

# New administrative procedure for invalidation and revocation of trademarks: key points and implications

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## ITALY

Legal updates: case law analysis and intelligence

- **Ministerial Decree No 180/2022 has introduced the possibility of filing revocation and invalidity actions before the PTO**
- **Rights owners may now file a revocation or invalidity action via an administrative procedure or before the courts**
- **The new administrative procedure has significant advantages in terms of speed and costs**

With Ministerial Decree No 180/2022, which entered into force on 29 December 2022, the Italian government has introduced the possibility of filing revocation and invalidity actions before the Italian Patent and Trademark Office (PTO) and completed the transposition of Article 54 of Directive 2015/2436, thereby allowing the filing of cancellation actions both in court and before the PTO via an administrative procedure.

## Key points

### **Grounds for filing revocation and invalidity actions**

Actions for a declaration of revocation of a trademark may be filed in the following cases:

- the trademark has become liable of misleading the public;
- the trademark has become a common (generic) name; and
- the trademark has not been put into genuine use within the period of five years following registration.

A declaration of invalidity of a registered mark may be requested on absolute grounds by any “interested party” where a registered mark is deemed to:

- be devoid of distinctive character;
- be unlawful (eg, contrary to law, public order or morality);
- consist of an emblem protected by international conventions or a sign containing a symbol of public interest, unless such registration has been authorised by the competent authority; and
- be excluded from registration in accordance with legislation or international agreements on the protection of designations of origin, protected geographical indications, traditional terms for wines, traditional specialties guaranteed or denominations of plant variety.

A declaration of invalidity of a registered mark may be requested based on third-party earlier rights (relative grounds) by the proprietor of the earlier mark or protected sign where the registered mark is deemed to:

- be identical to a mark that is valid in Italy for identical goods or services;
- be identical or similar to a mark that is valid in Italy, if a likelihood of confusion arises on the part of the public;
- be identical or similar to a mark that is valid in Italy for identical, similar or dissimilar goods or services, where the earlier mark enjoys a reputation in the European Union or in Italy, and the use of the later mark would take advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark;
- be identical or similar to a mark that is well known in a member state pursuant to Article 6*bis* of the Paris Convention; and
- have been filed by the agent or representative of the owner without its consent or without due cause.

Further grounds for bringing cancellation actions in court (eg, right to name or portrait, and earlier unregistered marks) have not been extended to administrative actions (the competent authority for these cases remains the Civil Court).

## **Proceedings**

After examining the admissibility of an application (the formality and basic requirements are checked at the time of filing), the PTO will grant the parties a two-month 'cooling-off' period (extendable by up to one year) to seek an amicable solution. If no agreement is reached, the owner of the contested mark will have 60 days to file its observations in reply to the applicant's grounds or to request proof of use of the earlier mark (if applicable). If such request is filed, the applicant will have 60 days to present proof of genuine use.

After such exchange, the PTO will issue its decision. Decisions may be appealed before the Board of Appeals and, eventually, the Supreme Court (*Corte di Cassazione*).

The phases of these proceedings clearly reflect the opposition procedure that is already in force; however, an applicant must present its grounds with all the other documents required by law (eg, the power of attorney) at the time of filing, since the late filing of documents is not allowed. The official fee for filing the abovementioned actions is €500.

## **Comment**

Administrative cancellation actions have advantages for the protection of trademark rights compared to judicial actions, in terms of the increased speed of the proceedings and the lower costs involved; it will also help to decrease the judicial backlog of the Italian courts. In some cases, however, the litigation route remains preferable (eg, for counterclaims).

Nonetheless, the easier accessibility of such actions will clearly put a greater responsibility on Italian trademark owners, who must now take into account that their registered trademarks may be invalidated more easily.

Further, as the PTO has been lax in granting borderline descriptive marks, it is advisable to evaluate the risks of counterclaims for revocation before proceeding with the enforcement of weak marks.

Finally, it is noteworthy that the PTO does not conduct a substantive novelty examination and that the opposition procedure is rather recent in Italy. For these reasons, the Italian trademark register is still crowded with similar or even identical trademarks. The new procedure, however, will allow to remove from the register those trademarks that undermine the distinctiveness of others.

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