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# Trademark invalidity and revocation proceedings before the Italian Patent and Trademark Office ("UIBM")

Green light from 29 December  
2022

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# Trademark invalidity and revocation proceedings before the Italian Patent and Trademark Office ("UIBM")

*Green light from 29 December 2022*

The Ministry of Economic Development has issued the decree that will make it possible to bring trademark invalidity or revocation proceedings before the UIBM.

Decree No. 180 of the Ministry of Economic Development of 19 July 2022 ("**Ministerial Decree**") was published in the Official Gazette of November 29, 2022, on amendments to Decree No. 33 of the Minister of Economic Development of 13 January 2010, implementing the Industrial Property Code adopted by Legislative Decree No. 30 of 10 February 2005 ("**IPC Implementing Regulations**") for the purpose of regulating the **invalidity and revocation proceedings of trademarks before the UIBM**.

This is the final piece necessary for the implementation of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015, to approximate the laws of the Member States relating to trade marks ("**Directive**").

According to what is stated on the UIBM's institutional website, "operational guidance will be provided shortly in a special circular".

However, the fact remains that the provisions set forth in the Ministerial Decree will in any case come into effect as of **29 December 2022**, the date from which it **will therefore be possible to initiate, even in Italy, proceedings for invalidity or revocation of a trademark, not only before the ordinary courts, as has been the case until now, but also in the administrative seats**.

Here are some very brief notes on some specific aspects of the new discipline.

First, it is worth noting that under the new Article 63-*bis* of the IPC Implementing Regulations, read in conjunction with Article 184-*ter* IPC, it will not be possible - as is already the case with opposition procedures - to file a petition for invalidity for lack of novelty, based on:

- earlier unregistered trademarks;
- earlier insignia, domain names, company names or designations; or
- earlier copyrights.

Such an application may be filed only by "*the owner of an earlier trademark or [by] the person authorised by law to exercise the rights conferred by a protected designation of origin or geographical indication*" (Art. 184-*ter* IPC).

Importantly, then, Paragraph 4 of the new Article 63-*quarter* of the IPC Implementing Regulations lists, among the cases of inadmissibility of the petition for invalidity or revocation proposed to the UIBM:

- **the failure to use the form prepared by the Office in the Italian language** and
- **the submission of a single petition for invalidity or revocation "against a plurality of registrations"**  
or

- **a single petition for invalidity or revocation** in which "*grounds for revocation **and** invalidity*" are "*asserted simultaneously*".

This means that, **unlike in Court**, applications for invalidity and revocation cannot be "combined" within the framework of a single proceeding before the UIBM, nor can multiple registrations of the same owner be attacked with a single application.

The regulations in Article 63-*undecies* of the IPC Implementing Regulations are also relevant, on "*total or partial withdrawal of a trademark subject to revocation or invalidity proceedings*" before the UIBM.

The legislature has, in fact, provided for two different mechanisms of operation depending on whether the withdrawal is made under a revocation proceeding or under an invalidity proceeding.

In the former case (revocation proceedings), in the absence of an express notice to the contrary from the petitioner, "*the effects of the withdrawal act remain suspended, and the revocation proceedings continue*".

In the second case, on the other hand, (invalidity proceedings), in the absence of an express notice to the contrary from the petitioner, "*the invalidity proceedings are terminated*" even if it is a "partial" withdrawal.

From a strictly operational standpoint, unlike in opposition proceedings, under these new procedures, all documentation must be produced when the petition is filed.

Thus, there will be no room for "*corrections*" or "*additions*," "*except in the case of material or obvious errors*" (Article 63-*terdecies* of the IPC Implementing Regulations).

Finally, as far as timing is concerned, the new Article 63-*quinquies* of the IPC Implementing Regulations has provided - just as for opposition procedures - for the Office to be granted an initial period of two months from the start of the proceedings, **extendable up to one year upon agreement of the parties**, to see if an amicable settlement of the matter can be reached (so-called **cooling-off**).

In addition to this, Article 63-*opties* of the IPC Implementing Regulations provided the option for the parties to jointly request "*at any stage*" an additional **stay of proceedings** "*up to a maximum of 24 months*".

According to Article 63-*decies* of the IPC Implementing Regulations, the **decision** should be issued **within 24 months** from the date of filing the petition, subject to any suspension periods.

Finally, the reimbursement of legal fees in favor of the winning party was set by the Ministerial Decree at a maximum "*of 600 euros*".

**If you need any clarification or assistance regarding the above, contact our IP team in Milan.**

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