

THE NATIONAL TRADEMARK

DURATION – LEGISLATION – WHAT IS A TRADEMARK? – PROCEDURES – PROTECTION – BRANDS AND MARKETING

Duration

Duration of the initial period of registration is fixed at 10 years from date of filing of the application; this period can be indefinitely prolonged by renewing registration at the end of each ten-year period.

Back to top

Legislation

The latest source of regulations on trademarks is the Code of Industrial Property Rights approved by Decree No. 30 on February 10 2005 under Chapter 1, Section 1, Articles 7-28. This cancelled previous legislation based on Royal Decree No. 929 of June 21 1942 (laws on Trademarks).

Back to top

What is a trademark?

The trademark is defined as an ensemble of distinctive signs that an entrepreneur uses to distinguish his own goods and services from similar products offered by other entrepreneurs. As such, to be valid the trademark must possess its own distinctive capacity compared with other trademarks but also compared with distinctive signs of a different type. One important function of a trademark is to guarantee a constant quality of products and services in the eyes of the consumer. To express the concept in greater detail, Article 7 of the Code of Industrial Property Rights states that “all new graphically expressible signs, especially words including names of persons, designs, letters, numbers, sounds, the shape of the product or of its packaging, chromatic combinations or tones, as long as they serve to distinguish the products and services offered by one firm from those offered by another” can be registered as trademarks. Trademarks are therefore denominative (logos), figurative or combinations of these.

Back to top



Procedures

The Italian Patent and Trademark Office (UIBM) registers national trademarks with validity throughout Italy.

The application for registration must indicate one or more classes of products or services to which the trademark applies, making reference, in so doing, to the international classification of products and services as laid down by the Nice Agreement of June 15, 1957 with its subsequent modifications.

The application, together with a description of the trademark, is published by UIBM which makes a careful examination of its validity necessarily involving a reasonable amount of delay.

Back to top

Protection

Registration is strongly advised as it provides certainty regarding the right of ownership to exploit the trademark in all permitted forms, a right that has to be constantly proved for an unregistered or de facto trademark, in any case subject to a number of restrictions.

Interested third parties may present critical observations to the UIBM aimed at preventing registration of trademarks belonging to others. UIBM has the right to take into account, or reject, the observations received.

Third parties can present an application to UIBM for opposition, at administrative level, to registration of the trademark. The application must be presented within three months from date of publication of registration. At the present time this possibility is only theoretical as regulations for operating it have not yet been issued.

In the case of attempted counterfeit, having once sent a warning to the offending party, the owner of the trademark can obtain a ruling from the law courts to protect it. Urgent measures can be taken to be confirmed at the next sessions to compensate the owner for any damage suffered.

Back to top

Brands and marketing

An adequately publicised trademark for distinguishing products or services can represent an enormous economic value for the firm holding it, being responsible for the results achieved by investments and interest shown by consumers for the products and services carrying the trademark sold throughout the country. Being therefore one of the most



important instruments in marketing techniques, the holder must take active steps to prevent its value diminishing from lack of use, so losing its capacity for distinguishing such products and services.

In view of its economic value, the trademark can be ceded to others or licensed; in this case it is advisable to have the transaction put in writing by an entry in the UIBM register. Since 1992 the trademark can be ceded irrespective of assignment of the branch of the firm concerned, as long as the public is in no way deceived as to the essential character and quality of the products and services bearing the trademark.

Back to top

