

ITALY

Trademark Law

Royal Decree No. 929 of June 21, 1942 as last amended by Legislative Decree

No. 198 of March 19, 1996

ENTRY INTO FORCE: April 15, 1996

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Title I Rights in Trademarks and Use of Trademarks

Chapter I Rights in Trademarks

Art. 1.

1. The rights of the owner of a registered trademark shall consist in the faculty to make exclusive use of the trademark. The owner shall have the right to prohibit third parties who do not have his consent from using:

(a) signs identical to the trademark for goods or services that are identical to those for which the trademark was registered;

(b) signs identical or similar to the registered trademark for goods or services that are identical or similar where the identity or similarity of the signs and the identity or similarity of the goods or services might create a risk of confusion for the public, such risk of confusion including also the risk of association between the two signs;

(c) signs identical or similar to the registered trademark for goods or services that are not similar, where the registered trademark is well known in the State and the use of the sign without just reason would allow undue advantage to be taken of the distinctiveness or notoriety of the trademark or would be detrimental to the latter.

2. In the cases provided for in paragraph 1 the owner of a trademark may, in particular, prohibit third parties from affixing the sign on the goods or their packaging, from offering such goods, placing them on the market or holding them for such purposes, or offering or providing the services distinguished by the sign, from importing or exporting goods distinguished by the sign and from using the sign in commercial correspondence and advertising.

Art. 1bis.

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

(a) his own name and address;

(b) references to the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or rendering of the service or other characteristics of the goods or services;

(c) the trademark, where it is necessary to specify the intended purpose of a product or service, in particular as accessories or spare parts; provided that the use is in accordance with the principles of honest trading and therefore does not have a trademark function, but only a descriptive function.

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

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

Art. 2.

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

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

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

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

5. Collective marks are subject to all other provisions of this Law, as

long as they do not conflict with the nature of such marks.

Art. 3.

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

Art. 4.

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

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

3. Registration shall be effective in relation to the goods or services mentioned therein and also similar goods or services, except as provided in paragraph 1(c) of Article 1.

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

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

Art. 5.

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

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

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

4. Renewal of the registration of a mark which has been transferred with

regard to some of the goods or services shall be effected by each proprietor separately.

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

Art. 6.

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

Art. 7.

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

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

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

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

Art. 8.

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

Refusal of protection for such marks on the territory of the State may

be issued within one year of the date of publication of the mark in the bulletin of the World Intellectual Property Organization (WIPO) in Geneva.

Chapter II Use of Trademarks

Art. 9.

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

Art. 10.

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

Art. 11.

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

Art. 12.

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

Art. 13.

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

2. The prohibition referred to in paragraph 1 shall extend to the adoption

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

Art. 14. [Repealed]

Art. 15.

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

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

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

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

Title II Subject Matter and Proprietor of Trademarks

Chapter I Subject Matter of Registration

Art. 16.

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

Art. 17.

1. A sign shall not be new within the meaning of Article 16 above if, on the filing date of the relevant application:

(a) it consists exclusively in a sign that has come into common use in everyday language or trade practice;

(b) it is identical with or similar to a sign that is already known as a trademark or sign distinguishing goods or services manufactured, marketed or rendered by others for identical or similar goods or services, and if the identity or similarity of the signs and the identity or similarity of the goods or services might create a risk of confusion for the public, such risk of confusion including also the risk of association between the two signs; a trademark shall likewise be considered known if, within the meaning of Article 6bis of the Paris Convention (Stockholm text, July 14, 1967), it is well known to the relevant sector of the public, which shall include notoriety gained within the State through the promotion of the trademark; previous use of the sign shall not destroy the novelty thereof, provided that it does not impart notoriety or imparts purely local notoriety; previous use of the sign by the applicant or his predecessor in title shall not be an obstacle to registration;

(c) it is identical with or similar to a sign that is already known as a company or corporate name or business style and emblem adopted by another, where the identity or similarity of the signs and the identity or similarity of the activity carried out by the undertaking and the goods or services for which the trademark was registered might create a risk of confusion for the public, such risk of confusion including also the risk of association between the two signs. Previous use of the sign shall not destroy the novelty thereof, provided that it does not impart notoriety or imparts purely local notoriety. Previous use of the sign by the applicant or his predecessor in title shall not be an obstacle to

registration;

(d) it is identical with a trademark that has already been registered in the State by others or is effective in the State following an application filed on an earlier date, or effective as from an earlier date on account of a seniority right or in the case of a Community trade mark a valid claim to priority, for identical goods or services;

(e) it is identical with or similar to a trademark that has already been registered in the State by others or is effective in the State following an application filed on an earlier date, or effective as from an earlier date on account of a seniority right or in the case of a Community trade mark a valid claim to priority, for identical or similar goods or services, where the identity or similarity of the signs and the identity or similarity of the goods or services might create a risk of confusion for the public, such risk of confusion including also a risk of association between the two signs;

(f) in the case provided for in (d) and (e) above, the novelty of a trademark shall not be destroyed by the existence of an earlier trademark the registration of which lapsed more than two years previously, or three years previously in the case of a collective trademark, or which may be considered revoked for non-use under Article 42 below at the time of the claim or counterclaim for nullity;

(g) it is identical with or similar to a trademark that has already been registered in the State by others or is effective in the State following an application filed on an earlier date, or effective from an earlier date on account of a seniority right or in the case of a Community trademark a valid claim to priority, for goods or services that are not similar, where the earlier trademark is well known in the European Economic Community in the case of a Community trade mark or in the State, and the use of the subsequent trademark without just reason would constitute undue exploitation of the distinctiveness or notoriety of the prior sign or would be detrimental to the latter;

(h) it is identical with or similar to a trademark that is already well known within the meaning of Article 6bis of the Paris Convention (Stockholm text, July 14, 1967) for goods or services that are not similar, where the situation provided for in (g) above obtains.

2. For the purposes provided for in paragraph 1(d), (e) and (g), prior applications shall be considered equivalent to previously registered trademarks, subject to the eventual registration thereof.

Art. 18.

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

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

(b) signs consisting exclusively of the generic names of goods or services or descriptive statements relating thereto, such as signs which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or time of production of the goods or of the provision of the service, or other characteristics of the product or service;

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

(d) escutcheons and other signs referred to in the relevant international conventions, in the cases and under the conditions set forth in such conventions, as well as signs including badges, emblems and escutcheons which are of public interest, unless the competent authority has authorized their registration;

(e) signs capable of deceiving the public, in particular as to the geographical origin, nature or quality of the goods or services;

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

Art. 19.

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

Art. 20. [Repealed]

Art. 21.

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

2. Personal names other than the name of the person seeking registration

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

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

Chapter II Proprietor of Trademark

Art. 22.

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

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

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

Art. 23.

1. Registration of a trademark may be granted to a foreigner who does not have, in the territory of the State, the undertakings in which the goods or services distinguished by the said trademark originate if the State to which the applicant belongs grants reciprocal treatment to Italian nationals.

2. Nationals of States that have ratified and enforced the Agreement on Trade-Related Aspects of Intellectual Property Rights, adopted in Marrakesh on April 15, 1994, shall be granted the same treatment as is provided for Italian nationals.

3. Any benefits that international treaties confer, have conferred or

will confer on foreigners in the territory of the State with respect to trademarks shall be presumed to extend also to Italian nationals.

Art. 24.

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

Title III Application, Examination and Registration

Art. 25.

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

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

(a) take over the application for registration in his own name and assume the capacity of applicant in all respects;

(b) file a new application for registration which, provided the mark it contains is substantially identical with that of the original application, shall have effect from the filing or priority date of the original application, which in any case shall cease to be effective;

(c) obtain the rejection of the application.

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

(a) obtain a court judgment, having retroactive effect, ordering the transfer to his name of the certificate of registration;

(b) enforce the invalidity of the registration granted in the name of the person not entitled to it.

Art. 26.

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

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

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

Art. 27.

1. Each application may concern only one mark.

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

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

Art. 28.

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

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

Art. 29.

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

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

(2) whether the word, design or sign, can be registered as a mark in accordance with Articles 16, 17.1(a), 18.1(a), (b), (c), (d) and (e) and 21;

(3) whether the conditions referred to in Article 23 are met;

(4) whether, in the case referred to in Article 24, the conditions stipulated in the international conventions are met.

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

Art. 30.

1. In the case of a mark including words, designs or signs having a political significance or a highly symbolic value, or including heraldic elements, the Office shall forward, prior to registration, a copy of the

mark and whatever else is appropriate, to the concerned or responsible public bodies to obtain their opinions, in accordance with the provisions of the following Article.

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

Art. 31.

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

Art. 32. [Repealed]

Art. 33.

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

Art. 34.

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

Art. 35.

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

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

Title IV Registration Fees

Art. 36.

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

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

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

Art. 37. [Repealed]

Art. 38.

1. The application fee and the initial registration fee shall be paid prior to the filing of the application.

2. Likewise, the renewal fee shall be paid prior to the filing of the relevant application.

3. If an application is rejected or withdrawn before the registration is granted, the fees paid shall be refunded, with the exception of the application fee.

Art. 39. [Repealed]

Art. 40.

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

Title V Revocation and Invalidity of Trademarks

Art. 41.

A trademark shall be revoked in the following cases:

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

Art. 42.

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

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

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

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

used to distinguish the same goods or services.

Art. 43.

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

Art. 44-46. [Repealed]

Art. 47.

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

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

Art. 47bis.

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

Art. 47ter.

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

Art. 48.

1. The owner of an earlier trademark within the meaning of paragraph 1(d), (e), (g) and (h) of Article 17 and the holder of a right of prior use that imparts not merely local notoriety who for five consecutive years have known of and condoned the use of a subsequently registered identical or similar trademark may not request that the subsequent trademark be declared invalid or oppose its use for the goods or services in respect of which it has been used by virtue of their own earlier trademark or prior use, except where the subsequent trademark was applied for in bad faith. The owner of the subsequent trademark may not oppose the use of the earlier one or the continuation of the prior use.

2. The preclusion of the claim for invalidity referred to in paragraph

1 shall also extend to other persons.

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

Title VI Registered Acts

Art. 49.

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

- (1) deeds inter vivos, whether for valuable consideration or not, constituting, modifying or transferring personal or property rights of possession or guarantee rights in respect of national marks;
- (2) deeds of partition, company deeds, deed of settlement, deeds of release relative to the rights referred to in the preceding item;
- (3) judgments establishing the existence of the acts referred to in the preceding items, where such acts have not been previously registered. Judgments establishing the invalidity, annulment, termination, rescission, revocation of a registered act must be noted in the margin of the registration of the act to which they refer. Furthermore, judicial claims to obtain the judgments referred to in this Article may be registered; in such case, the effects of the registration of the judgment shall be retroactive to the date of registration of the judicial claim;
- (4) wills and acts proving the intestate succession and the judgments relative thereto.

Art. 50.

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

6. Omissions or inaccuracies not leading to absolute uncertainty with respect to the act which is to be registered or with respect to the mark to which the act refers shall not affect the validity of the registration.

Art. 51.

1. The acts and judgments referred to in Article 49, except for the wills and the other acts and judgments referred to in item (4), shall be ineffective against others who have by any title acquired and legally maintained rights in a mark, until they have been registered.

2. Where more than one person has obtained the same right from the same proprietor, the person who has registered his title first shall have priority.

3. Wills and acts proving intestate succession and the judgments relative thereto shall be registered for the sole purpose of establishing the continuity of the transfers.

Title VII Administration and Jurisdiction

Art. 52.

1. The Italian Patent and Trademark Office of the Ministry of Industry, Trade and Craft Trades, referred to in Article 70, first paragraph, of Royal Decree No. 1127 of June 29, 1939, concerning patents for industrial inventions, shall perform the services pertaining to the matters governed by this Decree.

2. The competences of the Office with respect to the matters governed by this Decree shall also be taken into account with respect to the procedures set forth in the aforementioned Article 70, second paragraph.

Art. 53.

1. Appeals under this Decree against actions taken by the Italian Patent and Trademark Office shall be heard by the Board of Appeals referred to in Article 71, first and second paragraphs, of Royal Decree No. 1127 of June 29, 1939, concerning patents for industrial inventions.

2. The members of that Board, as also the technical experts, may be selected from among serving or retired officials, provided that the categories of official from which the selection is to be made are those stipulated in the aforementioned Article 71 and in any other provision of that Article.

3. The Board shall give a reasoned judgment after having heard the parties concerned or their representatives or agents and having considered their written observations.

4. The remaining provisions of the aforementioned Article 71 and those of Articles 72 and 73 of Royal Decree No. 1127 of June 29, 1939, shall likewise apply in trademark matters.

Art. 54.

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

Art. 55.

Legal actions in trademark matters shall constitute personal property actions.

Art. 56.

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

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

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

Art. 57.

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

Art. 58.

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

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

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

Art. 58bis.

1. Where a party has provided genuine evidence of the validity of his claims and has identified documents, data or information in the possession of the opposing party in support of that evidence, that party may request the court to order that the said evidence be produced or that the said information be acquired by interrogation of the opposing party. He may further request the court to order that such data be provided as are necessary for identifying the individuals involved in the production and distribution of the goods or services constituting the infringement.

2. When adopting the above measures, the court shall take such measures as are appropriate to ensure the protection of confidential information, after having heard the opposing party.

Art. 59.

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

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

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

Art. 60.

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

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

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

Art. 61.

The owner of the rights in a current or pending trademark registration may seek an order for the description or seizure of all or some of the goods constituting an infringement of those rights, of any means used

in producing the said goods and of the evidence concerning the reported infringement. In the latter case such measures shall be adopted as are appropriate to ensure the protection of confidential information.

Art. 62.

1. Except where otherwise provided in the following paragraphs, proceedings under Article 61 shall be governed by the provisions of the Code of Civil Procedure on the provisional measures of investigation and seizure, as the case may be.

2. Description and seizure shall be performed by a court official, who may be assisted by one or more experts where necessary, and may make use of technical, including photographic, means of verification.

3. The parties concerned may be authorized to attend the above operations, either in person or through their representatives, and to be accompanied by technical assistants of their choice.

4. Paragraphs 2 and 3 of Article 693 of the Code of Civil Procedure shall not apply to description. For the purposes of Article 697 of the Code of Civil Procedure, the condition of exceptional urgency shall be determined by the need not to jeopardize enforcement of the remedy. The provisions of Articles 669octies, 669novies, 669undecies and 675 of the Code of Civil Procedure shall apply also to description.

5. After the period provided for in Article 675 of the Code of Civil Procedure has elapsed, description and seizure operations already begun may be completed, but no such operations may be initiated by virtue of the same order; the foregoing shall be without prejudice to the possibility of applying to the court for further measures of description or seizure in the course of the procedure on the merits.

6. Description and seizure may likewise concern goods belonging to individuals not specified in the complaint, provided that those goods have been produced, offered, imported, exported or placed on the market by the party against whom the said measures were ordered and are not intended for personal use. The record of the seizure and description performed, together with the complaint and the court order, shall be served on the third party to whom the goods affected by the seizure or description belong within 15 days of the completion of the aforesaid operations, on pain of nullity.

Art. 63.

1. The owner of the rights in a current or pending trademark registration may apply to the court for an injunction prohibiting the manufacture, marketing and use of anything that constitutes an infringement of the trademark in accordance with the provisions of the Code of Civil Procedure on precautionary measures.

2. On pronouncing the injunction the court may specify a sum payable for any violation or non-compliance or for any delay in compliance.

Art. 64.

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

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

Art. 65.

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

Art. 66.

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

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

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

subsequently established and for any delay in the execution of the orders set forth in the judgment.

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

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

Art. 67.

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

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

Title VIII Provisions for Italian Territories Overseas

Art. 68-72. [Omitted]

Title IX General and Transitory Provisions

Chapter I General Provisions

Art. 73. [Repealed]

Art. 74.

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

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

Art. 75. [Repealed]

Art. 76.

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

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

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

Art. 77.

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

2. Where the appointment of one or more agents is not done by a separate

act, whether authentic or authenticated, it may be effected by a special letter of appointment, subject to payment of the prescribed fee.

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

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

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

Art. 78.

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

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

Art. 78bis.

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

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

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

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

Art. 78ter.

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

Art. 79.

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

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

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

Art. 80.

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

Chapter II Transitional and Final Provisions

Art. 81-86. [Omitted]

Art. 87.

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

Art. 88.

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

Art. 89.

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

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

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

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

Art. 90.

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

Art. 91.

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

Art. 92.

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

Art. 93.

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

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

Art. 94.

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

Art. 95.

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