



**POLITECNICO**  
MILANO 1863

DIPARTIMENTO DI ENERGIA

# Introduction to the new Italian administrative proceeding

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# Legal framework

## EU

- **Directive (EU) 2015/2436** (hereinafter “TMD”)

*«Without prejudice to the right of the parties to appeal to the courts, the MS shall provide an efficient and rapid administrative procedure for the revocation or declaration of invalidity of a TM to be carried out before their offices» ( art. 45)*

*« Member States shall bring into force the laws, regulations and administrative provisions to comply with Article 45 by 14 January 2023» ( art. 54)*

## IT

- Legislative decree February 20<sup>th</sup> 2019, n. 15 amended the **Industrial Property Code** ([Legislative decree February 10<sup>th</sup> 2005, n.30](#), hereinafter "CPI") introducing articles from **184-bis** to **184-decies**
- Decree July 19<sup>th</sup> 2022, n. 180 amended the **Regulation for the implementation of the CPI** ([Decree of January 13<sup>th</sup> 2010, n. 33](#), hereinafter "RACPI") introducing articles from **63-bis** to **63-terdecies**
- **Decree May 13<sup>th</sup> 2022** , regarding determination of application fees (500€)
- **Circular 622** of 12 December 2022 on filing application instructions

## Grounds for administrative « cancellation »

They are provided in article **184-bis CPI**:

- REVOCATION § (2)
- INVALIDITY § (3)

Provisions of article 5 (4) of the TMD – as well as other provisions of art. 24 (Revocation) and 25 (Invalidity) CPI - still remain protectable just before judicial authority, and particularly:

***(a) non-registered TM or to another sign used in the course of trade***

***(b) right to a name; a right of personal portrayal; a copyright; an industrial property right***

# «Absolute» grounds for **INVALIDITY**

*art. 184-bis § (3) a) CPI*

- **Signs lacking a distinctive character**, those consisting:
  - *only of signs that have become **commonly used in current language** or in the **common practice of trade** (art. **13** (1) b) CPI)*
  - ***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 good or the rendering of the service or the other characteristics of good or service. (art. **13** (1) a) CPI)*
  
- **Lawfulness and third-party rights:**
  - *Signs that are **contrary to the law, public policy or accepted principles of public morality** (art. **14, § 1, a)** CPI)*
  - ***Suitable for deceiving the public**, in particular on the geographical origin, on the nature or quality of the products or services, or on the type of TM (art. **14, § 1, b)** CPI)*

# «Absolute» grounds for INVALIDITY

*art. 184-bis (3) a) CPI*

## ○ Signs excluded from registration :

- *pursuant to EU legislation or the national law concerned, or to international agreements to which the EU or Italy is party, providing for protection of **designations of origin and geographical indications** (art. **14 (1) c-bis** CPI)*
- *pursuant to EU legislation or international agreements to which the EU is party, providing for protection of **traditional terms for wine** (art. **14 (1) c-ter** CPI)*
- *pursuant to EU legislation or international agreements to which the EU is party, providing for protection of **traditional specialities guaranteed** (art. **14 (1) c-quater** CPI)*
- *trade marks which consist of, or reproduce in their essential elements, an earlier **plant variety denomination registered** in accordance with EU legislation or the national law, or international agreements to which the UE or Italy is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species. (art. **14 (1) c-quinquies** CPI)*

## «Relative» grounds for INVALIDITY

*art. 184-bis (3) b) CPI*

- Signs excluded from registration, because :
  - they are **identical** to TM 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** (art. **12 (1) c)** CPI)
  - they are **identical or similar** to TM 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, if due to the identity or similarity between the signs and the **identity or similarities between the products 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 (art. **12 (1) d)** CPI)

## «Relative» grounds for INVALIDITY

*art. 184-bis (3) b) – c) CPI*

- Signs excluded from registration, because:
  - they are **identical or similar** to a TM 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 TM has a **reputation** in the EU, in case of a EU TM, or in the Country and were 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 TM (art. **12 (1) e**) CPI)
  - they are **identical or similar** to TM 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 lett. e) are present. (art. **12 (1) f**) CPI)
- an **agent or representative** of the proprietor of the trade mark applies for registration thereof in his own name **without** the proprietor's **authorisation**, unless the agent or representative justifies his action (art. **184-bis (3) c**) CPI)



# Grounds for REVOCATION

*art. 184-bis (2) CPI*

- A TM 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** (art. 13 (4) CPI)
  - if it has become **suitable to mislead the public**, in particular as to the nature, quality or origin of the products 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 (art. 14, (2) a) CPI)
  - if it is **not used** effectively by the owner or with his consent, for the goods or 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 (art. 24 (1) CPI)

# Content of the application

Art. 184-bis (4) CPI

The application:

- may concern **one TM registration only**
- may contain **revocation or invalidity grounds**, but not both in the same instance
- it is admissible if drafted in **Italian**
- and contains under penalty of inadmissibility:
  - a) in relation to the TM for which the declaration of revocation or invalidity is requested, the **identification of the owner, the number and date of registration**;
  - b) in relation to the **applicant's right, when this right is a requirement of** active legitimation pursuant to article 184-ter, the identification of the brand, the denomination of origin, the geographical indication, the traditional term for wine, the guaranteed traditional specialty of the variety denomination plant or other prior exclusive right;
  - c) the **reasons** on which the application is based

# Content of the application

Article 184-bis (4) CPI

The application for revocation or invalidity also contains:

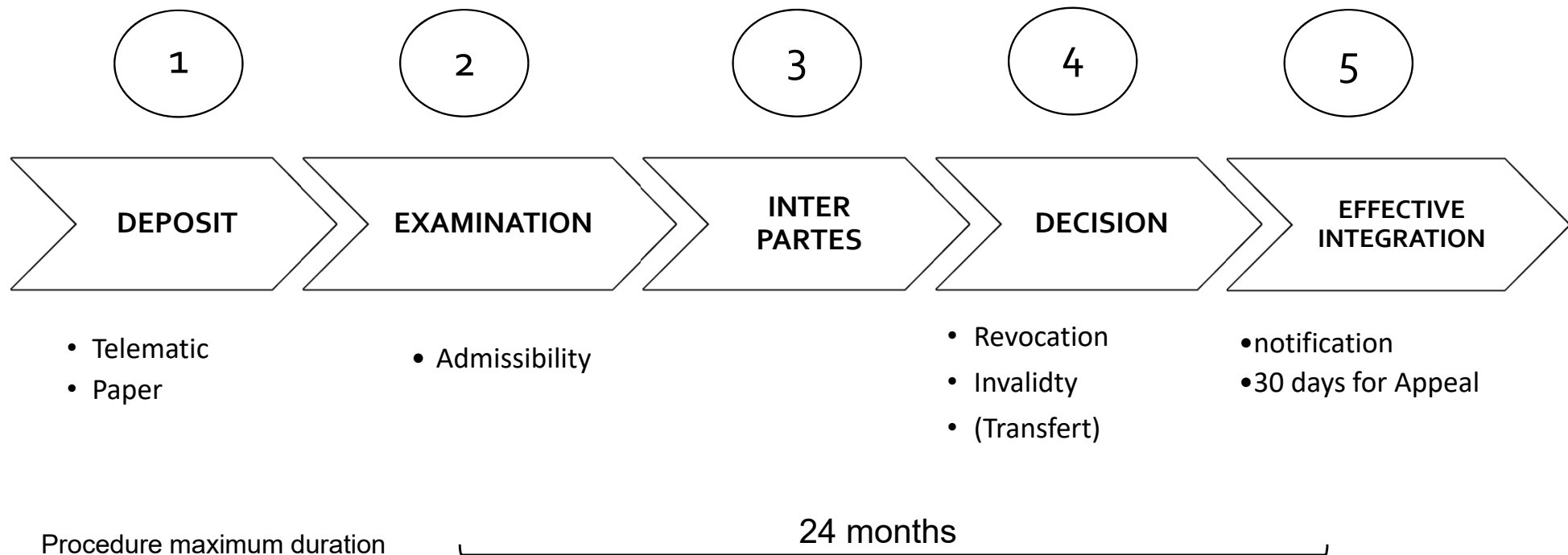
- the n relation to the TM for which the declaration of revocation or invalidity is requested, the **indication of the products and services** against which it is the application for revocation or invalidity has been proposed; in the absence of this indication, the application is considered directed against all the products or services covered by the contested TM.
- it is considered **withdrawn if the payment of the deposit fees** is not proven (€ 500, ex DM or 2 April 2007 ) + any **default fee** if late, except for the postponement of the filing date
- Attached to the application are: (the deposit reserve is not permitted!)
  - a) the **documents proving** the alleged facts;
  - b) documentation aimed at demonstrating **legitimacy** , where necessary;
  - c) the deed of appointment, if any, if an agent has been appointed.

# Legitimated

*art. 184-ter CPI*

- a) in cases of **revocation or «absolute» invalidity: any interested party** (§ 2 and 3, a), 184-bis));
- b) in the case of **«relative» invalidity**, the owner of an earlier TM or the person authorized by law to exercise the rights conferred by a designation of origin or a protected geographical indication (§ 3, b), 184-bis CPI);
- c) in the case of a **TM filed by an agent or representative** without the owner's consent, the interested TM owner (referred to in § 3, c), art. 184-bis CPI)

## PROCEDURAL STAGES



# DEPOSIT: Paper



## Istanze

## Seguiti vari

## Trascrizioni

## Ricorso

## Multiplo (Ritiro e altre istanze)

## Opposizione

## Marchio internazionale depositato in Italia

## Decadenza marchio

## Nullità marchio

## Decadenza marchio

### Decadenza marchio

#### ALLEGATI

- ISTRUZIONI DECADENZA.pdf
- Decadenza\_ \_MODULO.PDF
- Decadenza\_ Foglio Aggiuntivo -A.pdf
- Decadenza\_ Foglio Aggiuntivo -C.pdf

## Nullità marchio

### Nullità marchio

#### ALLEGATI

- ISTRUZIONI NULLITA.pdf
- Nullita\_ MODULO.pdf
- Nullita\_ FoglioAggiuntivo\_ A.pdf
- Nullita\_ FoglioAggiuntivo\_ C.pdf
- Nullita\_ FoglioAggiuntivo\_ E1.pdf
- Nullita\_ FoglioAggiuntivo\_ E2.pdf
- Nullita\_ FoglioAggiuntivo\_ E3.pdf

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Ministero delle Imprese e del Made in Italy MIMIT-DGTPI-UIBM

Ministero delle Imprese e del Made in Italy  
MIMIT-DGTPI- Ufficio Italiano Brevetti e Marchi

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I servizi esposti nell'area riservata sono disponibili nei giorni feriali dalle ore 08:00 alle ore 19:00.

Si avvisa la gentile utenza che, dal 2 Novembre 2021 in ottemperanza a quanto previsto dall'articolo 24 del decreto-legge 16 luglio 2020, n. 76, convertito, con modificazioni, dalla legge 11 settembre 2020, n. 120, l'accesso al portale UIBM sarà consentito, per tutti i cittadini residenti in Italia, esclusivamente tramite modalità di autenticazione basata su SPID. Successivamente sarà possibile accedere anche tramite CNS e CIE. Quest'ultima modalità di accesso consentirà di usufruire del servizio anche a tutti i cittadini dell'Unione Europea. Solo agli utenti UE non italiani (fintanto che non sarà operativo l'accesso tramite CIE) ed a quelli extra UE continuerà ad essere consentito l'accesso al portale tramite le tradizionali credenziali (username e password) già in loro possesso, ovvero di creare delle nuove.

Tali nuove modalità di accesso riguarderanno anche gli utenti abituati fino ad oggi ad accedere con le cosiddette 'utenze di secondo livello'. Affinché tali utenti continuino ad accedere con tale profilo, e quindi a poter depositare per conto dell'operatore di primo livello, è necessario che quest'ultimo ne comunichi le generalità tramite l'apposita funzionalità del portale prevista per la gestione del proprio profilo utente.

Al riguardo, il portale UIBM invierà una mail di remind a tutti gli operatori di primo livello collegati ad operatori di secondo livello per ricordare loro di effettuare tale necessaria operazione.

Con l'occasione, si comunica che il portale si avvarrà anche di alcuni servizi aggiuntivi di autenticazione forniti da Infocamere, finalizzati a:

1. identificare le società per le quali l'utente risulta, da visura camerale, rappresentante legale di impresa, o sia in possesso di una procura, e pertanto abilitato a depositare con il profilo di 'delegato' per conto di tali società;
2. verificare l'effettiva iscrizione all'albo italiano degli avvocati qualora l'utente intenda depositare con il profilo di 'rappresentante'

**Servizi**  
Principali servizi telematici offerti dal portale:  
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- Deposito telematico delle domande di registrazione di disegni e modelli e di marchi di impresa (ivi inclusa la c.d. procedura fast track e di rinnovo dei marchi), e delle istanze ad esse connesse;  
- Deposito della dichiarazione preventiva per l'esercizio temporaneo in Italia della professione di Consulente in proprietà industriale.

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Ministero delle Imprese e del Made in Italy  
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ACCEDI CON NOME UTENTE E PASSWORD

User Name

Password

Ricorda il mio username

ACCEDI

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# Examination: admissibility requirements

Art. 63-quater RACPI

1. Verified the payment of the **application fee**, the Office proceeds to examine the admissibility of the application pursuant to articles 148, § 1, and 184-bis CPI.

If the payment of the filing fee is omitted or irregular, the Office invites the applicant to regularize it, subject to a default fee in the event of late payment, within the term of two months.

- If the applicant makes or regularizes the payment, the Office recognizes the date on which the regularization was made as the **date of filing of the application for revocation or invalidity**.
- If the applicant does not comply within the deadline, the application is considered **withdrawn**.

2. The application is **inadmissible** if:

- a) the applicant or his representative are **unidentifiable** or **unreachable** pursuant to art. 148, § 1 CPI;
- b) **it is not drawn up by filling in the form** prepared by the Office in **Italian** and in this case the simultaneous translation is not filed pursuant to article 6.



# Procedural examination: admissibility

Art. 63-quater RACPI

3. The application is **inadmissible** if:

- a) it is directed against a **registration that does not exist or is no longer valid** on the date of submission;
- b) it **does not contain the identification of the disputed TM** and its **owner** (ex art 63-bis (2));
- c) it **does not contain or assert reasons** for revocation or invalidity **other than those provided for by art. 184-bis (2) (3) CPI**;
- d) it is based on an earlier right and **does not contain the identification of the right** (ex art 63-bis (3) or this right is not earlier);

- e) the **applicant is not legitimized** pursuant to art. 184-ter (1) b) and c) CPI;
- f) is based on non-use, pursuant to article 24 CPI, of a TM which, at the date of the application, has been registered for **less than five years**;
- g) it was **filed by an agent and the proxy was not filed mean time**;
- h) it is **not signed** by the applicant or his agent is omitted.

# Procedural examination: admissibility

Art. 63-quater RACPI

4. The application is also inadmissible if it is **directed against a plurality of registrations** or if it **simultaneously asserts reasons for revocation and invalidity** and, following the request of the Office to limit the object of the application within the peremptory term of thirty days from the date of receipt of the communication, the applicant does not accept the invitation.

## Relationship with legal action

*art. 184-bis (1) CPI*

- **Without prejudice to the proposition of the action before the judicial authority** pursuant to article 120 CPI, the persons entitled pursuant to art. 184-ter can submit a **written and motivated request** to the UIBM for a revocation or a invalidity of a registered TM.

*«1. The actions concernig 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 invalidity or for infringement is brought when the right has not yet been granted, the judgment may be issued only after the Italian Patent and TM Office has acted on the application, examining it prior to applications filed in earlier date. The Court, taking into account the circumstances, shall orders the suspension of the trial, for one or more times, and in the same order set the hearing in which the trial is to continue»***

*art. 120 CPI*

## Prejudicial administrative/judicial action

<p style="text-align: center;"><b>Art. 122 CPI</b> <b>Administrative action in civil proceedings</b></p>	<p style="text-align: center;"><b>Art. 184-bis CPI</b> <b>Judicial action in the administrative procedure</b></p>
<p><b>4-bis.</b> The action of invalidity or revocation of a registered TM <b><u>cannot be prosecuted if, on an application with the same object, the same constituent facts and between the same parties,</u></b> a <b>decision</b> has been pronounced by the UIBM pursuant to article 184-quater or <b>a proceeding is pending</b> before the UIBM, pursuant to article 184-bis.</p> <p><b>4-ter.</b> Apart from the case referred to in paragraph 4-bis, if the action for the invalidity or revocation of a registered TM is exercised pending an administrative proceeding, connected <b>by its object</b> , the judge <b><u>may suspend</u></b> the relative process. The part who is interested in it must request the setting of the new hearing within the peremptory term of three months from the definition of the connected administrative procedure, pursuant to article 297, third paragraph of the code of civil procedure.</p>	<p><b>9.</b> The application for revocation or invalidity <b><u>cannot be proceeded if, on an application with the same object, the same constituent facts and between the same parties, a decision</u></b> has been pronounced or a proceeding is <b>pending</b> before the UIBM or the judicial authority pursuant to article 122.</p> <p><b>10.</b> Except for the case referred to in paragraph 9, if an application for revocation or invalidity is presented to the UIBM pending a proceeding, administrative or judicial, <b>related to the subject</b> , the processing of the application <b>may be suspended</b> until that the pending proceeding is defined with an unquestionable administrative provision or with a sentence passed in thing judged.</p>

## *Inter partes phase*

Art. 184-quarter CPI

1. If the application for revocation or invalidity is admissible, the Office
  - **send a communication to the parties**
    - informing them of the beginning of interpartes phase
    - advising them of the **right to reach a conciliation agreement** within the term of **two months**, starting from the date of communication of the start of the procedure, which can be extended several times on joint request of the parties up to one year (63-quinquies RACPI)
    - In the absence of a conciliation agreement, the TM owner is assigned a further **term of 60 days to file observations** and any request for proof of use.
  - **The observations filed by the parties are communicated to the other party by the Office**

# Decision

Art 184-quarter CPI

5. At the end of the procedure, the Office issues a decision which:

- in **total acceptance** of the application, ascertains the revocation or declares the invalidity of the TM registration (all products or services);
- in **partial acceptance/rejection** of the application, ascertain the revocation or declare the invalidity of the TM registration (part of the products or services);
- **Rejects** the application for invalidity or revocation;
- in the event of an application presented by the agent or representative without the consent of the owner or a justified reason, if requested, orders the **transfer of ownership** in favor of the owner
- **charges the losing party with the reimbursement of expenses in favor of the other party** and **liquidates the amount** together with the expenses of professional representation in the proceeding, to the maximum extent of 600 €.

# Effects of the decision

Art 184-sexies CPI

1. The revocation or invalidity of a TM registration is **effective *erga omnes*** when it is declared by a provision of the UIBM **which has become indisputable**.
2. The **revocation** takes effect **from the date of filing the application or, upon request of the applicant, from a previous date (*ex nunc*)**.
3. The **invalidity** of the registration of a trade mark takes effect **from the date of registration (*ex tunc*)**.

# Suspension

art. 184-septies CPI

In addition to the art. 184-bis (10) (connection by object), the proceeding is suspended:

- a) if the application for invalidity is based on a **previous application for registration of a TM or GIs**, until a measure is adopted on these applications incontrovertible;
- b) if the application for invalidity is based on an **international TM**, until the time limits for refusing or filing an opposition against the registration of that TM have expired;
- c) if the application for invalidity is based on an **international TM** and the relative examination or opposition proceedings have been concluded;
- d) at the request of the owner of the later TM, if a **judgment of invalidity or revocation of the earlier TM** on which the request for invalidity is based or relating to the entitlement to registration is pending, until the decision becomes final;
- e) at the request of the owner of the later **TM**, if a proceeding for the invalidity or revocation of the earlier TM on which the application is based or relating to the entitlement to the right of registration is pending **before the UIBM**, until the relative provision is incontrovertible;
- f) at the request of the owner of the later TM, if a **procedure for the cancellation of the GIs** on which the request for invalidity is based is pending, up to the term in which the decision of the EC becomes incontrovertible;
- g) in the **other cases** envisaged by the implementing regulation of this code.



# Suspension

art. 63-octies CPI

- a) **during the period** granted to the parties to reach a **conciliation agreement**, pursuant to article *63-quinquies* (1);
- b) upon joint request of the parties, at each stage of the proceeding, up to a maximum of **twenty-four months**;
- c) at the request of the owner of the disputed TM, if **proceedings for the revocation or invalidity of the EU TM on which the application is based are pending before the EUIPO**, until the relative provision is unchallengeable;
- d) in the case of **transfer** of the earlier TM on which the application for invalidity is based, until the expiry of the term of sixty days assigned by the Office to the successor in right to provide proof of the transfer;
- e) if the **owner of the disputed TM is deceased or has lost the ability to act or is subjected to judicial liquidation proceedings** or when a sentence declaring the state of insolvency has emerged against him;
- f) in the event of **the death of the representative** of the owner of the disputed TM or in the event of the supervening impossibility of representing him.

# Extinction

Art. 184-octies

1. The revocation or invalidity procedure ends:
  - a) if the **brand on which the application is based** has been declared **null or void with a final judgment or with an indisputable provision**;
  - b) if the **waiver of the application for revocation or invalidity is accepted** , without reservations or conditions, by the established parties who may have an interest in the prosecution;
  - c) if the **application or registration** , which is the subject of the application for revocation or invalidity, is **withdrawn or rejected with an indisputable provision** for the products and services in question;
  - d) if no **request for continuation is presented** in the cases referred to in article 184-bis, paragraph 10, last sentence, and referred to in article 184-septies, paragraph 2, second sentence;
  - e) if the **application for protection of the designation of origin or geographical indication** on which the application for invalidity is based is **withdrawn or rejected** ;
  - f) if the **protected designation of origin or protected geographical indication or traditional specialty guaranteed** , on which the application for invalidity is based, is **cancelled** ;
  - g) if there is **no interest in acting**.

# Termination and renunciation

Art. 63-undecies RACPI

2. the total or partial **renunciation of a TM subject to revocation or invalidity proceedings is sent by the Office to the counterparty** with an invitation to notify the Office of any acceptance within the term of **thirty days** .

3. The communication of **acceptance is noted in the register** and produces the **effects of withdrawing the application for revocation or invalidity** .

revocation procedure , if no communication pursuant to paragraph 2 takes place, the **effects** of the deed of renunciation remain **suspended** and the revocation **procedure continues** .

invalidity proceeding , if there is no communication pursuant to paragraph 2 or if the applicant does not show a specific interest in continuing the proceeding, the **renunciation is noted in the register and the invalidity proceeding is extinguished** pursuant to article 184-octies, paragraph 1, letter g) of the Code, limited to products or services not renounced, in case of partial renouncement



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Thanks for your attention!

Avv. Enrico Maccallini