2. In assessing the individual character as stated in paragraph 1, consideration shall be given to the degree of freedom of which the designer benefited in realizing the design or model.

### 33-bis. Lawfulness.

1. A design or model that is contrary to public policy or accepted principles of morality shall not be registered; a design or model shall not be considered contrary to public policy or accepted principles of morality only because it is prohibited by a provision of law or administrative regulations.

2. A design or model shall not be registered if it constitutes the undue utilization of one of the elements listed in Article 6-ter of the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, or of signs, emblems and coats of arms different from those contemplated by that article and that are of particular public interest in the Country.<sup>(27)</sup>

---

(27) Article added by paragraph 1 of Article 18, Legislative Decree No. 131 of 13 August 2010.

### 34. Disclosure.

1. For the purposes of applying Articles 32 and 33, a design or model shall be deemed to have been made available to the public, if it has been made available to the public following registration or otherwise, or if it has been displayed, put on the market or otherwise made public, unless those events could not reasonably have become known to the circles specialized in the sector concerned, operating within the Community, in the normal course of business, before the date of filing of the application for registration, or if priority is disclaimed, before the date of the same.

2. A design or model is not considered to have been made available to the public for the sole reason that it has been disclosed to a third party under an explicit or implicit undertaking of confidentiality.

3. For the purposes of applying Articles 32 and 33, a design or model shall not be considered to have been made available to the public if it has been disclosed by the designer or his successor in title or by any third party as a result of information provided or action taken by the designer or his successor in title during the twelve months period prior to the date of filing of the application for registration, or if a priority is claimed, in the twelve months prior to the date of the same.

4. For the purposes of applying Articles 32 and 33, disclosure shall also not be considered to include the fact that a design or model has been made available to the public during the twelve months period prior to the date of filing of the application or the date of priority, as a direct or indirect result of an abuse committed with

respect to the designer or his successor in title.

5. [Disclosure that takes place during exhibitions that are official or officially recognized pursuant to the Convention Concerning International Exhibitions, signed in Paris on 22 November 1928, and subsequent amendments, shall also not be taken into consideration].<sup>(28)</sup>

---

<sup>(28)</sup> Substituted by paragraph 1 of Article 19, Legislative Decree No. 131 of 13 August 2010.

### **35. Complex product.**

1. A design or model applied to or incorporated in the component of a complex product complies with the requirements of novelty and individual character only:

- a) if the component, once incorporated in the complex product, remains visible during normal utilization, and thus during utilization by the final consumer, excluding maintenance, servicing and repair works; and
- b) if the visible features of the component fulfill per se the requirements of novelty and individual character.

### **36. Technical function.**

1. Features of appearance of a product shall not be registered as designs or models if they are solely dictated by the technical function of the product itself.

2. Features of appearance of a product shall not be registered as designs or models if they must necessarily be reproduced in their exact shapes and dimensions to permit the product in which the design or model is incorporated or to which it is applied to be joined or connected mechanically with another product, or to be incorporated into it or around or in contact with it, so that either product can perform its function. However, designs or models may be registered if they comply with the requirements of novelty and individual character when they have the purpose of allowing the union or multiple connection of interchangeable products in a modular system.<sup>(29)</sup>

---

<sup>(29)</sup> As amended by paragraph 1 of Article 20, Legislative Decree No. 131 of 13 August 2010.

### **37. Duration of protection.**

1. The registration of a design or model has a duration of five years starting from the date of filing of the application. The owner may obtain an extension of the duration for one or more periods of five years until a maximum of twenty-five years from the date of filing of the application for registration.

### **38. Right to registration and effects.**

1. Registration confers exclusive rights on the designs and models.
2. The author of the design or model and his successors in title have the right to registration.
3. Unless otherwise agreed upon, the right to registration of designs and models, that are created by

employees, to the extent that work is included among their duties, shall vest in the employer, without prejudice to the employee's right to be acknowledged as the author of the design or model and to have his name entered in the certificate of registration.

4. The effects of the registration start on the date on which the application with the related documentation is made available to the public.

5. The Italian Patent and Trademark Office makes the application for registration with the graphic reproductions or samples and any possible descriptions available to the public after filing, unless in the application the applicant has excluded such availability for a period that shall not be longer than thirty months from the date of filing or priority.

6. With respect to the persons who have been served by the applicant of the application with a reproduction of the design or model and any possible description, the effects of the registration start from the date of said service.

### 39. Multiple registration.

1. A single application may be used to request the registration of multiple designs and models, provided that they are to be implemented or incorporated in objects belonging to the same class of international classification of designs and models, pursuant to the provisions of the Locarno Agreement of 8 October 1968, as subsequently amended, ratified by Law No. 348 of 22 May 1974.<sup>(30)</sup>

2. Subject to paragraph 1 and Article 40, it is not possible to file an application concerning multiple registrations or a single registration for multiple designs and models. If the application is not admissible, the Italian Patent and Trademark Office will assign a deadline to the interested party to limit the application to the admissible part, with the right to file the respective number of applications for the remaining designs and models, that will also have the effective date of the first application.

3. The registration of multiple models or designs may be limited on request from the owner to one or more of them.

4. An application or registration concerning a design or model that does not meet the requirements of validity, on request from the owner, may be maintained in a modified form, if the Italian Patent and Trademark Office ascertains that in such a form the design or model preserves its identity. The modification may also follow a partial waiver by the owner or an entry on the certificate of registration of a judgment that declares the partial nullity of the registration.

---

<sup>(30)</sup> As amended by paragraph 1 of Article 21, Legislative Decree No. 131 of 13 August 2010.

### 40. Simultaneous registration.

1. If a design or model meets the requirements for registration and at the same time increases the utility of the object to which it refers, a simultaneous application may be made for a utility model and for the registration of a design or model, but the two types of protection may not be combined in a single title.

2. If the application for registration refers to an object whose shape or design confers it a new and individual character and at the same time increases its utility, the limitation procedure pursuant to Article 39(2) shall be applicable, subject to the necessary modifications.



#### 41. Rights conferred by the design or model.

1. The registration of a design or model confers the owner the exclusive right to use it and prevents third parties from using it without his consent.
2. Specifically, acts of utilization are constituted by making, offering, putting on the market, importation, exportation or the use of a product in which the design or model is incorporated or to which it is applied, or the stocking of that product for those purposes.
3. The exclusive rights conferred by the registration of a design or model extend to any design or model that does not produce on the informed user a different overall impression.
4. In assessing the scope of protection, the degree of freedom of the designer in developing the design or model shall be taken into consideration.

#### 42. Limitations of the right on design or model.<sup>(31)</sup>

1. The rights conferred following registration of a design or model do not extend to:
  - a) acts carried out privately and for non-commercial purposes;
  - b) acts carried out for experimental purposes;
  - c) reproductions necessary for citations or for didactic purposes, provided that they are compatible with fair trade practice, do not unduly prejudice the normal exploitation of the design or model, and the source is mentioned.
2. The exclusive rights conferred following registration of the design or model shall not be exercised in respect of:
  - a) the furnishing or equipment on ships and aircraft registered in a third country when these temporarily enter the territory of the Country;
  - b) the importation into the Country of spare parts and accessories for the repair of the crafts cited in letter a);
  - c) the execution of repairs on the cited crafts.

---

<sup>(31)</sup> Heading as substituted by paragraph 1 of Article 22, Legislative Decree No. 131 of 13 August 2010.

#### 43. Nullity.

1. A registration is null:
  - a) if the design or model cannot be registered pursuant to Articles 31, 32, 33, 34, 35 and 36;
  - b) if the design or model is contrary to public policy or accepted principles of morality; the design or model cannot be considered contrary to public policy or accepted principles of morality only because it is prohibited by a provision of law or administrative regulations;
  - c) if the owner of the registration did not have the right to obtain it and the author did not make use of the





rights conferred to him by Article 118;

d) if the design or model is in conflict with an earlier design or model that has been made available to the public after the date of filing of the application, or if a priority is claimed, after the date of the latter, but whose exclusive rights take effect from an earlier date due to registration at the EU, national or international level, or as a result of the respective application;

e) if the design or model is such that its use would constitute an infringement of a distinctive sign or a work of intellectual property protected by copyright;

f) if the design or model constitutes an improper use of any of the items listed in Article 6-ter of the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, or of signs, emblems and coats of arms different from those contemplated by that article and that are of particular public interest in the Country.

2. A claim of nullity of a registration of a design or model that is the object of prior rights pursuant to paragraph 1, letters d) and e), may be brought solely by the owner of those rights and his successors in title.<sup>(32)</sup>

3. The nullity of the registration of the design or model that constitutes an improper use of one of the items listed in Article 6-ter of the Paris Convention for Industrial Protection or of signs, emblems and coats of arms that are of particular public interest in the Country, may be claimed solely by the party interested in the use.

---

<sup>(32)</sup> As amended by paragraph 1 of Article 23, Legislative Decree No. 131 of 13 August 2010.

#### **44. Duration of right to exploitation of copyrights.**

1. The rights to exploitation of the industrial designs and models protected under Article 2, paragraph 1, number 10 of Law No. 633 of 22 April 1941, last for the entire life of the author and until the end of the seventieth calendar year after his death or the death of the last of the co-authors.<sup>(33)</sup>

2. [The Ministry for Cultural Heritage and Activities periodically communicates to the Italian Patent and Trademark Office the data relating to the works filed pursuant to Article 103 of Law No. 633 of 22 April 1941, with reference to the title, description of the object and author, name, domicile of the owner of the rights, date of publication, and any other entry or recording].<sup>(34)</sup>

3. [The Italian Patent and Trademark Office records the data as per paragraph 2 in the Official Bulletin, published pursuant to Article 189 of this Code].<sup>(35)</sup>

---

<sup>(33)</sup> As modified by Article 4, Law Decree No. 10 of 15 February 2007.

<sup>(34)</sup> Substituted by paragraph 1 of Article 24, Legislative Decree No. 131 of 13 August 2010.

<sup>(35)</sup> Substituted by paragraph 1 of Article 24, Legislative Decree No. 131 of 13 August 2010.

### **Section IV**

#### **Inventions**

#### 45. Subject matter of patents.

1. Patents may be granted for inventions, in all technical sectors, that are new and imply an inventive activity and are suitable for industrial application.<sup>(36)</sup>

2. Pursuant to paragraph 1, the following are not considered inventions:

a) discoveries, scientific theories and mathematical methods;

b) plans, principles and methods for intellectual activities, for games or for business activities and computer programs;

c) presentations of information.

3. The provisions of paragraph 2 exclude the patentability of what is specified there only to the extent the patent application or the patent concerns discoveries, theories, plans, principles, methods, programs and presentations of information considered as such.<sup>(37)</sup>

4. Patents may not be granted for the following:

a) methods for surgical or therapeutic treatment of the human or animal bodies and diagnostic methods applied to human or animal bodies;

b) plant varieties or animal species and essentially biological processes for the production of animals or plants, including new plant varieties with respect to which the invention consists exclusively of the genetic modification of other plant varieties, even if that modification is the result of a genetic engineering process.<sup>(38)</sup>

5. The provision of paragraph 4 does not apply to microbiological processes and products obtained through such processes, or to the products, and in particular substances or compositions, for the use of one of the specified methods.<sup>(39)</sup>

5-bis. Patents may not be granted to the biotechnological inventions as identified under Article 81-quinquies<sup>(40)</sup>.

---

<sup>(36)</sup> Paragraph as amended by paragraph 1 of Article 25, Legislative Decree No. 131 of 13 August 2010.

<sup>(37)</sup> Paragraph as amended by paragraph 2 of Article 25, Legislative Decree No. 131 of 13 August 2010.

<sup>(38)</sup> Paragraph as substituted by paragraph 3 of Article 25, Legislative Decree No. 131 of 13 August 2010.

<sup>(39)</sup> Paragraph as substituted by paragraph 3 of Article 25, Legislative Decree No. 131 of 13 August 2010.

<sup>(40)</sup> Paragraph added by paragraph 4 of Article 25, Legislative Decree No. 131 of 13 August 2010.

#### 46. Novelty.<sup>(41)</sup>

1. An invention shall be considered novel if it is not anticipated by the prior art.

2. Prior art consists of all that has been made available to the public in the territory of the Country or abroad prior to the date of filing of the patent application, through a written or verbal description, utilization or any other means.

3. Prior art is also considered to include the contents of applications for Italian patents or applications for European patents designating Italy, as they have been filed, that have a date of filing prior to the one

mentioned in paragraph 2 and that have been published or made available to the public on that date as well or later.<sup>(42)</sup>

4. The provisions of paragraphs 1, 2 and 3 do not exclude the patentability of a substance or a composition of substances already included in the prior art, provided that they are for the purpose of a new utilization.

---

<sup>(41)</sup> Heading as substituted by paragraph 1 of Article 26, Legislative Decree No. 131 of 13 August 2010.

<sup>(42)</sup> Paragraph as amended by paragraph 2 of Article 26, Legislative Decree No. 131 of 13 August 2010.

#### **47. Non-applicable disclosures and internal priority.<sup>(43)</sup>**

1. For the application of Article 46, a disclosure of an invention is not taken into consideration if it took place in the six months prior to the date of filing of the patent application and is the direct or indirect result of an evident abuse to the detriment of the applicant or his assignor.

2. A disclosure of an invention is also not taken into consideration if it took place in an official exhibition or an exhibition officially recognized pursuant to the Convention Concerning International Exhibitions, signed in Paris on 22 November 1928, as amended.

3. For the inventions for which a claim of priority has been made pursuant to international conventions, the relevant prior art pursuant to Articles 46 and 48 must be evaluated with reference to the date to which the priority refers.<sup>(44)</sup>

3-*bis*. For patents of inventions and utility models, a national filing in Italy gives rise to a right of priority also with respect to a subsequent national application filed in Italy, in relation to elements already contained in the application for which priority is claimed.<sup>(45)</sup>

---

<sup>(43)</sup> Heading as substituted by paragraph 1 of Article 27, Legislative Decree No. 131 of 13 August 2010.

<sup>(44)</sup> Paragraph as amended by paragraph 2 of Article 27, Legislative Decree No. 131 of 13 August 2010.

<sup>(45)</sup> Paragraph added by paragraph 1 of Article 19, Law No. 99 of 23 July 2009.

#### **48. Inventive activity.**

1. An invention is considered as implying an inventive activity if, for a person who is an expert in the field, it is not evident from the prior art. If the prior art includes documents as per paragraph 3 under Article 46, those documents are not taken into consideration for the assessment of the inventive activity.

#### **49. Industrial applicability.**

1. An invention is considered suitable to have an industrial application if its object can be manufactured or utilized in any type of industry, including agricultural industries.

#### **50. Lawfulness.**

1. Patents may not be granted for inventions whose implementation is contrary to public policy or accepted principles of morality.
2. The implementation of an invention cannot be considered contrary to public policy or accepted principles of morality due only to the fact that it is prohibited by a provision of law or administrative regulations.

### 51. Sufficient description.

1. An application for the granting of a patent for an industrial invention must be accompanied by the description, claims and designs necessary for it to be understood.<sup>(46)</sup>
2. The invention must be described in a sufficiently clear and complete manner so that any person who is an expert in the field can implement it, and it must be distinguished by a title corresponding to its object.
3. If an invention regards a microbiological process or product obtained by way of that process and implies the utilization of a microorganism not available to the public and that cannot be described in such a manner as to allow any person who is an expert in the field to implement the invention, as regards the description, the patent application must follow the rules established by Article 162.<sup>(47)</sup>

---

<sup>(46)</sup> Paragraph as amended by paragraph 1 of Article 28, Legislative Decree No. 131 of 13 August 2010.

<sup>(47)</sup> Paragraph as amended by paragraph 2 of Article 28, Legislative Decree No. 131 of 13 August 2010.

### 52. Claims.

1. The claims must indicate, specifically, what is intended to constitute the object of the patent.<sup>(48)</sup>
  2. The limits of the protection are determined by the claims; however, the description and designs have the purpose of interpreting the claims.<sup>(49)</sup>
  3. The provision of paragraph 2 must be understood in such a manner as to guarantee both fair protection to the owner and a reasonable legal certainty for third parties.
- 3-bis. To determine the scope of the protection granted by the patent, every element that is equivalent to an element indicated in the claims must be considered.<sup>(50)</sup>

---

<sup>(48)</sup> Paragraph as substituted by paragraph 1 of Article 29, Legislative Decree No. 131 of 13 August 2010.

<sup>(49)</sup> Paragraph as amended by paragraph 2 of Article 29, Legislative Decree No. 131 of 13 August 2010.

<sup>(50)</sup> Paragraph added by paragraph 3 of Article 29, Legislative Decree No. 131 of 13 August 2010.

### 53. Effects of patenting.

1. The exclusive rights considered by this code are conferred with the granting of the patent.
2. The effects of the patent start on the date on which the application with the description, claims and any

designs is made available to the public.<sup>(51)</sup>

3. Once eighteen months have passed from the date of filing of the application or the date of priority, or after ninety days from the date of filing of the application if the applicant has stated in the application that he wishes to make it immediately available to the public, the Italian Patent and Trademark Office makes the application available to the public together with the annexes.

4. With respect to the persons who have been notified of the application with the description, claims and any designs, the effects of the patent for an industrial invention start on the date of that notification.<sup>(52)</sup>

---

<sup>(51)</sup> Paragraph as amended by paragraph 1 of Article 30, Legislative Decree No. 131 of 13 August 2010.

<sup>(52)</sup> Paragraph as amended by paragraph 2 of Article 30, Legislative Decree No. 131 of 13 August 2010.

#### **54. Effects of European patent application.**

1. The protection conferred by a European patent application pursuant to Article 67(1) of the European Patent Convention of 5 October 1973, ratified by law No. 260 of 26 May 1978, starts on the date on which the owner has made available to the public, by way of the Italian Patent and Trademark Office, a translation of the claims into the Italian language or has directly notified the presumed infringer. Except as established by Article 46(3), the effects of a European patent application are considered null when the application has been withdrawn or rejected or when the designation by Italy has been withdrawn.<sup>(53)</sup>

---

<sup>(53)</sup> Paragraph as amended by paragraph 1 of Article 31, Legislative Decree No. 131 of 13 August 2010.

#### **55. Effects of the designation or election of Italy.**

1. An international application filed pursuant to the Patent Cooperation Treaty, ratified by Law No. 260 of 26 May 1978, and containing the designation or election of Italy, is equivalent to a European patent application in which Italy has been designated, and produces its effects pursuant to and at the conditions set for Euro-PCT applications by the European Patent Convention of 5 October 1973, ratified by Law No. 260 of 26 May 1978, and the Implementing Regulation of the same.<sup>(54)</sup>

---

<sup>(54)</sup> Paragraph as amended by paragraph 1 of Article 32, Legislative Decree No. 131 of 13 August 2010.

#### **56. Rights conferred by a European patent.**

1. A European patent issued for Italy confers the same rights and is subject to the same regime as Italian patents starting on the date on which the mention of granting of the patent is published in the European Patent Bulletin. If the patent is subject to an opposition or limitation proceeding, the scope of protection established by the conferral or with a decision for maintenance in modified form or a decision of limitation, is confirmed starting on the date on which the mention of the decision concerning opposition or limitation is published.<sup>(55)</sup>

2. Infringements are evaluated in accordance with Italian legislation on the subject.

3. The owner must provide the Italian Patent and Trademark Office with a translation into the Italian language of the text of the patent maintained in a modified form following the opposition proceeding or in a limited form following the limitation proceeding.<sup>(56)</sup>

4. The translation, that must be declared to be an authentic translation of the original text by the owner of the patent or his principal, must be filed within three months of the date of each of the publications as per paragraph 1.

5. In the event of failure to comply with the provisions of paragraphs 3 and 4, a European patent shall be considered to have no effect in Italy, from its initial date.

---

<sup>(55)</sup> Paragraph as substituted by paragraph 1 of Article 33, Legislative Decree No. 131 of 13 August 2010.

<sup>(56)</sup> Paragraph as amended by paragraph 2 of Article 33, Legislative Decree No. 131 of 13 August 2010.

### **57. Applicable text of the European application or patent.**

1. The text of the European patent application or European patent, drawn up in the language of the procedure before the European Patent Office, shall be applicable as concerns the extension of protection, without prejudice to Article 70(2) of the European Patent Convention of 5 October 1973, ratified by Law No. 260 of 26 May 1978.

2. However, the translation into the Italian language of the documents relating to the application filed or the European patent granted is considered applicable in the territory of the Country, if it confers a protection that is less broad than that conferred by the text drawn up in the language of the procedure of the European Patent Office.<sup>(57)</sup>

3. The provision in paragraph 2 shall not apply in the event of actions for a declaration of nullity.

4. A corrected translation may be filed, at any time, by the owner of the application or the patent; it enters into effect only after it has been made available to the public at the Italian Patent and Trademark Office or the presumed infringer has been notified.

5. Whoever has in good faith begun to implement an invention in Italy or has performed actual preparations for this purpose without that implementation constituting infringement of the application or patent in the text of the translation initially filed, may continue without charge the exploitation of the invention in his business activity or for the needs of the same even after the corrected translation has entered into effect.<sup>(58)</sup>

---

<sup>(57)</sup> Paragraph as amended by paragraph 1 of Article 34, Legislative Decree No. 131 of 13 August 2010.

<sup>(58)</sup> Paragraph as amended by paragraph 2 of Article 34, Legislative Decree No. 131 of 13 August 2010.

### **58. Conversion of European patent application.<sup>(59)</sup>**

1. A European patent application, in which Italy has been designated, may be converted into an Italian patent application for an industrial invention:

a) in the cases identified by Article 135, paragraph 1, letter a), of the European Patent Convention of 5 October 1973, ratified by Law No. 260 of 26 May 1978;

b) in the event of non-compliance with the deadline set in Article 14(2) of the European Patent Convention, when the application was originally filed in the Italian language. <sup>(60)</sup>

2. A European patent application that has been rejected, withdrawn or considered to be withdrawn, or a European patent that has been revoked whose object has the requirements for patentability set by Italian legislation for utility models, may be converted into a national application for a utility model.

3. Those persons who request the conversion as per paragraph 1 are allowed to simultaneously request the potential conversion into an application for utility model pursuant to Article 84.

4. If a regular request for conversion pursuant to paragraphs 1, 2 and 3 has been transmitted to the Italian Patent and Trademark Office, the patent application is considered to have been filed in Italy on the same date of filing as that of the European patent application; the documents annexed to that application that were filed with the European Patent Office are considered to have been filed in Italy on the same date.

---

<sup>(59)</sup> See also Article 9, Ministerial Decree No. 33 of 13 January 2010.

<sup>(60)</sup> Paragraph as amended by paragraph 1 of Article 35, Legislative Decree No. 131 of 13 August 2010.

## **59. Supremacy of European patent in the event of cumulative protections.**

1. If an Italian patent and a European patent valid in Italy have been granted for the same invention to the same inventor or his successor in title with the same date of filing and priority date, the Italian patent, to the extent it protects the same invention as the European patent, shall cease to have effect as of the date on which:

- a) the deadline for bringing an opposition the European patent has passed without any opposition being filed;
- b) the opposition proceeding has been definitively concluded with the maintenance in effect of the European patent;
- c) the Italian patent has been issued, if that date is later than the date in letters a) or b).

2. The provisions of paragraph 1 remain valid even if the European patent is subsequently cancelled or revoked.

3. As of the expiration of the deadlines indicated in paragraph 1, a person who has brought an action to protect an Italian patent may request a conversion of the same into a corresponding action to protect a European patent, without prejudice to the rights that result from the Italian patent for the earlier period.

## **60. Duration.**

1. A patent for an industrial invention has a duration of twenty years starting on the date of filing of the application and may not be renewed, nor may its duration be extended.

## **61. Complementary certificate for medicinal and phytosanitary products.**

1. Subject to what is established for complementary certificates in Article 81, paragraphs 1 to 4, the complementary certificates for medicinal products and the complementary certificates for phytosanitary products are granted by the Italian Patent and Trademark Office based on Regulations (EC) No. 469/2009,



(EC) No. 1901/2006 and (EC) No. 1610/96 and produce the effects established by those regulations.<sup>(61)</sup>

---

<sup>(61)</sup> Article as substituted by paragraph 1 of Article 36, Legislative Decree No. 131 of 13 August 2010.

## 62. Moral rights.

1. The right to be recognized as the author of an invention may be invoked by the inventor, and after his death by his spouse or descendants up to the second degree; if there are no such descendants or after their death, by the parents and their ancestors, and if there are no such ancestors or after their death as well, by relatives up to and including the fourth degree.

## 63. Property rights.

1. The rights resulting from industrial inventions, except for the right to be recognized as the author, may be transferred and disposed of.

2. The patent rights for an industrial invention belong to the author of the invention or his successors in title.

## 64. Inventions by employees.

1. When an industrial invention is made in the performance or fulfillment of a contract or work or employment relationship, in which the inventive activity is contemplated by the contract or relationship and is remunerated for that purpose, the rights deriving from the invention belong to the employer, without prejudice to the right for the inventor to be acknowledged as the author.

2. If remuneration is not provided for and set as compensation for the inventive activity, and the invention is made in the performance or fulfillment of a contract or work or employment relationship, the rights deriving from the invention belong to the employer, but the inventor, without prejudice to the right to be acknowledged as the author, shall, if the employer and its successors in title obtain the patent or use the invention under industrial confidentiality, have the right to a reasonable reward, the calculation of which must take into account the importance of the invention, the duties carried out and the remuneration received by the inventor, as well as the contribution that he received from the employer's organization. In order to ensure the prompt conclusion of the procedure for obtaining the patent and the consequent attribution of the reasonable reward to the inventor, and on request from the relevant employer's organization, an advance examination of the application aimed at obtaining a patent may be allowed.<sup>(62)</sup>

3. If the conditions set in paragraphs 1 and 2 are not present and the industrial invention falls within the employer's field of activity, the employer has the option for exclusive or non-exclusive use of the invention or for the purchase of the invention, and for the right to request or acquire patents abroad for the same invention, upon payment of the fee or price, to be set deducting a sum corresponding to the assistance that the inventor however received from the employer to arrive at the invention. The employer may exercise that option within three months of the date of receipt of the notification of the patent application being filed. The relationships established with the exercise of that option shall be automatically terminated if the amount due is not paid in full as of its due date.<sup>(63)</sup>

4. Notwithstanding the jurisdiction of the ordinary courts relating to the determination of the existence of the right to the reasonable reward, fee or price, if an agreement is not reached concerning the amount of the same, even if the inventor is an employee of a state agency, the determination of the amount shall be made by an Arbitration Board consisting of three members, one each appointed by each of the parties and a third



appointed by the first two, or in the absence of agreement between them, by the President of the specialized division of the Court with jurisdiction where the provider of the services habitually performs his duties. To the extent they are compatible, the provisions of Articles 806 *et seq.* of the Code of Civil Procedure shall apply.<sup>(64)</sup>

5. The Arbitration Board may also be activated while the proceeding for the determination of the existence of the right to the reasonable reward, fee or price is pending, but in such a case, the enforceability of its decision shall be subordinate to that of the judgment for establishing the right. The Arbitration Board must proceed with a fair assessment. If the determination is clearly unfair or erroneous, the determination shall then be carried out by the Court.

6. Pursuant to paragraphs 1, 2 and 3, an industrial invention shall be considered to have been made during the performance of the contract or work or employment relationship when the patent has been requested within a year of when the inventor left the private business or public agency in the field of activity of the invention.

---

<sup>(62)</sup> Paragraph as substituted by paragraph 1 of Article 37, Legislative Decree No. 131 of 13 August 2010.

<sup>(63)</sup> Paragraph as amended by paragraph 2 of Article 37, Legislative Decree No. 131 of 13 August 2010.

<sup>(64)</sup> Paragraph as amended by paragraph 3 of Article 37, Legislative Decree No. 131 of 13 August 2010.

## **65. Inventions of researchers at universities and public research entities.**

1. In derogation of Article 64, when the employment relationship exists with a university or a public agency whose institutional purposes includes research, the researcher shall be the sole owner of the rights resulting from the patentable invention of which he is the author. In the event of multiple authors who are employees of the university, the cited public agencies or other public agencies, the rights resulting from the invention shall belong to all of the inventors in equal parts, unless otherwise agreed upon. The inventor shall file the patent application and notify the agency of that action.

2. In the context of their independence, the universities and public agencies shall set the amount of the fee relating to licenses for third parties to use the invention, due to the university or public agencies themselves or to private financiers of the research, as well as any additional aspect of the mutual relationships.

3. In any event, the inventor shall have the right to not less than fifty percent of the income or fees from exploitation of the invention. In the event that the universities or public agencies do not make the determinations indicated in paragraph 2, they shall have the right to thirty percent of the income or fees.

4. Once five years have passed from the date of issue of the patent, if the inventor or his successors in title have not begun the industrial exploitation of the same, unless that is due to causes beyond their control, the public agency which employed the inventor at the time of the invention shall automatically have a free of charge non-exclusive right to exploit the invention and related property rights or to have third parties exploit them, without prejudice to the inventor's right to be recognized as the author.

5. The provisions of this article shall not apply in the event of research that is financed by private bodies, in full or in part, or carried out in the context of specific research projects financed by public bodies other than the university, entity or agency to which the researcher belongs.

## **66. Patent rights.**

1. The patent rights for an industrial invention consist of the exclusive right to implement the invention and profit from the same in the territory of the Country, within the limits and at the conditions established by this

Code.

2. In particular, the patent grants the owner the following exclusive rights:

- a) if the object of the patent is a product, the right to prohibit third parties, subject to the consent of the owner, from producing, using, putting on the market, selling or importing the product in question for such purposes;
- b) where the patent is on a process, the right to prohibit third parties, subject to the consent of the owner, from applying the process, and to use, put on the market, sell or import the product directly obtained by the process in question for such purposes.

### **67. Patent of a process.**

1. In the case of a patent of process, each product identical to that obtained through the patented process is presumed to be obtained by way of that process, unless demonstrated otherwise, if either:

- a) the product obtained through the process is new; or
- b) there is a substantial probability that the identical product has been manufactured through the process and if the owner of the patent has not succeeded, through a reasonable effort, in determining the process actually carried out.

2. In order to provide contrary evidence, the legitimate interest of the party accused of infringement to the protection of his manufacturing and business secrets must be taken into account.

3. When the owner of a patent concerning a new industrial method or process provides to others the means intended solely to implement the object of the patent, it is assumed that he has also given a license to make use of that method or process, provided that agreements to the contrary do not exist.

### **68. Limitations on patent rights.**

1. Whatever the object of the invention may be, the exclusive authority attributed by patent rights does not extend to the following:

- a) actions carried out in the private sphere and for non-commercial purposes, or as experimentation;
- b) studies and trials aimed at obtaining a marketing authorization for a drug, including in foreign countries, and the resulting practical requirements including the preparation and utilization of the pharmacologically active raw materials strictly necessary for the same;
- c) the infrequent preparation of unit doses of drugs in pharmacies on prescription, and the drugs thus prepared, provided that active principles produced industrially are not utilized.<sup>(65)</sup>

1-bis. Subject to the provisions of paragraph 1, the companies that intend to produce pharmaceutical specialities outside of the coverage of patents may initiate the procedure for registration of the product containing the active principle one year in advance of the expiration of the complementary coverage, or one year in advance of the patent coverage of the active principle, also taking into account any potential extension.<sup>(66)</sup>

2. A patent for an industrial invention, whose implementation implies that inventions protected by earlier patents for industrial inventions are still in effect, may not be implemented or used without the consent of the owners of the latter.

3. During the twelve months prior to the date of filing of the patent application or the date of priority, whoever has made use of the invention in his own business may continue to use it within the limits of previous use. That authority may only be transferred together with the business activity in which the invention is used. The proof of previous use and its extension is the responsibility of said previous user.

---

(65) Paragraph as substituted by paragraph 1 of Article 38, Legislative Decree No. 131 of 13 August 2010.

(66) Paragraph added by paragraph 2 of Article 38, Legislative Decree No. 131 of 13 August 2010.

### **69. Responsibility of implementation.**

1. An industrial invention that is the object of a patent must be implemented in the territory of the Country to such an extent as not to be gravely disproportionate to the needs of the Country.
2. The inventions regarding objects that appear for the first time in an official or officially recognized exhibition, held in the territory of the Country, are considered to be implemented since the objects are introduced there until the closing of the same, provided that they have been displayed for at least ten days, or in the event of a shorter period of display, for the entire period of the same.
3. The introduction or sale in the territory of the Country of objects produced in Countries other than Member States of the European Union or the European Economic Area or Member States of the World Trade Organization, shall not constitute implementation of the invention.

### **70. Compulsory license due to lack of implementation.**

1. Once three years have passed from the date of issue of a patent or four years from the date of filing of an application, whichever comes last, if the owner of the patent or his successor in title has not implemented the patented invention, directly or through one or more licensees, producing in the territory of the Country or importing objects produced in a Member State of the European Union or the European Economic Area or a Member State of the World Trade Organization, or has implemented it to an extent that is gravely disproportionate to the Country's needs, a mandatory license may be granted for the non-exclusive use of the invention, to any interested party who so requests.
2. The compulsory license pursuant to paragraph 1 may also be granted if the implementation of the invention has been suspended or reduced in such a manner as to be gravely disproportionate to the Country's needs, for more than three years.
3. The compulsory license is not granted if the lack of or insufficient implementation is due to causes outside the control of the owner of the patent or his successor in title. Such causes shall not include the lack of financial means, and if the same product is circulated abroad, the lack of demand in the internal market for the product patented or obtained with a patented procedure.
4. The granting of the compulsory license does not release the owner of the patent or his successor in title from the obligation to implement the invention. The patent shall be forfeited if the invention has not been implemented within two years of the date of granting of the first compulsory license or if it has been implemented to an extent that is gravely disproportionate to the Country's needs.

### **71. Dependent patent.**

1. A compulsory license may be granted if the invention protected by the patent cannot be used without harm

to the rights relating to a patent granted based on a previous application. In that case, the license may be granted to the owner of the later patent to the extent necessary to exploit the invention, provided that with respect to the object of the earlier patent, it represents important technical progress of considerable economic importance.

2. A license thus obtained may not be transferred unless accompanied by the patent on the dependent invention. The owner of the patent on the principal invention, in turn, shall have the right to be granted a compulsory license at reasonable conditions on the patent of the dependent invention.

## **72. Common provisions.**

1. Whoever requests the granting of a compulsory license pursuant to Articles 70 and 71 must prove that he has contacted the owner of the patent first and has been unable to obtain a contractual license from him at fair conditions.

2. A compulsory license may be granted only against payment of fair compensation by the licensee to the owner of the patent or his successors in title, and provided that the party requesting the license gives the necessary guarantees in relation to a satisfactory implementation of the invention in accordance with the conditions set in the license.

3. A compulsory license shall not be granted if it is found that the requesting party has infringed the patent, unless the party can demonstrate its good faith.

4. A compulsory license may be granted for an exploitation of the invention aimed principally at supplying the internal market.

5. A compulsory license is granted for a duration not greater than the remaining duration of the patent, and provided the consent exists of the owner of the patent or his successor in title, it may only be transferred with the business activity of the licensee or the particular branch of the same in which the license is used.

6. The granting of a compulsory license does not harm the possibility, including for the licensee, to take legal action concerning the validity of the patent or the extension of the rights that derive from the same.

7. In the order granting the license the following shall be determined: the scope and duration, the methods of implementation, the terms and other conditions on which the granting of the license is conditioned upon in relation to its purpose, the amount and method of payment of the compensation. In the event of opposition, the amount and method of payment of the consideration are determined in accordance with Article 80.

8. The conditions of the license may be modified by a decree of the Ministry of Productive Activities on request from each of the interested parties, if valid reasons exist in that regard.

9. For the modification of the compensation, Article 80 shall apply.

10. In the event that the owner of the patent for which a compulsory license is granted or his successor in title allows third parties to use the patent at conditions that are more advantageous than those established for the compulsory license, those same conditions are extended to the compulsory license, on request from the licensee.

## **73. Revocation of compulsory license.**

1. A compulsory license shall be revoked by a decree of the Ministry of Productive Activities if it is found that the conditions established for implementation of the invention have not been fulfilled, or if the owner of the license has not made payment of the compensation in the amount or by the methods set.

2. A compulsory license shall also be revoked by a decree of the Ministry of Productive Activities if and when the circumstances that led to it being granted cease to exist and it is unlikely that they will recur, or by a mutual request from the parties.

3. The revocation may be requested by the owner of the patent with a request filed with the Italian Patent and Trademark Office, which shall promptly notify the owner of the compulsory license by registered mail letter, return receipt requested. Within sixty days of receipt of the registered mail letter, the owner may file a grounded opposition to the revocation, by a petition filed with the Italian Patent and Trademark Office. The provisions of Article 199, paragraphs 3, 4, 5, 6 and 7 shall apply.

4. In the event of revocation, the party who obtained the license may implement the invention at the same conditions, within the limits of previous use or the limits that are determined by serious and actual preparations.

#### **74. Military inventions.**

1. The provisions relating to the granting of a compulsory license due to lack of or insufficient implementation of inventions, or relating to a dependent patent, do not apply to patented inventions belonging to military agencies or agencies subject to an obligation of confidentiality by military agencies.

#### **75. Forfeiture due to lack of payment of fees.**

1. A patent for an invention shall be forfeited if payment has not been made within six months of the due date of the annual fee, conditional upon compliance with the provisions of paragraphs 2, 3 and 4.

2. Once the month in which the annual fee is due has passed, and after an additional six months have passed in which payment is allowed with the application of a late fee, and once the final deadline for payment of the fee has expired, the Italian Patent and Trademark Office shall notify the interested party, by registered mail, that payment of the fee has not been received by the relevant deadline. Thirty days after the date of that notification, the Italian Patent and Trademark Office shall make a specific notation in the Patent Register of the revocation of the patent due to lack of payment of the annual fee, and then publish the notice of the revocation in the Official Bulletin.

3. If the owner of the patent demonstrates that he has promptly made the payment, he may request, by an appeal to the Board of Appeal, within six months of the date of publication in the Official Bulletin, the cancellation of the above-cited record of revocation and the correction of the publication. The Commission shall proceed after consulting the interested party or his representatives and taking into account any written observations from the same. Both the filing of the appeal and the operative part of the judgment must be recorded in the Patent Register and notice must be published in the Official Bulletin.

4. Once publication has occurred as per paragraph 2 and six months have passed from the date of that publication, or if an appeal has been rejected, the patent shall be considered to be revoked with respect to everyone from the time of the end of the last year for which the fee was properly paid.

#### **76. Nullity.**

1. A patent is null:

a) if the invention cannot be patented pursuant to Articles 45, 46, 48, 49 and 50;

b) if, pursuant to Article 51, the invention is not described in a sufficiently clear and complete manner so as to

allow an expert person to implement it;

c) if the object of the patent extends beyond the contents of the initial application or the protection of the patent has been extended;<sup>(67)</sup>

d) if the owner of the patent did not have the right to obtain it and the qualified person did not make use of the right granted to him by Article 118.

2. If the causes of nullity only partially affect the patent, the respective judgment of partial nullity entails a corresponding limitation of the patent, and in the case contemplated by Article 79(3), establishes the new claims resulting from the limitation.<sup>(68)</sup>

3. A null patent may produce the effects of a different patent of which it contains the requirements of validity and that would have been desired by the requesting party, if he had known of the nullity. The application for conversion may be filed in any instance and degree of judgment. The judgment which determines the requirements for validity of the different patent orders the conversion of the null patent. Within six months of the conversion judgment becoming final, the owner of the converted patent shall file a request for correction of the text of the patent. After verifying that the text corresponds to the judgment, the Office makes it available to the public.<sup>(69)</sup>

4. If the conversion entails the extension of the original duration of the null patent, the licensees and those who in view of the upcoming expiration had made serious and actual investments to use the object of the patent shall have the right to obtain a compulsory license that is free and non-exclusive for the extended period.

5. A European patent may be declared null for Italy under this article, and also when the protection conferred by the patent has been extended.

---

<sup>(67)</sup> Letter as modified by paragraph 1 of Article 39, Legislative Decree No. 131 of 13 August 2010.

<sup>(68)</sup> Paragraph as amended by paragraph 2 of Article 39, Legislative Decree No. 131 of 13 August 2010.

<sup>(69)</sup> Paragraph as amended by paragraph 3 of Article 39, Legislative Decree No. 131 of 13 August 2010.

## **77. Effects of nullity.**

1. A declaration of nullity of a patent has retroactive effect, but does not affect:

a) enforcements of final judgments on infringement that have already been executed;

b) contracts concerning an invention concluded prior to a judgment declaring nullity becoming final, to the extent they have already been performed. In this case, however, the Court, taking into account the circumstances, may grant a reasonable reimbursement of amounts already paid in the performance of the contract;

c) payments already made pursuant to Articles 64 and 65, as reasonable rewards, fees or prices.

## **78. Surrender.**

1. The owner may surrender his rights to a patent by a written statement received by the Italian Patent and Trademark Office, to be entered in the patent register.



2. If in relation to a patent, judicial documents or judgments have been recorded that attribute or confirm third-party property rights on the patent or claims which request the attribution or confirmation of those rights, the surrender shall not be valid unless accompanied by the written consent of those third parties.

#### **79. Limitation.**

1. A patent may be limited on request from the owner, which must be accompanied by the modified description, claims and designs.

2. If the Italian Patent and Trademark Office grants the request, the requesting party must follow the regulatory provisions relating to the re-publication of the patent and the payment of the respective fees, when required. <sup>(70)</sup>

3. In a proceeding concerning nullity, the owner of the patent has the right to submit to the Court, at any stage or instance of judgment, modified claims that remains within the limits of the content of the patent application as initially filed and that does not extend the protection conferred by the patent granted. <sup>(71)</sup>

3-bis. When there is both a limitation of the European patent following a limitation procedure as per the European Patent Convention, and a limitation of the same European patent with effect in Italy following a national procedure, the scope of protection conferred by the patent is determined taking into account each of the limitations established. <sup>(72)</sup>

4. The Italian Patent and Trademark Office shall publish the notice of the limitation of the patent in the Bulletin.

---

<sup>(70)</sup> Paragraph as substituted by paragraph 1 of Article 40, Legislative Decree No. 131 of 13 August 2010.

<sup>(71)</sup> Paragraph as substituted by paragraph 1 of Article 40, Legislative Decree No. 131 of 13 August 2010.

<sup>(72)</sup> Paragraph added by paragraph 2 of Article 40, Legislative Decree No. 131 of 13 August 2010.

#### **80. License of right.**

1. In the application or also in a request from the mandatory received by the Italian Patent and Trademark Office, if no exclusive license is recorded, the requesting party or owner of the patent may offer to the public a license for non-exclusive use of the invention.

2. The effects of the license shall start as of notification to the owner of acceptance of the offer, even if the compensation is not accepted.

3. In such a case, the determination of the amount and methods of payment of the compensation shall be made by an Arbitration Board, consisting of three members, one each appointed by each of the parties and a third appointed by the first two, or in the absence of agreement between them, by the President of the Board of Appeal. The Arbitration Board must proceed based on a fair assessment. If the determination is clearly unfair or erroneous, or one of the parties refuses to appoint its arbitrator, the determination shall be made by the Court.

4. The compensation may be modified in the same manner prescribed in the determination of the original amount, if circumstances have occurred or been disclosed that make the compensation already set appear to be clearly inadequate.

5. A requesting party or owner of the patent who has offered a license on the patent to the public has the right

to reduction by one-half of the annual fees.

6. The reduction as per paragraph 5 is granted by the Italian Patent and Trademark Office. The offer declaration is entered in the patent register, published in the Bulletin, and its effects last until it is revoked.<sup>(73)</sup>

---

<sup>(73)</sup> Paragraph as amended by paragraph 1 of Article 41, Legislative Decree No. 131 of 13 August 2010.

### **81. Complementary certificate pursuant to Law No. 349 of 19 October 1991, and voluntary license on active principles mediated by the Minister.**

1. Complementary certificates of protection granted pursuant to Law No. 349 of 19 October 1991 shall be subject to the legal system concerning patents, with the same exclusive rights and obligations. The complementary certificate of protection produces the same effects as the patent to which it refers, limited to the part or parts of it covered by the marketing authorization.

2. The effects of the complementary certificate of protection enter into force from the time at which the patent reaches its natural expiration under law and last for a time equal to the period that passed between the date of filing of the patent application and the date of the order by which the first marketing authorization of the medicine is granted.

3. The duration of the complementary certificate of protection may in no case be greater than eighteen years, starting on the date on which the patent reaches its natural expiration under law.

4. In order to gradually adjust the duration of the complementary and patent coverage to that established by EU regulations, the provisions of Law No. 939 of 19 October 1991, and of Regulation (EEC) No. 1768/1992 of the Council, of 18 June 1992, shall be implemented through a reduction of the complementary protection equal to six months for each calendar year, starting on 1 January 2004, until full alignment with European law.

5. Third parties who intend to produce for export active principles covered by complementary certificates of protection pursuant to Law No. 349 of 19 October 1991 shall be allowed to initiate with the holders of those certificates, at the Ministry of Economic Development, a procedure for the issuance of voluntary non-exclusive licenses for compensation, in accordance with applicable legislation on the subject.

6. The licenses indicated in paragraph 5 are however valid solely for export towards countries in which patent and complementary certificate protection does not exist, has expired, or in which the export of the active principle does not constitute infringement of the respective patent in compliance with applicable laws in the destination countries.

7. The license ceases its effect as of the expiration of the respective complementary certificate.<sup>(74)</sup>

---

<sup>(74)</sup> Article as substituted by paragraph 1 of Article 42, Legislative Decree No. 131 of 13 August 2010.

### **Section IV-bis** <sup>(75)</sup>

#### **Biotechnological Inventions**

##### **81-bis. Reference.**

1. The provisions of Section IV on industrial inventions also have effect as regards biotechnological inventions,



to the extent they are not derogated by the provisions in Section IV-*bis*.<sup>(76)</sup>

---

<sup>(75)</sup> Section IV-*bis*, including the Articles from 81-*bis* to 81-*octies*, was added by paragraph 1 of Article 43, Legislative Decree No. 131 of 13 August 2010.

<sup>(76)</sup> Article added by paragraph 1 of Article 43, Legislative Decree No. 131 of 13 August 2010.

### **81-*ter*. Definitions.**

1. For the purposes of this Code, the terms below shall be defined as follows:

a) biological material: a material containing genetic or self-reproducing material, or material able to reproduce itself in a biological system;

b) microbiological process: any process which uses microbiological material, that entails an intervention on microbiological material or that produces a microbiological material.

2. A process for production of plants or animals is essentially biological when it consists fully of natural phenomena such as crossbreeding or selection.

3. The notion of a plant variety is defined by Article 5 of Regulation (EC) No. 2100/94 of the Council, of 27 July 1994.<sup>(77)</sup>

---

<sup>(77)</sup> Article added by paragraph 1 of Article 43, Legislative Decree No. 131 of 13 August 2010.

### **81-*quater*. Patentability.**

1. The following may be patented provided that they meet the requirements of novelty and inventive activity and are susceptible to industrial application:

a) a biological material, isolated from its natural environment or produced through a technical process, even if pre-existing in a natural state;

b) a technical process through which biological material is produced, processed or used, even if pre-existing in a natural state;

c) any new utilization of a biological material or of a technical process relating to biological material;

d) an invention relating to an element isolated from the human body or produced otherwise, through a technical process, even if its structure is identical to that of a natural element, provided that its function and industrial application are concretely indicated and described. A technical process is understood as that which only human beings are capable of carrying out and that nature by itself is not able to perform;

e) an invention regarding plants or animals or rather a plant grouping characterized by the expression of a specific gene and not of its entire genome, if their application is not limited, from a technical standpoint, to the obtainment of a specific plant variety or animal species, and in order to obtain thereof, not only essentially biological processes are used, in accordance with the provisions established by Article 170-*bis*, paragraph 6.<sup>(78)</sup>

---

[\(78\)](#) Article added by paragraph 1 of Article 43, Legislative Decree No. 131 of 13 August 2010.

### **81-quinquies. Exclusions.**

1. Subject to the exclusions set forth in Article 45(4), the following may not be patented:

a) the human body, from the moment of conception and in the various stages of its development, nor the mere discovery of one of the elements of the body itself, including the sequence or partial sequence of a gene, in order to guarantee that patenting rights are exercised with respect for the fundamental rights and integrity of man and the environment;

b) inventions whose commercial exploitation is contrary to human dignity, public order and morality, the safeguarding of health, the environment and the life of persons and animals, the preservation of plants and biodiversity and the prevention of serious environmental harm, in compliance with the principles contained in Article 27(2) of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement. That exclusion regards, in particular:

1) any technological process for human cloning, whatever technique is used, the maximum stage of planned development of the cloned organism and the aims of cloning;

2) the processes for modification of the germinal genetic identity of the human being;

3) any utilization of human embryos, including the lines of human embryonic stem cells;

4) processes for modifying the genetic identity of animals, sufficient to provoke their suffering without substantial medical usefulness for human beings or animals, as well as the animals resulting from those processes;

5) inventions regarding genetic screening protocols, whose exploitation leads to a discrimination against or stigmatization of human persons on a genetic, pathological, racial, ethnic, social or economic basis, or for purposes of eugenics and not diagnostics;

c) a simple DNA sequence, a partial sequence of a gene, used to produce a protein or a partial protein, unless an indication and description is provided of a function useful for evaluation of the requirement of industrial application and the corresponding function has been specifically claimed; each sequence is considered independent for patent purposes in the event of sequences that overlap only in the parts not essential to the invention.

2. In any event, any technical process which uses human embryonic cells may not be patented. [\(79\)](#)

---

[\(79\)](#) Article added by paragraph 1 of Article 43, Legislative Decree No. 131 of 13 August 2010.

### **81-sexies. Extension of protection.**

1. The protection attributed by a patent relating to a biological material that as a result of an invention has certain properties, extends to all of the biological materials derived there from through reproduction or multiplication in an identical or differentiated form and having the same properties.

2. The protection attributed by a patent relating to a process that allows for producing a biological material that as a result of an invention has certain properties, extends to the biological material directly obtained from that process and any other biological material derived from the biological material obtained through

reproduction or multiplication in identical or differentiated form and having the same properties.

3. Subject to what is established by Article 81-*quinquies*, paragraph 1, letter *a*), the protection attributed by a patent to a product containing or consisting of genetic information extends to any material in which the product is incorporated and in which the genetic information is contained and performs its function.<sup>(80)</sup>

---

<sup>(80)</sup> Article added by paragraph 1 of Article 43, Legislative Decree No. 131 of 13 August 2010.

### **81-septies. Limits to extension of protection.**

1. The protection provided for in Article 81-*sexies* does not extend to biological material obtained through reproduction or multiplication of biological material marketed in the territory of the Country by the owner of the patent or with his consent, if the reproduction or multiplication necessarily derives from the utilization for which the biological material has been marketed, provided that the material obtained is not subsequently used for other reproductions or multiplications.<sup>(81)</sup>

---

<sup>(81)</sup> Article added by paragraph 1 of Article 43, Legislative Decree No. 131 of 13 August 2010.

### **81-octies. Compulsory license.**

1. The Italian Patent and Trademark Office issues a compulsory license also to:

*a*) the breeder, for the non-exclusive exploitation of the invention protected by the patent, if that license is necessary for the exploitation of a plant variety;

*b*) the owner of a patent regarding a biotechnological invention for the use of the patent on a plant variety right.

2. The issuance of the license under paragraph 1 takes place in accordance with the provisions and conditions set forth in Articles 71 and 72, to the extent they are compatible.

3. In the event of the granting of a compulsory license, the owner of the patent and the owner of the industrial property rights for plant protection have the right, mutually, to a license in accordance with conditions that, if no agreement is reached between the parties, are determined by the Italian Patent and Trademark Office.

4. The issuance of the license as per paragraph 1 is conditional upon the demonstration by the requesting party:

*a*) that he contacted the owner of the patent or of the plant variety rights to obtain a contractual license, unsuccessfully;

*b*) that the plant variety or invention constitutes a significant case of technical progress, of considerable economic interest with respect to the invention indicated in the patent or the protected plant variety.<sup>(82)</sup>

---

<sup>(82)</sup> Article added by paragraph 1 of Article 43, Legislative Decree No. 131 of 13 August 2010.

## Section V

### Utility Models

#### **82. Subject matter of patents.**

1. Patents for utility models may be granted for new models apt to provide particular efficacy or convenience of application or use for machines, or parts thereof, instruments, tools or functional objects in general, such as new models consisting of particular conformations, arrangements, configurations or combinations of parts.
2. A patent for machines as a whole does not include protection of the individual parts.
3. The effects of a patent for utility model extend to the models that achieve the same utility, provided that they use the same innovative concept.

#### **83. Right to patent.**

1. The right to patent lies with the author of the new utility model or his successors in title.

#### **84. Alternative patenting.**

1. A person who requests a patent for an industrial invention, in accordance with this Code, is allowed to simultaneously file a patent request for a utility model, to be valid in the event that the former is not granted or is granted only in part.
2. If the object of the application is a model rather than an invention, or vice versa, the Italian Patent and Trademark Office invites the interested party to modify the application, setting a period of time, while the effective date of the application shall nevertheless be the date of the original filing.
3. If the patent application for a utility model also contains an invention or vice versa, Article 161 shall apply.<sup>(83)</sup>

---

<sup>(83)</sup> Paragraph as amended by paragraph 1 of Article 44, Legislative Decree No. 131 of 13 August 2010.

#### **85. Duration and effects of patenting.**<sup>(84)</sup>

1. A patent for utility model has a duration of ten years from the date the application is filed.
2. The rights conferred and the starting date of the effects of the patent are regulated in accordance with Article 53.

---

<sup>(84)</sup> Heading thus modified by paragraph 1 of Article 45, Legislative Decree No. 131 of 13 August 2010.

#### **86. Reference.**

1. The provisions of section IV, on industrial inventions, also have effect on the subject of utility models, to the extent applicable, in addition to the cited inventions.
2. In particular, the provisions concerning inventions by employees and compulsory licenses are extended to patents for utility models.

## Section VI

### Topographies of Semiconductor Products

#### **87. Subject matter of protection.**

1. A semiconductor product is represented by any finished or intermediate product that:
  - a) consists of a group of materials that includes a layer of semiconductor material;
  - b) contains one or more layers made up of conductor, insulation or semiconductor material, laid out based on a pre-set three-dimensional scheme;
  - c) is intended to perform an electronic function, exclusively or together with other functions.
2. The topography of a semiconductor product is a series of related designs, however fixed or codified:
  - a) representing the three-dimensional scheme of the layers of which a semiconductor product consists;
  - b) in which series each image reproduces in full or in part a surface of the semiconductor product in any stage of its manufacture.

#### **88. Requirements for protection.**

1. Exclusive rights may be granted for topographies if they are the result of the creative intellectual efforts of their author that are not common or familiar within the semiconductor product industry.
2. Exclusive rights may also be granted for topographies resulting from the combination of common or familiar elements, provided that as a whole they meet the requirements under paragraph 1.

#### **89. Right to protection.**

1. The exclusive rights on the topographies of semiconductor products that present the requirements for protection belong to the author and his successors in title.
2. If the topography is created in the context of an employee or work relationship, Article 64 shall apply.
3. If the topography is created in the performance or fulfillment of a contract other than an employment contract, the client who commissioned the topography is entitled to the right to protection, unless otherwise established by the contract.

## 90. Content of the rights.

1. The exclusive rights on the topographies of semiconductor products consist of the right to:

a) reproduce the topography in any manner or form, totally or partially;

b) commercially exploit, or hold or distribute for sale, or import a topography or a semiconductor product in which the topography is fixed.

2. Commercial exploitation is represented by sale, rental, leasing or any other method of commercial distribution or an offer for such purposes.

## 91. Limitation of exclusive rights.

1. The protection granted to topographies of semiconductor products does not extend to concepts, processes, systems, techniques or codified information that are incorporated in those same topographies.

2. The exclusive rights under Article 90 do not extend to reproductions carried out in the private sphere, as experimentation, for the purpose of teaching, analysis or evaluation of the topography and concepts, processes, systems or techniques included in that same topography.

3. The exclusive rights shall not be exercised with respect to topographies created by third parties based on an analysis or evaluation carried out in compliance with paragraph 2, if those topographies meet the requirements for protection.

## 92. Registration.

1. The topography of semiconductor products may be protected on the condition that:

a) registration is requested in Italy, or if the topography was the subject of prior commercial exploitation anywhere in the world, registration is requested within a period of two years from the date of that first exploitation, provided that the date is specified in a written declaration. For that purpose, commercial exploitation does not include exploitation in conditions of confidentiality in which there was no further distribution to third parties, unless the exploitation of the topography takes place in accordance with conditions of confidentiality dictated by the adoption of measures considered necessary to safeguard essential interests of national security and that refer to the production or sale of arms, munitions and war material;

b) at the time of the first commercial exploitation or request for registration, the owner of the topography is an Italian citizen or legal entity, or if a foreigner, meets the requirements indicated in Article 3 of section I.

2. The right to request registration lapses once fifteen years have passed from the date of the first fixing or codification of the topography, if it has not been the object of commercial exploitation in any part of the world for that same period. For that purpose, commercial exploitation is understood as not including exploitation in conditions of confidentiality in accordance with the indications contained in paragraph 1, letter a).

## 93. Starting date and duration of protection.

1. The exclusive rights under Article 90 arise as of the first of the following dates, in order of time: a) the date of the first commercial exploitation of the topography in any part of the world; b) the date on which the application for registration was presented in proper form.

2. The exclusive rights under paragraph 1 shall be terminated ten years after the first of the following dates, in order of time:

- a) the end of the calendar year in which the topography was commercially exploited for the first time in any part of the world;
- b) the end of the calendar year in which the application for registration was filed in the proper form.

3. For the purposes of this article, commercial exploitation is understood as not including exploitation in conditions of confidentiality in accordance with the indications contained in Article 92, paragraph 1, letter a).

#### **94. Mention of rights reserved.**

1. The topography, the semiconductor product and its external casing may contain a mention consisting of:

- a) the sign "T" enclosed by a circle;
- b) the date on which the topography was the object of commercial exploitation for the first time;
- c) the name, denomination or abbreviation of the owner of the rights to the topography.

2. That mention proves the registration of the topography, or the claim of ownership to the topography or the intention to request registration within the term of two years from the date of the first commercial exploitation.

3. The mention may not be affixed to products for which the application for registration has not been presented within two years of the date of the first commercial exploitation anywhere in the world or has been definitively rejected.

#### **95. Infringement.**

1. The following activities, carried out without the consent of the owner, and including by way of third parties, constitute acts of infringement and violation of exclusive rights on the topographies of semiconductor products:

- a) the reproduction of the topography in any manner and by any means;
- b) the fixing by any means of the topography in a semiconductor product;
- c) the utilization, importation and possession for the purpose of trade, and the trade or distribution of the semiconductor product in which the topography is fixed.

2. Infringement does not include the importation, distribution, trade or utilization of infringed semiconductor products, carried out unknowingly or without a valid reason to suspect the existence of the exclusive rights under Article 90.

3. In the case identified in paragraph 2, the activity undertaken may be continued, within the limits of the contracts already executed and the existing stock, but the owner of the exclusive rights shall be entitled to the payment of fair compensation, starting from the moment in which he adequately notified the good faith buyer that the topography was reproduced illegally. In the absence of an agreement between the parties, the determination and method of payment of the fair compensation compared to the market price shall be subject to the provisions established by Section IV for the license of right.



## 96. Compensation for damages and reasonable compensation.

1. After the registration of the topography or after a cease-and-desist notice from the person who filed the application for registration, if accepted, whoever carries out the actions as per Article 95, shall be obliged to pay compensation for damages pursuant to the provisions of Title III.
2. If the actions under paragraph 1 take place between the first act of commercial exploitation of the semiconductor product with mention of reserved rights and the registration of the topography, the responsible party is obliged to pay only reasonable compensation to the owner of the registered topography.
3. If the acts indicated in letters *a)* and *b)* of paragraph 1 of Article 95 take place after the first act of commercial exploitation of a semiconductor product without the mention of reserved rights, the owner of the registered topography has the right to reasonable compensation and the author of the infringement has the right to obtain a license at fair conditions to continue to exploit the topography within the limits of the use made before it was registered. If the owner of the registration refuses to issue a contractual license, the provisions concerning the granting of a compulsory license set forth in Section IV shall apply, to the extent they are compatible, including those relating to the amount and methods of payment of the compensation in the event of opposition.
4. Whoever has purchased a semiconductor product unknowingly or without having a valid reason to believe that the product is protected by registration, has the right to continue the commercial exploitation of the product. However, for all actions carried out after having learned or having valid reasons to believe that the semiconductor product is protected, payment of reasonable compensation is due. Successors in title of the purchaser under this paragraph shall maintain the same rights and obligations.
5. For the purposes of this article, commercial exploitation is understood as not including exploitation in conditions of confidentiality in accordance with the indications contained in Article 92, paragraph 1, letter *a)*.<sup>(85)</sup>

---

<sup>(85)</sup> Paragraph as amended by paragraph 1 of Article 46, Legislative Decree No. 131 of 13 August 2010.

## 97. Nullity of registration.

1. An application aimed at obtaining a judicial declaration of nullity of the registration of the topography may be brought at any time and by whomever is interested in doing so, if one of the following requirements is omitted, not met or entirely uncertain:
  - a) the requirements of protectability as per Article 88;
  - b) the owner of the topography is not one of the persons indicated in Article 92, paragraph 1, letter *b)*;
  - c) registration has not been requested in Italy within the term set by Article 92, paragraph 1, letter *a)* and, if the commercial exploitation of the topography began in the two-year period prior to 18 March 1989, the registration was not requested by 18 March 1990;<sup>(86)</sup>
  - d) the date of the first act of exploitation was not specified in a specific written declaration;
  - e) the application for registration and the respective attachments do not allow for the identification of the topography and the evaluation of the requirements under letter *a)*.<sup>(87)</sup>

[\(86\)](#) Letter as modified by paragraph 1 of Article 47, Legislative Decree No. 131 of 13 August 2010.

[\(87\)](#) Letter as modified by paragraph 2 of Article 47, Legislative Decree No. 131 of 13 August 2010.

## **Section VII**

### **Confidential Information**

#### **98. Scope of protection.**

1. Protection is granted to business information and technical-industrial experience, including commercial information and experience, subject to the legitimate control of the owner, as long as that information:

a) is confidential, in the sense that as a whole or in its precise configuration and combination of its elements it is not generally known or easily accessible for experts and operators in the field;

b) has an economic value inasmuch as it is confidential;

c) is subject, by the persons to whose legitimate control it is subject, to measures to be considered reasonably adequate to keep it confidential.

2. Protection shall also be granted to data relating to tests or other confidential data, whose processing entails a considerable effort and whose presentation is conditional upon the marketing authorization of chemical, pharmaceutical or agricultural products implying the use of new chemical substances.

#### **99. Protection.**

1. Without prejudice to the provisions on unfair competition, the legitimate owner of the information and business experience as per Article 98, has the right to prohibit third parties, subject to his consent, from acquiring, disclosing to third parties or using that information and experience in an unauthorized manner, except for cases in which the third party has obtained it in an independent manner by the third party. [\(88\)](#)

---

[\(88\)](#) Paragraph as substituted by paragraph 1 of Article 48, Legislative Decree No. 131 of 13 August 2010.

## **Section VIII**

### **New Plant Varieties**

#### **100. Scope of the right.**

1. The right on a new plant variety may consist of a group of plants in a botanical taxon of the lowest grade known that, whether it is or is not entirely consistent with the conditions set for the granting of the breeder's right, can be: [\(89\)](#)

- a) defined based on characteristics resulting from a given genotype or a given combination of genotypes;
- b) distinguished from any other group of plants based on the expression of at least one of said characteristics;
- c) considered as a unit with regard to its suitability to be reproduced unchanged.<sup>(90)</sup>

---

<sup>(89)</sup> Paragraph as modified by paragraph 1 of Article 49, Legislative Decree No. 131 of 13 August 2010.

<sup>(90)</sup> Letter as modified by paragraph 2 of Article 49, Legislative Decree No. 131 of 13 August 2010.

#### **101. Breeder.**

1. For the purposes of this Code, a breeder shall be understood as:

- a) the person who created or discovered and developed a variety;
- b) the person who is the employer of the aforementioned person or who commissioned the latter's work;
- c) the qualified person or successor in title of the persons indicated in letters a) and b).

#### **102. Requirements.**

1. The breeder's right is conferred if the variety is novel, distinct, homogenous and stable.

#### **103. Novelty.**

1. The variety shall be deemed to be new when, as of the date of filing of the breeder application, the vegetative reproduction or multiplication material or a harvest product of the variety has not been sold or otherwise transferred to third parties, by the breeder or with his consent, for the purposes of exploitation of the variety:

- a) on the Italian territory for more than one year from the date of filing of the application;
- b) in any other Country for more than four years, or in the case of trees and vines, for more than six years.

#### **104. Distinctness.**

1. The variety is deemed to be distinct if it is clearly distinguishable from any other variety whose existence, as of the date of filing of the application, is well known.

2. In particular, another variety is deemed to be well known when:

- a) an application for the conferral of the breeder's right or entry in an official register has been filed, in any country, provided that the application has the effect of conferring a breeder's right or the entry of the varieties in the official register;

b) it appears in public collections.

#### **105. Homogeneity.**

1. The variety is deemed to be homogenous when its characteristics that are pertinent and relevant for the purposes of protection are sufficiently uniform, with the reservation of the foreseeable variation as a result of the peculiarities relating to its sexed reproduction and vegetative multiplication.

#### **106. Stability.**

1. The variety is deemed to be stable when its characteristics that are pertinent and relevant for the purposes of protection remain unchanged following subsequent reproductions or multiplications, or in the case of a particular reproduction or multiplication cycle, at the end of each cycle.

#### **107. Scope of the breeder's right.**

1. The authorization of the breeder is necessary for the following actions carried out in relation to the reproduction or multiplication materials of the protected variety:

- a) production or reproduction;
- b) conditioning for the purpose of reproduction or multiplication;
- c) offer for sale, sale or any other form of trade;
- d) exportation or importation;
- e) possession for one of the purposes listed above.

2. The authorization of the breeder is required for the actions mentioned in paragraph 1 carried out in relation to the product of the harvest, including entire plants and parts of plants, obtained through the unauthorized use of materials for reproduction or multiplication of protected varieties, unless the breeder has been able to reasonably exercise his right in relation to the reproduction or multiplication materials. Any use shall be presumed to be unauthorized in the absence of contrary evidence.

3. The provisions of paragraphs 1 and 2 also apply:

- a) to the varieties essentially derived from the protected variety, when the latter is not itself, an essentially derived variety;
- b) to the varieties which are not clearly distinguished from the protected variety in compliance with the requirement of distinctness;
- c) to the varieties whose production requires the repeated use of the protected variety.

4. For the purposes of paragraph 3, letter a), a variety is considered to be essentially derived from another variety, defined as an initial variety, when:

- a) it derives predominantly from the initial variety or from a variety that in turn is predominantly derived from the initial variety, despite preserving the expressions of the essential characteristics that are the result of the



genotype or the combination of genotypes of the initial variety;

*b)* it is clearly distinguishable from the initial variety, and except for the differences generated by the derivation, it complies with the initial variety in terms of the expression of the essential characteristics that are the result of the genotype or the combination of the genotypes of the initial variety.

5. Essentially derived varieties can be obtained, among others, through the selection of a natural or induced mutant or from a somaclonal variation, through selection of an individual variation from plants of the initial variety, through back breeding or transformation through genetic engineering.

6. During the period between the publication of the application and the granting of the patent right, the breeder has the right to reasonable compensation from any person who, in that period, has carried out actions that, once the right has been granted, require the authorization of the breeder's consent.

#### **108. Limitations to the breeder's rights.**

1. The breeder's right shall not extend to: actions carried out in the private sphere, for non-commercial purposes; actions carried out for experimentation; actions carried out for the purpose of creating other varieties, and where the provisions of Article 107, paragraph 3 are not applicable, to actions identified in the same Article 107, paragraphs 1 and 2, carried out with respect to those other varieties.

2. Without prejudice to the provision of Article 107(1), whoever in view of certification, intends to perform the multiplication of material originating from varieties subject to a patent for new plant varieties, is obliged to notify the owner of the right in advance.

#### **109. Duration of the protection.**

1. The breeder's right, granted pursuant to this Code, has a duration of twenty years starting from the grant date. For trees and vines that right has a duration of thirty years from the grant thereof.

2. The effects of the patent right take effect from the date on which the application, accompanied by the descriptive elements, is made accessible to the public.

3. In respect to the persons to whom the application, accompanied by the descriptive elements, has been notified by the breeder, the effects of the patent rights begin from the date of that notification.

#### **110. Moral rights.**

1. The right to be recognized as the author of a new plant variety may be enforced by the author himself, and after his death by the spouse and by the descendants up to the second degree; in their absence or after their death, by the parents and other ancestors, and in their absence or after their death, by relatives up to and including the fourth degree.

#### **111. Property rights.**

1. The rights arising from the establishment of new plant varieties, except for the right to be acknowledged as the author thereof, are disposable and assignable.

2. If the new plant variety is created in the context of employment relationship, Article 64 shall apply.

### **112. Nullity of the right.**

1. The breeder's right is null if it is determined that:

- a) the conditions set by the regulations concerning novelty and distinctness were not actually fulfilled at the time of the conferral of the breeder's right;
- b) the conditions set by the regulations on homogeneity and stability were not actually fulfilled at the time of conferral of the breeder's right, if the breeder's right was essentially conferred on the basis of information or documents provided by the breeder;
- c) the breeder's right was conferred to a person who was not entitled to it and the entitled person did not make use of the rights conferred to him pursuant to Article 118.

### **113. Revocation of the right.**

1. The breeder's right is revoked when it is determined that the conditions relating to homogeneity and stability are no longer actually fulfilled.

2. The right is also revoked if the breeder, upon being served with a notice of default by the competent agency:

- a) does not file the information, documents or materials considered necessary for the control of the maintenance of the variety, within the term of thirty days;
- b) has not paid the fees due to maintain his right;
- c) in the event of cancellation of the denomination of the variety subsequent to the conferral of the right, does not propose another adequate denomination.

3. In the cases provided for in paragraph 2, letters a) and c), the revocation is declared by the Italian Patent and Trademark Office, upon initiative of the Ministry of Agricultural and Forestry Policies.

### **114. Denomination of the variety.**

1. The variety shall be designated by a denomination intended to be its generic designation.

2. The denomination must enable the variety to be identified. It shall not consist only of numerals, unless this is an established practice to designate certain varieties. It must not be susceptible of misleading or creating confusion in regard to its characteristics, the value or the identity of the variety or of the breeder. In particular, it must differ from any other denomination that in the territory of a State belonging to the Union for the Protection of New Varieties of Plants (UPOV), designates a pre-existing variety of the same plant species or a similar plant species, unless this other variety no longer exists and its denomination has not taken on any particular importance.

3. The rights previously acquired by third parties are not prejudiced.

4. The denomination must be identical to that already registered in one of the States belonging to the Union for the Protection of New Varieties of Plants (UPOV) to designate the same variety.

5. A denomination that is filed and meets the requirements of paragraphs 1, 2, 3 and 4 above is registered.
6. A filed and registered denomination, as well as the respective variations, are communicated to the competent authorities of the States belonging to the UPOV.
7. A registered denomination must be used for the variety also after the extinction of the breeder's right, to the extent that, in compliance with the provisions of paragraph 3, the previously acquired rights do not prevent such use.
8. It is possible for the variety denomination to be associated to a trademark, a business name or similar indication, provided that the variety denomination is in any event easily recognizable.

### **115. Compulsory licenses and expropriations.**

1. The breeder's right may be the object of non-exclusive compulsory licenses only for reasons of public interest, as per paragraph 3.
2. To the extent that they are compatible with the provisions contained in this section, compulsory licenses shall be subject to the rules concerning compulsory licenses in Section IV, including those relating to the determination of the amount and method of payment of the compensation in the event of opposition.
3. A Ministerial Decree may at any time grant non-exclusive special compulsory licenses, through payment of reasonable compensation to the owner of the breeder's right, for the utilization of protected new plant varieties that can be useful for the nourishment of humans or livestock, as well as for therapeutic uses or for the production of medicines.
4. The licenses provided for in paragraph 3 are granted based on an affirmative opinion of the Ministry of Agricultural, Food and Forestry Policies that states its position on the conditions prescribed for the granting of licenses.
5. The order granting the license may establish the obligation for the owner of the right to make available to the licensee the necessary material for propagation or multiplication.
6. For new plant varieties, expropriation takes place upon consultation with the Ministry of Agricultural, Food and Forestry Policies.<sup>(91)</sup>

---

<sup>(91)</sup> Article as substituted by paragraph 1 of Article 50, Legislative Decree No. 131 of 13 August 2010.

### **116. Reference.**

1. New plant varieties are subject to the provisions of Section IV, to the extent they do not conflict with the provisions of this section.



## TITLE III

### Judicial Protection of Industrial Property Rights

#### Section I

#### Procedural Regulations

#### **117. Validity and ownership.**

1. Registration and patenting do not affect the exercise of actions concerning the validity and ownership of industrial property rights.

#### **118. Claims.**

1. Whoever is entitled to do so under this Code may file an application for registration or a patent application.
2. If by a final judgment it is determined that the right to registration or the patent belongs to a person other than the one who filed the application, such person may, if the industrial property title has not yet been issued, and within three months of the judgment becoming final:
  - a) take over the application for the patent or registration in his own name, assuming the capacity as the applicant for all purposes;
  - b) file a new application for a patent or registration whose starting date, to the extent that its content does not exceed that of the first application or refers to an object that is essentially identical to that of the first application, dates back to the date of filing or priority of the initial application, which in any case ceases to have effect; in the case of a trademark, file a new application for registration, whose starting date, to the extent that the trademark contained in it is essentially identical to that of the first application, dates back to the date of filing or priority of the initial application, which in any case ceases to have effect;
  - c) obtain the rejection of the application.
3. If the patent has been issued or the registration made in the name of a person other than the entitled party, the latter may do one of the following:
  - a) obtain the transfer of the patent or certificate of registration to his name by way of a judgment, starting on the date of the filing;
  - b) claim the nullity of the patent or registration granted to the person who was not entitled to it.
4. Once a period of two years has passed from the date of publication of the granting of the patent for an invention, utility model, new plant variety, or from the publication of the granting of the registration of a topography of semiconductor products, without the entitled person having made use of one of the rights under paragraph 3, nullity may be claimed by whomever has an interest to do so.
5. The provision of paragraph 4 does not apply to registrations of trademarks and designs and models.
6. Subject to the application of any other safeguards, on request from the entitled party, the registration of a business domain name granted in violation of Article 22 or requested in bad faith may be revoked or

transferred to him by the registration authority.

### 119. Moral rights.

1. The Italian Patent and Trademark Office does not verify the accuracy of the designation of the inventor or author, nor the legitimacy of the applicant's rights, except as regards the controls established by the law or by international conventions. Before the Italian Patent and Trademark Office, it is presumed that the applicant is the owner of the right to registration or to the patent and is entitled to exercise that right.

2. An incomplete or erroneous designation may be corrected only by a request accompanied by a declaration of consent of the person previously designated, and if the request is not filed by the applicant or the owner of the patent or registration, also by a declaration of consent of that party.<sup>(92)</sup>

3. If a third party submits to the Italian Patent and Trademark Office an enforceable judgment which states that the requesting party or the owner of the patent or registration is obliged to designate the former as the inventor or author, the Office records it in the register and publishes the information in the Official Bulletin.

---

<sup>(92)</sup> Paragraph as amended by paragraph 1 of Article 51, Legislative Decree No. 131 of 13 August 2010.

### 120. Jurisdiction and venue.<sup>(93)</sup>

1. The actions concerning industrial property whose titles are granted or in the process of being granted, are brought before the judicial authority of the Country, whatever the citizenship, domicile or residence of the parties may be. If the action for nullity or for infringement are brought when the title has not yet been granted, the judgment may be issued only after the Italian Patent and Trademark Office has acted on the application, examining it prior to the applications filed on an earlier date. The Court, taking account of the circumstances, shall order the suspension of the trial, one or more times, and in the same order set the hearing in which the trial is to continue.<sup>(94)</sup>

2. The actions provided for in paragraph 1 are brought before the judicial authority of the place in which the defendant has his residence or domicile, and if these are unknown, in the place where the defendant has his place of abode, except for what is established in paragraph 3. When the defendant does not have a residence, domicile or place of abode in the territory of the Country, the actions are brought before the judicial authority of the place in which the plaintiff has his residence or domicile. If neither the plaintiff nor the defendant have their residence, domicile or place of abode in the territory of the Country, jurisdiction shall lie with the judicial authority of Rome.

3. The indication of domicile made by the application for registration or patenting and recorded in the register shall be valid as election of exclusive domicile, for the purposes of determining jurisdiction and any service of process before ordinary and administrative judicial authorities. The domicile thus elected may be modified only by way of a specific request for substitution to be recorded in the register by the Italian Patent and Trademark Office.

4. Jurisdiction over matters of industrial property rights lies with the courts expressly indicated for that purpose by Legislative Decree No. 168 of 27 June 2003.

5. Community trademark courts and design and model courts pursuant to Article 91 of Regulation (EC) No. 40/94 and Article 80 of Regulation (EC) No. 2002/6 are understood to be those in paragraph 4.

6. Actions based on circumstances that are presumed to harm the plaintiff's rights may also be brought before the judicial authority having specialized sections in the district where the acts were committed.<sup>(95)</sup>

6-*bis*. The rules of jurisdiction and venue under this article also apply to actions for a declaration of non-infringement, including those brought as precautionary measures.<sup>(96)</sup>

---

<sup>(93)</sup> See also paragraph 2 of Article 128, Legislative Decree No. 131 of 13 August 2010.

<sup>(94)</sup> Paragraph as substituted by paragraph 2 of Article 19, Law No. 99 of 23 July 2009. See also paragraph 8 of that same Article 19.

<sup>(95)</sup> Paragraph as amended by paragraph 1 of Article 52, Legislative Decree No. 131 of 13 August 2010.

<sup>(96)</sup> Paragraph added by paragraph 2 of Article 52, Legislative Decree No. 131 of 13 August 2010.

### 121. Allocation of the burden of proof.

1. The burden of proving the nullity or forfeiture of the title of industrial property always lies with the party that challenges the title. Subject to the provision of Article 67, the burden of proving infringement lies with the owner. The proof of forfeiture of the trademark due to non-use may be provided by any means, including simple presumptions.

2. If a party has provided serious clues that its claims are grounded and has identified documents, elements or information held by the other party that confirm those clues, it may request that the Court order their production or request the information from the other party. The party may also request that the Court order the other party to provide the elements for the identification of the persons involved in the production and distribution of the goods or services that constitute an infringement of the industrial property rights.<sup>(97)</sup>

2-*bis*. In the event of an infringement committed on a commercial scale through acts of piracy as per Article 144, the Court, on request from the party, may also order the production of the banking, financial and commercial documentation that is in the possession of the other party.<sup>(98)</sup>

3. In taking the actions identified above, the Court shall adopt measures suitable to guarantee the safeguarding of confidential information, after consulting with the other party.

4. The Court shall deduce items of evidence from the responses that the parties give and from any unjustified refusal to comply with the orders.

5. In the matters under this Code, the court-appointed expert may receive the documents relating to the questions posed by the Court even if they have not yet been submitted in the case, making them known to all of the parties. Each party may appoint more than one expert.

---

<sup>(97)</sup> Point as modified by Article 14, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

<sup>(98)</sup> Paragraph added by Article 14, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006) and then as modified by paragraph 1 of Article 53, Legislative Decree No. 131 of 13 August 2010.

### 121-bis. Right of information.

1. In both proceedings for interim relief and proceedings on the merits, based on a grounded and proportionate request from the requesting party, the judicial authority may order that information be provided on the origin and distribution networks of goods or the provision of services that violate a right under this law by the author of the infringement and any other person that:

a) has been found to be in possession of goods that infringe a right, on a commercial scale; has been caught

using services that infringe a right, on a commercial scale;

b) has been caught supplying on a commercial scale services used in activities of infringing of a right;

c) has been identified by persons under letters a) or b) as a person involved in the production, manufacture or distribution of those goods or in the supply of those services.

2. The information indicated in paragraph 1 may, among other things, include the name and address of the producers, manufacturers, distributors, suppliers and other prior owners of the goods or services, as well as of wholesalers and retailers, and information on the quantities produced, manufactured, delivered, received or ordered, and also the price of the goods or services in question.

3. The information is acquired through questioning of the persons identified in paragraph 1.

4. The requesting party must provide a specific indication of the person to be questioned and the circumstances on which each is to be questioned.

5. If the Court admits the questioning, it shall ask the persons identified in paragraph 1 for the information indicated by the party; it may also ask them, on its own initiative or on a party's request, all of the questions it deems useful to clarify the circumstances at issue in the questioning.

6. Articles 249, 250, 252, 255 and 257, paragraph 1, of the Code of Civil Procedure, shall apply.<sup>(99)</sup>

---

<sup>(99)</sup> Article added by Article 15, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

## **122. Standing to bring an action for nullity and forfeiture.**<sup>(100)</sup>

1. Subject to the provisions of Article 118(4) an action aimed at obtaining a declaration of forfeiture or nullity of an industrial property title may be exercised by whomever has an interest in doing so, or brought directly by the Public Prosecutor. In derogation of Article 70 of the Code of Civil Procedure, the intervention of the Public Prosecutor is not mandatory.<sup>(101)</sup>

2. An action aimed at obtaining a declaration of nullity of a trademark due to the existence of earlier rights or because the use of the trademark is claimed to constitute an infringement of another's copyright, industrial property rights or other exclusive rights of third parties, or because the trademark constitutes an infringement of the right to the name or image because the registration of the trademark was made in the name of a person not entitled, may be exercised only by the owner of the earlier rights and by his successor in title or by the entitled person.

3. An action aimed at obtaining a declaration of nullity of a design or model due to the existence of earlier rights as per Article 43, paragraph 1, letters d) and e), or because the registration was made in the name of a person not entitled or because the design or model constitutes undue utilization of one of the elements listed in Article 6-ter of the Paris Union Convention for the Protection of Industrial Property - Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, or of designs, emblems and coats of arms that are of particular public interest in the Country, may be exercised, respectively, only by the owner of the earlier rights and his successor in title or by the entitled person, or by a party who has an interest in utilization.

4. An action for forfeiture or nullity of a title of industrial property is exercised jointly with all of those who are recorded in the register as entitled persons because they are owners of the title.<sup>(102)</sup>

5. The judgments that declare the nullity or forfeiture of a title of industrial property are recorded in the register by the Italian Patent and Trademark Office.

6. A copy of the initial pleading of any civil proceeding concerning titles of industrial property must be served

to the Italian Patent and Trademark Office, by the party that brings the action. <sup>(103)</sup>

7. If the aforementioned notification is not made, the judicial authority, at any instance of judgment, and before deciding on the merits, shall order that the notification be made.

8. The clerk of the Court must transmit to the Italian Patent and Trademark Office a copy of any judgment concerning titles of industrial property. <sup>(104)</sup>

---

<sup>(100)</sup> See also paragraph 2 of Article 128, Legislative Decree No. 131 of 13 August 2010.

<sup>(101)</sup> Paragraph as substituted by letter a) of paragraph 3 of Article 19, Law No. 99 of 23 July 2009.

<sup>(102)</sup> Paragraph as amended by paragraph 1 of Article 54, Legislative Decree No. 131 of 13 August 2010.

<sup>(103)</sup> Paragraph as amended by letter b) of paragraph 3 of Article 19, Law No. 99 of 23 July 2009. See also paragraph 4 of that same Article 19.

<sup>(104)</sup> Paragraph as amended by letter b) of paragraph 3 of Article 19, Law No. 99 of 23 July 2009. See also paragraph 4 of that same Article 19.

### 123. Effect erga omnes.

1. Forfeiture or nullity of an industrial property title, even when only partial, have effect towards all when they are declared by a final judgment.

### 124. Corrective measures and civil sanctions. <sup>(105)</sup>

1. By the judgment that determines the infringement of an industrial property right, an injunction may be ordered against the manufacture, sale and use of the items constituting an infringement of the right, and the order to definitively withdraw those items from the market, against the person who is their owner or who has them available. The injunction and order for definitive withdrawal from the market may also be issued against any intermediary who is a party to the proceeding and whose services are used to infringe an industrial property right. <sup>(106)</sup>

2. In issuing the injunction, the Court may set a sum due for any infringement or instance of non-compliance subsequently determined, and for any delay in carrying out the order.

3. In the judgment that determines the infringement of an industrial property right, the destruction of all of the items constituting the infringement may be ordered, if there are no particular reasons against it, at the expense of the author of the infringement. The destruction of the items shall not be ordered, and the entitled person may only receive compensation for damages, if the destruction of the items would cause harm to the national economy. If the goods constituting infringement of the industrial property rights are susceptible to legitimate use, upon adequate modification, instead of their definitive withdrawal or destruction, the Court may order their temporary withdrawal from the market, with the possibility of reinstatement following the adjustments ordered to ensure compliance with the right. <sup>(107)</sup>

4. By the judgment that determines the infringement of industrial property rights, it may be ordered that the items produced, imported or sold infringing the right and the specific means that univocally serve to produce them or to carry out the protected method or process, be assigned to the ownership of the owner of the right, without prejudice to the right to compensation for damages.

5. The Court shall also have the authority, on request from the owner of the items or means of production under paragraph 4, taking into account the remaining duration of the title of industrial property or the

particular circumstances of the case, to order the seizure at the expense of the author of the infringement of the items and means of production until the extinction of the title. In the latter case, the owner of the industrial property right may request that the seized items be awarded to him at a price that, in the absence of an agreement between the parties, will be set by the Judge presiding over the enforcement, after receiving the opinion of an expert, if necessary.

6. The items that constitute an infringement of the industrial property right shall not be ordered to be removed or destroyed, nor may their use be prohibited, when they belong to a person who makes only a personal or domestic use of them. In applying the sanctions, the judicial authority must take into account the necessary proportion between the seriousness of the infringements and the sanctions, as well as the interests of third parties.<sup>(108)</sup>

7. Any challenges that arise during the execution of the measures mentioned in this article, shall be decided by the Judge that issued the judgment containing those measures, by a ruling not subject to appeal, after hearing the opinions of the parties.

---

<sup>(105)</sup> Heading as substituted by Article 16, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

<sup>(106)</sup> Paragraph as substituted by Article 16, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

<sup>(107)</sup> Paragraph as substituted by Article 16, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

<sup>(108)</sup> Point added by Article 16, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

## **125. Compensation for damages and restitution of profits of the author of the infringement.**

1. Compensation due to the damaged party shall be set according to the provisions of Articles 1223, 1226 and 1227 of the Civil Code, taking into account all of the pertinent aspects, such as the negative economic consequences, including lost income, of the owner of the infringed right, the benefits achieved by the infringer, and in the appropriate cases, non-economic elements, such as the moral damage caused to the owner of the right by the infringement.

2. The judgment that rules on the compensation of damages may establish payment of an overall sum set based on the proceedings in the case and the presumptions that result from them. In this case the loss of profits shall however be determined as an amount not less than the royalties that the author of the infringement would have had to pay, had he obtained a license from the owner of the infringed right.

3. In any event, the owner of the infringed right may request the recovery of the profits obtained by the infringer, either as an alternative to compensation for the loss of profits or to the extent that they exceed that compensation.<sup>(109)</sup>

---

<sup>(109)</sup> Article as substituted by Article 17, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

## **126. Publication of the judgment.**

1. The judicial authority may order that the interim relief order or the judgment that determines the infringement of the industrial property rights be published in full or as a summary, or only the ruling of the judgment be published, taking into account the seriousness of the circumstances, in one or more newspapers indicated by it, at the expense of the losing party.



## 127. Criminal and administrative sanctions.

1. Abrogated. <sup>(110)</sup>

1-*bis*. Whoever refuses, without just cause, to respond to the questions of the judge pursuant to Article 121-*bis* or provides false information to the judge, shall be punished with the penalties established by Article 372 of the Criminal Code, reduced by one-half. <sup>(111)</sup>

2. Whoever places words or indications on an item that are not true, and that tend to lead persons to believe that the item is protected by a patent, design or model or a topography, or lead persons to believe that the trademark that it bears is registered, shall be punished by an administrative sanction of from 51,65 Euros to 516,46 Euros.

3. Unless the act constitutes a crime, whoever makes use of a registered trademark, after the respective registration has been declared null, when the cause of nullity entails the unlawfulness of the use of the trademark, or suppresses the trademark of the producer or merchant from whom it received the goods or wares for purposes of trade, shall be punished with an administrative sanction of up to 2.065,83 Euros.

---

<sup>(110)</sup> Paragraph abrogated by paragraph 2 of Article 15, Law No. 99 of 23 July 2009, with the effective date indicated there.

<sup>(111)</sup> Paragraph added by Article 18, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

## 128. Preliminary expert's report.

1. Requests for the completion of a preliminary expert's report provided for by Article 696-*bis* of the Code of Civil Procedure, are to be filed with the President of the specialized section of the court having jurisdiction for the proceeding on the merits, in accordance with the provisions of this article, to the extent compatible. <sup>(112)</sup>

---

<sup>(112)</sup> Article as substituted by paragraph 1 of Article 55, Legislative Decree No. 131 of 13 August 2010.

## 129. Description and seizure.

1. The owner of an industrial property right may request the description or seizure, and also the seizure conditional on the description, of some or all of the items constituting an infringement of that right, as well as of the means used for their production and of the elements of proof concerning the reported infringement and its entity. The measures necessary to guarantee the safeguarding of confidential information shall be adopted.

2. The Court, upon consulting the parties, and when necessary acquiring summary information, shall issue an order, and if the Court orders the description, it shall authorize the possible taking of samples of the items indicated in paragraph 1. In cases involving special urgency, and in particular when possible delays could cause an irreparable harm to the owner of the rights or when the convening of the other party could prejudice the carrying out of the order for description or seizure, the Court shall act on the request issuing a grounded order.

3. Subject to the needs of criminal justice, items in which an infringement of an industrial property right is recognized shall not be seized, but only described, as long as they are present within the confines of an exhibition, that is official or officially recognized, held in the territory of the Country, or that are in transit from or to the same.



4. Description and seizure proceedings are governed by the provisions of the Code of Civil Procedure concerning proceedings for interim relief, to the extent compatible and not derogated by this Code. For the purposes of confirmation, modification or revocation of description and of the possible granting of the interim measures requested together with or conditional upon description, the Court shall set a hearing for oral discussion taking into account the description in order to evaluate its result. <sup>(113)</sup>

---

<sup>(113)</sup> Article as substituted by paragraph 1 of Article 56, Legislative Decree No. 131 of 13 August 2010.

### **130. Execution of description and seizure.** <sup>(114)</sup>

1. Description and seizure are carried out by a judicial official, with the assistance of one or more experts, where necessary, and also with the use of technical means for inspection, photographic or other equipment.
2. The interested parties may be authorized to be present during the operations, including by way of their representatives, and to be assisted by technicians chosen by them.
3. Once the terms set by Article 675 of the Code of Civil Procedure have expired, description and seizure operations that have already been initiated may be completed, but others based on the same order may not be initiated. It shall still be possible to ask the Court to order additional description or seizure measures during the course of the proceeding on the merits.
4. Description and seizure may concern items belonging to persons who need not be identified in the petition, provided that the items are produced, offered, imported, exported or put on the market by the party against whom these measures have been issued, and provided that those items are not for personal use.
5. The record of the seizure and description operations, with the petition and the order, must be notified to the third party to whom the items on which the description or seizure have been carried out belong, within fifteen days of the date of conclusion of the operations, on penalty of losing effect.

---

<sup>(114)</sup> Heading as substituted by paragraph 1 of Article 57, Legislative Decree No. 131 of 13 August 2010.

### **131. Injunction.**

1. The owner of an industrial property right may ask that an injunction be issued against any imminent infringement of his right and the continuance or repetition of any infringements under way, and in particular may ask for an injunction against manufacturing, trading and using the items constituting an infringement of the right, and an order to withdraw them from the market, against a party who is the owner or who has them in any way available, in accordance with the provisions of the Code of Civil Procedure concerning proceedings for interim relief. The injunction and order for withdrawal from the market may be requested, based on the same preconditions, against any party whose services are used to violate an industrial property right. <sup>(115)</sup>

1-*bis*. Abrogated. <sup>(116)</sup>

1-*ter*. Abrogated. <sup>(117)</sup>

1-*quater*. Abrogated. <sup>(118)</sup>

2. In issuing the injunction, the Court may set a sum due for any infringement or instance of non-compliance subsequently determined, and for any delay in executing the order.

---

(115) Paragraph as substituted by Article 19, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006).

(116) Paragraph added by Article 19, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006) and then abrogated by paragraph 1 of Article 58, Legislative Decree No. 131 of 13 August 2010.

(117) Paragraph added by Article 19, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006) and then abrogated by paragraph 1 of Article 58, Legislative Decree No. 131 of 13 August 2010.

(118) Paragraph added by Article 19, Legislative Decree No. 140 of 16 March 2006 (Official Gazette No. 82 of 7 April 2006) and then abrogated by paragraph 1 of Article 58, Legislative Decree No. 131 of 13 August 2010.

### **132. Anticipation of precautionary protection and relationships between the precautionary proceedings and the proceedings on the merits.**

1. The measures provided for by Articles 126, 128, 129, 131 and 133 may also be granted during the patenting or registration procedure, as long as the application has been made available to the public or with respect to the persons to whom the notification of the application was given.
2. If in issuing the precautionary measure the Judge does not set a term by which the parties must start the proceedings on the merits, this must be initiated within the term of twenty business days or thirty-one calendar days if the latter represent a longer period. The term starts from the order if it is issued during the hearing, or otherwise, from its communication. If further precautionary measures are requested in addition to description, together or conditional upon the latter, in order to calculate the term reference will be made to the order of the designated Judge, that also ruled on those further measures.
3. If the proceeding on the merits is not initiated by the mandatory term set in paragraph 2, or if it extinguish after its start, the precautionary measure loses its effect.
4. The provisions provided for by paragraph 3 do not apply to urgent measures issued pursuant to Article 700 of the Code of Civil Procedure and the other precautionary measures suitable to anticipate the effects of the judgment on the merits. In these cases, each party may start the proceedings on the merits.
5. In all of the precautionary proceedings, in order to obtain summary technical indications, the Judge may order an expert testimony. <sup>(119)</sup>

---

(119) Article as substituted by paragraph 1 of Article 59, Legislative Decree No. 131 of 13 August 2010.

### **133. Precautionary protection of domain names.**

1. The judicial Authority may order, as a precautionary measure, in addition to an injunction against use in economic activity of an illegitimately registered domain name, also its provisional transfer, making it conditional, if it is found appropriate, on the presentation of a suitable security deposit by the beneficiary of the measure. <sup>(120)</sup>

---

(120) Paragraph as amended by paragraph 1 of Article 60, Legislative Decree No. 131 of 13 August 2010.

### 134. Rules concerning jurisdiction.

1. The specialized divisions provided for by Legislative Decree No. 168 of 27 June 2003 have jurisdiction for:

a) judicial proceedings concerning industrial property and unfair competition, excluding only those cases that do not interfere, even indirectly, with the exercise of industrial property rights, and also concerning unlawful act regarding the exercise of industrial property rights pursuant to Law No. 287 of 10 October 1990, and Articles 81 and 82 of the Treaty establishing the European Union, the cognizance of which lies with the ordinary courts, and in general on matters that have reasons for connection, even if improper, with those under the jurisdiction of the specialized divisions;

b) disputes on matters regulated by Articles 64, 65, 98 and 99 of this Code;

c) disputes concerning indemnities for expropriation of industrial property rights, under the jurisdiction of the ordinary courts;

d) disputes that concern the orders of the Council of the type under Title VI, under the jurisdiction of the ordinary courts. <sup>(121)</sup>

---

<sup>(121)</sup> Article as substituted by paragraph 5 of Article 19, Law No. 99 of 23 July 2009. See also paragraph 8 of that same Article 19.

### 135. Board of Appeal.

1. An appeal may be filed with the Board of Appeal against the decisions of the Italian Patent and Trademark Office that totally or partially reject an application or request, refuse registration or prevent the recognition of a right, and in the other cases provided for by this Code, within the mandatory term of sixty days from the date of receipt of the notification of the decision. <sup>(122)</sup>

2. The Board of Appeal is made up of a Chairman, a Deputy Chairman, and eight members chosen from among judges of a level not lower than Appeal Court judge, after consulting with the Supreme Judicial Council, or from among professors of juridical fields at universities or superior state institutions. <sup>(123)</sup>

3. The Board is divided into two divisions, officiated by the Chairman and the Deputy Chairman. The Chairman, the Deputy Chairman and the members of the Board are appointed by a decree of the Ministry of Productive Activities, and their term of office lasts for two years. The appointment may be renewed. <sup>(124)</sup>

4. Experts chosen by the Chairman from among professors at universities or superior institutes and from among consultants in industrial property, registered with the Italian Industrial Property Consultants Institute and having proven experience as court-appointed experts may join the Board provided for by paragraph 2 in order to report on single questions submitted to it. The additional experts are not entitled to vote in the decisions of the Commission.

5. The choice of the members of the cited Board, as well as of the experts, may involve both officials in active service, and retired officials, provided that the categories of officials from among which the choice must be made are respected.

6. The Board of Appeal is assisted by a Secretariat whose members are appointed by the same decree establishing the Board, or with a separate decree. The members of the Secretariat must be chosen from among the officials of the Italian Patent and Trademark Office, and their remuneration is established by the existing law, regulations and contracts.

7. The Board of Appeal have consultative function in favour of the Ministry of Productive Activities concerning

matters of industrial property. This function is exercised on request from the Ministry of Productive Activities. The meetings of the Board for such consultations shall not be valid in absence of the absolute majority of its members having the right to vote.

8. The salary of the members of the Board, the members of the Board's Secretariat and the experts aggregated to the Board, shall be set by decree of the Ministry of Productive Activities, in concert with the Ministry of Economy and Finance.

---

[\(122\)](#) Paragraph as amended by paragraph 1 of Article 61, Legislative Decree No. 131 of 13 August 2010.

[\(123\)](#) Paragraph as amended by paragraph 2 of Article 61, Legislative Decree No. 131 of 13 August 2010.

[\(124\)](#) Paragraph as amended by paragraph 3 of Article 61, Legislative Decree No. 131 of 13 August 2010.

### **136. Proceedings before the Board of Appeal.**

1. Notification of the appeal must be filed with the Italian Patent and Trademark Office and served to the opponents to whom the notice directly refers within the term of sixty days from the date on which the interested party received the notification, or was informed of it, or for judicial documents for which individual notification is not required, from the date on which the deadline for publication expired, if this is provided for by law or regulations, without prejudice to the obligation to arrange for additional notifications to other opponents, if ordered by the Board of Appeal. The appeal, with the proof of notification, with a copy of the appealed decision if the appellant is in possession of the same and with the documents that the appellant intends to use in the proceedings, must be filed within the term of thirty days from the last notification, with the offices indicated in Article 147 or sent directly, by registered mail, to the Secretariat of the Board of Appeal, at the Italian Patent and Trademark Office. [\(125\)](#)

2. Together with the appeal, proof of payment of the fee provided for by Article 9 of Presidential Decree No. 115 of 30 May 2002 must be submitted.

3. The original of the appeal must be accompanied by a copy on plain paper for each members of the Board and the opposing parties, although the President of the Board may request a greater number of copies to the interested party.

4. Failure to submit a copy of the appealed decision and the supporting documents shall not imply any forfeiture. The Italian Patent and Trademark Office, within thirty days of the expiration of the deadline for filing the appeal, must present the possible appealed decision by including it in the specific folder kept by the Board's Secretariat, along with the judicial documents and legal briefs based on which the appealed decision was issued, any documents cited in the same, and other documents that the Office considers significant for the proceedings. [\(126\)](#)

5. The President of the Board shall assign the appeal to the relevant division. The Chairman or Deputy Chairman shall appoint a rapporteur from among the members assigned to the division, and if there are technical issues involved, may also appoint one or more additional rapporteurs, chosen from among the additional experts.

6. The Chairman, or the rapporteur appointed by the same, shall set the terms, that in any event shall not be longer than sixty days, for the filing of the briefs and reply briefs of the parties and the submission of the relevant documents.

7. Once the terms under paragraph 6 have expired, the Board may order the means of evidence that it deems appropriate, establishing the methods for their performance. During the course of the preparatory inquiry, the Chairman, or the rapporteur appointed by the same, may consult with the parties for any necessary clarification. If it is not necessary to gather means of evidence, or once that operation has been completed,

the Chairman shall set the date for the oral discussion before the Board.

8. When the divisions of the Board decide on the appeals, they shall make their decisions with the presence of a Chairman and two members with voting rights.

9. The Board has the power to request clarification and documents to the Italian Patent and Trademark Office.

10. The appellant, or his attorney if one has been appointed, who submits a petition within the relevant time period and in any event at least two days before the oral discussion, shall have the right to be present and explain his arguments orally. The appellant may take part to the proceedings personally or assisted by an attorney or a certified attorney with the participation also of an expert. The Office may stand in the proceedings as respondent Agency, with one of its officials. Once the session is opened, the rapporteur reports on the appeal. Subsequently, the parties or their representatives explain their arguments, and in the event of a request from the members of the Board, the director of the Italian Patent and Trademark Office or an official from the same Office designated by the director to represent him, provides the information and documents requested. <sup>(127)</sup>

11. Before the end of the oral discussion of the appeal, any interested party may file explanatory briefs with the Board. If during the oral discussion new circumstances emerge that could influence the decision, the parties must be notified.

12. The Board always has the power to order to gather the means of evidence that it deems suitable, and also has the power, in any event, to defer the decision, or also the oral discussion, to another session.

13. The Commission shall make its decision after the parties have left.

14. If the Board of Appeal finds the appeal to be inadmissible, it shall rule it by judgment; if it finds that the appeal is groundless, it shall reject it by judgment; if it grants the appeal, it shall cancel the judgment in full or in part and adopt the consequent actions. <sup>(128)</sup>

15. The rapporteur, or another member of the Board, shall be assigned to draw up the judgment explaining the grounds for the decision.

16. The judgment shall be notified, by registered mail, by the Secretariat of the Board, to the interested party or to his attorney, if appointed, and published in the Official Bulletin. Only the operative part of the judgment need be published, although the Board shall have the power to order the judgments to be published in full in the Bulletin when they regard general issues and when the publication can cause no harm.

17. If the appellant, alleging serious and irreparable harm as a result of the enforcement of the challenged decision, or of the lack of action by the Italian Patent and Trademark Office, during the time necessary to reach a decision on the appeal, asks for an order of precautionary measures that, based on the circumstances, appear most suitable to provisionally ensure the effects of the decision on the appeal, the Board of Appeal shall rule on the request with an order issued in chambers. Before dealing with the request for precautionary measures, in cases of extreme gravity and urgency, so as not to allow for even a postponement until the date of the session in chambers, together with the request for precautionary measures or with a separate request notified to the other parties, the appellant may ask the Chairman of the Board of Appeal, or the division of the Board to which the appeal has been assigned, to order provisional precautionary measures. The Chairman shall rule by way of a decision with stated grounds, even without due process. The decision shall be effective until the ruling of the Board, to which the request for precautionary measures has to be submitted in the first possible session in chambers. At the time of the decision on the request for precautionary measures, the Board of Appeal, upon determining the entirety of the due process and of the investigation and if the prerequisite are fulfilled, having consulted the parties present in the proceedings, may settle the proceedings on the merits in accordance with the above paragraphs.

18. A petition for revocation or modification of the precautionary measures granted and the filing of a previous request for precautionary measures that was dismissed, shall be admissible only if justified with reference to supervening circumstances.

19. In the event that the Office has not complied with the precautionary measures granted, or has complied only partially, the interested party may ask the Board of Appeal for the appropriate implementation measures, by submitting a grounded request that is notified to the other parties. The Board of Appeal shall exercise the powers relating to the judgment of compliance with the decision, as per Article 27, paragraph 1, No. 4), of the Consolidation Act of laws on the Council of State, approved by Royal Decree No. 1054 of 26 June 1924, as amended, and order the enforcement of the precautionary order indicating the methods for the same, and if necessary, also the entity that must provide for it.

---

[\(125\)](#) Paragraph as amended by paragraph 1 of Article 62, Legislative Decree No. 131 of 13 August 2010.

[\(126\)](#) Paragraph as amended by paragraph 2 of Article 62, Legislative Decree No. 131 of 13 August 2010.

[\(127\)](#) Paragraph as amended by paragraph 3 of Article 62, Legislative Decree No. 131 of 13 August 2010.

[\(128\)](#) Paragraph as amended by paragraph 4 of Article 62, Legislative Decree No. 131 of 13 August 2010.

### **137. Levy of execution and seizure of industrial property titles.**

1. The property rights relating to industrial property may be levied in execution.
2. Execution shall be governed by the provisions established by the Code of Civil Procedure for the enforcement of movable property.
3. The attachment of industrial property titles is carried out by means of an order notified to the debtor by a judicial official. The order must contain:
  - a) the declaration of attachment of the industrial property title, subject to mention of the elements sufficient to identify it;
  - b) the date of the title and its transmission in enforceable form;
  - c) the sum for which the execution is to be carried out;
  - d) the first and last name, and domicile or residence of the creditor and of the debtor;
  - e) the first and last name of the judicial official.
4. Starting on the date of notification, the debtor assumes the obligations of the judicial executor of the industrial property title, also as regards any potential proceeds. The proceeds, accrued after the date of notification, resulting from the granting of use of the industrial property right, are combined with the revenues from the sale, for the purpose of the subsequent awarding.
5. With regard to the notification of the order of attachment, the provisions contained in the Code of Civil Procedure for the notification of summons shall be applied. If the person to whom the order of attachment must be notified does not have a domicile or residence in the Country, and has not elected domicile there, the notification is made to the Italian Patent and Trademark Office. In the latter case, a copy of the order is affixed in the register of the Office and included in the Official Bulletin.
6. The order of attachment of the industrial property right must be recorded, on penalty of nullity, within eight days of the notification. Once the order of attachment of the industrial property right is recorded, and until the attachment takes effect, the attachments recorded subsequently shall be valid as opposition on the price of sale, when they are notified to the creditor.
7. The sale and awarding of the attached industrial property rights are made according to the corresponding



provisions of Code of Civil Procedure to the extent applicable, without prejudice to the particular provisions of this Code.

8. The sale of the industrial property right shall not occur unless at least thirty days have passed from the attachment. For the sale, a period of twenty days must pass from the order setting the date of the sale. For the sale and awarding of the industrial property rights, the Court shall set the special forms that it deems appropriate in the individual cases, and also provide for the announcement of the sale to the public, even notwithstanding the provisions of the Code of Civil Procedure. For that purpose, the Court may determine that the announcement shall be affixed in the premises of the Chamber of Commerce and in those of the Italian Patent and Trademark Office and published in the Bulletin of industrial property rights.

9. The record of the award must contain the details of the industrial property right in accordance with the records of the respective titles.

10. In the enforcement of claims on industrial property rights, at least ten days prior to the sale, the petitioning creditor must notify to the creditors who hold the security interests, that are recorded, the order of attachment and the order setting the date of the sale. Those creditors must file at the registry of the competent judicial authorities, their claims for positioning with the supporting documents within fifteen days of the sale. Whoever is interested may examine those requests and documents.

11. Once the period of fifteen days provided for by paragraph 10 has passed, on request of the party, the Court shall set the hearing during which it will propose the ranking and division of the price obtained from the sale and from any potential proceeds. During the hearing, once the Judge has determined that the provisions of paragraph 10 have been followed, if the parties did not agree on the distribution of the proceeds, the Judge shall proceed to determine the ranking among the creditors and the distribution of those proceeds, in accordance with the provisions of the Code of Civil Procedure concerning enforcement of movable property. Possible or qualified credits with interest on arrears become collectible in accordance with the provisions of the Civil Code. <sup>(129)</sup>

12. The party that obtain the industrial property right shall have the right to obtain the cancellation of the records of the security interests on the corresponding title, by filing with the Italian Patent and Trademark Office a copy of the record of the award and the clerk's certificate of the payment of the price of the award, in accordance with the provisions for cancellation of the records.

13. Industrial property rights, even when they are being granted or registered, may be subject to seizure. The seizure proceedings is subject to the provisions concerning execution provided for by this article and also those on attachment provided for by the Code of Civil Procedure.

14. Disputes concerning the levy of execution and seizure of industrial property rights are brought before the judicial authorities of the Country with jurisdiction pursuant to Article 120.

---

<sup>(129)</sup> Paragraph as amended by paragraph 1 of Article 63, Legislative Decree No. 131 of 13 August 2010.

### **138. Registration.**

1. The following legal documents must be made public through registration at the Italian Patent and Trademark Office:

a) *inter vivos* conveyances, for or without consideration, that transfer, in full or in part, rights on industrial property titles;

b) *inter vivos* conveyances, for or without consideration, that establish, modify or transfer personal rights or rights in rem, special privileges or security interests, concerning these titles established pursuant to Article



140;

- c) deeds of division, association, settlements or waivers, relating to the rights identified in letters a) and b);
- d) the record of attachment;
- e) the record of the award following the forced sale;
- f) the record of suspension of the sale of part of the attached industrial property rights to be returned to the debtor, pursuant to the Code of Civil Procedure;
- g) expropriation decrees for reasons of public interest;
- h) judgments that declare the existence of the conveyances indicated in letters a), b) and c), when those transfers have not been previously registered. The judgments that declare the nullity, cancellation, termination, revocation of a registered conveyance must be noted on the margin of the registration of the conveyance they refers to. Legal actions aimed at obtaining the judgments under this article may also be registered. In that case, the effects of the registration of the judgment date back to the date of registration of the legal action;
- i) wills and legal documents that prove that a statutory succession has occurred and the respective judgments;
- l) judgments concerning claims on industrial property rights and the respective legal actions;
- m) judgments that order the conversion of null industrial property rights and the respective legal actions;
- n) legal actions aimed at obtaining the judgments under this article. In this case, the effects of the registration of the judgment date back to the date of registration of the action.

2. The registration is subject to the payment of the prescribed fee.

3. In order to obtain the registration, the applicant must file a specific note of registration, in the form of an application, attaching a certified copy of the public act or the original or a certified copy of the certified private agreement, or any other documentation required by Article 196. <sup>(130)</sup>

4. After examining the formal regularity of the legal documents, the Italian Patent and Trademark Office shall proceed, without delay, to perform the registration with the date the application was filed.

5. The order of the registrations is determined by the order of the applications' submissions.

6. Any omissions or mistakes that do not lead to total uncertainty concerning the legal documents to be registered or the industrial property title the legal document refers to, shall not entail the invalidity of the registration.

---

<sup>(130)</sup> Paragraph as amended by paragraph 1 of Article 64, Legislative Decree No. 131 of 13 August 2010.

### 139. Effects of registration.

1. The legal documents and judgments, with the exception of the wills and the other legal instruments and judgments indicated in letters d), i) and l) of Article 138, until they are registered, shall not be valid towards third parties that have in any manner purchased and legally preserved rights on the industrial property title.

2. In the event of a conflict between multiple purchasers of the same industrial property right from the same

owner, the purchaser who registered his title of purchase first shall have precedence.

3. The registration of a record of attachment, as long as it has effect, suspends the effects of additional registrations of the above-cited legal documents and judgments. Those registrations lose their effect after the registration of the record of the award, provided that this takes place within three months of the date of the award.

4. The wills and legal instruments that prove that a statutory succession has occurred and the respective judgments are registered only to establish the continuity of the transfers.

5. Instruments that transfer, in full or in part, or modify, the rights relating to a European application or patent, are enforceable towards third parties, provided that they have been recorded in the European Patent Register or registered in the Italian Register of European patents.<sup>(131)</sup>

---

<sup>(131)</sup> Paragraph as amended by paragraph 1 of Article 65, Legislative Decree No. 131 of 13 August 2010.

#### **140. Security interests.**

1. Security interests on industrial property titles must consist of cash loans.
2. In the presence of conflicting security interests, the priority is determined by the order of the registrations.
3. The cancellation of the registrations of security interests is carried out following the submission of the statement of consent of the creditor with certified signature, or when the cancellation is ordered by a judgment that has become final, or following the satisfaction of the secured rights following the enforcement.
4. For cancellation, the same fee is necessary as required for registration.

#### **141. Expropriation.**

1. Except for rights on trademarks, industrial property rights, even during the registration or patenting procedure, may be expropriated by the State in the interest of military defense of the Country or for other reasons in the public interest.
2. Expropriation may be restricted to the right of use for the needs of the Country, without prejudice to the provisions concerning compulsory licenses to the extent compatible.
3. With the cited expropriation, when it is carried out in the interest of the military defense of the Country and regards an industrial property title of Italian owners, the right to apply for an industrial property titles abroad is also transferred to the expropriating agency.

#### **142. Expropriation decree.**

1. Expropriation is ordered by a decree of the President of the Republic, on proposal from the relevant Minister, in concert with the Ministries of Productive Activities and of Economy and Finance, upon receiving the opinion of the Council of Ministers, if the measure regards the military defense of the Country, or in other cases, by the Board of Appeal.

2. An expropriation decree in the interest of the military defense of the Country, when issued prior to the printing of the certificate of patenting or registration, may include the obligation and establish the duration of

confidentiality concerning the subject matter of the industrial property title.

3. The violation of the requirement of confidentiality shall be punished pursuant to Article 262 of the Criminal Code.

4. The expropriation decree shall set the indemnity due to the owner of the industrial property right, determined based on the market value of the same, upon receiving the opinion of the Board of Appeal. <sup>(132)</sup>

5. Judicial protection before the administrative courts is regulated by the Administrative Trial Code. <sup>(133)</sup>

---

<sup>(132)</sup> Paragraph as amended by paragraph 1 of Article 66, Legislative Decree No. 131 of 13 August 2010.

<sup>(133)</sup> Paragraph as substituted by paragraph 16 of Article 3 of Annex 4 to Legislative Decree No. 104 of 2 July 2010, starting from 16 September 2010, in accordance with what is established by Article 2 of that same measure.

### **143. Indemnity for expropriation.**

1. If the owner of the expropriated right does not accept the indemnity set pursuant to Article 142, and if no agreement is reached between the owner and the proceedings agency, the indemnity shall be determined by an arbitration board.

2. An inventor or author who proves that he has lost the right to priority abroad due to a delay in a negative decision by the Ministry relating to expropriation, shall be granted reasonable compensation, in accordance with the rules regarding the indemnity for expropriation.

3. Expropriation decrees must be recorded in the Register of industrial property titles by the Italian Patent and Trademark Office.

## **Section II**

### **Measures against Piracy**

#### **144. Acts of piracy.**

1. For the purposes of the provisions contained in this section, acts of piracy shall include evident infringement of registered trademarks, designs and models and the infringements of others' industrial property rights carried out willfully and systematically.<sup>(134)</sup>

---

<sup>(134)</sup> Paragraph as substituted by paragraph 1 of Article 67, Law Decree No. 131 of 13 August 2010.

#### **144-bis. Preliminary seizure for securing damages collection.**

1. When the injured party invokes the existence of circumstances sufficient to prejudice the satisfaction of the compensation for damages, the judicial authorities, pursuant to Article 671 of the Code of Civil Procedure, may order the preliminary seizure of the personal and real property of the alleged author of the infringement, including the freezing of his bank accounts and other assets up to the level of the presumable amount of damage. To that end, the judicial authorities may order the communication of the banking, financial and business documentation, or authorize access to the relevant information.<sup>(135)</sup>

---

<sup>(135)</sup> Article added by Article 20, Law Decree No. 140 of 16 March 2006 (Off. Bulletin No. 82 of 7 April 2006).

#### **145. National Anti-Counterfeiting Council (CNAC).**

1. A National Anti-Counterfeiting Council is established at the Ministry of Economic Development, with functions of policy, initiative and coordination of the strategic actions undertaken by each agency, in order to improve the sum of actions to fight against the infringement at the national level.

2. The National Anti-Counterfeiting Council shall be presided over by the Minister of Economic Development or by a representative designated by the same. In order to guarantee the representation of public and private interests and ensure the needed synergy between the public administration and the entrepreneurs, the Council shall be made up of a representative of the Ministry of Economic Development, a representative of the Ministry of Economy and Finance, a representative of the Ministry of Foreign Affairs, a representative of the Ministry of Defense, a representative of the Ministry of Agricultural, Food and Forestry Policies, a representative of the Ministry of the Interior, a representative of the Ministry of Justice, a representative of the Ministry of Cultural Heritage and Activities, a representative of the Ministry of Labor and Social Policies, a representative of the Ministry of Health, and a representative of the Department of the Public Function and a representative designated by the National Association of Italian Municipalities (ANCI). Based on the issues discussed, the Board may invite representatives of other public agencies to participate in its proceedings, as well as representatives of categories of businesses, workers and consumers.

3. The method of functioning of the National Anti-Counterfeiting Council shall be defined by a decree of the Ministry of Economic Development, in agreement with the Ministries of Economy and Finance, Foreign Affairs, Defense, Agricultural, Food and Forestry Policies, the Interior, Justice, Cultural Heritage and Activities, Labor and Social Policies and Health. The secretariat activities shall be carried out by the General Directorate for the

Fight against Counterfeiting - Italian Patent and Trademark Office.

4. Participation in the National Anti-Counterfeiting Council shall not give rise to the payment of compensation, emoluments, indemnities or expense reimbursements. The implementation of paragraphs 1, 2 and 3 shall take place using the human and financial resources and equipment available under current legislation. <sup>(136)</sup>

---

<sup>(136)</sup> This article, already abrogated by Article 1-*quater* of Law Decree No. 35 of 14 March 2005, in the text supplemented by the respective conversion law. It was then substituted by paragraph 1 of Article 68, Law Decree No. 131 of 13 August 2010.

#### **146. Actions against piracy.**

1. If it receives any information regarding cases of piracy, the Ministry of Productive Activities shall notify the Public Prosecutor's Office for the respective territory of such cases so that it may take the actions under its purview.

2. Notwithstanding the repression of crimes and the application of national and EU regulations on the subject, under the authority of the customs authorities, the Ministry of Productive Activities, through the Prefect of the respective province and the mayors, as regards the municipal territories, may order the administrative attachment of the infringed goods, including *ex officio*, and once three months have passed, subject to authorization from the judicial authorities indicated in paragraph 3, may proceed to destroy the goods at the expense of the offender. Samples may be kept to be used for judicial purposes.

3. The responsibility for authorizing such destruction lies with the president of the specialized section as indicated in Article 120, in whose territory the act of piracy has taken place, on request from the state or municipal agency that ordered the attachment.

4. An opposition against the order for destruction as per paragraph 2 may be brought before the specialized section of the Court with territorial jurisdiction in the forms set forth in Articles 22 and 23 of Law No. 689 of 24 November 1981, as amended. The time limit for the appeal shall start from the date of notification of the order or that of its publication, in the form of an extract, in the Official Bulletin of the Italian Republic. <sup>(137)</sup>

---

<sup>(137)</sup> Paragraph as amended by paragraph 1 of Article 69, Law Decree No. 131 of 13 August 2010.

## **TITLE IV**

### **Purchase and Maintenance of Industrial Property Rights and Related Procedures**

#### **Section I**

##### **Applications in General**

#### **147. Filing of applications and requests.** <sup>(138)</sup>

1. All applications, requests, legal instruments, documents and notified appeals mentioned in this Code, with the exception of what is provided for by international conventions and agreements, are to be filed at the Italian Patent and Trademark Office, the Chambers of Commerce, Industry and Crafts, and at the public offices or entities determined by a decree of the Minister of Economic Development. By a decree of that same Minister, with respect to the provisions contained in Legislative Decree No. 82 of 7 March 2005, the methods



of filing are determined, including those to be implemented through the use of alternative means of communication. As of receipt of the above, the aforementioned offices or entities shall issue a certification of filing and within the subsequent ten days, they shall transmit to the Italian Patent and Trademark Office, in the forms indicated in the decree, the legal documents filed and the respective certification.<sup>(139)</sup>

2. The offices or entities authorized to receive the filings are obliged to adopt the measures necessary to ensure observance of official confidentiality.

3. Members of the staff of the Italian Patent and Trademark Office may not directly or through third parties request patents for industrial inventions or become assignees of the same, until two years have passed from when they ceased belonging to their office.<sup>(140)</sup>

3-bis. The applicant or his attorney, if one exists, shall in each application indicate or elect his domicile in the Country for all of the communications and notifications to be made pursuant to this Code.<sup>(141)</sup>

---

<sup>(138)</sup> See also Ministerial Decree No. 33 of 13 January 2010.

<sup>(139)</sup> Paragraph as substituted by paragraph 1 of Article 70, Law Decree No. 131 of 13 August 2010.

<sup>(140)</sup> See also Ministerial Decree 10 April 2006 and Ministerial Decree 24 October 2008.

<sup>(141)</sup> Paragraph added by paragraph 2 of Article 70, Law Decree No. 131 of 13 August 2010.

#### **148. Admissibility and supplementation of the applications and date of filing.**<sup>(142) (143)</sup>

1. Applications for patents, registration and renewal as per Article 147(1) shall not be admitted if the applicant cannot be identified or contacted, and in the case of first filing of trademarks, also when the application does not contain a reproduction of the mark or the list of products or services. Subject to what is established in paragraph 3, inadmissibility is declared by the Italian Patent and Trademark Office.<sup>(144)</sup>

2. The Italian Patent and Trademark Office shall invite the applicant to submit all of the necessary additional material, subject to a late fee in the event of late payment, within the time limit of two months from the date of communication, if it determines that:

a) the application for industrial inventions and utility models is not accompanied by an enclosed document that can be considered similar to a description, or lacks part of the description or a design referenced in it, or if the application, instead of the description, contains a reference to an earlier application for which the number, date of filing, state in which it was filed and identification data of the applicant are not provided;

b) the application for plant varieties is not accompanied by at least one sample of the description with at least one copy of the photographs referenced in the same;

c) the application for models and designs is not accompanied by a graphic or photographic reproduction;

d) the application for topographies is not accompanied by a document that allows for its identification;

e) the documents proving payment of the prescribed fees are not delivered by the deadline set in Article 226;

e-bis) no domicile or certified attorney is indicated in Italy.<sup>(145)</sup>

3. If the applicant complies with the request from the office by the time limit set in paragraph 2 or spontaneously provides the relevant additional material, the Office recognizes as the date of filing, for all intents and purposes, the date of receipt of the additional material requested and notifies the applicant. If the applicant does not comply with the request from the office by the time limit set in paragraph 2, except in

cases where, by that time limit, the applicant has expressly waived part of the missing description or design as per paragraph 2, letter a), the Office declares the application to be inadmissible pursuant to paragraph 1.

4. If, however, the additional material concerns only the proof of payment of the fees by the required deadline or the indication of domicile or the attorney in Italy, and that proof or indication is delivered within the time limit set in paragraph 2, the Office shall recognize as the date of filing the date of receipt of the application.<sup>(146)</sup>

5. All of the applications, requests and appeals pursuant to Article 147, with the enclosed documents, shall be drawn up in the Italian language. Translations into Italian shall be provided of any documents in other languages. The translation may be declared to be consistent with the original text by the applicant or a certified attorney. If the description is presented in a language other than Italian, the translation into Italian shall be filed by the deadline set by the Office.<sup>(147)</sup>

5-*bis*. Upon request, the Office shall issue a copy or a certified copy of the documents or references submitted as of the filing. The Italian translation, if filed subsequently, shall be enclosed on request.<sup>(148)</sup>

---

<sup>(142)</sup> Heading as substituted by paragraph 1 of Article 71, Law Decree No. 131 of 13 August 2010.

<sup>(143)</sup> See also arts. 4 to 6 and 11, of Ministerial Decree No. 33 of 13 January 2010.

<sup>(144)</sup> Paragraph as amended by paragraph 2 of Article 71, Law Decree No. 131 of 13 August 2010.

<sup>(145)</sup> Letter added by paragraph 3 of Article 71, Law Decree No. 131 of 13 August 2010.

<sup>(146)</sup> Paragraph as substituted by paragraph 4 of Article 71, Law Decree No. 131 of 13 August 2010.

<sup>(147)</sup> Paragraph as amended by paragraph 5 of Article 71, Law Decree No. 131 of 13 August 2010.

<sup>(148)</sup> Paragraph added by paragraph 6 of Article 71, Law Decree No. 131 of 13 August 2010.

#### **149. Filing of European patent applications.**<sup>(149)</sup>

1. European patent applications shall be filed at the Italian Patent and Trademark Office in the manner established by the Implementation Regulation.

2. The provisions of Article 198, paragraphs 1 and 2, shall apply. For the purposes of application of those provisions, the application shall be accompanied by a summary in Italian that exhaustively defines the characteristics of the invention, as well as a copy of any designs.<sup>(150)</sup>

3. The Italian Patent and Trademark Office shall immediately inform the European Patent Office of the filing of the application.

---

<sup>(149)</sup> See also Ministerial Decree No. 33 of 13 January 2010.

<sup>(150)</sup> Paragraph as amended by paragraph 1 of Article 72, Law Decree No. 131 of 13 August 2010.

#### **150. Forwarding of a European patent application.**

1. European patent applications whose object, in the opinion of the military patent service of the Ministry of Defense, are manifestly not susceptible of being bound by confidentiality for reasons of military defense, shall



be forwarded by the Italian Patent and Trademark Office to the European Patent Office in the shortest time possible, and in any event within six weeks from the date of their filing.

2. In the event that the European patent applications are deemed to be withdrawn pursuant to Article 77(5) of the European Patent Convention, within three months of the date of receipt of the communication, the applicant shall have the right to request the conversion of the application into an Italian patent application for an industrial invention.

3. Subject to the provisions for safeguarding the confidentiality of inventions regarding the military defense of the Country, the Italian Patent and Trademark Office, if twenty months have not yet passed from the date of filing or priority, shall transmit a copy of the request for conversion as per paragraph 2 to the central services of the other Countries indicated in the same request, annexing a copy of the European patent application submitted by the requesting party.

#### **151. Filing of international application.** <sup>(151)</sup>

1. Italian individuals and legal entities who have domicile or their registered office in Italy may file international applications for the protection of inventions at the Italian Patent and Trademark Office, which acts as the receiving office pursuant to Article 10 of the Patent Cooperation Treaty of 19 June 1970, ratified by Law No. 260 of 26 May 1978.

2. The application may be filed at the Italian Patent and Trademark Office in accordance with the provisions of the Implementation Regulation; the date of filing of the application is determined pursuant to Article 11 of the Patent Cooperation Treaty.

3. An international application may also be filed at the European Patent Office, in its capacity as the receiving office, pursuant to Article 151 of the European Patent Convention of 5 October 1973, ratified by Law No. 260 of 26 May 1978, No. 260, at the World Intellectual Property Organization of Geneva as the receiving office, following the provisions of Article 198, paragraphs 1 and 2.

---

<sup>(151)</sup> See also Ministerial Decree No. 33 of 13 January 2010.

#### **152. Requirements of international application.**

1. An international application shall comply with the provisions of the Patent Cooperation Treaty of 19 June 1970, ratified by Law No. 260 of 26 May 1978, and its Implementation Regulation.

2. Only for the purposes of the application of Article 198, paragraphs 1 and 2, the application shall be accompanied by a summary in the Italian language that exhaustively defines the characteristics of the invention, as well as a copy of any drawings. <sup>(152)</sup>

3. An international application and each of its annexed documents, with the exception of those proving the payment of the fees, shall be filed in original with two copies in addition. Any missing copy will be prepared by the Italian Patent and Trademark Office at the expense of the applicant.

---

<sup>(152)</sup> Paragraph as amended by paragraph 1 of Article 73, Law Decree No. 131 of 13 August 2010.

### **153. Confidential nature of international application.**

1. The Italian Patent and Trademark Office, subject to the consent of the applicant, shall allow public access to the application only after the international publication has taken place or after the designated office has received the communication pursuant to Article 20 of the Patent Cooperation Treaty of 19 June 1970, ratified by Law No. 260 of 26 May 1978, or the copy as per Article 22 of that same Treaty, or in any event, once twenty months have passed from the date of priority.

2. The Italian Patent and Trademark Office may give notice that it has been designated, disclosing only the name of the applicant, the title of the invention, the date of filing and the number of the international application.

### **154. Forwarding of international application.**

1. The Italian Patent and Trademark Office shall forward the international application to the international office and the agency that is assigned to conduct the search, within the terms set by rules 22 and 23 of the Implementation Regulation of the Patent Cooperation Treaty.

2. If by fifteen days prior to the expiration date of the time limit for forwarding of the original copy of the international application, as set by rule 22 of the Implementation Regulation of the Patent Cooperation Treaty, the imposition of the restriction of confidentiality has been received from the Ministry of Defense, the Office shall notify the applicant, directing him to comply with the obligation of confidentiality.

3. Within ninety days of the date of notification as per paragraph 2 may be presented a request to convert the international application into a national application that takes the same date as the international one; if the conversion is not requested, the application is considered to be withdrawn.

### **155. Filing of international applications for designs and models.**

1. Italian individuals and legal entities or those who have domicile or a genuine organization in Italy may file international applications for the protection of designs or models directly at the International Office or with the Italian Patent and Trademark Office, pursuant to Article 4(1) of the Hague Agreement Concerning the International Deposit of Industrial Designs of 6 November 1925, and subsequent revisions, ratified by Law No. 744 of 24 October 1980, and hereinafter referred to as: the "Agreement."<sup>(153)</sup>

2. The application at the Italian Patent and Trademark Office may also be sent through a registered mail, return receipt requested.

3. The date of filing of the application is that of Article 6(2) of the Agreement.

4. An international application shall comply with the provisions of the Agreement and the respective Implementation Regulation, in addition to the administrative instructions issued by the International Office, and be drawn up in French or English on the forms prepared by the International Office.

---

<sup>(153)</sup> Paragraph as amended by paragraph 1 of Article 74, Law Decree No. 131 of 13 August 2010.

### **156. Application for registration of trademark.**

1. An application for registration of trademark shall contain: <sup>(154)</sup>

a) the identification of the applicant and the attorney, if one exists;

b) any claim of priority or the date from which the effects of the application begin following the granting of conversion of a previous Community application or an application for international registration pursuant to the relevant protocol of the Madrid Agreement Concerning the International Registration of Marks of 27 June 1989, ratified by Law No. 169 of 12 March 1996;

c) the reproduction of the mark;

d) the list of the products and services that the mark is intended to identify, grouped according to the categories of classification of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks, Geneva text of 13 May 1977, ratified with Law No. 243 of 27 April 1982. <sup>(155)</sup>

2. When an attorney has been appointed, the application shall be accompanied by the letter of engagement pursuant to Article 201.

---

<sup>(154)</sup> See also Article 44, paragraph 2, Ministerial Decree No. 33 of 13 January 2010.

<sup>(155)</sup> Letter as modified by paragraph 1 of Article 75, Law Decree No. 131 of 13 August 2010.

### **157. Application for registration of collective mark.** <sup>(156)</sup>

1. An application for registration of a collective mark shall be accompanied by, in addition to the documents pursuant to Article 156, paragraphs 1 and 2, also a copy of the regulations pursuant to Article 11. <sup>(157)</sup>

---

<sup>(156)</sup> See also Article 44, paragraph 2, Ministerial Decree No. 33 of 13 January 2010.

<sup>(157)</sup> Paragraph as amended by paragraph 1 of Article 76, Law Decree No. 131 of 13 August 2010.

### **158. Division of the application for registration of trademark.** <sup>(158)</sup>

1. Each application shall concern only one trademark.

2. If the application concerns more than one trademark, the Italian Patent and Trademark Office shall invite the interested party, setting a deadline, to limit the application to only one trademark, with the right to file a number of applications equal to the remaining trademarks, that will have the date of the first application.

3. Each application for registration, concerning multiple goods or services, may be divided by the applicant into multiple partial applications, in which the goods or services of the initial application will be divided, in the following cases:

a) before the decision of the office relating to the registration of the trademark;

b) during each opposition proceeding concerning the decision of the office on registration of the trademark;

c) during each appeals proceeding against the decision relating to registration of the trademark. <sup>(159)</sup>

4. Partial applications maintain the date of filing of the initial application, and if applicable, the benefit of the right of priority.

5 An appeal to the Board of Appeal suspends the time limit set by the office.

---

[\(158\)](#) See also arts. 15 and 44, paragraph 2, Ministerial Decree No. 33 of 13 January 2010.

[\(159\)](#) Letter as modified by paragraph 1 of Article 77, Law Decree No. 131 of 13 August 2010.

### **159. Application for renewal of trademark.** [\(160\)](#)

1. An application for renewal of a trademark shall be made by the owner or his successor in title.

2. [The application, accompanied by the payment of the fees due, shall be filed within the last twelve months prior to the date of expiration of the decade under way. Once that period has passed, the application for renewal may be filed in the six months subsequent to the month of expiration with an application of an extra fee]. [\(161\)](#)

3. When there is an attorney, the application shall be accompanied by the letter of engagement pursuant to Article 201.

4. For registered trademarks based on an application for conversion of an application for a Community trademark or of a Community trademark, filed pursuant to Council Regulation (EC) No. 40/94, of 20 December 1993, on the Community trademark and subsequent amendments, or based on an application for conversion of an international registration, filed pursuant to Article 9-*quinquies* of the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks of 27 June 1989, ratified by Law No. 169 of 12 March 1996, the effects of the first registration, for the purposes of renewal, shall start from the date of filing of the application for a Community trademark or the date of international registration, respectively.

5. [If the earlier trademark belongs to multiple persons, the application for renewal shall be made by one only, on behalf of all of them]. [\(162\)](#)

6. If the application for renewal or the fees paid refer only to a part of the goods or services for which the trademark was registered, the registration is renewed only for the relevant goods or services.

---

[\(160\)](#) See also arts. 18 and 44, paragraph 2, Ministerial Decree No. 33 of 13 January 2010.

[\(161\)](#) Paragraph abrogated by paragraph 1 of Article 78, Law Decree No. 131 of 13 August 2010.

[\(162\)](#) Paragraph abrogated by paragraph 1 of Article 78, Law Decree No. 131 of 13 August 2010.

### **160. Application for patent for invention and utility model.** [\(163\)](#)

1. The application must contain:

a) the identification of the applicant and attorney, if one exists;

b) the indication of the invention or model, in the form of a title, that expresses its character and purpose briefly but precisely. [\(164\)](#)

2. A single application may not contain the request for more than one patent, or a single patent for more than one invention or model.

3. The application must be accompanied by:

- a) the description and claims as per Article 51; <sup>(165)</sup>
- b) the drawings of the invention, where possible;
- c) the designation of the inventor;
- d) when an attorney has been appointed, also the letter of engagement pursuant to Article 201;
- e) in the event of claims of priority, the relevant documents.

4. The description of the invention or the model must begin with a summary only with the purpose of providing technical information, and must be followed by one or more claims. The latter, if they have not been included with the description at the time of filing, must be filed within the term of two months from the date of the application. In that case, the date of filing already recognized shall remain valid. <sup>(166)</sup>

---

<sup>(163)</sup> See also Article 21, Ministerial Decree No. 33 of 13 January 2010.

<sup>(164)</sup> Letter as modified by paragraph 1 of Article 79, Legislative Decree No. 131 of 13 August 2010.

<sup>(165)</sup> Letter as substituted by paragraph 2 of Article 79, Legislative Decree No. 131 of 13 August 2010.

<sup>(166)</sup> Paragraph as substituted by paragraph 3 of Article 79, Legislative Decree No. 131 of 13 August 2010.

### **161. Unique nature of invention and division of application.**

1. Each application must concern only one invention.
2. If the application includes multiple inventions, the Italian Patent and Trademark Office will set a deadline and ask the interested party to limit that application to only one invention, with the right to file a number of applications equal to the remaining inventions, that will have effect from the date of the initial application. That right may be exercised by the applicant, even in the absence of a request from the Italian Patent and Trademark Office, before that Office has granted the patent. <sup>(167)</sup>
3. An appeal to the Board of Appeal suspends the term assigned by the Office.

---

<sup>(167)</sup> Paragraph as amended by paragraph 1 of Article 80, Legislative Decree No. 131 of 13 August 2010.

### **162. Deposit, access and new deposit of biological material.**

1. If an invention regards a biological material which is not available to the public and that cannot be described in the patent application in such a manner as to allow an expert in the field to implement the invention, or implies the use of that material, the description is considered sufficient, pursuant to Article 51(3), only if:

- a) the biological material has been deposited with a recognized depository authority not beyond the date of



filing of the patent application. Recognition is given to at least the international depositary authorities that have acquired that qualification pursuant to Article 7 of the Budapest Treaty, of 28 April 1977, ratified by Law No. 610 of 14 October 1985, on the International Recognition of the Deposit of Microorganisms for the purposes of the procedure concerning patents, hereinafter referred to as: the "Budapest Treaty;"

b) the application filed provides all of the relevant information that the depositor has concerning the characteristics of the biological material deposited;

c) the patent application specifies the name of the depositary authority and the registration number of the deposit.

2. The indications set forth in paragraph 1, letter c), may be communicated within a term of 16 months starting from the date of filing of the application or earlier in the case of advance availability to the public or notification of third parties pursuant to Article 53, paragraphs 3 and 4.

3. Without prejudice to the provisions of Article 53, paragraphs 2, 3 and 4, access to the biological material deposited is guaranteed through the issuance of a sample. On request from the depositor, the sample shall be released only to an independent expert:

a) starting on the date of availability to the public pursuant to Article 53(3), until the granting of the patent;

b) for a period of 20 years starting from the date of filing of the patent application, in the event of refusal or withdrawal of the same.

4. The delivery takes places exclusively if the applicant makes the following undertakings, for the duration of the effects of the patent:

a) not to make available to third parties samples of the biological material deposited or materials derived from the same; and

b) to use samples of the biological material deposited or of materials derived from it only for experimental purposes, unless the applicant or the owner of the patent explicitly waives that commitment.

5. The designated expert shall be jointly and severally liable for any abuses committed by the applicant.

6. If the biological material deposited pursuant to this article is no longer available at the recognized depositary authority, a new deposit of the material may be made at the same conditions established by the Budapest Treaty.

7. Each new deposit must be accompanied by a declaration signed by the depositor certifying that the biological material that is the object of the new deposit is identical to that of the initial deposit. <sup>(168)</sup>

---

<sup>(168)</sup> Article as substituted by paragraph 1 of Article 81, Legislative Decree No. 131 of 13 August 2010.

### **163. Application for complementary certificate for medicines and phytosanitary products.**

1. The application for the certificate must be filed with the Italian Patent and Trademark Office with reference to the marketing authorization for the product. <sup>(169)</sup>

2. The Italian Patent and Trademark Office shall publish at least the following data concerning the application for the certificate:

a) name and address of the applicant;

- b) basic patent number;
- c) title of the invention;
- d) number and date of the marketing authorization as well as the indication of the product whose identity is indicated in that authorization; <sup>(170)</sup>
- e) if appropriate, the number and date of the first marketing authorization in the European Union.

---

<sup>(169)</sup> Paragraph as amended by paragraph 1 of Article 82, Legislative Decree No. 131 of 13 August 2010.

<sup>(170)</sup> Letter as modified by paragraph 2 of Article 82, Legislative Decree No. 131 of 13 August 2010.

#### **164. Patent application for plant varieties.**

1. The patent application for plant varieties must contain:

- a) the identification of the applicant and also the attorney, if one exists;
- b) the indication in Italian and Latin of the genus and species to which the variety belongs;
- c) the proposed denomination, specifying if it is a code or an invented name;
- d) the name and nationality of the author of the plant variety;
- e) any claims of priority;
- f) the list of annexed documents.

2. The application must be accompanied by:

- a) the description of the plant variety. In the event of a hybrid variety, on request from the inventor, the information relating to the genealogical components shall not be made available to the public by the receiving office;
- b) the photographic reproduction of the plant variety and its specific characteristics; <sup>(171)</sup>
- c) any information and documentation considered useful for the purpose of the examination of the application, and in particular, the results of any growing tests that may have been conducted in Italy or abroad. Any documentation drawn up in a foreign language is to be accompanied by an Italian translation, declared to be authentic by the applicant or his attorney;
- d) the declaration indicated in Article 165;
- e) the documents proving any priorities that may have been claimed;
- f) when an attorney has been appointed, the letter of engagement pursuant to Article 201;
- g) [the document proving the payment of the application fee, the fee for the letter of appointment or for the relevant self-certification] <sup>(172)</sup>.

3. The documents indicated in paragraph 2, letters d), and e), may be filed subsequently, but not beyond the term of six months from the filing of the application. The documents indicated in paragraph 2, letters c), may





be filed subsequently but not beyond the starting date of the growing tests of the variety.<sup>(173)</sup>

4. The variety must be described in such a manner as to make clear how it has been obtained and its morphological or physiological characteristics that distinguish it from other similar known varieties.

5. The description is also to indicate the denomination proposed by the inventor.

6. If it is an essentially derived variety pursuant to paragraph 4 of Article 107, the initial variety is to be indicated. If the variety is genetically modified, the origin and nature of the genetic modification must be indicated.

---

<sup>(171)</sup> Letter as modified by paragraph 1 of Article 83, Legislative Decree No. 131 of 13 August 2010.

<sup>(172)</sup> Letter eliminated by paragraph 2 of Article 83, Legislative Decree No. 131 of 13 August 2010.

<sup>(173)</sup> Paragraph as amended by paragraph 3 of Article 83, Legislative Decree No. 131 of 13 August 2010.

#### **165. Declaration of the inventor.**

1. The inventor must declare that:

a) the variety for which he is requesting protection, to the best of his knowledge, represents a new plant variety pursuant to Article 103 and meets the requirements of that provision;

b) he has obtained authorization from the owners of any other new plant varieties that may be necessary for the production of the variety in the application;

c) he undertakes to supply, on request from the competent bodies of the Ministry of Agricultural and Forestry Policies, herein identified with the abbreviation "MIPAF," and in the terms established by the same, the plant reproduction or multiplication material of the variety that will allow for examination of the same;

d) an application for protection of the same variety has been filed in other Countries and the outcome of the same;

e) he surrenders any trademark that may be used, if it is identical to the denomination proposed for the variety.

#### **166. Application for variety denomination.**

1. The denomination proposed for the new variety:

a) must comply with the provisions set forth by Article 63 of Regulation (EC) No. 2100/94, Regulation (EC) No. 637/2009 and if necessary the guidelines of the Board of Directors of the Community Plant Variety Office;<sup>(174)</sup>

b) must not be contrary to law, public policy and accepted principles of morality;

c) must not contain geographical names.

---

<sup>(174)</sup> Letter as substituted by paragraph 1 of Article 84, Legislative Decree No. 131 of 13 August 2010.

### **167. Application for registration of designs and models.** [\(175\)](#)

1. The application must contain:

- a) the identification of the applicant and also of the attorney, if one exists;
- b) the indication of the design or model, in the form of a title, and any potential indication of the characteristics of the products intended to be claimed.

2. The application must be accompanied by:

- a) the graphic reproduction of the design or model, or the graphic reproduction of the industrial products whose manufacture must be the object of the exclusive right, or a sample of the products when they are industrial products that essentially have only two dimensions;
- b) the description of the design or model, if necessary for understanding the design or model;
- c) when an attorney has been appointed, the letter of engagement pursuant to Article 201;
- d) in the case of a claim of priority, the relevant documents.

---

[\(175\)](#) See also Article 25, Ministerial Decree No. 33 of 13 January 2010.

### **168. Application for registration of topographies.**

1. Each application must regard only one topography of a semiconductor product, and if it indicates a date of first commercial exploitation, it must correspond to the topography existing on that date.

2. The application for registration must be accompanied by:

- a) documentation that allows for the identification of the topography, in compliance with the requirements of the regulation;
- b) a declaration certifying the date of the first act of commercial exploitation of the topography if this date is prior to that of the application for registration. If the applicant is a person other than the person who carried out the first act of commercial exploitation, he must declare the legal relationships that existed with the latter;
- c) when an attorney has been appointed, the letter of engagement pursuant to Article 201;
- d) the potential designation of the author or authors of the topography.

3. Technical terms from foreign languages may be used if they have become common in the specific sector.

### **169. Claim of priority.**

1. When the priority of an application is claimed pursuant to Article 4, copy of the priority application must be submitted with the indication of the name of the applicant, the entity and extension of the industrial property

right, and the date on which the filing was made.

2. If the filing was made by others, the applicant must also give proof of being the assignee or successor in title of the first applicant. The document of transfer of the priority right may consist of a declaration of assignment or a declaration to have assigned the right pursuant to Article 196, paragraph 1, letter a). <sup>(176)</sup>

3. When separate applications have been filed abroad, on different dates, for the various parts of a single trademark, and the applicant intends to claim the right of priority for each of them, a separate application must be filed for each part, although they represent a whole. If one application makes claims on multiple registrations or multiple applications of those different parts of a single trademark, the new separate applications shall be subject to Article 158, paragraphs 1 and 2.

4. When separate applications have been filed, on different dates, for the various parts of a single invention, the priority right may be claimed by means of a single application if there is unity of invention. In the case that one application claims multiple filings and no unity of invention is found, the new separate applications shall be subject to Article 161.

5. Upon enactment of the Ministerial Decree for the temporary protection of the new trademarks affixed on products or materials relating to the provision of a service, which were displayed in an exhibition, and rights of priority are claimed for that temporary protection, the applicant must enclose to the application for registration a certificate of the executive committee or management or the chairman of the exhibition, with the content required by the respective regulation. <sup>(177)</sup>

5-*bis*. A claim of priority which has not been filed at the time of the filing of the patent or utility model application may also be filed subsequently within the term of 16 months from the date of the first priority claimed. Within the same term, the applicant may correct the data of a previous claim of priority, provided however that, if that correction modifies the date of the first priority claimed, and that date is earlier than the date originally indicated, the term starts from the actual date of that priority, rather than from the date originally indicated. A claim of priority which has not been claimed at the time of the filing of the application for a design and model or trademark, may be filed within the subsequent term of one month for designs and models and two months for trademarks, from the date of filing of that application. <sup>(178)</sup>

5-*ter*. A request for correction relating to a previous declaration of priority in accordance with paragraph 5-*bis* must however be filed within the term of four months from the date of filing the application of a patent for industrial invention or utility model. <sup>(179)</sup>

6. Patenting or registration are carried out without mention of priority, if within six months of the date of filing the application, the documents indicated in paragraph 1 are not submitted, in the appropriate forms. For inventions and utility models, the term for filing such documents is sixteen months from the date of the prior application, for which priority is claimed, if that term is more favorable to the applicant.

7. If the priority of an application filed in compliance with applicable international conventions is refused, the record of the industrial property title must mention the refusal.

8. The claim of priority in an application for a new plant variety is refused if it is filed after the term of twelve months from the date of filing of the first application and if the applicant does not have the right to it. If priority is refused, no mention of it is made in the title.

---

<sup>(176)</sup> Paragraph as amended by paragraph 1 of Article 85, Legislative Decree No. 131 of 13 August 2010.

<sup>(177)</sup> See also Article 28, Ministerial Decree No. 33 of 13 January 2010.

<sup>(178)</sup> Paragraph added by paragraph 2 of Article 85, Legislative Decree No. 131 of 13 August 2010.

<sup>(179)</sup> Paragraph added by paragraph 2 of Article 85, Legislative Decree No. 131 of 13 August 2010.

## 170. Examination of applications.

1. The examination of the applications which have been found to meet the formal requirements, is aimed at determining:

a) for trademarks: if Article 11 may be applied when collective marks are involved; if the word, design or sign can be registered as a trademark pursuant to Articles 7, 8, 9, 10, 13, paragraph 1, and 14, paragraph 1, letters a) and b); if the conditions indicated in Article 3 are met; <sup>(180)</sup>

b) for inventions and utility models, that the object of the application is consistent with what is established by Articles 45, 50 and 82, including the validity requirements, in the case that the priority search is regulated by ministerial decree and, in any event, if the absence of those requirements is absolutely evident based on the declarations and submissions of the applicant, or is certain as a public knowledge; <sup>(181)</sup>

c) for designs and models, that the object of the application is consistent with the requirements of Article 31 and Article 33-*bis*; <sup>(182)</sup>

d) for plant varieties, the requirements of validity established in Section VIII of Title II of the Code, as well as the compliance with the provisions laid down under Article 114 of the same Section. The examination of such requirements is carried out by the Ministry of Agricultural and Forestry Policies, which formulates a binding opinion, availing itself of the Commission identified in paragraphs 3-*bis et seq.* The Commission operates according to the rules of procedure set by a specific implementing regulation. In order to verify the continued presence of the requirements, the Ministry of Agricultural and Forestry Policies may ask the owner or his successor in title to supply the reproduction or multiplication material necessary to carry out the examination; <sup>(183)</sup>

e) for topographies of semiconductor products, that the object of the application is consistent with the provisions of Article 87, excluding the validity requirements until the examination will be regulated by a Ministerial Decree.

2. For trademarks relating to agricultural products and foodstuffs of primary processing, that use geographical designations, the Office transmits copy of the trademark and any other documentation to the Ministry of Agricultural and Forestry Policies, that must express its opinion within ten days of the date of receipt of the request.

3. If the conditions indicated above are not found to be present, the Italian Patent and Trademark Office proceeds in accordance with Article 173, paragraph 7.

3-*bis*. The binding opinion on the requirements of validity provided for in Section VIII of Title II of the Code, and on the observance of the provisions set forth in Article 114, is expressed by the Ministry of Agricultural, Food and Forestry Policies by way of a Consultation Commission made up of:

a) the General Director of Competitiveness for Rural Development of the Ministry of Agricultural, Food and Forestry Policies, as chairperson of the Commission;

b) the responsible of the Biotechnologies, Seeds and Variety Registers Office of the Ministry of Agricultural, Food and Forestry Policies, who in the event of impediment of the chairperson, acts in his place;

c) the responsible of the Italian Patent and Trademark Office, with responsibility concerning new plant varieties;

d) the technical examiner of the Italian Patent and Trademark Office;

e) an official of the Biotechnologies, Seeds and Variety Registers Office of the Ministry of Agricultural, Food and Forestry Policies;



f) the director of an Institute of agrarian research and experimentation, designated by the Ministry of Agricultural, Food and Forestry Policies. <sup>(184)</sup>

3-ter. For the members indicated in paragraph 3-bis, letters b) to f), a substitute must be designated. <sup>(185)</sup>

3-quater. The functions of secretary of the Commission are exercised by the official of the Ministry of Agricultural, Food and Forestry Policies identified in paragraph 1, letter e). <sup>(186)</sup>

3-quinquies. The Commission, without new or greater costs for the public accounts, shall be in force for three years and its members may be renewed; participation is provided free of charge, without the payment of emoluments, and its functioning is organized within the context of the human and financial resources and means available under current legislation. <sup>(187)</sup>

3-sexies. On a grounded request from the Chairman, qualified experts in the field may be called on to participate in the Commission, from time to time and for the examination of specific issues. <sup>(188)</sup>

3-septies. Before expressing its opinion, the Commission may consult with the interested parties or their representatives, on its own initiative or on request from the same. <sup>(189)</sup>

3-octies. The opinion is to be accompanied by the indication of the trials, methods and inspections carried out as well as the results obtained and any observations and comments by the applicant. <sup>(190)</sup>

3-nonies. By a decree of the Ministry of Economic Development, in concert with the Ministry of Agricultural, Food and Forestry Policies, the implementation regulation of the Industrial Property Code are defined concerning new plant varieties, including the provisions relating to the appointment and functioning of the Commission identified in paragraph 3-bis. <sup>(191)</sup>

---

<sup>(180)</sup> Modified by paragraph 1 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(181)</sup> Substituted by paragraph 2 of Article 86, Legislative Decree No. 131 of 13 August 2010. See also Ministerial Decree 3 October 2007 and Ministerial Decree 27 June 2008.

<sup>(182)</sup> Modified by paragraph 3 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(183)</sup> Modified by paragraph 4 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(184)</sup> Paragraph added by paragraph 5 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(185)</sup> Paragraph added by paragraph 5 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(186)</sup> Paragraph added by paragraph 5 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(187)</sup> Paragraph added by paragraph 5 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(188)</sup> Paragraph added by paragraph 5 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(189)</sup> Paragraph added by paragraph 5 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(190)</sup> Paragraph added by paragraph 5 of Article 86, Legislative Decree No. 131 of 13 August 2010.

<sup>(191)</sup> Paragraph added by paragraph 5 of Article 86, Legislative Decree No. 131 of 13 August 2010.

### **170-bis. Requirements concerning biotechnological inventions.**

1. The Italian Patent and Trademark Office, for the purpose of evaluating the patentability of biotechnological inventions, in order to ensure compliance with Article 81-quinquies, paragraph 1, letter b), may request an

opinion from the National Committee for Biosafety and Biotechnologies.

2. The provenance of biological material of animal or plant origin, which is the basis of the invention, is to be declared together with the application of the patent both with reference to the country of origin, in order to verify compliance with import and export legislation, and in relation to the biological organism from which it was isolated.

3. A patent application relating to an invention whose object is, or that utilizes, biological material of human origin, must be accompanied by the express, free and informed consent, for that sample and utilization, of the person from whom the material was taken, based on applicable legislation.

4. An application relating to an invention whose object is, or that utilizes, biological material containing microorganisms or genetically modified microorganisms, must be accompanied by a declaration that guarantees compliance with the obligations regarding those modifications, deriving from national and EU regulations, and in particular from the provisions in paragraph 6 and in Legislative Decrees No. 206 of 12 April 2001, and No. 224 of 8 July 2003.

5. Concerning biotechnological inventions, the utilization by a farmer of patented material of plant origin, for the reproduction or multiplication in his own farm, must take place in compliance with the provisions established by Article 14 of Regulation (EC) No. 2100/94 of the Council, of 27 July 1994.

6. A decree of the Ministry of Agricultural, Food and Forestry Policies, in concert with the Ministries of Health and Economic Development, shall regulate the scope and methods of exercise of the derogation in paragraph 2 of Article 11 of Directive 98/44/EC of the European Parliament and of the Council, of 6 July 1998, regarding the sale or other form of trade of breeding livestock or other reproduction material of animal origin, by the owner of the patent or with his consent. In particular, the decree establishes the prohibition on further sale of the livestock for an activity of commercial production, unless the animals having the same properties have been obtained through exclusively biological means and without prejudice to the possibility for direct sale by the breeder for live animals included in normal agricultural activity.

7. If the Italian Patent and Trademark Office ascertains the lack of the conditions for patenting a biotechnological invention or the failure to file the declarations under paragraphs 2, 3 and 4, shall proceed in accordance with Article 173, paragraph 7, and in the event it determines the absence of the conditions for patenting as set forth by Articles 81-*quater*, 81-*quinquies* and Article 162, it shall reject the application.<sup>(192)</sup>

---

<sup>(192)</sup> Article added by paragraph 1 of Article 87, Legislative Decree No. 131 of 13 August 2010.

#### **170-ter. Sanctions.**

1. Unless the action constitutes a crime, whoever, for the purpose of patenting an invention, utilizes biological material of human origin, being aware of the fact that it has been taken or utilized for that purpose without the express consent of the person who has the right to it, shall be punished with an administrative fine from 100.000,00 to 1.000.000,00 Euros.

2. Unless the action constitutes a crime, whoever, in the declaration required by Article 170-*bis*, paragraph 2, makes false statements concerning the provenance of biological material of animal or plant origin, shall be punished with an administrative fine from 10.000,00 to 100.000,00 Euros.

3. Whoever, in a patent application for an invention that utilizes biological material containing genetically modified microorganisms or organisms, falsely asserts compliance with the obligations of law regarding those modifications, shall be punished with a pecuniary administrative sanction of from 10.000,00 to 100.000,00 Euros.

4. Within the minimum and maximum limits established by this article, the amount of the administrative fines



shall be determined taking account the criteria set forth by Article 11 of Law No. 689 of 24 November 1981, the different potential for causing harm to the protected interest that each violation has in the abstract, the specific personal qualities and the property advantage that the violation can bring to the guilty party or the person or entity in whose interest he acts.

5. The administrative fines established by this article are not subject to the reduced payment as provided for by Article 16 of Law No. 689 of 24 November 1981.<sup>(193)</sup>

---

<sup>(193)</sup> Article added by paragraph 1 of Article 88, Legislative Decree No. 131 of 13 August 2010.

### **171. Examination of international trademarks.**

1. The Italian Patent and Trademark Office conducts the examination of international trademarks designating Italy in accordance with the rules relating to national trademarks, pursuant to Article 170, paragraph 1, letter a).

2. If the Italian Patent and Trademark Office deems that the trademark shall not be registered in full or in part, or if an opposition has been filed by third parties pursuant to Article 176, the Office shall proceed pursuant to Article 5 of the Madrid Agreement for the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976 or the respective protocol of 27 June 1989, ratified by Law No. 169 of 12 March 1996, to issue a provisional refusal of the international registration and gives notice to the World Intellectual Property Organization.

3. The provisional refusal under paragraph 2 is issued within one year for international registrations based on the Madrid Agreement for the International Registration of Marks, and within eighteen months for those based on the respective Protocol. The terms start on the dates respectively indicated in the cited international Conventions.

4. In the case of provisional refusal, the protection of the trademark shall be the same as that of a trademark application filed with the Italian Patent and Trademark Office.

5. Within the mandatory term set out by the Italian Patent and Trademark Office, the owner of an international registration, for which a provisional refusal has been communicated to the World Intellectual Property Organization, through an attorney appointed in accordance with Article 201, may submit his own arguments, or request a copy of the opposition paper based on which the provisional refusal was issued. In the latter case, if the owner of the international registration requests a copy within the required period, the Office shall send the notice to the parties as per Article 178, paragraph 1, and apply the other rules on the opposition proceeding set forth by Articles 178 *et seq.*

6. If within the term indicated in paragraph 5, the owner of the international registration does not submit his arguments, or does not request a copy of the opposition paper in accordance with the rules indicated above, the Italian Patent and Trademark Office shall issue the final refusal.

7. The Italian Patent and Trademark Office shall notify the World Intellectual Property Organization of the final decisions relating to international trademarks designating Italy.

8. In the case that the trademark designating Italy based on the Madrid Protocol is subsequently cancelled in full or in part on request from the industrial property office of origin, its owner may file an application for registration of the same sign with the Italian Patent and Trademark Office. Such application shall have effect from the date of the international registration, with recognition of any priority, or from the recording date of the territorial extension concerning Italy.

9. The application is to be filed within the mandatory term of three months, starting from the date the international registration is cancelled, and may regard only the products and services listed in the same



relating to Italy.

10. The application shall be subject to the regulations applicable to national applications.

### **172. Withdrawal, corrections, and additions to the application.** <sup>(194)</sup>

1. The applicant may withdraw the application at any time during the examination procedure, and in the case of trademarks, also during the opposition procedure, before the Italian Patent and Trademark Office has granted the trademark.

2. Before the Italian Patent and Trademark Office has granted the trademark or decided on a request or opposition, or before the Board of Appeal upon request has decided on a recourse, the applicant shall be allowed to correct the non-substantial aspects of the application originally filed or any other request relating to it, as well as, in the case of a patent application for an invention or utility model, to supplement it with new examples or limit the description, claims or drawings originally filed, and in the case of an application for a trademark, to limit or specify the products or services originally listed.

3. On invitation from the Italian Patent and Trademark Office, the applicant must complete or correct the documentation where necessary for assessing the industrial property right or to better determining the scope of the requested protection.

4. If the tests identified in Article 170, paragraph 1, letter *d*) are necessary, the Ministry of Agricultural and Forestry Policies shall invite the applicant to submit the material for reproduction or multiplication of the variety, and in the case of hybrid varieties, the Ministry may request, if necessary, also the delivery of the material of the genealogical components. The institutes and entities designated for the tests shall issue a receipt for the material delivered to them. If the material is delivered in an insufficient quantity or with unsuitable quality, the cited institutes and entities shall prepare a specific official report to be transmitted to the Ministry of Agricultural and Forestry Policies.

5. The Ministry of Agricultural and Forestry Policies, in concert with the entities and bodies responsible for the tests, on request from the owner of the application or from third parties, may also decide that visits are to be made to the fields so that the interested parties may view the tests. If they deem it necessary, the entities and bodies responsible for the tests shall ask the owner of the application to visit the test fields. At the end of the tests, the designated entity or body transmits a report with the indication of the results to the Ministry of Agricultural and Forestry Policies, which in the event of doubts concerning the results, may order to repeat the tests. Based on the examination report, the Ministry of Agricultural and Forestry Policies draws up the official description of the variety. Upon receiving the official description from the Ministry of Agricultural and Forestry Policies, the Office transmits it to the inventor, assigning a term for submission of observations.

6. The Italian Patent and Trademark Office must preserve the documentation relating to the initial application, record the date of receipt of the modifications or additions, and adopt any other suitable precautionary measures.

---

<sup>(194)</sup> See also Article 29, Ministerial Decree No. 33 of 13 January 2010.

### **173. Observations.**

1. The observations relative to the applications and requests must be communicated to the interested party granting a term for response of not less than two months from the date of receipt of the communication.

2. The observations from third parties and the observations which result from the examination of the application for new plant varieties are communicated to the interested party granting a term for response not

longer than six months. In the event that an observation refers to the denomination, the new proposal is to be accompanied by a supplemental declaration also including the declaration indicated in letter e) of paragraph 1 of Article 165. The Office and the Ministry of Agricultural and Forestry Policies communicate to each other their comments and the observations transmitted to the applicant and the responses received.

3. When due to irregularities in the appointment of the attorney, as per Article 201, the failure to comply with the observations determines the rejection of the application and the related requests, the observations must be communicated to the applicant.

4. When the term has elapsed without receiving a response to the observations, the application or request is rejected by a decision to be notified to the owner of the application or the request, by a registered mail letter, return receipt requested. However, if the observation concerns the claim of a right of priority, failure to respond determines only the loss of that right.

5. An application for new plant varieties is refused:

a) in the case of a lack of response to the observations of the Office and the Ministry of Agricultural and Forestry Policies within the due term;

b) in the case of failure to deliver the materials for the varietal tests in accordance with Article 165, paragraph 1, letter c), unless the lack of delivery depended on reasons of force majeure;

c) in the case of absence of one of the requirements set by Article 170, paragraph 1, letter d).

6. If the application for new plant varieties is not granted or when it is withdrawn, the fee due for technical controls is reimbursed only when the cited technical controls have not yet been started.

7. Before rejecting in full or in part an application or a related request, for reasons that were not set forth in observations pursuant to paragraph 1, the Italian Patent and Trademark Office assigns the applicant a term of two months to submit observations. Once that term has expired, if no observations have been submitted or if the Office does not believe that it can accept those submitted, the application or request is rejected in full or in part.

8. For international patent applications, the Italian Patent and Trademark Office, after completing the checks indicated in Article 14 of the Patent Cooperation Treaty of 19 June 1970, ratified by Law No. 260 of 26 May 1978, invites the applicant to make any corrections if necessary, granting a term of no more than three months, without prejudice for the compliance of the term for transmission of the original copy of the international application, required by rule 22 of the Implementation Regulation of the Patent Cooperation Treaty. The Italian Patent and Trademark Office declares that the application is considered to be withdrawn in the cases identified by Article 14 of the Patent Cooperation Treaty. <sup>(195)</sup>

9. If the application is granted, the Italian Patent and Trademark Office proceeds to grant the title.

10. The files of the documents relating to patenting or registration applications, as well as the registers of the industrial property titles and the registers of the applications, are preserved by the Italian Patent and Trademark Office until ten years after the extinction of the corresponding rights. After the expiration of that term, the Office may destroy the files even without the opinion of the Central State Archive, upon electronic copying on unalterable devices of the originals, of the legal documents and records contained in the same. <sup>(196)</sup>

---

<sup>(195)</sup> Paragraph as amended by paragraph 1 of Article 89, Legislative Decree No. 131 of 13 August 2010.

<sup>(196)</sup> Paragraph as modified by paragraphs 2 and 3 of Article 89, Legislative Decree No. 131 of 13 August 2010.

## Section II

### Observations on Trademarks and Oppositions to the Registration of Trademarks

#### **174. Observations and oppositions to the registration of trademarks.** <sup>(197)</sup>

1. Applications for trademark found to be registrable in accordance with Article 170, paragraph 1, letter a), registrations of trademark made according to the procedure set forth in Article 179, paragraph 2, and international trademark designating Italy, may be the object of observations and oppositions in compliance with the provisions set forth in the articles below.

---

<sup>(197)</sup> See also Article 20, Ministerial Decree No. 33 of 13 January 2010 and Ministerial Decree 11 May 2011.

#### **175. Filing of third-party observations.** <sup>(198)</sup>

1. Any interested party, without thereby assuming the role of a party in the registration proceeding, may address written observations to the Italian Patent and Trademark Office, specifying the reasons for which a trademark should not be registered ex officio, within two months. <sup>(199)</sup>

2. The observations, if found to be pertinent and significant, shall be communicated by the Italian Patent and Trademark Office to the requesting party, who may submit his own arguments within thirty days from the date of the communication.

3. In the case of an international trademark, the observations are considered by the Italian Patent and Trademark Office only for the purpose of the examination indicated in Article 170, paragraph 1, letter a).

---

<sup>(198)</sup> See also Article 20, Ministerial Decree No. 33 of 13 January 2010.

<sup>(199)</sup> Paragraph as substituted by paragraph 1 of Article 90, Legislative Decree No. 131 of 13 August 2010.

#### **176. Filing of opposition.**

1. The qualified persons pursuant to Article 177 may file an opposition with the Italian Patent and Trademark Office against the acts indicated under letters a), b) and c), which, on penalty of inadmissibility, must be in written form, grounded and documented, within the mandatory term of three months from:

a) the date of publication of an application for registration, that is considered to be registrable in accordance with Article 170, paragraph 1, letter a), or considered to be registrable based on a judgment of acceptance that has become final;

b) the date of publication of the registration of a trademark, the application for which was not published in accordance with Article 179, paragraph 2;

c) the first day of the month following the month in which the international trademark was published in the Bulletin of the Organisation Mondiale de la Propriété Intellectuelle des Marques Internationales. <sup>(200)</sup>

2. The opposition, that may regard a single trademark application or registration trademark, shall be

admissible only if drawn up in the Italian language, and must contain the following, on penalty of inadmissibility: <sup>(201)</sup>

a) in relation to the trademark subject to the opposition, the identification of the applicant, the number and date of the application for registration and the goods and services against which the opposition is brought;

b) in relation to the trademark or right of the opponent, the identification of the earlier trademark(s) as per Article 12, paragraph 1, letters d) and e), and also the products and services on which the opposition or right is based as per Article 8;

c) the grounds for the opposition.

3. The opposition shall be considered to be withdrawn if it lacks the demonstration of the payment of the opposition fees within the terms and by the methods established by the decree indicated in Article 226.

4. Whoever submits an opposition must also file the following, within the mandatory deadline of two months from the expiration date of the terms for the reaching of a conciliation agreement under Article 178, paragraph 1:

a) a copy of the application or certificate of registration of the trademark on which the opposition is based, if those documents are not national applications or certificates, and if appropriate, the documentation relating to the right of priority or seniority to which it benefits, along with a translation of the same into Italian; in the case of seniority, this must have already been claimed in relation to the application or registration of the Community trademark;

b) any other documentation proving the circumstances cited;

c) the necessary documentation to demonstrate standing to submit an opposition, if the earlier trademark is not registered in his name by the Register kept by the Italian Patent and Trademark Office;

d) the letter of engagement pursuant to Article 201, if an attorney has been appointed.

5. An opposition may be used to claim the impediments to registration of the trademark established by Article 12, paragraph 1, letters c) and d), for all or a part of the goods or services for which registration has been requested, and the lack of consent to registration by the qualified persons identified in Article 8. <sup>(202)</sup>

---

<sup>(200)</sup> Paragraph as substituted by paragraph 1 of Article 91, Legislative Decree No. 131 of 13 August 2010.

<sup>(201)</sup> Paragraph as modified by paragraph 2 of Article 91, Legislative Decree No. 131 of 13 August 2010.

<sup>(202)</sup> Paragraph as amended by paragraph 3 of Article 91, Legislative Decree No. 131 of 13 August 2010.

## **177. Standing to file an opposition.**

1. The following persons have standing to file an opposition:

a) an owner of a trademark already registered in the Country and with effect in the Country from an earlier date;

b) a person who filed an application for registration of a trademark in the Country on an earlier date or that has effect in the Country from an earlier date by virtue of a right of priority or a valid claim of seniority;

c) a licensee with the exclusive use of the trademark;

d) the persons, entities and associations identified in Article 8.

### 178. Examination of the opposition and decisions.

1. Within two months of the expiration of the terms set in Article 176, paragraph 1, the Italian Patent and Trademark Office, upon verifying the admissibility of the opposition in accordance with Articles 148, paragraph 1, and 176, paragraph 2, shall notify the applicant for the registration of that opposition, informing both the applicant and the opponent of the right to reach a conciliation agreement within two months of the date of the notification, which period may be extended upon joint request by the parties up to the maximum term set by the Implementation Regulation of this Code. <sup>(203)</sup>

2. In the absence of an agreement pursuant to paragraph 1, the applicant who has received the documentation indicated in Article 176, paragraphs 2 and 4, letters a), b) and c), may submit his arguments in writing by the term specifically set by the Office. <sup>(204)</sup>

3. During the opposition proceeding, the Italian Patent and Trademark Office may, at any time, ask the parties to file within a term it sets, additional documents, arguments or observations in relation to the allegations, arguments and observations of the other parties.

4. On request from the applicant, the opponent who is a owner of an earlier Trademark registered for at least five years, shall provide the documents suitable to prove that the Trademark was actually used, by him or with his consent, for the goods and services in respect of which it was registered and on which the opposition is based, or that there are legitimate reasons for the lack of utilization. In the absence of such proof, that is to be provided within sixty days of the date of notification of the request by the Italian Patent and Trademark Office, the opposition shall be rejected. If the actual use is demonstrated only for a portion of the goods or services for which the earlier mark was registered, for the purposes of the examination of the opposition only, the trademark shall be considered registered only for that portion of goods or services. <sup>(205)</sup>

5. A request by the applicant to obtain proof of the actual use of the trademark must be filed by no later than the date of filing of the initial arguments in accordance with paragraph 2.

6. In the event of multiple oppositions relating to the same mark, the oppositions subsequent to the first shall be joined to the same.

7. At the end of the opposition proceeding, the Italian Patent and Trademark Office shall grant the opposition by rejecting the application for registration in full or in part if it is found that the trademark cannot be registered for the entirety or even only a part of the goods and services indicated in the application; otherwise, it shall reject the opposition. In the case of an international registration, the Italian Patent and Trademark Office shall issue a partial or total definitive rejection or reject the opposition, providing notification to the World Intellectual Property Organization (WIPO).

---

<sup>(203)</sup> Paragraph as substituted by paragraph 1 of Article 92, Legislative Decree No. 131 of 13 August 2010. See also Article 60, paragraph 2, Ministerial Decree No. 33 of 13 January 2010.

<sup>(204)</sup> Paragraph as substituted by paragraph 2 of Article 92, Legislative Decree No. 131 of 13 August 2010.

<sup>(205)</sup> Paragraph as amended by paragraph 3 of Article 92, Legislative Decree No. 131 of 13 August 2010.

### 179. Extension of protection.

1. If the applicant intends to extend the protection of the trademark abroad pursuant to the Madrid Agreement for the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, or in a foreign Country that requires the prior registration of the Italian Trademark, the Italian Patent

and Trademark Office, even if an opposition has already been submitted, shall proceed to register the trademark and make the relevant notations on the same.<sup>(206)</sup>

2. If the application for the trademark, as indicated in paragraph 1, has not yet been published, the publication of the registration shall in that case be accompanied by the notice that the publication marks the date on which the time limit for opposition begins. The granting of an opposition shall determine the total or partial striking of the trademark.

---

<sup>(206)</sup> Paragraph as amended by paragraph 1 of Article 93, Legislative Decree No. 131 of 13 August 2010.

### **180. Suspension of the opposition proceeding.**

1. An opposition proceeding shall be suspended:

a) during the period allowed to the parties in order to reach a conciliation agreement, pursuant to Article 178, paragraph 1;

b) if the opposition is based on an application for a trademark, until the registration of that trademark;

c) if the opposition is based on an international trademark, until the terms have expired for refusal or the filing of an opposition against the registration of that trademark, or if the relevant examination or opposition proceedings have been concluded;

d) if the opposition is brought against a national trademark subject to review following observations as per Article 175, paragraph 2, until the respective review procedure has been concluded;

e) if a judgment is pending concerning nullity or revocation of a trademark on which the opposition is based or relating to the title to the right of registration pursuant to Article 118, until the judgment becomes final, if the applicant for the registration has filed a specific request to that end;

*e-bis*) in the other cases provided for by the Implementation Regulation of this Code.<sup>(207)</sup>

2. On request from the applicant for the registration, the suspension indicated in paragraph 1, letter e), may subsequently be revoked.

3. If the opposition is suspended pursuant to paragraph 1, letters b), c), d) and f),<sup>(208)</sup> the Italian Patent and Trademark Office shall give priority to the examination of the application for a trademark or the registration of the international trademark.<sup>(209)</sup>

3-*bis*. The Italian Patent and Trademark Office shall give priority to the examination of a trademark if it is the reason for which an opposition to an application for a Community trademark or an action for revocation of a Community registration has been filed.<sup>(210)</sup>

---

<sup>(207)</sup> Letter added by paragraph 1 of Article 94, Legislative Decree No. 131 of 13 August 2010.

<sup>(208)</sup> Editor's note: letter f) is to be understood as letter *e-bis*).

<sup>(209)</sup> Paragraph as amended by paragraph 2 of Article 94, Legislative Decree No. 131 of 13 August 2010.

<sup>(210)</sup> Paragraph added by paragraph 3 of Article 94, Legislative Decree No. 131 of 13 August 2010.



### 181. Cancellation of the opposition proceeding.

1. An opposition proceeding is cancelled if:

- a) the trademark on which the opposition is based has been declared to be null or revoked by a judgment that has become final;
- b) the parties have reached an agreement in accordance with Article 178, paragraph 1;
- c) the opposition has been withdrawn;
- d) The application or registration, subject to opposition, has been withdrawn or rejected by a final decision;<sup>(211)</sup>
- e) the party that presented the opposition ceases to be entitled to have standing to do so pursuant to Article 177.

---

<sup>(211)</sup> Letter as modified by paragraph 1 of Article 95, Legislative Decree No. 131 of 13 August 2010.

### 182. Appeal.

1. The action by which the Italian Patent and Trademark Office declares an opposition proceeding to be inadmissible or cancelled, even partially, or by which it rejects an opposition, is to be communicated to the parties, who, by the terms set in Article 135, paragraph 1, shall have the right to file an appeal with the Board of Appeal, as per Article 135.<sup>(212)</sup>

---

<sup>(212)</sup> Article as substituted by paragraph 1 of Article 96, Legislative Decree No. 131 of 13 August 2010.

### 183. Appointment of examiners.

1. Oppositions are decided by officials appointed for a period of two years by a decree of the General Director from among those in an executive or management career at the Italian Patent and Trademark Office who have a degree in law. The examiners who participated in the examination of the applications or registrations of the trademark at issue in the opposition shall not decide on those oppositions.<sup>(213)</sup>

2. The appointment to the position of examiner, as per paragraph 1, may be renewed and shall be entitled to compensation to be set by a decree of the Ministry of Productive Activities, in concert with the Ministry of Economy and Finance, and shall be reserved to those who, in possession of the requirements set forth in paragraph 1, have successfully completed a specific training course to be organized by the Italian Patent and Trademark Office.<sup>(214)</sup>

3. If the number of officials appointed pursuant to paragraphs 1 and 2 is inadequate in relation to the oppositions filed, then officials chosen from among the personnel of the Ministry of Productive Activities, with equal requirements and training, or experts with recognized knowledge of the matters, may be appointed.

4. The overall number of officials designated for the examination of the oppositions may not exceed thirty.



[\(213\)](#) Paragraph as amended by paragraph 1 of Article 97, Legislative Decree No. 131 of 13 August 2010.

[\(214\)](#) See also Article 62, Ministerial Decree No. 33 of 13 January 2010.

#### **184. Entry into force of the opposition proceeding.** [\(215\)](#)

1. The regulations on the opposition proceeding shall enter into force with the subsequent decree of the Ministry of Productive Activities that establishes the methods of application.

---

[\(215\)](#) See also Ministerial Decree No. 33 of 13 January 2010.

### **Section III**

#### **Advertising**

#### **185. Files of industrial property titles.** [\(216\)](#)

1. Original industrial property titles must be signed by the director of the relevant office and or by an official appointed by the same.

2. Industrial property titles are marked, based on their type, by a sequential number based on the date of grant, and contain the following: [\(217\)](#)

a) the date and number of the application;

b) the first and last name and domicile of the owner, and in the case of plant varieties, of the inventor, the company name or title and registered office, for legal entities;

c) the first and last name and domicile of the attorney, if one exists;

d) the first and last name of the inventor or author; [\(218\)](#)

e) the details of the priority claimed;

f) in the case of plant varieties, the genus and species to which the new plant varieties belong and the respective denomination.

3. The originals of the industrial property titles are gathered in specific folders. All of the references to the register of trademark and patents contained in the Code must be understood as referring to the originals, in paper or electronic form, of the corresponding titles gathered in the folders. [\(219\)](#)

4. A certified copy of the industrial property title is transmitted to the owner. In the case of rights for plant varieties the office informs the MIPAF of the grant.

---

[\(216\)](#) See also Article 32, Ministerial Decree No. 33 of 13 January 2010.

[\(217\)](#) Paragraph as substituted by paragraph 1 of Article 98, Legislative Decree No. 131 of 13 August 2010.

[\(218\)](#) Letter as modified by paragraph 2 of Article 98, Legislative Decree No. 131 of 13 August 2010.

[\(219\)](#) Paragraph as amended by paragraph 3 of Article 98, Legislative Decree No. 131 of 13 August 2010.

## 186. Consultation and publication.

1. The files of industrial property titles and of the applications may be consulted by the public, on authorization from the Italian Patent and Trademark Office, on request.
2. The Italian Patent and Trademark Office, without prejudice to the terms set for public access to the applications, shall keep available to the public for free consultation the folders concerning an application, patent, registration or request, notwithstanding the limitations established by the Implementation Regulation. [\(220\)](#)
3. The Italian Patent and Trademark Office may allow the extraction of copies of the applications, descriptions, claims and drawings, as well as the other documents that the public is allowed to view, to those who so request, subject to the precautions that are considered necessary to avoid any damage or deterioration of the documents available to the public. [\(221\)](#)
4. The prescribed stamp duties must have been paid for the copies for which authentication of conformity to the copy made available to the public is requested. The Ministry of Productive Activities may however establish that the copying or the reproduction, including photographic reproduction, of the legal documents and records will be carried out exclusively by the Office, upon payment of the secretarial fees.
5. The copies of extracts of the industrial property titles and of certificates relating to announcements to be extracted from the relevant documentation, as well as the duplicates of the originals, are to be made exclusively by the Italian Patent and Trademark Office subject to a request which indicates the sequential number of the title of which a copy or extract is requested.
6. The certification of authenticity of the copies is subject to stamp duty and the payment of secretarial fees to be made to the Italian Patent and Trademark Office for each page and each drawing plate.
7. The amount of the fees provided for by this Code is set by a decree of the Ministry of Productive Activities, in concert with the Ministry of Economy and Finance. The rates for the copying and photographic reproduction work, which is carried out by the Italian Patent and Trademark Office, are set in the same manner. [\(222\)](#)
8. The industrial property titles, divided by classes, the registrations and the judgments identified in Article 197, paragraph 6, are published at least monthly in the Official Bulletins for each type of title from Articles 187, 188, 189 and 190. The publication shall contain the essential indications included in each title and, respectively, the applications for registration. The Bulletin may also contain both the analytical indexes of the industrial property rights and the alphabetical indexes of the owners, which may also include the publication of summaries of the descriptions. [\(223\)](#)
9. The Bulletin is made available in electronic form and may be distributed free of charge to Chambers of Commerce, as well as to the entities indicated in a list to be drawn up by the Ministry of Productive Activities. [\(224\)](#)

---

[\(220\)](#) Paragraph as substituted by paragraph 1 of Article 99, Legislative Decree No. 131 of 13 August 2010.

[\(221\)](#) Paragraph as amended by paragraph 2 of Article 99, Legislative Decree No. 131 of 13 August 2010.

[\(222\)](#) In implementation of what is established by this paragraph see Ministerial Decree 2 April 2007.

[\(223\)](#) Paragraph as amended by paragraph 3 of Article 99, Legislative Decree No. 131 of 13 August 2010.

[\(224\)](#) Paragraph as amended by paragraph 4 of Article 99, Legislative Decree No. 131 of 13 August 2010.

### 187. Official Bulletin of Trademark.

1. The Official Bulletin of Trademark, to be published at least monthly by the Italian Patent and Trademark Office, shall contain at least the following information relating to:

- a) applications considered to be registrable in accordance with Article 170, paragraph 1, letter a), with indication of any priority;
- b) applications resulting from the request for conversion of a Community trademark, indicating the date of filing of the respective application;
- c) registrations;
- d) registrations accompanied by the notice pursuant to Article 179, paragraph 2;
- e) renewals;
- f) applications for recording of the legal documents indicated by this Code and records made;
- f-bis) applications subject to opposition and applications refused following opposition; [\(225\)](#)
- f-ter) judgments as per Article 197, paragraph 6. [\(226\)](#)

2. The identification data of the applications and registrations, in addition to the specific information indicated in paragraph 1, letters a), b) and d), and the respective numbers and dates, are those indicated in Article 156.

3. The Official Bulletin is accompanied by analytical indexes, that are at least alphabetical for the owners, numerical and by class.

---

[\(225\)](#) Letter added by paragraph 1 of Article 100, Legislative Decree No. 131 of 13 August 2010.

[\(226\)](#) Letter added by paragraph 1 of Article 100, Legislative Decree No. 131 of 13 August 2010.

### 188. Official Bulletin of new plant varieties.

1. The communication to the public provided for by Article 30 of the International Union for the Protection of New Varieties of Plants (UPOV) - Geneva text of 19 March 1991, ratified by Law No. 110 of 23 March 1998, is made through publication of an "Official Bulletin of New Plant Varieties" published by the Office.

2. The Bulletin must be published at least once every six months, and contain:

- a) the list of sole-right variety applications, divided by species, indicating, in addition to the number and date of filing of the application, the name and address of the applicant and the name of the author, if different from the applicant, the proposed denomination and a succinct description of the plant variety for which the protection is requested;
- b) the list of varieties granted, by genus and species, indicating the number and date of filing of the corresponding application, the name and address of the owner and the varietal denomination definitively



attributed;

*b-bis*) judgments as per Article 197, paragraph 6, <sup>(227)</sup>

c) any other information of public interest.

3. The Bulletin is sent free of charge, in exchange, to the competent offices of the other Member States of the Union pour la protection des obtentions végétales (U.P.O.V.).

---

<sup>(227)</sup> Letter added by paragraph 1 of Article 101, Legislative Decree No. 131 of 13 August 2010.

### **189. Official Bulletin of patents of inventions and utility models, registrations of designs and models, topographies of semiconductor products.**

1. The Official Bulletin of patent of inventions and utility models, registrations of designs and models, and topographies of semiconductor products, to be published at least monthly by the Italian Patent and Trademark Office, shall contain at least the following information relating to:

a) applications for patents or registration with the indication of any priority or request for deferral of public access;

b) patents and registrations granted;

c) patents and registrations revoked due to lack of payment of the prescribed annual maintenance fees;

d) patents and registrations offered to the public under license;

e) patents and registrations subject to expropriation decrees or compulsory licenses;

f) patents and registrations subject to conversion;

g) applications for recording of legal documents as per Article 138 and registrations made;

*g-bis*) judgments as per Article 197, paragraph 6. <sup>(228)</sup>

2. The identification data of applications, patents and registrations, in addition to the specific information indicated in paragraph 1, letters a), d) and e), and the respective numbers and dates, are those identified in Articles 160, paragraph 1, 167, paragraph 1, 168, paragraphs 1 and 2, letters b) and d).

3. The Official Bulletin is accompanied by analytical indexes, that must be at least alphabetical for owners, numerical and by class.

---

<sup>(228)</sup> Letter added by paragraph 1 of Article 102, Legislative Decree No. 131 of 13 August 2010.

### **190. Official Bulletin of complementary certificates for medicines and phytosanitary products.**

1. The Official Bulletin of applications and complementary certificates for medicines and phytosanitary products, to be published at least monthly by the Italian Patent and Trademark Office, shall contain at least

the information required by Article 11 of regulations EEC No. 1768/92 of the Council, of 18 June 1992 and (EC) No. 1610/96 of the European Parliament and of the Council, of 23 July 1996.

## **Section IV**

### **Terms**

#### **191. Expiration of terms.**

1. The terms set in this Code may be extended on request filed before their expiration to the Italian Patent and Trademark Office, unless the term is indicated as not being extendable.
2. Unless otherwise established by the Implementation Regulation of this Code, on grounded request, the extension may be granted up to a maximum of six months from the date of expiration or communication by which the Italian Patent and Trademark Office set the term, or two months from the date of receipt by the requesting party of the communication by which the Office grants the extension, if that term expires subsequently, or by which the Office refuses it. <sup>(229) (230)</sup>

---

<sup>(229)</sup> For the extension of the term set by this paragraph see Article 23, paragraph 14, Law Decree No. of 1 July 2009, No. 78.

<sup>(230)</sup> Paragraph as amended by paragraph 1 of Article 103, Legislative Decree No. 131 of 13 August 2010.

#### **192. Continuation of the proceeding.**

1. When the applicant for an industrial property right has not complied with a term relating to a proceeding before the Italian Patent and Trademark Office, the proceeding may be resumed on request from the applicant without the non-compliance with the term entailing the loss of the industrial property right or any other consequences.
2. The request for continuation of the proceeding must be filed within two months of the expiration of the term not complied with or the extended term set by Article 191, paragraph 2, if an extension was requested, and must be accompanied by the proof of having fulfilled within that term the requirements that had not been fulfilled within the previous, expired term. The request must be accompanied by proof of payment of the fee established for the continuation of the proceeding in table A annexed to the decree of the Ministry of Economic Development on 2 April 2007, published in Official Gazette No. 81 of 6 April 2007.
3. The provision in this article is not applicable to the term for the claim of a right of priority, the terms regarding an opposition proceeding, the term for the filing of an appeal to the Board of Appeal, the period for submission of the document of priority, the period for supplementing the application or the filing of the translation pursuant to Article 148, the term for the payment of the fees for maintenance of industrial property titles with late fees, the terms set for the re-establishment of the right as per Article 193 and the term for the submission of the translation into English of the claims of a patent application as per Article 8 of the decree of the Ministry of Economic Development on 27 June 2008 concerning the search for earlier rights, published in Official Gazette No. 153 of 2 July 2008. <sup>(231)</sup>

---

<sup>(231)</sup> Article as substituted by paragraph 1 of Article 104, Legislative Decree No. 131 of 13 August 2010. See also Article 23, paragraph 14, Law Decree No. of 1 July 2009, No. 78 e Article 30, Ministerial Decree No. 33 of 13 January 2010.

### 193. Re-establishment.

1. The applicant or owner of an industrial property title who, despite having used the diligence required by the circumstances, was unable to comply with a term with respect to the Italian Patent and Trademark Office or the Board of Appeal, shall have his rights restored if the non-compliance has the direct consequence of rejection of the application or of a related request, or the revocation of the industrial property title or the loss of any other right or the right to appeal. <sup>(232)</sup>

2. Within the term of two months from the cessation of the cause justifying the non-compliance, the omitted act must be carried out and a claim for re-establishment must be filed indicating the circumstances and justifications, with appropriate documentation. The claim is not admissible after one year from the expiration of the unfulfilled term. In the case of failure to pay a fee for maintenance or renewal, that period of one year starts on the date of expiration of whatever applicable term however is set for the payment of the fee. In this case, a certificate of payment of the due fee, including any late fees, must be enclosed. <sup>(233) (234)</sup>

3. Prior to the rejection of a claim, the applicant or owner of the industrial property right may file his own arguments or evidence, within the term fixed by the Office.

4. The provisions of this article are not applicable to the terms under paragraph 2, to the term assigned for the division of applications for patents and registration, and for the filing of the division request and the filing oppositions to the registration of trademarks. <sup>(235)</sup>

5. If the applicant for the registration or patent, who notwithstanding the use of the diligence required by the circumstances, was unable to comply with the term for claiming priority, shall have the right restored if priority is claimed within two months of the expiration date of such term. This provision also applies in the case of failure to comply with a term required for submitting the priority document. <sup>(236)</sup>

6. Whoever in good faith has made serious and actual preliminary activity or started to use the object of others' intellectual property in the period between the loss of the exclusive rights or the right to purchase it and the re-establishment pursuant to paragraph 1, may:

a) if it is an invention, utility model, design or model, new plant variety or topography of semiconductor products, implement them without consideration in the limits of previous use or as they result from the preliminary activities;

b) if it is a trademark, ask to be reimbursed for the expenses sustained.

---

<sup>(232)</sup> Paragraph as amended by paragraph 1 of Article 105, Legislative Decree No. 131 of 13 August 2010.

<sup>(233)</sup> For the extension of the term set by this paragraph see Article 23, paragraph 14, Law Decree No. 78 of 1 July 2009..

<sup>(234)</sup> Paragraph as amended by paragraph 2 of Article 105, Legislative Decree No. 131 of 13 August 2010.

<sup>(235)</sup> See also Article 59, Ministerial Decree No. 33 of 13 January 2010.

<sup>(236)</sup> Paragraph as amended by paragraph 3 of Article 105, Legislative Decree No. 131 of 13 August 2010.

## TITLE V

### Special Procedures

#### 194. Expropriation procedure.

1. A copy of an expropriation decree is transmitted to the Italian Patent and Trademark Office and notified to the interested parties, in the forms established for the service of process. Once notification has been made, the rights that were the subject of the expropriation are acquired by the relevant Administration, that shall have an unquestioned right to make use of them. The Administration also acquires any obligation for payment of the prescribed fees for the maintenance in effect of the industrial property right. Except in the case where publication can cause harm, expropriation decrees and decrees that modify or revoke the previous decrees, the Italian Patent and Trademark Office gives notice in the Official Bulletin and makes a note on the title or in the application.

2. An expropriation decree of only the use of the industrial property right must indicate the duration of the use expropriated. In the event that the expropriation regards only the use of the industrial property right, the patenting and registration, as well as the publication of the respective titles, are carried out according to ordinary procedure.

3. Only for the purposes of determining the indemnity to be paid for the expropriation, if an agreement is not reached concerning the amount of the same, the decision shall be made by an Arbitration Board consisting of three members, one appointed by each of the parties and the third appointed by the first two, or if no agreement is reached, by the president of the specialized section of the Tribunal of Rome. The arbitrators must be chosen from among those who have acquired professional skills and experience in the industrial property field. The provisions of Article 806 *et seq.* of the Code of Civil Procedure shall apply if consistent.

4. The Arbitration Board must proceed with a fair assessment, taking into account the loss of competitive advantage that would derive from the expropriated patent.

5. The costs for the arbitration, the fees due to the arbitrators and the costs and fees for the defense are set in the judgment, that also establishes who is to be responsible for the relevant costs, and to what extent. In any event, the responsibility for those costs shall lie with the expropriated party when the indemnity is set at a level below that initially offered by the Administration. <sup>(237)</sup>

6. The decision of the arbitrators may be appealed before the specialized section of the Tribunal of Rome that quantifies the indemnity. The term for appeal is sixty (60) days from the time at which the decision on the indemnity is communicated to the parties.

---

<sup>(237)</sup> Paragraph as amended by paragraph 3 of Article 105, Legislative Decree No. 131 of 13 August 2010.

#### 195. Requests for registration. <sup>(238)</sup>

1. Requests for registration must be drawn up in accordance with the requirements set in the decree of the Ministry of Productive Activities. <sup>(239)</sup>

2. The request must contain:

a) the first and last name and domicile of the beneficiary of the requested registration and the attorney, if one exists;

b) the first and last name of the owner of the industrial property right;

c) the nature of the requested registration or the reason that justifies it;

d) the list of the industrial property rights concerned by the requested registration;

e) in the event of a change in ownership, the name of the Country in which the new applicant or new owner



has citizenship, the name of the Country in which the new applicant or new owner has domicile, or the name of the Country in which the new applicant or the new owner has an actual and serious industrial or commercial establishment.

---

[\(238\)](#) See also Ministerial Decree No. 33 of 13 January 2010.

[\(239\)](#) Paragraph as amended by paragraph 1 of Article 106, Legislative Decree No. 131 of 13 August 2010.

## 196. Registration procedure.

1. Registration requests, as per paragraph 2 of Article 195, must be accompanied by the following: [\(240\)](#)

a) a copy of the conveyance which shows the change in ownership or the legal document that constitutes or modifies or extinguishes the personal or secured rights or security interests indicated in paragraph 1, letters a), b), c) and i) of Article 138, or a copy of the records and judgments indicated in paragraph 1, letters d), e), f), g) and h) of Article 138, in compliance with the provision of the law on registers where necessary, or an extract of the same legal document or in the case of merger, a certification issued by the Company Register or another competent authority, or in the case of transfer or grant of a license, a declaration of transfer, or of conveyance, or grant of a license signed by the transferor and the transferee listing the rights subject to the transfer or grant. The Italian Patent and Trademark Office may ask for a copy of the legal document or extract to be certified as an authentic copy of the original by a public official or another competent public authority; [\(241\)](#)

b) a document proving the payment of the prescribed fees.

2. A single request is sufficient when the registration regards multiple industrial property rights both in the application phase and granted to the same person, provided that the beneficiary of the change in ownership or secured rights or security interests or the legal document to be registered is the same for all of the titles and that the numbers of all of the requests and titles in question are indicated in the same request.

3. When an attorney has been appointed, the letter of engagement pursuant to Article 201 must also be enclosed.

4. For each registration, the following must be indicated on the register:

a) the date of filing of the request, that is the same as that of recording;

b) the first and last name and domicile of the successor in title, or the company name and registered office, if it is a company or charitable organization, as well as the first and last name and domicile of the attorney, when one exists;

c) the nature of the rights to which the recording refers.

5. The documents and judgments, submitted for registration, shall be preserved by the Italian Patent and Trademark Office.

6. Requests for cancellation of the registrations must be made in the same forms and following the same methods established for requests for registration. Cancellations must be carried out through notes in the margin.

7. If for the recording of security interests it is necessary to convert the amount of the credit into the national currency, that conversion shall be carried out based on the exchange rate for the date on which the interest was granted.

---

[\(240\)](#) Paragraph as modified by paragraph 1 of Article 107, Legislative Decree No. 131 of 13 August 2010.

[\(241\)](#) Letter as substituted by paragraph 2 of Article 107, Legislative Decree No. 131 of 13 August 2010.

### **197. Annotations.** [\(242\)](#)

1. [The applicant or his attorney, where one exists, must indicate or elect his domicile in the Country in each request for all of the communications and notifications to be carried out under this Code]. [\(243\)](#)
2. Any changes in the name and domicile of the owner of the industrial property right or his attorney, if one exists, must be communicated to the Office for the annotations on the register as per Article 185. [\(244\)](#)
3. A request for annotation of changes in name and address must be drawn up in one copy only following the requirements of the Implementation Regulation. [\(245\)](#)
4. A single request is sufficient when the modification regards multiple industrial property rights in the application phase or that have already been granted.
5. The provisions of paragraphs 1, 2 and 3 shall apply to changes in the name or address of the attorney as per Article 201.
6. A declaration of surrender, even if partial, of an industrial property right signed by the owner, and the judgments that declare the nullity or revocation of the industrial property titles received by the Italian Patent and Trademark Office, must be noted on the folder of the originals, and notification of the same must be given in the Official Bulletin. [\(246\)](#)

---

[\(242\)](#) See also Ministerial Decree No. 33 of 13 January 2010.

[\(243\)](#) Paragraph abrogated by paragraph 1 of Article 108, Legislative Decree No. 131 of 13 August 2010.

[\(244\)](#) See also Article 32, Ministerial Decree No. 33 of 13 January 2010.

[\(245\)](#) See also Article 41, Ministerial Decree No. 33 of 13 January 2010.

[\(246\)](#) Paragraph as substituted by paragraph 2 of Article 108, Legislative Decree No. 131 of 13 August 2010. See also Article 32, Ministerial Decree No. 33 of 13 January 2010.

### **198. Military classification procedure.** [\(247\)](#)

1. Persons who reside in the territory of the Country may not, without the authorization of the Ministry of Productive Activities, file their applications for patents for inventions, utility models or topographies only at the offices of foreign Countries or the European Patent Office or the International Office of the World Intellectual Property Organization as the receiving office, if those applications regard objects that could be useful for the defense of the Country, nor file them in those offices before ninety (90) days have passed from the date of filing in Italy, or from that of submission of the request for authorization. The cited Ministry shall act on the requests for authorization, after receiving approval from the Ministry of Defense. Once the term of ninety (90) days has passed without a decision of refusal being made, the authorization is to be considered granted. The provisions of this paragraph do not apply to inventions realized pursuant to international agreements ratified with national laws. [\(248\)](#)

2. Unless the act constitutes a more serious crime, the violation of the provisions of paragraph 1 shall be

punished with a fine of not less than 77,47 Euros, or with detention. If the violation is committed when authorization has been denied, detention of not less than one year shall apply.

3. The Italian Patent and Trademark Office shall immediately make available to the Patents and Intellectual Property Service of the Ministry of Defense the applications for patents for industrial inventions, utility models and topographies of semiconductor products that they have received. <sup>(249)</sup>

4. If the cited Service believes that the applications regard inventions, models and topographies useful for the defense of the Country, officials and officers outside of that same Service expressly authorized by the Ministry of Defense may also review the descriptions, claims and drawings annexed to the applications, at the premises of the Office. <sup>(250)</sup>

5. Confidentiality obligations shall apply to anyone who has reviewed the applications and documents relating to patents or have learned of them for official reasons.

6. Within the ninety (90) days following the date of filing of the applications, the Ministry of Defense may ask the Italian Patent and Trademark Office to grant an extension for the granting of the industrial property title and any related publications. The Office shall inform the interested party of the request, and warn him to comply with the obligation of confidentiality.

7. If within eight months of the date of filing of the application, the competent Ministry has not sent to the Office and the applicant the notice of the intention to proceed with the expropriation, since they indicated their domicile in the Country, the ordinary procedure for the granting of the industrial property title will be followed. Within the cited term, the Ministry of Defense may request that the granting of the industrial property title and all related publications be further postponed, for a period no longer than three years from the date of filing of the application. In that case, the inventor or his successor in title has the right to an indemnity which shall be determined applying the regulations concerning expropriation.

8. For utility models, the further postponement indicated in paragraph 7 may be requested for a time not greater than one year from the date of filing of the application.

9. On request from foreign Countries that provide reciprocal treatment, the Ministry of Defense may request the deferral of the granting of the patent and any publications relating to the invention, for a period of even more than three years, for patent applications already filed abroad and subject to obligations of secrecy.

10. Any indemnities shall be the responsibility of the requesting foreign Country.

11. The invention must be kept confidential after the communication of the request for deferral and for the entire duration of the deferral, and also during the execution of the expropriation and after the respective decree if this contains the obligation of confidentiality.

12. The invention must also be kept confidential in the case provided for by paragraph 6, after the decision to bring the expropriation with imposition of confidentiality has been communicated to the interested party.

13. The obligation of secrecy ceases when the Ministry of Defense so allows.

14. The violation of confidentiality shall be punished in accordance with Article 262 of the Criminal Code.

15. The Ministry of Defense may request that applications for patents for industrial inventions by subordinate or supervised bodies be kept confidential.

16. If, for an invention that concerns the military defense of the Country, the Ministry of Defense requests, or in the case of deferral as per paragraph 6, allows the granting of the patent, the relevant procedure shall be carried out, on request from the Ministry, in confidential form. In that case, no publication shall be made and the consultations in this Code shall not be allowed.

17. In cases of exhibitions to be held in the territory of the Country, the Ministry of Defense has the authority, through its own officials and officers, to proceed to a detailed exam of the objects and inventions delivered for

the exhibition that can be considered useful for the military defense of the Country, and also has the authority to obtain information and request clarification on those objects and inventions.

18. The organizing bodies of exhibitions must deliver to those officials or officers the complete lists of the objects to be exhibited referring to industrial inventions not protected under this Code.

19. The officials and officers as identified in paragraph 17 may impose on the entity a prohibition on exhibition of the objects useful for the military defense of the Country.

20. The Ministry of Defense, by way of a registered mail letter, return receipt requested, must inform the chairmanship of the exhibition and those affected by the prohibition on exhibition, informing them of the obligation of confidentiality. The chairmanship of the exhibition must preserve the objects covered by the prohibition on exhibition with the constraint of confidentiality regarding their nature.

21. In the event that the prohibition on exhibition is imposed after the objects have been displayed, those objects must be immediately withdrawn, but without the imposition of the obligation of confidentiality.

22. In any event, the Ministry of Defense shall maintain the authority, for the objects that refer to inventions recognized as useful to the military defense of the Country, to proceed to expropriate the rights resulting from the invention, model or topography in accordance with the provisions relating to expropriation contained in this Code. <sup>(251)</sup>

23. If the prohibition on exhibition is not followed, the directors of the unauthorized exhibition shall be punished with an administrative sanction of from 25,00 Euros to 13.000,00 Euros.

---

<sup>(247)</sup> See also Article 45, Ministerial Decree No. 33 of 13 January 2010.

<sup>(248)</sup> Paragraph as modified by paragraphs 1 and 2 of Article 109, Legislative Decree No. 131 of 13 August 2010.

<sup>(249)</sup> Paragraph as amended by paragraph 3 of Article 109, Legislative Decree No. 131 of 13 August 2010.

<sup>(250)</sup> Paragraph as substituted by paragraph 4 of Article 109, Legislative Decree No. 131 of 13 August 2010.

<sup>(251)</sup> Paragraph as amended by paragraph 5 of Article 109, Legislative Decree No. 131 of 13 August 2010.

### **199. Procedure for compulsory license.**

1. Whoever wishes to obtain an compulsory license as indicated in Articles 70 and 71 of Title II, Section IV, for the non-exclusive use of an industrial invention or a utility model, must submit a grounded request to the Italian Patent and Trademark Office, indicating the amount and method of payment of the compensation offered. The Office shall promptly give notice of the request, by way of a registered mail letter, return receipt requested, to the owner of the patent and to those who purchased rights to the patent based on legal documents that have been registered or noted.

2. Within sixty (60) days of the date of receipt of the registered mail letter, the owner of the patent and all those who have rights based on the registered or noted legal documents may oppose the granting of the request or state that they do not accept the amount and method of payment of the compensation. Grounds must be stated for any oppositions.

3. In the case of oppositions, within forty-five (45) days of the expiration date of the term for the submission of the same, the Italian Patent and Trademark Office shall convene the opponent, the owner of the patent and all those who have rights based on registered or noted legal documents, for an attempt at conciliation. The notice of call is sent to the parties by registered mail letter, return receipt requested, or by other methods, including by computer, provided that those methods guarantee sufficient certainty of receipt of the

communication.

4. In the notice of call, the Italian Patent and Trademark Office must communicate and transmit a copy of the oppositions filed to the opponent.
5. The opponent may submit written counterarguments to the Italian Patent and Trademark Office by the fifth day prior to the date that the meeting is to be held.
6. In the forty-five (45) days subsequent to the date of the meeting for the attempt at conciliation, the Ministry of Productive Activities either grants the license or rejects the request.
7. The term for the conclusion of the proceeding is one hundred eighty (180) days, starting from the date the application is filed.

#### **200. Procedure for voluntary license on active principles.**

1. The application for a voluntary license on active principles, accompanied by the certification demonstrating the payment of the fees in the amount established by the decree of the Ministry of Productive Activities as per Article 226, must contain the following information:

- a) the name or company title and domicile or registered office of the applicant for the voluntary license;
- b) the name of the active principle;
- c) the details of protection, patent number and complementary certificate of protection;
- d) an indication of the Italian pharmaceutical laboratory, duly-authorized by the Ministry of Health in accordance with law, if the party intends to produce the active principle.

2. The applicant must send to the Italian Patent and Trademark Office (UIBM), by registered mail, return receipt requested or other methods that guarantee confirmation of receipt of the communication, a request, with a translation into the English language enclosed, accompanied by the elements provided for by paragraph 1. <sup>(252)</sup>

3. The UIBM shall give prompt notice of the request, by registered mail, return receipt requested, or by other methods that guarantee confirmation of receipt of the communication, to the interested parties and to those who have acquired rights on the patent or on the complementary certificate of protection based on registered or noted legal documents.

4. If within ninety (90) days of receipt of the application, which period may be extended on agreement between the parties, the parties reach an agreement based on a limited royalty, a copy of the same must be transmitted, by analogous methods, to the Ministry of Productive Activities - UIBM. If in the subsequent thirty (30) days the Office does not communicate any findings to the parties, the voluntary license agreement shall be considered to be completed.

5. In the case that the parties communicate to the UIBM that it is not possible to reach an agreement, the Office shall initiate the conciliation proceeding as indicated in paragraph 6 *et seq.* <sup>(253)</sup>

6. The Ministry of Productive Activities, by issuing a decree, appoints a commission with the assignment of evaluating the requests for voluntary licenses for which no agreement was reached between the parties.

7. The commission consists of six members and six alternates, including:

- a) two representatives of the Ministry of Productive Activities;

b) a representative of the Ministry of Health;

c) a representative of the Italian Medicines Agency;

d) a representative of the owners of CCPs (complementary protection certificates), on proposal from the most representative trade associations;

e) a representative of the producers of pharmaceutical active principles, on proposal from the most representative trade associations.

8. Within thirty (30) days of the date of the communication received from the UIBM concerning the lack of an agreement reached between the parties, the commission identified in paragraphs 6 and 7 shall proceed to convene the parties, in order to identify a potential agreement aimed at reconciling the needs of the parties, while however guaranteeing reasonable remuneration for the party who issues the voluntary license, through the indication of a limited royalty, set with criteria that take account of the needs of international competition of producers of active principles.<sup>(254)</sup>

9. If, despite the mediation of the Ministry, a license agreement is not concluded, if the Ministry of Productive Activities determines that the legal prerequisites have been met, the Ministry shall order the transmission of the legal documents of the proceeding to the Italian Antitrust Authority.

---

<sup>(252)</sup> Paragraph as amended by paragraph 1 of Article 110, Legislative Decree No. 131 of 13 August 2010.

<sup>(253)</sup> Paragraph as amended by paragraph 2 of Article 110, Legislative Decree No. 131 of 13 August 2010.

<sup>(254)</sup> Paragraph as amended by paragraph 3 of Article 110, Legislative Decree No. 131 of 13 August 2010.

## TITLE VI

### Professional Regulation

#### **201. Representation.**

1. Nobody is obliged to be represented by a professional representative in the proceedings before the Italian Patent and Trademark Office; individuals and legal entities may act through one of their employees, even if that person is not certified, or through an employee of another affiliated company, pursuant to Article 205, paragraph 3.
2. The appointment of one or more attorneys, if not made in the application, or by a separate legal document that is authentic or authenticated, may be made by a specific letter of engagement, subject to the payment of the prescribed fee.
3. The appointment or letter of engagement may regard one or more applications or in general the professional representation for any proceedings before the Italian Patent and Trademark Office and the Board of Appeal. In that case, in each subsequent application, request or appeal, the attorney must make reference to the Power of Attorney or letter of appointment. <sup>(255)</sup>
4. The appointment may be granted only to attorneys registered in a specific Register established for that purpose at the Board of the Industrial Property Consultants Institute.
5. [The appointment may also be granted to citizens of the European Union who possess a qualification corresponding to that of the certified consultants concerning patents and trademarks registered in the Italian Register of Industrial Property Consultants, officially recognized in the Member State of the European Union where they have their professional domicile, on the condition that in the activity carried out the attorney uses only the professional title of the Member State in which he resides, expressed in the original language, and that the activity of representing his principals is provided only in a temporary fashion. The attorney shall send the documentation, proving the possession of the qualification in his own Member State, to the Office and Board of the Institute, which is responsible for checking compliance with the conditions for exercising the activity of professional representation provided for in this article]. <sup>(256)</sup>
6. The appointment may also be granted to a lawyer admitted to the Bar.

---

<sup>(255)</sup> Paragraph as amended by paragraph 1 of Article 111, Legislative Decree No. 131 of 13 August 2010.

<sup>(256)</sup> Paragraph abrogated by Article 60, Legislative Decree No. 206 of 9 November 2007.

#### **202. Register of consultants.**

1. Subject to the provisions set forth by Article 201, the representation of individuals or legal entities in proceedings before the Italian Patent and Trademark Office and the Board of Appeal may be assumed only by certified consultants registered in the Register established at the Board of the Institute and denominated the "Register of Certified Industrial Property Consultants," as well as those who are admitted to the Bar.
2. The Register consists of two sections, denominated, respectively, the patents section and the trademarks sections with the first reserved to consultants who are certified as regards patents and inventions, utility models, designs and models, new plant varieties, and topographies of semiconductor products, and the second for consultants who are certified as regard designs and models, trademarks and other distinctive signs and



geographical indications.

3. The persons included in the Register constitute the Industrial Property Consultants Institute.

4. The oversight of the exercise of the profession is carried out by the Ministry of Productive Activities, through the Italian Patent and Trademark Office.

### 203. Requirements for registration.

1. Any individual may be included in the Register of Certified Industrial Property Consultants if he:

a) has all his civil rights in the national legal system and is a person of good civil and moral conduct;

b) is an Italian citizen or a citizen of the Member States of the European Union or a citizen of Foreign Countries with respect to which reciprocal treatment is accorded;

c) has a professional domicile in Italy or in the European Union if the person is a citizen of an EU Member State; the requirement of professional domicile in Italy is not required if the person is a citizen of a non-EU country that allows Italian citizens to be included in corresponding registers without that requirement; <sup>(257)</sup>

d) has passed the qualification exam, as per Article 207, or has passed the aptitude test required for industrial property consultants indicated in paragraph 2 of Article 6 of Legislative Decree No. 115 of 27 January 1992.

2. The registration is made by the Board of the Institute on presentation of a request accompanied by the documents proving the possession of the requirements set forth in paragraph 1 or including the self-certifications provided for by law. Completion of the registration must be promptly communicated by the Board to the Italian Patent and Trademark Office.

3. The persons indicated in paragraph 5 of Article 201 who exercise the activity of representation in a temporary manner are considered to be automatically entered into the Register of Industrial Property Consultants for the purpose of the exercise of the rights and compliance with the obligations established in the professional regulations to the extent compatible, but they do not participate in the General Meetings of the members of the Register and shall not be elected as members of the Board of the Institute.

4. The persons indicated in paragraphs 1 and 3 who have their professional domicile in a Member State of the European Union are obliged to elect domicile in Italy pursuant to and in accordance with Article 120, paragraph 3 of this Code. <sup>(258)</sup> <sup>(259)</sup>

---

<sup>(257)</sup> Letter as modified by paragraph 1 of Article 112, Legislative Decree No. 131 of 13 August 2010.

<sup>(258)</sup> Paragraph as amended by paragraph 2 of Article 112, Legislative Decree No. 131 of 13 August 2010.

<sup>(259)</sup> See also Article 2, Ministerial Decree 30 May 1995, No. 342, as substituted by Article 7, Las No. 62 of 18 April 2005, Community Law 2004.

### 204. Professional title of the activity.

1. The title of industrial property consultant is reserved to the persons registered in the Register of Certified Consultants. The persons registered only in the patents section must use the title in the form of consultant in patents, and the persons registered only the trademarks section must use the title in the form of consultant in trademarks. The persons registered in both of the sections may use the title of industrial property consultant without further specification.

2. The persons indicated in Article 202 carry out all of the requirements set by the regulations that govern the relevant services, on behalf of any individual or legal entity, with respect to matters of patents for inventions, utility models, designs and models, new plant varieties, topographies of semiconductor products or matters of trademarks, designs and models and geographical indications, depending on the section in which they are registered. They may certify the authenticity of translations into the Italian language and of any legal documents from abroad to be submitted to the Italian Patent and Trademark Office. <sup>(260)</sup>

3. Furthermore, on appointment and in representation of the interested parties, they may also perform any other function that is similar, related or consequent to what is provided for in paragraph 2.

4. If the appointment is granted to multiple certified consultants, unless otherwise indicated, they may also act separately. If the appointment is granted to multiple certified consultants, joined in a partnership or company, the appointment is to be considered granted to each of them inasmuch as they act within that partnership or company.

---

<sup>(260)</sup> Paragraph as amended by paragraph 1 of Article 113, Legislative Decree No. 131 of 13 August 2010.

## **205. Incompatibility.**

1. Registration in the Register of Certified Industrial Property Consultants and the exercise of the profession of industrial property consultant are incompatible with any job or public or private office with the exception of the employment relationship or positions held in companies, offices or specialized services in the field, whether they are independent or organized in the context of entities or businesses, and teaching activity exercised in any form; with the exercise of commerce, the profession of notary, professional journalist, mediator, exchange attorney or tax collector.

2. Registration in the Register of Certified Industrial Property Consultants and the exercise of the profession of industrial property consultant are compatible, if not otherwise established and subject to the provisions of paragraph 1, with registration in other professional registers and the exercise of the respective professions.

3. Certified industrial property consultants who exercise their activity in offices or services organized within entities or enterprises, or in the context of consortia or groups of enterprises, may operate only in the name and on behalf of:

a) the entity or enterprise for which they work;

b) the enterprises belonging to the consortium or group in whose organization they are stably included;

c) enterprises or persons who are with entities or enterprises or groups or consortia, in which the certified consultant is included, in systematic collaboration relationships, including for research, production or technological exchange.

## **206. Obligation of professional confidentiality.**

1. Industrial Property Consultants are obliged to maintain professional confidentiality and Article 200 of the Code of Civil Procedure applies to them.

## **207. Qualifying exam.**

1. Certification is granted upon passage of an exam taken before a Commission consisting of the following

persons, for each session:

- a) the director of the Italian Patent and Trademark Office or a representative of the same with the functions of chairman;
- b) a member of the Board of Appeal, designated by the Chairman of the same, with the functions of Deputy Chairman;
- c) two university professors, in the legal and technical fields, respectively, designated by the Ministry of Productive Activities;
- d) four certified industrial property consultants, designated by the Board indicated in Article 215, two of whom are to be chosen from among employees of entities or enterprises, and two who exercise the profession independently;
- e) alternate members who may replace those indicated in letters b), c) and d), if the latter have impediments. <sup>(261)</sup>

2. The qualifying exam may be taken by any person who:

a) has got:

- 1) a university degree or equivalent university qualification in any foreign country;
- 2) a diploma or qualification issued by a Member State of the European Union including the certification that the candidate has successfully concluded post-secondary school studies with a minimum duration of three years or an equivalent duration taken part-time, at a university or institution of higher learning or in another institution with the same level of training, provided that the course of study has a technical-professional orientation relating to the activity of industrial property consultant concerning patents of inventions and models, or concerning trademarks and designs and models, depending on the certification requested;
- b) has completed at companies, offices or services specialized in industrial property, at least two years of actual professional apprenticeship, appropriately documented.

3. The qualifying exam for registration in the patents section may be taken by any person who has passed the qualifying exam as a certified consultant at the European Patent Office.

4. The period of apprenticeship is limited to twelve months if the candidate for the qualifying exam demonstrates that he has attended and received credit for a qualified training course for certified consultants in matters of patents or trademarks, depending on the certification requested.

5. The qualifying exam for registration in the patents section and the trademarks section, respectively, consist of written and oral tests, aimed at verifying the theoretical and practical preparation of the candidate in the specific field of industrial property rights, and also in terms of technical, juridical and language culture, consistent with the relevant section, based on the methods established in the regulation to be issued by a decree.

6. The qualifying exam for registration in the patents section or in the trademarks section is announced every two years by a decree of the Ministry of Productive Activities.

---

<sup>(261)</sup> Letter as modified by paragraph 1 of Article 114, Legislative Decree No. 131 of 13 August 2010.

## 208. Exemption from the qualifying exam.

1. Persons may be exempted from the qualifying exam if they are former employees of the Ministry of Economic Development or the Ministry of Defense, and have worked for at least five years with managerial duties at the Italian Patent and Trademark Office or the Patent and Intellectual Property Service, respectively. <sup>(262)</sup>

2. Italian citizens who have worked for at least five years with duties as examiners at the European Patent Office are also exempt.

---

<sup>(262)</sup> Paragraph as substituted by paragraph 1 of Article 115, Legislative Decree No. 131 of 13 August 2010.

### **209. Register of certified industrial property consultants.**

1. The Register established pursuant to Article 202 must contain for each member the first and last name, place and date of birth, academic qualifications, date of registration, and professional domicile in Italy, which may also consist of the registered office of the entity or enterprise for which he works. <sup>(263)</sup>

2. The date of registration determines seniority. Those who are cancelled from the Register and then re-enrolled shall have seniority dating from the first registration, reduced by the duration of the interruption.

---

<sup>(263)</sup> Paragraph as amended by paragraph 1 of Article 116, Legislative Decree No. 131 of 13 August 2010.

### **210. Cancellation from the Register and automatic suspension.**

1. A certified consultant is cancelled from the Register:

- a) when one of the requirements for registration is no longer present, as per Article 203;
- b) when one of the cases of incompatibility is present as established by Article 205;
- c) when the interested party so requests.

2. A certified consultant may request re-registration in the Register when the causes for cancellation have ceased, without needing to take the exam again.

3. A certified consultant shall be declared to be automatically suspended from the right to exercise the profession from the time he is subject to the coercive or restrictive measures indicated by sections II and III of section IV, title I, of the Code of Civil Procedure, until the time of revocation of those measures, and also in the case of failure to pay the annual fee by the set deadline, until the date on which it is demonstrated that the requirement has been fulfilled.

### **211. Disciplinary sanctions.**

1. Certified consultants are subject to censure in cases of minor abuses and offenses, and to suspension for no more than two years in the case of serious abuses; to expulsion in the case of conduct that has seriously damaged their reputation and professional dignity.

## **212. General Meeting of the consultants registered in the Register.** <sup>(264)</sup>

1. The General Meeting is convened by the president, upon a resolution of the Board of the Institute. It is duly-constituted on first call with the presence of at least one-half of the members, and on second call, which shall not take place on the same day set for the first call, with the presence of at least one-sixth of the members present, and if the members present and represented reach the level of at least one-fifth of the members. The meeting makes decisions by absolute majority votes.
2. Each certified consultant included in the Register may be represented by another certified consultant included in the Register by way of a written proxy. A single participant may not represent more than five members.
3. The method of convening and governing the General Meeting shall be determined by a decree of the Ministry of Productive Activities.

---

<sup>(264)</sup> See also Ministerial Decree No. 33 of 13 January 2010.

## **213. Responsibilities of the General Meeting.**

1. The General Meeting shall meet at least once a year by the end of the month of March, to approve the preliminary and final accounts, for the determination of the annual fee that must be equal for all of the members, and if necessary, for the election of the Board of the Institute, in which case the meeting must be convened at least one month prior to the date of the end of the Board's time limit.
2. The General Meeting shall also meet each time the Board of the Institute deems it necessary, and also when request has been made in writing with an indication of the subjects to be discussed by at least one-tenth of the members of the Register.

## **214. General Meeting for the election of the Institute's Board.** <sup>(265)</sup>

1. The members of the Institute's Board as indicated in Article 215 shall be elected by simple majority of secret votes validly expressed by way of ballots containing a number of names not greater than one-half plus one of the members to be elected. The ten candidates who have received the highest number of votes shall be elected. In the event of a tie, the candidate with the most seniority shall prevail, and among those who have the same seniority, the oldest shall prevail.
2. Each category of consultants who exercise the profession independently, both individually and in the context of independent companies, offices or services, on the one hand, and consultants who exercise the profession in specialized offices and services within entities or enterprises as per Article 205, paragraph 3, on the other, shall not be represented on the Board of the Institute by more than eight members. Likewise, each section of the Register shall not be represented on the Board by more than seven members who are registered only in that section.
3. Participation and votes may not be expressed by proxy. Votes may be expressed by letter.
4. The methods for conducting votes, the vote counting operations and the proclamation of those elected are set by a decree of the Ministry of Productive Activities.

(265) See also Ministerial Decree No. 33 of 13 January 2010.

### **215. Board of the Industrial Property Consultants Institute.**

1. The Industrial Property Consultants Institute is governed by a Board that remains in office for three years and that consists of ten members with no less than three years of seniority, elected by the General Meeting. Members of the Board who are terminated for any reason prior to the end of their term shall be substituted by the candidates included in the list who, after those who were elected, obtained the highest number of votes, without prejudice to the provisions set forth in paragraph 2 of Article 214.
2. In the event of failure to promptly renew the Board, the Board of the Institute shall continue to function until the appointment of the new Board.
3. Meetings of the Board of the Institute shall be duly-constituted only with the presence of the majority of members, and decisions shall be made by absolute majority votes. In the event of a tie vote, the vote of the chairman shall be decisive. As regards disciplinary matters, the Board of the Institute shall make decisions with the presence of at least three-fourths of its members.

### **216. Powers of the Chairman of the Board of the Institute.**

1. The Board of the Institute shall appoint from among its members a Chairman, who shall represent the Institute: in urgent cases, he shall adopt the necessary measures, subject to ratification by the Board in the next meeting, and he shall exercise the remaining powers attributed to him by this Code.
2. The Chairman may assign secretarial or treasury functions to members of the Board.
3. The Board shall also appoint a Deputy Chairman from among its members, who shall substitute the Chairman when he is absent or has an impediment, or on authorization from the same for individual actions.

### **217. Powers of the Board of the Institute.**

1. The Board of the Institute shall:
  - a) promptly fulfill the requirements relating to enrollment, suspension and cancellations to be made in the Register, giving immediate notice to the Italian Patent and Trademark Office;
  - b) ensure the safeguarding of the professional title of industrial property consultant and propose the initiatives necessary to that end to the General Meeting;
  - c) on mutual request from the parties, intervene to settle disputes that arise between members of the Register related to the exercise of the profession;
  - d) propose modifications and updates to the professional fee schedule;
  - e) on request from a client or from a certified consultant, express an opinion on the amount of fees due to industrial property consultants for services related to the exercise of the profession;
  - f) adopt disciplinary measures;
  - g) designate the four certified industrial property consultants who make up the examination commission as per Article 207;

- h) take the most appropriate initiatives to achieve the improvement and training of the members in performing their professional activities;
- i) establish its own office and arrange the equipment necessary for its functioning;
- l) collect and manage the annual fee of the members;
- m) draw up the budget and prepare the final accounts of operations;
- n) receive applications for admission to the qualifying exam as indicated in Article 207, and verify compliance with the conditions for admission;
- o) keep relationships and collaborate with the bodies and institutions that operate in the sector of industrial property or that carry out activities related to the same, providing proposals or opinions where suitable;
- p) carry out all of the tasks defined by decree of the Ministry of Productive Activities that are instrumental with respect to those provided for by this Code;
- p-bis*) record registrations in the Register of apprentices and perform the relevant updates. <sup>(266)</sup>

---

<sup>(266)</sup> Letter added by paragraph 1 of Article 117, Legislative Decree No. 131 of 13 August 2010.

## **218. Termination from position of member of the Board of the Institute, dissolution and lack of constitution of the Board of the Institute.**

1. Any members who, without good reason, do not participate in three consecutive meetings of the Board of the Institute shall be declared to be terminated from their positions.
2. The Board may be dissolved by the Ministry of Productive Activities, if it is not able to function and in any case if more than four of the original members have been terminated or are deceased, or in the case that serious irregularities have been found.
3. In the case of dissolution of the Board, its functions are taken on by an administrator appointed by the Ministry of Productive Activities. Within sixty days, the administrator shall call new elections, for which the General Meeting must be held no earlier than thirty days and no later than sixty days from the date of the notice of call.

## **219. Meetings of the Board of the Institute.**

1. The Board of the Institute shall be convened by the Chairman at least once every six months or when he deems it necessary, or when a request has been made by a majority of its members. The resolutions of the Board are recorded by a member appointed to act as the secretary at the beginning of each meeting.

## **220. Disciplinary proceedings.**

1. When a report is received of actions that could lead to the application of one of the disciplinary sanctions established by Article 211, the Chairman shall appoint a rapporteur from among the members of the Board.
2. Upon notification of the actions at least 10 days prior to the hearing of the interested party, the Board, after



examining any briefs and documents, shall make a decision by absolute majority of those present; in the case of a tie vote, the decision that is most favorable for the accused shall prevail.

3. If the interested party does not appear or submit any defense briefs, the proceeding shall continue in his absence, unless a legitimate impediment has been demonstrated.

4. The resolution must contain an indication of the actions, the grounds and a summary statement of the decision.

5. When the reasons indicated by Article 51(1) of the Code of Civil Procedure are present, if applicable, the members of the Board must abstain, and they may be disqualified for the same reasons by a request filed with the secretariat of the Board before the discussion.

6. In all other cases in which serious reasons of expediency exist, the members must request authorization from the Chairman of the Board of the Institute to abstain.

7. The Board of Appeal shall decide on recusals.

#### **221. Appeals against actions of the Board of the Institute.**

1. All of the actions taken by the Board of the Institute may be appealed before the Board of Appeal within the maximum time limit of one year from the communication of the action to the interested party.<sup>(267)</sup>

2. The director of the Italian Patent and Trademark Office shall ensure the proper operation and functioning of the Board, and for any irregularities found, may file an appeal with the Board of Appeal within thirty days of communication of the decision. The appeal shall not have suspensive effect.

---

<sup>(267)</sup> Paragraph as substituted by paragraph 1 of Article 118, Legislative Decree No. 131 of 13 August 2010.

#### **222. Professional fee schedule.**

1. The Ministry of Productive Activities, by issuing a decree, shall approve the modifications and updates to the professional fee schedule proposed by the Board of the Institute, pursuant to Article 217, paragraph 1, letter d).

2. The performance of activities relating to the professional regulations shall not entail additional costs for the state budget.

## TITLE VII

### Management of Services and Rights

#### 223. Tasks.

1. The services relating to the matters regulated by this Code shall be under the responsibility of the Italian Patent and Trademark Office.
2. Without prejudice to the institutional responsibilities of the Ministry of Foreign Affairs in matters of industrial property and the coordination activity of the Prime Minister, the Italian Patent and Trademark Office of the Ministry of Productive Activities shall promote and maintain relations with the EU and international bodies with authority over those matters, as well as the national industrial property offices of other Countries, and deal with the relevant issues, ensuring participation in the bodies and working groups.
3. The Italian Patent and Trademark Office shall also provides for the following further activities:
  - a) the creation and management of data bases and the disclosure of patent information, with particular reference to updates on prior art;
  - b) the promotion of technical-legal preparation of the public administration personnel operating in the field of industrial property and technological innovation, and those who work or intend to work as consultants in the field of industrial property;
  - c) promotion of the culture and use of industrial property for potential users, in particular at small and medium-sized enterprises and in under-developed areas;
  - d) conducting studies, research, surveys and producing publications related to industrial property, and the development of patent indicators for competitive analysis of Italy, on its own and in collaboration with public agencies, research institutes, associations and international bodies;
  - e) the provision of non-institutional services for payment, on request from private individuals, provided that the services are compatible with the institutional function and role attributed to it.
4. The Italian Patent and Trademark Office may stipulate conventions with regions, chambers of commerce, industry, crafts and agriculture, public and private entities, for the purpose of carrying out its tasks. <sup>(268)</sup> <sup>(269)</sup>

---

<sup>(268)</sup> By Prime Minister's Decree of 25 September 2006 (Official Gazette No. 235 of 9 October 2006) the Italian Patent and Trademark Office was identified as the Italian authority responsible for receiving international letters rogatory from the European Patent Office and transmitting them to the relevant specialized Courts on industrial and intellectual property for execution.

<sup>(269)</sup> See also Article 67, Ministerial Decree No. 33 of 13 January 2010.

#### 224. Financial resources.

1. The Italian Patent and Trademark Office shall carry out its tasks and the financing of prior art searches with the resources determined in the preliminary budget of the Ministry of Productive Activities, with the amounts directly collected for the services rendered in respect of industrial property.
2. The Ministry of Productive Activities shall annually transfer fifty per cent of the amount of fees under paragraph 1 to the European Patent Office, as provided for by Article 39 of the Munich Convention of 5 October 1973, ratified by Law No. 260 of 25 May 1978. <sup>(270)</sup>

3. The Italian Patent and Trademark Office shall carry out its tasks also using any payments and reimbursements made by international industrial property organizations in which Italy participates, and with any other income resulting from its activities.

---

(270) Paragraph as amended by paragraph 1 of Article 119, Legislative Decree No. 131 of 13 August 2010.

## 225. Grant and maintenance of right.

1. For applications submitted to the Ministry of Productive Activities in order to obtain industrial property titles, for grants, oppositions, registrations and renewals, the registry fee is due, as well as the governmental grant fee and the fees which, in relation to each title or application and the interval of time to which they refer, are set by a specific decree of the Ministry of Productive Activities, in accordance with the Ministry of Economy and Finance.

2. The individual fee for designation of Italy in the application for international registration of a trademark, in the posterior designation or request for renewal applicable to foreign international trademarks that request protection in the Italian territory through the World Intellectual Property Organization, pursuant to the Protocol relating to the Madrid Agreement for the International Registration of Marks of 27 June 1989, ratified by Law No. 169 of 12 March 1996, is set at the rate of ninety percent of the fees established for the filing of a grant of a national trademark or its renewal.

## 226. Terms and methods of payment.

1. The payment of the taxes and fees for the government grant under this Code is made in the terms and by the methods set by the Ministry of Productive Activities, by a decree issued by the same. (271)

---

(271) In implementation of what is established by this article see the Ministerial Decree of 11 May 2011.

## 227. Fees for maintenance of industrial property titles.

1. All fees set for the maintenance of the industrial property titles must be paid in advance, by the end of the month in which the application was filed, once the period covered by the previous payment has passed. The application for renewal of a trademark must be filed within the twelve months prior to the last day of the month in which the current decade expires.

2. The fees for maintenance of patents for inventions, utility models and designs and models, if they are already due at the end of the month in which the certificate of grant is issued, or are due by the end of the subsequent third month, are payable within four months from the end of the month of issue.

3. The fees for maintenance of rights on plant varieties are due, for the duration of the right indicated in Article 109, paragraph 1, starting with the grant of the right, and must be paid in advance by the end of the month corresponding to that of the grant.

4. Once the deadline indicated in paragraphs 1 and 2 has passed, payment is allowed in the subsequent six months with the application of a late payment penalty, the amount of which is set for each industrial property right by the Ministry of Economic Development, in agreement with the Ministry of Economy and Finance.

5. A delay in payment of more than six months entails the revocation of the industrial property right.
6. Multiple annual fees may be paid in advance.
7. In the case indicated in Article 6, paragraph 1, all parties are jointly and severally liable for the payment of the maintenance fees.
8. The payment of the maintenance fees of European patents valid in Italy due starting from the year subsequent to that in which the grant of the European Patent is published in the European Patent Bulletin, are subject to the terms of payment established for national patents and the regulations set forth in Article 230 on regularization.<sup>(272)</sup>

---

<sup>(272)</sup> Article as substituted by paragraph 1 of Article 120, Legislative Decree No. 131 of 13 August 2010. See also paragraph 851 of Article 1, Law No. 296 of 27 December 2006.

## **228. Exemption and suspension from payment of fees.**

1. For an inventor who demonstrates that he is in conditions of poverty, the Ministry of Productive Activities may grant an exemption from the grant fees and a suspension of the payment of the annual fees for the first five years. As of the expiration of the fifth year, the inventor who intends to maintain a patent must pay any back fees, in addition to the annual fee for the sixth year. On the contrary, the patent is revoked and the inventor is not obliged to pay the fees for the previous years.

## **229. Reimbursable fees.**

1. Should the application be rejected or waived, before the registration has been made or the patent has been granted, the fees paid are reimbursed, with the exception of the application fee. The fee required for the filing of an opposition is reimbursed in the event of cancellation of the opposition pursuant to Article 181, paragraph 1, letter b).<sup>(273)</sup>
2. The reimbursement of fees is authorized by the Ministry of Productive Activities. The authorization is granted ex officio when the fees to be reimbursed refer to an application for registration or patent that has been definitively rejected. In all other cases, the reimbursement is made on request from the qualified person, with a direct request to the Ministry of Productive Activities.<sup>(274)</sup>
3. The reimbursements must be noted in the Patent Register, and if they refer to applications withdrawn or rejected, are recorded in the application register.

---

<sup>(273)</sup> Paragraph as amended by paragraph 1 of Article 121, Legislative Decree No. 131 of 13 August 2010.

<sup>(274)</sup> Paragraph as amended by paragraph 2 of Article 121, Legislative Decree No. 131 of 13 August 2010.

## **230. Incomplete or irregular payment.**

1. If due to an evident error, or for other excusable reasons, a fee is paid in an incomplete or irregular manner, the Italian Patent and Trademark Office may allow the supplementing or regularization of the payment, including if made late.<sup>(275)</sup>



2. If the fee is an annual fee, the Italian Patent and Trademark Office shall act only on request from the interested party. If the request is rejected, the interested party may have recourse to the Board of Appeal identified in Article 135, paragraph 1. <sup>(275)</sup>

3. [A delay in payment of more than six months entails the revocation of the industrial property right]. <sup>(277)</sup>

---

<sup>(275)</sup> Paragraph as amended by paragraph 1 of Article 122, Legislative Decree No. 131 of 13 August 2010.

<sup>(276)</sup> Paragraph as amended by paragraph 2 of Article 122, Legislative Decree No. 131 of 13 August 2010.

<sup>(277)</sup> Paragraph abrogated by paragraph 3 of Article 122, Legislative Decree No. 131 of 13 August 2010.

## TITLE VIII

### Transitional and Final Provisions

#### Section I

#### Marks

##### **231. Earlier applications.**

1. Applications for trademark registration and applications for recording in the register filed before the date of entry into force of Legislative Decree No. 480 of 4 December 1992, are treated in accordance with the provisions contained in them. However, as regards the formal requirements, they are subject to the pre-existing regulations.

##### **232. Limits on exclusive rights on well known trademarks.**

1. The right to make exclusive use of a registered trademark before the date of entry into force of Legislative Decree No. 480 of 4 December 1992 and that is well known, does not allow the owner to oppose the additional use in commerce of a sign that is identical or similar to the trademark for goods or services not similar to those for which it has been registered.

##### **233. Nullity.**

1. The trademarks registered before the date of entry into force of Legislative Decree No. 480 of 4 December 1992, in regards to nullity actions, are subject to provisions of earlier laws.

2. A trademark shall not be declared null if prior to the filing of the principal request or counterclaim of nullity, the mark, following the use that has been made of it, has acquired a distinctive character.

3. A trademark shall not be declared null if the earlier mark has expired for more than two years, or three years if it is a collective trademark or may be considered revoked for non use prior to the presentation of the principal request or counterclaim for nullity.

4. For the purposes of the application of Article 48 of Royal Decree No. 929 of 21 June 1942, as substituted by Legislative Decree No. 480 of 4 December 1992, the term of five years starts from the date of entry into force

of the same.

#### **234. Transfer and licensing of the trademark.**

1. The provisions of Legislative Decree No. 480 of 4 December 1992, that regulate the transfer and licensing of trademarks, also apply to trademarks already granted, but not to contracts concluded before the date of entry into force of Legislative Decree No. 480 of 4 December 1992.

#### **235. Revocation due to non-use.**

1. The provisions of Legislative Decree No. 480 of 4 December 1992, that regulate revocation due to non-use, apply to trademarks already granted at the date of entry into force of that Legislative Decree, provided that they had not already been revoked on that date.

#### **236. Revocation due to misleading use.**

1. The provisions of Legislative Decree No. 480 of 4 December 1992, that regulate the revocation of trademarks due to misleading use, apply to trademarks already granted on the date of entry into force of the same Legislative Decree, in relation to misleading use made after its entry into force.

### **Section II**

#### **Designs and Models**

#### **237. Earlier applications.**

1. Applications for patents for design or ornamental model and applications for registration filed before the date of entry into force of Legislative Decree No. 95 of 2 February 2001, are treated in accordance with the provisions contained in the same. Those applications are subject to the previous regulations relating to formal regularity.

#### **238. Extension of right.**

1. Patents for design or ornamental model granted before the date of entry into force of Legislative Decree No. 95 of 2 February 2001, provided that they had not expired or been revoked as of the date of entry into force of the cited Decree, may be extended by a maximum term of twenty-five years from the date of filing of the patent application. The licensees and those who in view of the upcoming expiration have made serious and actual investments to utilize the design and model shall have the right to obtain a free, non-exclusive compulsory license for the longer period. This authority shall not apply to infringers of patents not yet expired.

2. The grant fees paid in a single payment shall be valid for the first two extensions. The fees on governmental grants relating to the fourth and fifth five-years periods, starting on 19 April 2001, shall be of an amount corresponding to the installment of the third five-year period established by Article 10, title IV, number 2, letters c) and f), of the rates indicated in the table annexed to Presidential Decree No. 641 of 26 October 1972.

### 239. Limits on protection granted by copyrights.

1. The protection granted to designs and models pursuant to Article 2, No. 10), of Law No. 633 of 22 April 1941, also includes industrial design works that, prior to the date of 19 April 2001, were or entered into the public domain. Nevertheless, any third parties who in the twelve months prior to 19 April 2001 manufactured or traded products produced in compliance with the industrial design works then in the public domain shall not be liable for infringement of the copyrights carried out by continuing this activity even after that date, limited to the products manufactured or acquired by the same prior to 19 April 2001 and those manufactured in the thirteen years after that date, and provided that the activity also remained within the quantitative limits of previous use. <sup>(278)</sup>

---

<sup>(278)</sup> Article as substituted first by Article 4, Law Decree No. 10 of 15 February 2007, as amended by the respective conversion law, and then by paragraph 6 of Article 19, Law No. 99 of 23 July 2009, and by paragraph 1 of Article 123, Legislative Decree No. 131 of 13 August 2010. In addition, this article had been substituted by paragraph 10 of Article 8, Law Decree No. 70 of 13 May 2011, and subsequently eliminated by the respective conversion law. The paragraph had also be amended by art.22-bis, Legislative Decree n° 216 of 29 December 2011.

### 240. Nullity.

1. Patents for design and ornamental model granted before the date of entry into force of Legislative Decree No. 95 of 2 February 2001, are subject, as regards of nullity actions, to the earlier provisions of law, and as for the effects of a declaration of nullity, to the provisions set forth in Article 77 of this Code.

### 241. Exclusive rights on components of a complex product.

1. Until Directive 98/71/EC of 13 October 1998 of the European Parliament and the Council, on legal protection of designs and models, is amended on proposal of the Commission pursuant to Article 18 of that Directive, the exclusive rights on the components of a complex product shall not be invoked to prevent the manufacture and sale of the components themselves for the repair of a complex product, in order to restore the original appearance.

## Section III

### New Plant Varieties

### 242. Duration of the patent.

1. The provisions of Article 109 of this Code are applicable to patents for new plant varieties granted in accordance with Presidential Decree No. 974 of 12 August 1975, that had not expired or been revoked by the date of entry into force of Legislative Decree No. 455 of 3 November 1998.

2. The licensees and those who, as of the entry into force of Legislative Decree No. 455 of 3 November 1998, had made serious and actual investments for the utilization of the new plant varieties covered by the inventor's right, shall have the right to obtain a free, non-exclusive, compulsory license for the longer period. This right shall not apply to infringers of rights not yet expired.

2-bis. The annual fees paid from the date of filing for the maintenance of the applications and patents for new plants already filed or granted as of 29 March 1999, shall be considered valid as payment of the corresponding annual fees due from the grant of rights in accordance with Article 25 of Legislative Decree No. 455 of 3 November 1998. <sup>(279)</sup>



---

[\(279\)](#) Paragraph added by paragraph 1 of Article 124, Legislative Decree No. 131 of 13 August 2010.

#### **Section IV**

##### **Inventions**

#### **243. Inventions by university researchers and public research entities.**

1. The inventions developed by employees whose employment relationship exists with a university or a public agency whose institutional aims include research, are subject to the regulations, set respectively by Article 24-*bis* of Royal Decree No. 1127 of 29 June 1939, introduced by Law No. 383 of 18 October 2001, by the original text of Article 65 of this Code, and by the current text of the same article, in force at the time in which the inventions were conceived, even if deriving from previous research. [\(280\)](#)

---

[\(280\)](#) Article as substituted by paragraph 1 of Article 125, Legislative Decree No. 131 of 13 August 2010.

#### **Section IV**

##### **Inventions**

#### **243-*bis*. Report to Parliament concerning legal protection of biotechnological inventions.**

1. The Ministry of Economic Development, in concert with the Ministries of Health, Agricultural, Food and Forestry Policies, the Environment and Protection of the Territory and Sea, Education, University and Research, and Labor and Social Policies, shall submit a report on the application of the regulations established by Title II, Section IV-*bis* of this Code to the Parliament each year. [\(281\)](#)

---

[\(281\)](#) Article added by paragraph 1 of Article 126, Legislative Decree No. 131 of 13 August 2010.

#### **Section V**

##### **Earlier Applications**

#### **244. Treatment of applications.**

1. Applications for patents or registration and those for recording and notation, even if already filed at the time of entry into force of this Code, shall be treated in accordance with the regulations contained in the same. The applications as per Item IV, Section I, are subject to the pre-existing regulations relating to conditions of admissibility.

#### **Section VI**

## Procedural Rules

### **245. Procedural provisions.**

1. The provisions of Sections I and IV of Title II and those of Title III and the provisions of Articles 35 and 36 of Title V of Legislative Decree No. 5 of 17 January 2003, apply to the legal proceedings and arbitrations that began with a notified judicial document or with the filing of an appeal six months after entry into force of this Code.
2. Disputes at the appeals level concerning the matters identified by Article 134, initiated after the date of entry into force of this Code, shall continue to be referred to the cognizance of the specialized sections as per Legislative Decree No. 168 of 27 June 2003, even if the first instance judgment or the arbitration decision were initiated or conducted in accordance with the rules previously in force, unless a ruling on jurisdiction was already made in the context of one of those proceedings. <sup>(282)</sup>
3. The procedures for appeals of cases on the merits concerning the matters identified in Article 134, that were initiated after the date of entry into force of this Code, shall continue to be referred to the cognizance of the specialized section as per Legislative Decree No. 168 of 27 June 2003, even if they regard precautionary measures in accordance with the rules previously in force. <sup>(283)</sup>
4. The procedural rules as per Article 136 concerning the jurisdictional function of the Board of Appeal become applicable starting one year after the entry into force of the Code.
5. The procedural rules set forth in Articles 137, 146, 194, 195, 196, 198, 199 and 200 become applicable with the entry into force of the Code.

---

<sup>(282)</sup> Paragraph as substituted by letter a) of paragraph 7 of Article 19, Law No. 99 of 23 July 2009.

<sup>(283)</sup> Paragraph as substituted by letter b) of paragraph 7 of Article 19, Law No. 99 of 23 July 2009.

## Section VII

### Abrogations

### **246. Abrogation provisions.**

1. The following provisions are abrogated:
  - a) Royal Decree No. 1127 of 29 June 1939;
  - b) Royal Decree No. 244 of 5 February 1940;
  - c) Royal Decree No. 1411 of 25 August 1940;
  - d) Royal Decree No. 1354 of 31 October 1941;
  - e) Royal Decree No. 929 of 21 June 1942;
  - f) Presidential Decree No. 795 of 8 May 1948;
  - g) Article 34 of Presidential Decree No. 3 of 10 January 1957;
  - h) Presidential Decree No. 540 of 30 June 1972;



- i)* Ministerial Decree of 22 February 1973 of the Ministry of Industry, Trade and Crafts, published in the Official Gazette of the Italian Republic No. 69 of 15 March 1973;
- j)* Presidential Decree No. 974 of 12 August 1975, without prejudice to Article 18;
- m)* Ministerial Decree of 22 October 1976 of the Ministry of Industry, Trade and Crafts, published in the Official Gazette of the Italian Republic No. 15 of 18 February 1977;
- n)* Presidential Decree No. 32 of 8 January 1979;
- o)* Presidential Decree No. 338 of 22 June 1979;
- p)* Law No. 194 of 3 May 1985;
- q)* Law No. 620 of 14 October 1985;
- r)* Ministerial Decree of 26 February 1986 of the Minister of Industry, Trade and Crafts, published in the Official Gazette of the Italian Republic No. 104 of 7 May 1986;
- s)* Law No. 60 of 14 February 1987;
- t)* Law No. 70 of 21 February 1989;
- u)* Ministerial Decree No. 320 of 19 July 1989 of the Minister of Industry, Trade and Crafts, published in the Official Gazette of the Italian Republic No. 220 of 20 September 1989;
- v)* Ministerial Decree No. 122 of 11 January 1991 of the Minister of Industry, Trade and Crafts, published in the Official Gazette of the Italian Republic No. 85 of 11 April 1991;
- z)* Law No. 349 of 19 October 1991; Legislative Decree No. 480 of 4 December 1992; Law No. 302 of 26 July 1993;
- aa)* Presidential Decree No. 595 of 1 December 1993;
- bb)* Presidential Decree No. 360 of 18 April 1994;
- cc)* Presidential Decree No. 391 of 18 April 1994;
- dd)* Law No. 890 of 21 December 1984;
- ee)* Ministerial Decree No. 342 of 30 May 1995 of the Minister of Industry, Trade and Crafts, published in the Official Gazette of the Italian Republic No. 192 of 18 August 1995;
- ff)* Legislative Decree No. 198 of 19 March 1996; Legislative Decree No. 455 of 3 November 1998; Legislative Decree No. 447 of 8 October 1999;
- gg)* Legislative Decree No. 95 of 2 February 2001;
- hh)* Legislative Decree No. 164 of 12 April 2001;
- ii)* Article 7 of Law No. 383 of 18 October 2001;
- ll)* Legislative Decree No. 26 of 2 February 2002;
- mm)* paragraphs 8, 8-*bis*, 8-*ter* and 8-*quater* of Article 3 of Law No. 112 of 15 June 2002, that converted with amendments Law Decree No. 63 of 15 April 2002;

*nn)* Ministerial Decree of 17 October 2002 of the Minister of Productive Activities, published in the Official Gazette No. 253 of 28 October 2002;

*oo)* Article 17 of Law No. 273 of 12 December 2002;

*pp)* paragraphs 72, 73, 79, 80 and 81 of Article 4 of Law No. 350 of 24 December 2003.