



Fresh amendments to the Italian Industrial Property Code. “Trademarks Package” and “Unitary Patent Package” implemented

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📖 INTELLECTUAL PROPERTY

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The Italian Industrial Property Code (Legislative Decree no. 30/2005, IPC) again gets updated, to incorporate significant amendments on both trademarks and patents, introduced by two recent Legislative Decrees.

Legislative Decree no. 15 of 20 February 2019, which implements Directive (EU) 2015/2436 on the approximation of Member States' laws relating to trademarks, and adapts national legislation to Regulation (EU) 2015/2424 amending the 2009 Regulation on the Community trademark (so-called “Trademarks Package”). It entered into force on March 23, 2019.

Legislative Decree no. 18 of 19 February 2019, to adapt national legislation to the provisions on European

patent with unitary effect, in particular the Unitary Patent Regulation (Regulation (EU) no. 1257/2012) and the EU Agreement on a Unified Patent Court (UPC Agreement) ratified by Italy with Law no. 214 of 3 November 2016 (so-called “Unitary Patent Package”). It entered into force on March 27, 2019.

Trademarks Package

Among the main changes on trademarks, we highlight the following:

- repeal of the graphic representation requirement for registration;
- as to shape trademarks, ban on registering a sign consisting exclusively (not only of a shape, but also) of another “characteristic” resulting from the nature of the goods, or necessary to obtain a technical result, or giving substantial value to the goods themselves;



- introduction of certification marks;
- new grounds for refusal of registration, e.g. in case of conflict with geographical indications;
- enhancement in the protection of well-known trademarks, in particular by extending the scope of infringement to uses that do not have a distinctive purpose;
- further grounds for opposition against trademark registration, e.g. where the opponent's prior mark enjoys reputation;
- prohibition of preparatory acts for counterfeiting;
- specific provision on the locus standi of the licensee to bring infringement action;
- introduction of proceedings for trademark nullity or revocation at administrative level, before the IPTO (besides in the Courts);
- seizure at the border of counterfeit products in mere transit within EU territory.

Unitary Patent Package

Otherwise than the ordinary European patent, which constitutes a bundle of national patents having effect in the States designated by the applicant, the European patent with unitary effect (unitary patent), which is granted through a single centralized procedure before the European Patent Office, will provide uniform protection in all 26 EU Member States participating in the new system.

The new system has not become operative yet, because its entry into force is subject to the ratification of the UPC Agreement by Germany, currently on hold until adjudication of the on-going proceedings before the Federal Constitutional Court. Meanwhile, Italy gets ready by including in the IPC new provisions specifically dedicated to the European patent with unitary effect.

Among the main changes, the following are worth mentioning.

- Equivalence in effects between European patent with unitary effect and classic European patent validated in Italy.

- A safeguard mechanism, to handle possible consequences of the overlap between proceedings before the EPO for the grant of either breed of patent. In particular, in case of an application for unitary effect of a European patent has been filed before the EPO, the three-months term for submitting the translation of the patent documentation to the IPTO (to be complied with in order for the European patent to take effect in Italy) does not run from the notice of grant by the EPO, but rather from the date when the final act of rejection or revocation of the unitary effect is received or when the EPO receives the application for withdrawal. The purpose of the Italian legislator is to prevent that, while the EPO decision on the application for unitary effect is pending, the patent holder becomes foreclosed from validating its European patent in Italy.
- New limitations to patent rights are introduced, in line with the provisions of the UPC Agreement.
- A transitional regime for domestic judicial proceedings on the national portion of a European patent (considering that the UPC Agreement establishes a system of supranational Courts endowed with exclusive jurisdiction on litigation concerning European patents with unitary effect as well as ordinary European patents). Said proceedings will be adjudged pursuant to Italian law, if they are pending until the date when the UPC Agreement enters into force or are initiated thereafter during the transitional period provided by the UPC Agreement itself.

It remains to be seen how businesses, and stakeholders in general, will concretely utilize the new tools offered by the implementation of the packages. Among others, a particularly interesting question is to what extent, thanks to the repeal of the graphic representation requirement, the registration of non-traditional marks (such as sound and smell trademarks) will actually take off.





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