



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



**POLITECNICO**  
MILANO 1863

DIPARTIMENTO DI ENERGIA

# Relations with judicial proceedings strengths and weakness



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## Whereas 31 Directive CE 2436/2015

(31) Trade marks fulfil their purpose of distinguishing goods or services and allowing consumers **to make informed choices only** when **they are actually used on the market**. A requirement of use is also necessary in order **to reduce the total number of trade marks registered** and protected in the **Union and, consequently, the number of conflicts which arise between them**. It is therefore essential to require that registered trade marks actually be used in connection with the goods or services for which they are registered, or, if not used in that connection within five years of the date of the completion of the registration procedure, be liable to be revoked.

## **EFFECTS** **of** **A Revocation / Nullity**

- 1) The impossibility to invoke any entitlement to prevent third parties from using the same sign, but
- 2) Does not impede the use of the same sign from the previous owner, with the sole exception of:

**Art. 21.3 It IPcode** It is **prohibited** for any person to make use of a registered trade mark after its registration has been declared invalid, when the ground for invalidity entails the unlawfulness of the use of the trade mark  
i.e.

**Art. 14.1 It IPcode**

- (a) signs contrary to law, public order or morality;
- (b) signs which are likely to deceive the public, in particular as to the geographical origin, nature or quality of the goods or services, or as to the type of mark;

[see art. 7.1 f\) - g\) of the TM Regulation and 4.1 f\) - g\) of the TM Directive\)](#)

[but no use prohibition effect](#)

**REASONS**  
for  
an action on  
Revocation / Nullity

- 1) Prevent a possible future conflict**
  - eliminate registered third-party trademark
  - eliminate of a not-in-use trademark

aim: use / registration of an identical or similar sign
  
- 2) Challenge the ground of an announced conflict**
  - warning letter received
  - customs intervention on EU suspension














aim: use of an identical or similar sign
  
- 3) React to / Manage a conflict already pending**
  - infringement action started

aim: use of an identical or similar sign

  - “legal fake” defense

aim: enforce prior rights against an identical or similar registered trademark

# Main Factors

	Administrative	Judicial (ordinary)	Judicial (urgent)
Costs		  	 
Time	 	   	

**Art. 128.2** An EU trade mark court **shall reject** a counterclaim for revocation or for a declaration of invalidity if a decision taken by the Office relating to the same subject matter and cause of action and involving the same parties has already become final.

**Art. 128.24 [...]** If an application for revocation or for a declaration of invalidity of the EU trade mark had already been filed before the Office before the counterclaim was filed, the court shall be informed thereof by the Office and stay the proceedings in accordance with Article 132(1) until the decision on the application is final or the application is withdrawn.

**Art. 128.7** The EU trade mark court hearing a **counterclaim** for revocation or for a declaration of invalidity **may stay** the proceedings on application by the proprietor of the EU trade mark and after hearing the other parties **and may request the defendant to submit an application for revocation or for a declaration of invalidity to the Office** within a time limit which it shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 132(3) shall apply.

It IP Code  
**Art. 122**

**4-bis.** An action for a declaration of invalidity or revocation of a registered trade mark shall be barred [before IP Court] where, on an application with the same subject-matter, the same constituent facts and between the same parties, a decision has been handed down by the Italian Patent and Trade Mark Office within the meaning of Article 184-quater or proceedings are pending before the Italian Patent and Trade Mark Office within the meaning of Article 184-bis

It IP Code  
**Art. 184 bis**

**9.** An application for revocation or declaration of invalidity [before UIBM] is inadmissible if on an application having the same subject-matter, the same facts and between the same parties, a decision has been given or proceedings are pending before the proceedings before the Italian Patent and Trademark Office or the court seised pursuant to Article 122.

## **PREFERRED OPTION**

### **for an action on Revocation / Nullity**

#### **1) Prevent a possible future conflict**

- eliminate registered third-party trademark
- eliminate of a not-in-use trademark

aim: use / registration of an identical or similar sign

**Administrative**

#### **2) Challenge the ground of an announced conflict**

- warning letter received
- customs intervention on EU suspension

aim: use of an identical or similar sign

**Administrative**

#### **3) React to / Manage a conflict already pending**

- infringement action started

aim: use of an identical or similar sign

- “legal fake” defense

aim: enforce prior rights against an identical or similar registered trademark

**Judicial**





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Thanks for your attention!



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