



The new **trademark's**  
**invalidity and revocation**  
proceedings in Italy



**POLITECNICO**  
MILANO 1863

DIPARTIMENTO DI ENERGIA

## Comparison with EUIPO procedure: similarities and differences

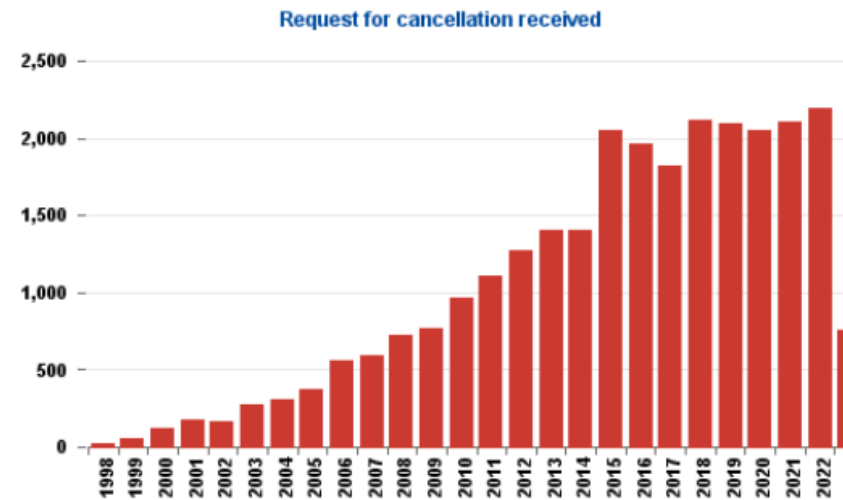
Giovanni F. **Casucci (EY)** & Emanuela **Bianco (SB)**

## 7. EUTM Cancellations

### 7.1. Cancellations

Anulaciones - Nichtigkeit - Cancellations - Annulations - Annullamenti

	Solicitudes de anulación recibidas Erhaltene Nichtigkeitsanmeldungen Requests for cancellation received Demande en nullité reçues Domande d'annullamento ricevute	Σ
1998	18	18
1999	58	76
2000	116	192
2001	172	364
2002	158	522
2003	274	796
2004	300	1,096
2005	370	1,466
2006	552	2,018
2007	594	2,612
2008	724	3,336
2009	763	4,099
2010	959	5,058
2011	1,101	6,159
2012	1,269	7,428
2013	1,401	8,829
2014	1,400	10,229
2015	2,052	12,281
2016	1,960	14,241
2017	1,820	16,061
2018	2,113	18,174
2019	2,098	20,272
2020	2,052	22,324
2021	2,100	24,424
2022	2,191	26,615
2023	751	27,366



## 7. EUTM Cancellations

### 7.2. Cancelled and surrendered

MARCAS DE LA UNIÓN EUROPEA OBJETO DE ANULACIÓN Y DE RENUNCIA

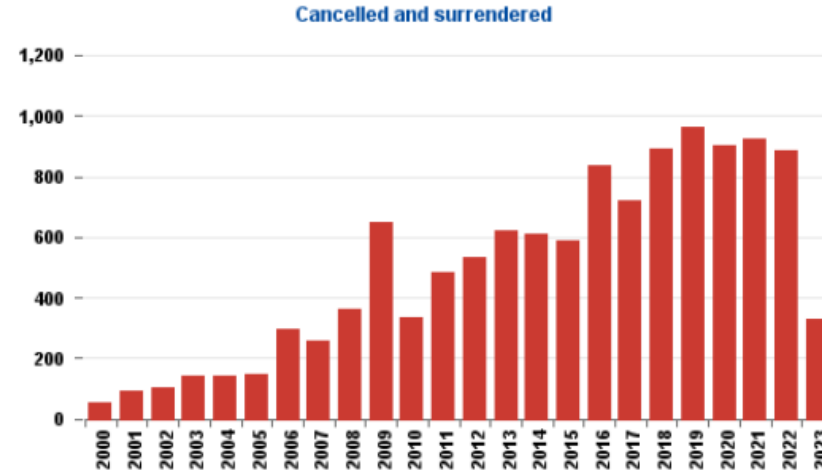
UNIONSMARKE, DIE FÜR NICHTIG ERKLÄRT WURDEN / AUF DIE VERZICHTET WURDE

EUROPEAN UNION TRADE MARKS CANCELLED AND SURRENDERED

MARQUES DE L' UNION EUROPÉENNE ANNULÉES OU AYANT FAIT L'OBJET D'UNE RENONCIATION

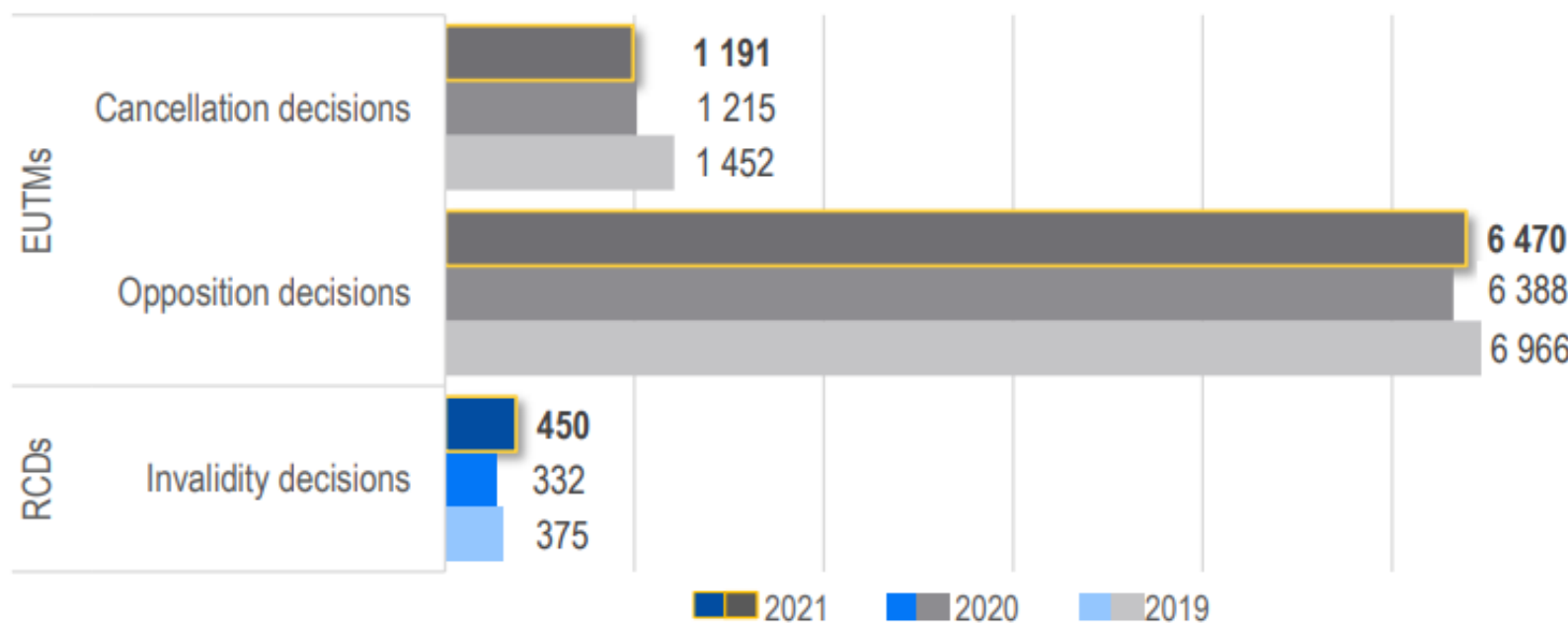
MARCHIO DELL'UNIONE EUROPEA DICHIARATO NULLO E RINUNCIA AL MARCHIO DELL'UNIONE EUROPEA

	Anulación y renuncia Die für nichtig erklärt wurden/auf die verzichtet wurde Cancelled and surrendered Annulées ou ayant fait l'objet d'une renonciation Nullo e rinuncia	Σ
2000	53	53
2001	93	146
2002	104	250
2003	143	393
2004	141	534
2005	147	681
2006	295	976
2007	259	1,235
2008	363	1,598
2009	647	2,245
2010	335	2,580
2011	486	3,066
2012	533	3,599
2013	624	4,223
2014	612	4,835
2015	586	5,421
2016	834	6,255
2017	723	6,978
2018	894	7,872
2019	965	8,837
2020	900	9,737
2021	925	10,662
2022	887	11,549
2023	332	11,881





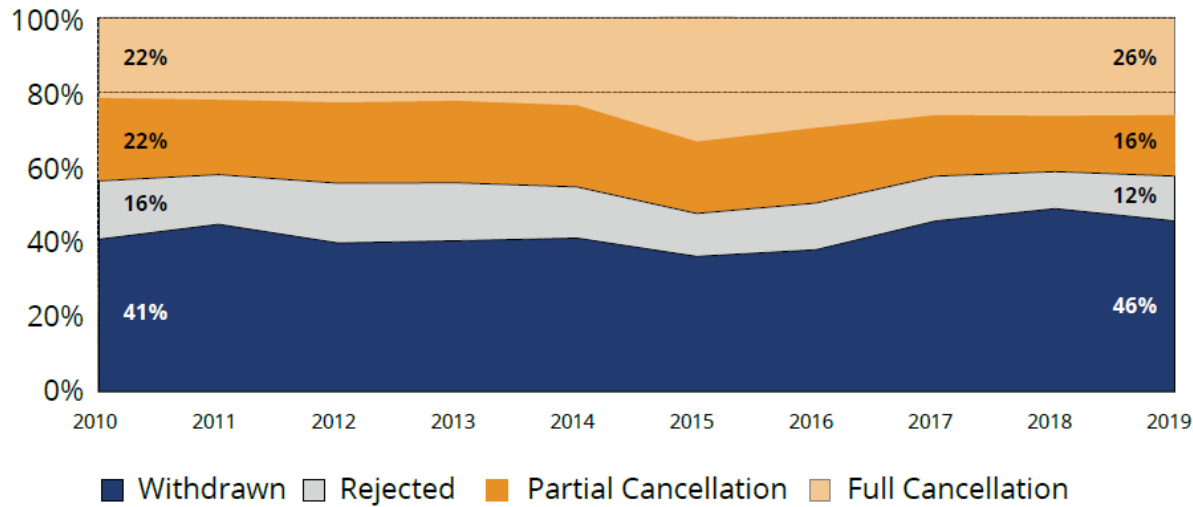
### EUTM (opposition & cancellation) & RCD (invalidity) decisions



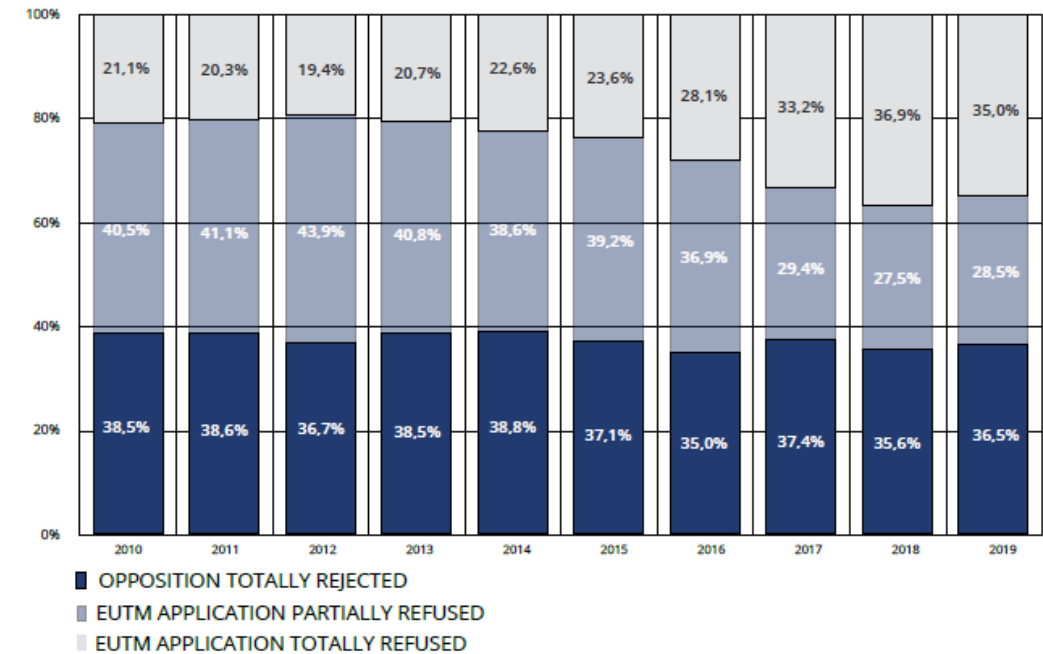
# Validity Issues

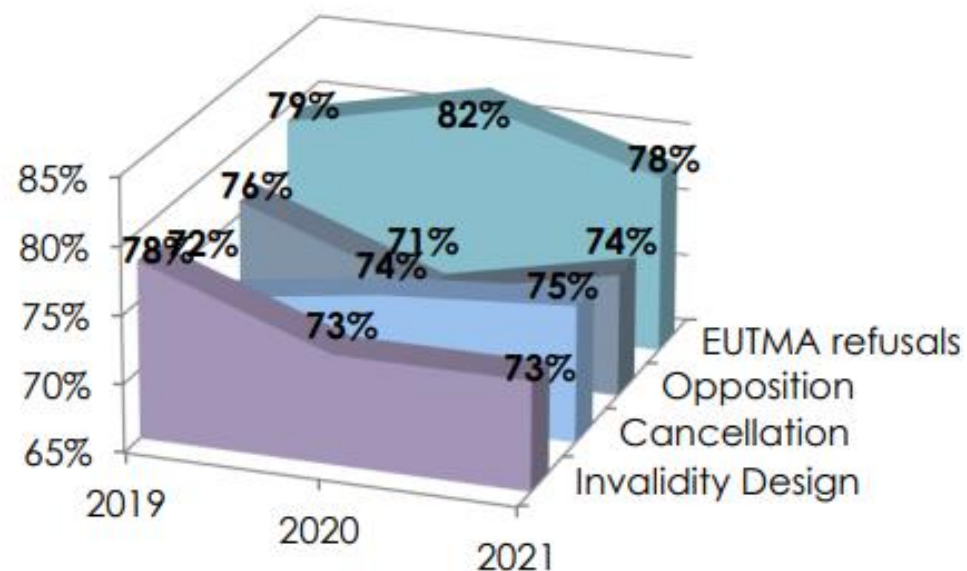


Types of Outcomes for Cancellation Filings



Opposition Division Decisions  
on Admissible Filings that reached the end of Adversarial Proceedings



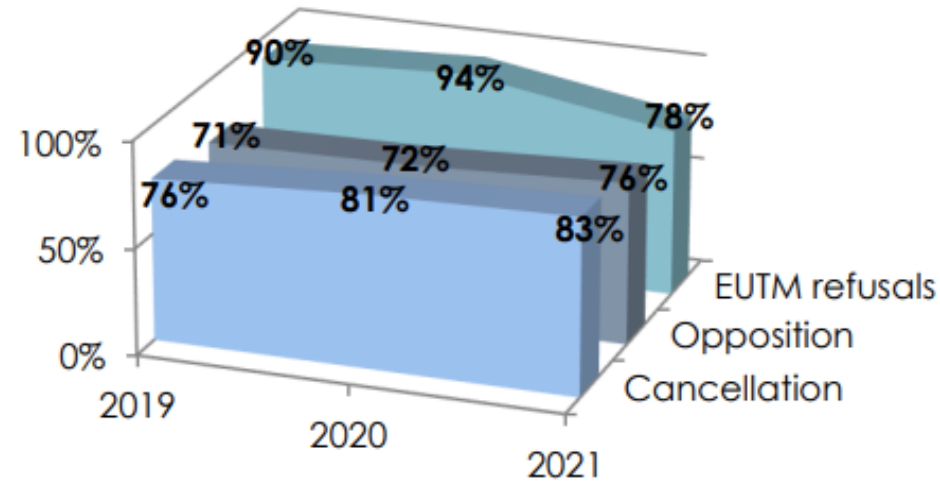


*Figure 9. Confirmation rate of first instance decisions*

### 3.2 Confirmation rates

The confirmation rates of first-instance decisions by the BoA are shown in Figure 9.

Particularly relevant is the positive evolution of cancellation cases, which increased from 72 % in 2019 to 75 % in 2021. The EUTM proceedings confirmation rate has slightly decreased from the previous year, whereas the confirmation rate for opposition decisions has increased, while for design invalidity decisions it has remained the same.



*Figure 10. Confirmation rate of BoA decisions by the General Court*

**The appeal rate increased from 2020 reaching 11.8 % in 2021.**

The confirmation rate for opposition decisions increased by 4 percentage points, while for EUTM refusals it decreased. For cancellations there was a slight increase of 2 percentage points.

In 2021, 369 new actions were brought before the EU Courts against the decisions of the BoA. In total, the Litigation Service dealt with 342 pending actions (as at 31/12/2021) before the EU Courts.

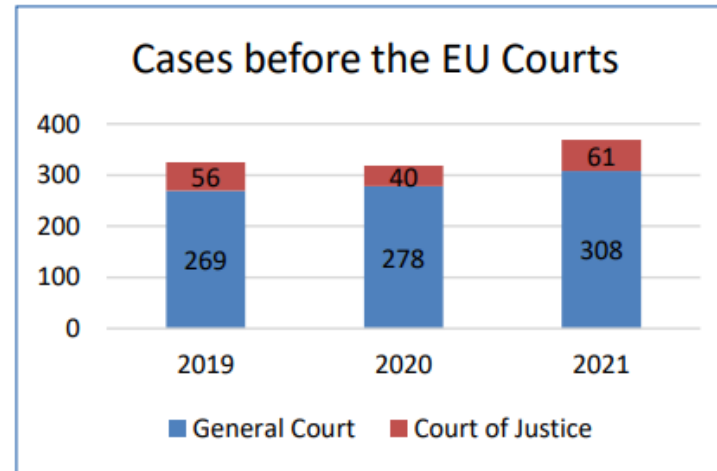


Figure 19. Cases before the EU Courts

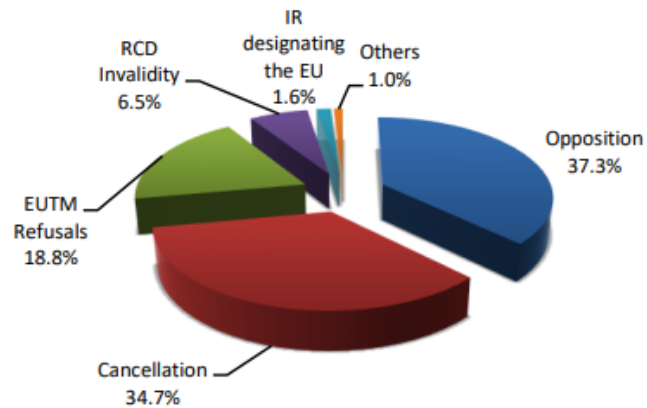


Figure 20. GC cases lodging ratio by type of first instance decision

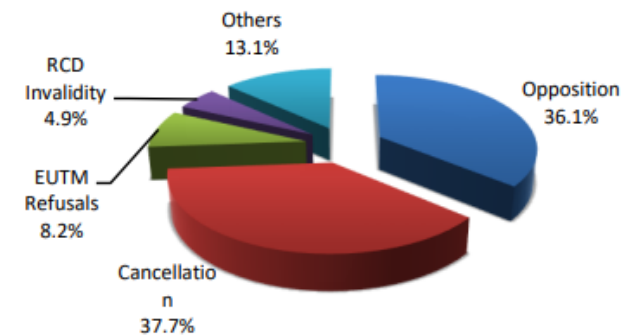
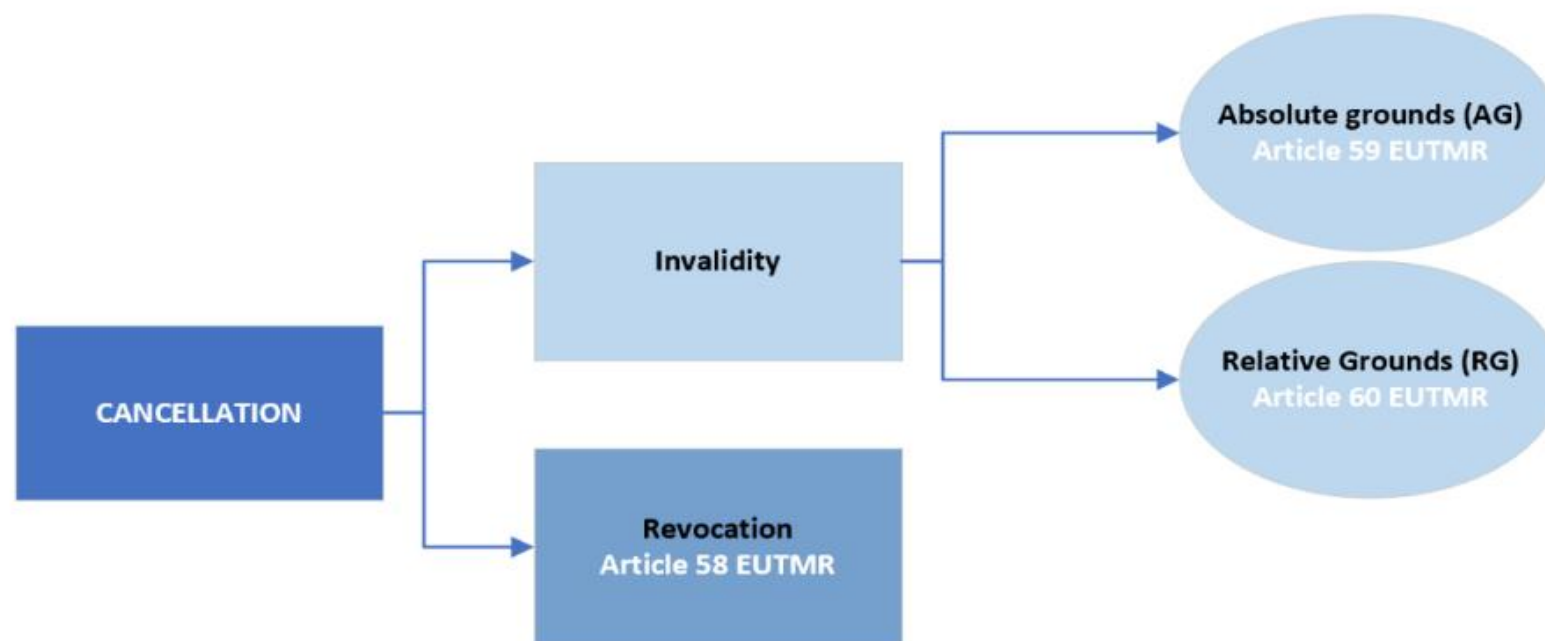


Figure 21. CJEU cases lodging ratio by type of first instance decision



# Invalidity and Revocation



## GROUNDINGS FOR REVOCATION(Art. 58 RMUE)

### Same grounds envisaged in the Italian Industrial Property Code art. 184bis (2)

- ▶ a) **Article 58(1)(a) EUTMR: NON-USE** for more than 5 years after registration > burden of proof solely on the holder of the contested EUTME (*art. 24 Italian I.P.C.*)
- ▶ [C-183/21, 10.03.2022, MAXXUS, 35-46] b) **Article 58(1)(b) EUTMR: EUTM becomes generic/common** name > burden of proof is on the applicant. (*art. 13 (4) Italian I.P.C.*)
- ▶ [C-409/12, KORNSPITZ; anche se in un solo SM, T-718/16, 08.11.2018, SPINNING]
- ▶ c) **Article 58(1)(c) EUTMR: EUTM is used in a deceptive way** and is liable to mislead the public. Burden of proof is on the applicant. (*art. 14 (2) Italian I.P.C.*)
- ▶ (C-259/04 ELIZABETH EMANUEL; T-306/20, 23.06.2022, LA IRLANDESA)

# Invalidity

- ▶ - Absolute Grounds: filed by **anybody**
- ▶ - Relative grounds: filed by **owners/licensees of earlier rights**
- ▶ - Filed at any time, but only against a registered EUTM/IR
- ▶ - One application based on several grounds for invalidity
- ▶ - Burden of proof on the invalidity > applicant
- ▶ - Effect of a successful declaration of invalidity:
  - the EUTM will be deemed not to have had effect **from the filing date**
- ▶ • Possible outcome: **assignment**

## Invalidity – Absolute grounds, Article 59(1) EUTMR

*Grounds envisaged in the Italian Industrial Property Code art. 184bis (3), lett. a)*

– **Article 59(1)(a) EUTMR:**

- EUTM registered in breach of Article 7 EUTMR (same grounds as for refusal in examination)
- [*Art. 13 (1), lett. a),b) and Art. 14 (1), lett. a),b) Italian I.P.C*]

– **Article 59(1)(b) EUTMR:**

- bad faith (the goal of the EUTM owner when applying for the trademark was not to protect its intellectual property, but to use the EUTM as a tool in pursuing illicit aims)

→ ***not envisaged by the Italian I.P.C.***

## Invalidity – Relative grounds, Article 60(1) EUTMR

*Grounds envisaged in the Italian Industrial Property Code art. 184bis (3), lett. b) Italian I.P.C.*

- EUTM registered contrary to **Article 8(1),(5) EUTMR**:
  - ▶ • Contested EUTM is identical to the earlier mark [\[Art. 12 \(1\), lett. c\)\]](#)
  - ▶ • Contested EUTM is similar to the earlier mark [\[Art. 12 \(1\), lett. d\)\]](#)
  - ▶ • Contested EUTM takes unfair advantage of the reputation of the earlier mark. [\[Art. 12 \(1\), lett. e\)\]](#)
- **Article 8(2)(c) EUTMR**: contested EUTM is identical or similar to the well-known mark [\[Art. 12 \(1\), lett. f\)\]](#)
- **Article 8(3) EUTMR**: contested EUTM filed by an agent of the applicant (without the proprietor's consent). [\[Art. 184bis \(3\), lett. c\)\]](#)
- **Article 8(4) EUTMR**: non-registered trademark (trade name, company name, or other) or sign was used in trade before the contested EUTM was filed → ***not envisaged by the Italian I.P.C.***

## Invalidity – Relative grounds, Article 60(2) EUTMR

- **Article 60(2) EUTMR** — EUTM registered contrary to other earlier rights:
  - ▶ • right to a name
  - ▶ • right of personal portrayal
  - ▶ • a copyright
  - ▶ • an industrial property right
  - ▶ • other earlier right
  - ▶ → ***not envisaged by the Italian I.P.C.***
- **Article 60(1)(d) EUTMR** — Basis for invalidity: protected designation of origin or geographical indication
  - → *envisaged by the Italian I.C.P. as an absolute ground art. 14 (1) lett. c bis, c ter, c quater, c quinquies)*

## Limitation in consequence of acquiescence

### - **Art. 61 EUTMR: PRECLUSION FOR TOLERANCE:**

- owner of a trademark/previous right, who for 5 consecutive years has acquiesced the use of the same or similar registered later trademark IS NOT ENTITLED TO apply for INVALIDITY based on lack of novelty

[T-77/15, 20.04.2016, *Sky Tec*, 33-44; T-150/17, 04.10.2018, *Flügel*, 31-50; C466/20, 19.05.2022, *Heitec*]

→ *Italian system Art. 28 I.P.C.*

+ *Supreme Court of Cassation no 7504 of 15/03/2023 (Rv. 667464 - 01)*

# Admissibility of the application

## **NON ADMISSIBLE IF:**

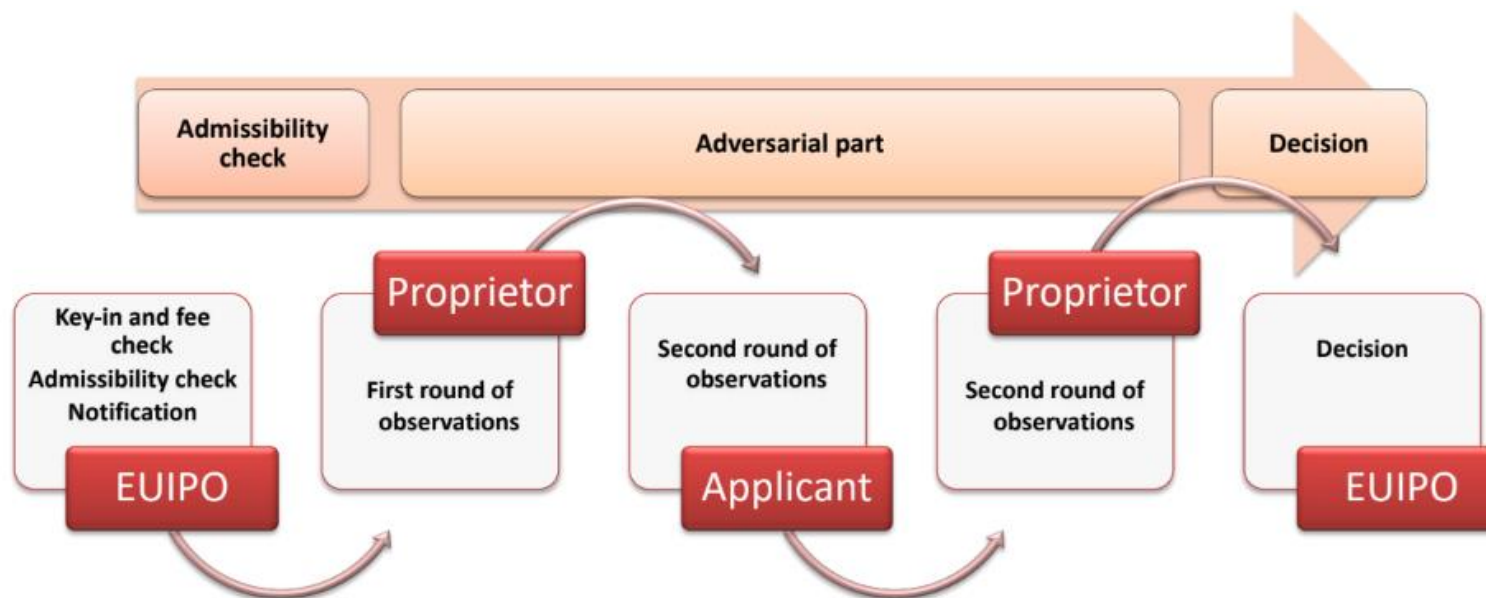
- **Art. 63(3) EUTMR (*Res Judicata*):** JUDGMENT TRIB. EU MARKS or earlier EUIPO DECISION OF CANCELLATION *res judicata* between same **parties/marks/motives** (revocation or invalidity) and adjudicated on the merits
  
- **Art. 60(4) EUTMR : PREVIOUS DEMAND FOR INVALIDITY** of the MUE (before EUIPO or counterclaim) by the **same holder** based on **another of the prior rights** that it could have asserted in support of the first claim (always inadmissible, regardless of the outcome: T-207/20, 15.09.2021, PALLADIUMHOTELS/GRAND HOTEL PALLADIUM, 43-45).



## ADMISSIBLE EVEN IF:

- - **PREVIOUS APPLICATION FOR INVALIDITY** of the EUTM (in EUIPO or counterclaim) by the same holder based on the same prior right **if not adjudicated on the merits** (withdrawn, declared inadmissible, etc., T-207/20, 15.09.2021, PALLADIUM HOTELS/GRAND HOTEL PALLADIUM, 46)
- - **PREVIOUS EUIPO OPPOSITION DECISION** (see *KINDERJOGHURT*, T-140/08 dated 14.10.2009; T-11/13, *MEGO*, 09/23/2014)
- → *pursuant to art. 184bis (9) I.P.C. this would not stricto jure cause the inadmissibility of the application, but with limitations*

# Development of the proceedings (ARTT. 12-19 RDMUE)



- Once the application for Invalidation has been found Admissible > NOTIFICATION

**!!! EUIPO cancellation system DOES NOT provide a cooling-off period**

[Besides, it is possible to request the suspension of the proceedings for negotiations: joint request, 6 months granted (up to a max of 2 years in total), see **art. 71 (2) EUTMDR**]

→ *Instead, the Italian system provides **faculty to reach a conciliation agreement within the period of two months**, commencing from the date of notice of the commencement of the proceedings, **extendable** several times upon joint application of the parties up to a maximum of one year a cooling off*

*[Art. 63quinquies I.C.P.]*

> The **proprietor** is invited to file observations within 2 months time limit → = *art 63quinquies I.P.C.*

>**ART 16 EUTMDR** - The **applicant** can present the facts, evidence and arguments in support of the application (and translations) with **no specific deadline, up to the closure of the adversarial part**

→ If the applicant does not submit the required facts, arguments or

evidence, the application may be rejected as unfounded

→ *the Italian system is front loaded - arguments in support of the application may be submitted within the application itself together with the grounds [Art. 63bis (2) lett. C]*



# INVALIDITY

REQUEST PROOF OF USE (Article 19(2) EUTMDR)

→ I.P.C. artt. 63quinquies (2) and 184quinquies

- proprietor requests proof of use of one or several earlier marks from the applicant;
- the request must be filed within the proprietor's first time limit (not admissible at a later stage);
- separate document;
- the earlier mark must have been registered for at least 5 years at the time of the filing of the invalidity request.



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DIPARTIMENTO DI ENERGIA

EU Case law → effective use was not recognized by the **Opposition Division**, but due to the filing of new supporting evidence in the 2<sup>nd</sup> instance it was recognized by the **BoA**:

> McDonald's v Supermac's, Case R0543/2019-4, EUIPO Board of Appeal (December 2022)

- **Opposition Division**: McDonald's fails to prove the use of its EUTM "BIG MAC"

→ REVOCATION

→ appeal

- **Board of appeal**: allowed new evidence and eventually recognized the effective use

→ Revocation eventually has been rejected

*Standard International Management v EUIPO Case T-768/20 EU General Court (July 2022):*

- **Opposition Division:** revoked a EUTM for non-use, due to the fact that the owner was a hotel physically located in the US

➤ → Revocation despite ample evidence of use → promotional campaigns/advertisements aimed at costumers in the EU

- **Bord of Appeal** : confirmed the Division Opposition decision

- **General Court:** overrules 1<sup>st</sup> and 2<sup>nd</sup> instance

> distinction between the place where these services were provided (here hotel services in the US) and the place where the trademark is used (the EU by way of advertising).



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Thanks for your attention!