

Protection of IP

Italy

I. TRADE MARKS**I.1 INTRODUCTION**

The Italian government has reorganised its IP laws by enacting the legislative decree number 30, on 10 February 2005, which simplified the laws governing IP and coordinated the Italian domestic laws with both EU and International laws on IP. The Intellectual Property Code in particular was structured using the TRIPs agreement as a model.

The Code is all-inclusive in so far as it governs under one text most of the existing IP rights: patents, trade marks, distinctive signs (different from trade marks), domain names, design rights, utility models, trade secrets, plant breeders' rights, semiconductor topographies, geographical indications, and denominations of origin (with the exclusion of copyright).

I.2 REGISTERED TRADE MARKS

In Italy, registrable trade marks are signs (i.e. words, devices or shapes) which are capable of being graphically represented and which fulfil the requirements of novelty, distinctiveness and lawfulness. Graphically represented sounds, colour combinations or a particular shade of color are also registrable. Some types of terms are not registrable as trade marks, such as those deemed to be generic, those containing false indications of quality or origin of goods, and those with similar terms which are already registered or for which applications are pending. In respect of some goods, geographic names may not be used in the trade mark nor can the portraits of persons be registered without their consent.

Trade mark applications are examined to ensure their format is acceptable. If an application is in order, the mark will be registered. There is no opportunity for opposition and the first applicant is entitled to registration. However, any other person who claims to be the first user of the mark in Italy can have the prior registration cancelled, provided the claim is proven. However, no claim of prior use can be made after the mark has been registered for 5 years.

Trade marks are valid for 10 years from the filing date and can be renewed for subsequent 10-year periods. Lack of use in the 5 years following its registration can cause a trade mark to lapse. Trade marks may be assigned to other users provided such action does not involve deceptive trade practices.

I.3 UNREGISTERED TRADE MARKS

An unregistered mark which is not well known or is known only locally may continue to be used locally despite subsequent registration by third parties. Local use does not affect novelty as far as subsequent trade mark registration by a third party is concerned. Conversely, an unregistered mark used widely and known at a national level enjoys exclusive rights which may be enforced pursuant to the provisions against unfair competition.

Trade mark owners may apply for injunctive relief to protect their rights against infringers. Even before the case is heard in court, the rights holder may request the judge to grant an inhibitory order, ie an order to cease the allegedly infringing activity and/or leave to seize the allegedly infringing items.

2. PATENTS

2.1 INTRODUCTION

In Italy, a patent covers a new product or process in any field of technology, with the exclusion of therapeutic methods for the treatment of humans or animals, new animal and plant varieties or biological methods for the production of plants or animals.

To be patentable, an invention must be new (ie it must not have been available to the public anywhere else before the date of filing), involve an inventive step and have an industrial application.

As the invention must be novel, any disclosure of the invention before the filing date of the patent application or before the priority date can render the patent null.

The Italian Patent and Trade Mark Office carries out no prior art search, but only classifies the invention upon grant according to the International Patent Classification system. Since there is no prior art search involved, the Examiner will only detect blatantly obvious inventions.

Patents for inventions are currently granted about 2 to 3 years after the filing date. Patents for utility models are granted about 5 years after the filing date.

Patents are granted for 20 years from the effective filing date of application. They can be assigned and transferred. A patent can be subject to compulsory licensing if not used within 3 years from the date of grant or 4 years from the filing date of application, whichever is later.

The patent entitles the applicant to prevent unauthorised third parties from using the invention and to commence court actions or request interlocutory injunctions to enforce their rights. He may do so starting 18 months after filing or priority date (term during which the patent application is open to public inspection), or earlier, providing the third party has been notified.

2.2 DATA PROTECTION

The Code is unique in that it brings together all the various laws, codes and regulations relating to data protection since 1996. The three key guiding principles behind the code are simplification, harmonisation and effectiveness.

The first part of the Code sets out the general data protection principles that apply to all organisations. Part two of the Code provides additional measures that will need to be undertaken by organisations in certain areas, for example, healthcare, telecommunications, banking and finance, or human resources. Part three relates to sanctions and remedies.

The code applies to all processing within the State and its territories. It will also affect outside organisations that make use of equipment located within Italy, i.e. PCs and other computer-

based systems. This means that the use of cookies is covered by the Italian Code, which will have important ramifications for online businesses.

If an organisation outside the EU is processing data on the Italian territory, it must appoint a representative in Italy to comply with the Italian rules, such as notifying the [Garante] and providing data subjects with information notices.

2.3 DESIGNS

Following the European Directive, Italian law defined "design" as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation. A design may consist of a component of a complex product, provided it is visible during normal use of the product and complies with all the requirements necessary for its protection.

The design may be registered if it is new and has individual character. The requirement of novelty is satisfied if no identical design has been made available to the public before the filing date or the date of priority. The design has an individual character if the overall impression it produces on an informed user differs from the overall impression produced on such user by any design which has been made available to the public before the date of filing or the date of priority. The degree of freedom of the designer in developing the design is taken into account to assess the requirement of individual character. The design must not be dictated by the object's technical function.

In order to allow designers to test their products before deciding if it is worth registering their designs, the design will not be considered to have been disclosed to the public if it is made available to the public by the designer during the 12-month period preceding the filing date of the application or the date of priority. For example, designers may present their creations at trade exhibitions or fashion shows, and subsequently decide within a year which designs to register.

One application for registration may cover up to 100 designs, provided that they relate to products falling within the same class. This serves the interest of industries that produce large numbers of designs having a short market life where the formalities of registration must be reduced to a minimum.

The registration of a design confers on the proprietor the exclusive right to use it and to prevent any third party from using it without its consent. The registration of the design lasts for 5 years from the filing date, but the design holder may obtain 5-year extensions up to a period of 25 years. The duration of the utility model, however, lasts for 10 years.

2.4 TRADE SECRETS

Express protection is now granted for company secrets, including "trade information," provided the information is secret, valuable only if kept secret and where adequate measures have been taken to protect its confidentiality.

Revealing secret information to third parties is now considered to be a violation of IP rights and is sanctioned accordingly, provided that the conditions listed above have been satisfied.

3. PROTECTION OF IP RIGHTS

3.1 REGISTRARS

3.1.1 Patents

Any natural or legal person of Italian or foreign nationality may apply for an Italian patent. Applicants may only be represented by qualified patent agents which are members of the Italian Industrial Property Consultants Institute or by attorneys-at-law. Patent applications may be filed in Italy, at the Provincial Offices of the Ministry of Industry or at the Italian Patent and Trade mark Office.

A European patent must be validated in Italy within three months of the date of grant by filing an Italian translation of the specifications with the Italian Patent and Trade mark Office. This three-month term cannot be extended.

Annual fees must be paid each year during the period an Italian patent is in force.

3.1.2 Trade Marks

Once the Trade Marks Office (TO) approves the registration, the application must be published in the Official Bulletin so that third parties are informed of the application. If objections arise, a time limit of 30 days is established to present a judicial claim.

The decision of the TO can be appealed.

Any natural or legal person who is a citizen or resident of a member country of the European Union, the Paris Convention or the World Trade Organization, or of a country guaranteeing reciprocity of treatment, may apply for an Italian trade mark.

Trade mark applications may be filed in Italy, at the Provincial Offices of the Ministry of Industry or at the Italian Patent and Trade Mark Office.

Registrations are granted approximately 2 to 3 years after filing, if the application is accepted.

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