

# Legal 500

## Country Comparative Guides 2025

**Italy**

**Intellectual Property**

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This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Italy.

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# Italy: Intellectual Property

**1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).**

**(a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how);**

In Italy, inventions may be protected by different types of intellectual property rights mainly provided for in, and governed by, Italian Legislative Decree no. 30 of 2005 (hereinafter "Intellectual Property Code" or "IPC").

In particular:

- **Patents for inventions** (Articles 45 to 80 and 81-bis to 81-octies of the IPC).

Patents can also take the form of Unitary Patents governed by EU Regulation no. 1257/2012.

- **Supplementary Protection Certificates – SPCs** for medicinal products and plant protection products (Article 61 of the IPC, referring to SPCs granted under EC Regulations nos. 2009/469, 2006/1901 and 1996/1610, and Article 81 of the IPC, concerning SPCs previously granted under Italian Law no. 349 of 1991, abrogated in 2005 by the IPC).

SPCs are granted to avoid that the protection for these particular patents is shortened in a meaningful manner due to the timeframe required for the process of obtaining a marketing authorization.

- **Utility model patents** (Articles 82 to 86 of the IPC)

protect models that are capable of conferring increased effectiveness or comfort of use or applications of machines, instruments or tools. These models may consist of new conformations, dispositions, configurations or combinations of parts.

- **Rights in trade secrets, confidential information and know-how** (Articles 98 and 99 of the IPC).

**(b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees);**

In Italy, brands may be protected by different types of intellectual property rights as provided for, and governed by, either the IPC or the Italian Civil Code (hereinafter "CC"). With reference to these intellectual property rights, the Italian legal framework is supplemented by the European Union legal provisions.

In particular, the protection of brands involves:

- **Trademarks**, including traditional, collective and certification marks (Articles 7 to 28 of the IPC; Articles 2569 to 2574 of the CC; EU Regulation no. 2017/1001).

Domestic law provides for the protection of both registered and unregistered marks. Trademarks can also take the form of EUTMs or International marks designating the territory of Italy.

- **Protection against acts of unfair competition** (Articles 2598 to 2601 of the CC), which aim at protect the fairness of competition between market actors, prohibiting *g.* the use of confusingly similar signs or slavish imitation.
- **Other hallmarks** such as company/business names (Articles 2563 to 2567 of the CC), signs (Article 2568 of the CC) and domain names.
- **Geographical Indications ("GIs"), Appellations of Origin ("AO")** (Articles 29 and 30 of the IPC and EU Regulation no. 2012/1151), and **Traditional Speciality Guaranteed ("TSG")** certifications (EU Regulation no. 2012/1151), protecting the reference to the names of specific territorial areas, which are recognized as the location where certain products are produced or processed.

(c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

In Italy, other creations, technology and proprietary interests may be protected by different types of intellectual property rights and means provided for, and governed by, either the IPC or the Italian Law no. 633 of 1941 (hereinafter "Italian Copyright Law" or "ICL"), namely:

- **Copyright**, which protects original works of authorship having creative character, including software, industrial design works having artistic value as well and databases which, by reason of selection or arrangement of their content, constitute the author's own intellectual creation.
- **Neighbouring rights** (Articles 72 to 102 of the ICL), protecting the rights of performers, producers of phonograms, producers of cinematographic or audio-visual works, sport events organizers, radio or television broadcasters, authors of critical and scholarly editions of works in the public domain and simple photographs;
- **Design rights** (Articles 31 to 44 of the ICP; European Union Regulation no. 2002/6 as amended by European Union Regulation no. 2025/73).

Design rights protect the appearance of a whole product or part thereof, limited to those aesthetic characteristics resulting from the features of the product/part or its ornamentation, lines, contours, colours, shape, texture and/or materials. Purely functional characteristics, and products or parts thereof whose form are dictated by functionality, are excluded from protection.

Designs can be either national or EU community. EU designs can be also protected as unregistered designs if they meet the requirements set forth for registered designs.

- **Semiconductor topography rights** (Articles 87 to 97 of the IPC) protect a series of interrelated and fixed/coded drawings, representing the three-dimensional scheme of the layers of a semiconductor product and where each drawing reproduces the whole, or part of the, surface of the semiconductor products during any phase of its production process.
- **Database "sui generis" rights** (Articles 102-bis and 102-ter of the ICL) protect databases showing qualitatively and/or quantitatively substantial investments in either obtaining, verifying or presenting the contents thereof;
- **Plant variety rights** (Articles 100 to 116 of the ICP);

- **Rights in trade secrets, confidential information and know-how** (Articles 98 and 99 of the IPC). Please, see above (A.1.a).

## 2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

In Italy, the duration of each of the intellectual property rights mentioned under A.1 is the following:

- **Patents**: 20 years from the filing of the application.
- **SPCs**: starting from the expiration of the patent, the protected subject matter can be protected for a period equal to the period that elapsed between the patent application filing date and the granting of the first authorization to market the product, reduced by 5 years, provided that it cannot last more than 5 years. That said, for certain medicinal products, a proprietor can benefit from the so-called "Paediatric 6-months extension", which is granted when a request for authorization includes all studies conducted in compliance with an agreed paediatric investigation plan.
- **Utility models**: 10 years from filing date (Article 85 of the IPC).
- **Trademarks**:
  - **Registered trademarks**: 10 years from the filing date. The duration may be extended for 10-year periods through the filing of a trademark renewal application. There is no limit on the number of trademark renewal applications that can be filed;
  - Unregistered trademarks are not subject to any term limit; however, the unregistered mark is protected only so long as the mark is in use, and the rights conferred are extinguished if the trademark is not used for a period of time sufficient to cause it to fade from the public consciousness.
- **Other hallmarks** are not subject to terms limits, except for domain names, which are usually subject to an annual renewal to maintain registration.
- **Copyright**: for rights of economic exploitation, the term is equal to the life of the author plus 70 years. On the contrary, moral rights are perpetual.
- **Neighbouring rights**: duration is usually equal to 50 years from the event that established such right (e.g. the performance, fixation, event, etc.).
- **Design rights**:
  - **Registered designs**: the initial duration is 5 years from filing. This term can be extended for 5-year renewal terms up to an overall duration of 25 years;

- **Unregistered EU designs:** 3 years from the date on which the design was first made available to the public of the European Union.
- **Semiconductor topography rights:** 10 years from either the end of the year in which the topography was commercially exploited anywhere in the world or the end of the year of filing, whichever occurs first.
- **Database rights:** 15 years from the end of the year of completion of the database. Further 15-year terms are granted for integrations, or substantial modifications, to the database.
- **Plant variety rights:** 20 years from the date of grant (30 years if the subject matter is trees or grapevines).
- **GIs, AO and TSG** are not subject to any term limits.
- **Trade secrets/Know-How:** No statutory term limits, they continue to be valid only so long as they meet the legal requirements for protection. However, enforcement and claims for compensation for violation/misappropriation of trade secrets are subject to the statute of limitations (5 years from the date on which the right holder could have enforced its rights).
- **Unfair competition:** formally no term limit, but claims for compensation of damages are also subject to the 5-year statute of limitations.

### 3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

- **Patents:** the inventor is the first owner of moral rights on the invention, of the right to file the patent and all the economic exploitation rights deriving therefrom. However, while moral rights cannot be assigned, the right to file the patent and subsequent economic exploitation rights are assignable.  
If as a general principle the right to a patent belongs to the author of the invention, this principle is significantly modified for rights created in the course of employment or under a commission, as detailed below.
  - **Inventions created in the course of employment:** the ownership of a patent for an invention made by an employee depends on the specific context of the employment relationship.  
When the inventive activity is the specific subject of the employee's contract and is compensated as such, the patent rights belong to the employer. The employee retains the moral right to be recognized as the inventor.  
When inventing is not a specific contractual duty, but the invention is made within the field of

activity of the employer, the patent rights also belong to the employer. However, in this case, the employee is entitled to receive fair compensation. This compensation is determined based on the importance of the invention, the employee's duties, and the resources provided by the company.

If the invention falls outside the field of activity of the employer, the rights belong to the employee. In this scenario, the employer has an option right for the (exclusive or non-exclusive) exploitation of the invention or the assignment of the patent or the filing of the same patent in other jurisdictions, against payment to the employee of an appropriate royalty/purchase price.

- **Inventions created in the course of an employment relationship with a university or similar entities:** the economic exploitation rights automatically pertain to the entity, without prejudice to the inventor's moral rights. However, if the entity does not file the patent application within the six months following the inventor's communication of the creation of the invention, the inventor is entitled to file the patent her/himself.
- **Inventions created under a commission:** unless the contract explicitly states otherwise, the rights to the invention belong to the commissioning party, especially when the purpose of the contract was the creation of that specific invention.
- **Utility model patents and semiconductor topographies rights:** in light of the express reference in Articles 86 and 89 of the IPC to the provisions related to patents, the ownership parameters set forth for patent rights are also applicable to utility model patents and semiconductor topographies rights.
- **SPCs:** the first owner of the certificate is the owner of the relevant patent.
- **Trademarks:**
  - **Registered trademarks:** the first owner is the applicant filing the relevant trademark application;
  - **Unregistered trademarks:** the first owner is the person or entity using the sign as a trademark in a consistent and sufficient manner.
- **Other Hallmarks:** the first owner is the entity using the sign, except for corporate and domain names, which shall be registered;
- **GIs, AO and TSG:** the first owner is the "collective" (e. any association of producers or processors of the same product) that applied for the relevant protection.
- **Copyright:** the first owner of the work is/are its author/s. However, there are specific categories of works, such as cinematographic rights, for which the

rights of economic exploitation vest in the producer, provided that the author of the plot, of the script, of the score and the director are considered co-authors. With reference to software, database and industrial designs protected by copyright and developed by employees in the course of an employment relationship, the first owner of the rights of economic exploitation is the employer or the customer, unless otherwise agreed.

- **Neighbouring rights:** the first owner is the performer, the producer of the phonogram, the broadcaster, the author of critical and scholarly editions of works in the public domain or the photographer.
- **Design rights:** the first owner of the design rights is the author of the design. However, if it was created by the employee in the course of the employment relationship, or as a work-for-hire, the rights are vested in the employer, without prejudice to the designer's right to be recognized as the author and to be mentioned in the registration certificate.
- **Database rights:** the first owner is the maker of the database, e. the entity which undertook the investments necessary for its development.
- **Plant variety rights:** the first owner is the breeder of the new variety. However, if the new variety has been created in the course of an employment relationship or under commission, the first owner is the employer/customer, without prejudice to the moral rights of the breeder.
- **Rights in trade secrets, confidential information and know-how:** the first owner is the legitimate holder of the secret information.

#### 4. Which of the intellectual property rights described above are registered rights?

The registered intellectual property rights amongst those mentioned in section A are: patents, utility model patents, SPCs, semiconductor topographies rights, registered trademarks, geographical indications, appellations of origins, traditional speciality guaranteed, registered designs and plants varieties rights.

Furthermore, also corporate and domain names are subject to registration.

#### 5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

##### Patents:

Unless there has been an assignment of the right to file

the patent or development of the invention during the course of an employment relationship or under commission (see A.3), the inventor is entitled to apply for the patent.

The patent application is filed before the Italian Intellectual Property Office ("Ufficio Italiano Brevetti e Marchi" – "UIBM"), directly or through the Chambers of Commerce. The application must include a request form, a detailed description of the invention, one or more claims (which define the scope of protection), any necessary drawings, and an abstract. Unless otherwise stated by the applicant, the application shall be kept secret for 18 months after filing.

After checking the formalities of the application, the UIBM verifies that the subject matter is patentable, legal and sufficiently disclosed. Then, a prior art search is carried out by the EPO, and the applicant is entitled to review the patent search report and file a reply with its remarks or amendments to the description or to the claims of the application, at least 3 months before the expiration of the 18-months secrecy period.

The UIBM then examines the merits of the patent application. If the patent application meets all the requirements for patentability, the patent will be granted. Otherwise, the application is rejected, and the applicant has 60 days from receipt of the decision to file an appeal before the Board of Appeal ("Commissione dei Ricorsi"). The decision of the BOA, in turn, can be appealed before the Italian Supreme Court within 60 days.

Unitary Patents are granted by the European Patent Office upon filing a European Patent application. In particular, once the European Patent has been granted, the proprietor shall file a request for the Unitary Patent within 1 month from the publication of the grant in the European Patent Bulletin.

**Utility model patent** applications can be filed by the author or their assignees. The registration process is substantially identical to that for patents for inventions. However, no prior art reports are drafted.

**SCP** applications can be filed by the owner of the relevant patents before the UIBM within 3 months of receiving the marketing authorization for the medicinal/plant protection product.

**Semiconductor topographies** applications can be filed before the UIBM by the author, their assignees or, if the subject matter has been developed in the course of an employment relationship or under commission, by the employer/customer. The UIBM will verify that the



application refers to a semiconductor product and that the drawings constituting the topography are duly filed and comply with the requirements set forth in the IPC.

**Registered trademark** applications can be filed before the UIBM (directly or through the Chambers of Commerce) or the European Union Intellectual Property Office (EUIPO) by the individual or the entity using or that intends to use the sign to distinguish the goods/services offered in commerce.

After a verification of the admissibility of the application, the relevant office evaluates the application in light of the so-called "absolute grounds of refusal" (e.g. lack of distinctive character, deceptiveness, etc.).

Then, the trademark application is published in the Official Gazette. For 2 months, any interested party may file observations. For a period of 3 months from publication, the owners of prior rights are entitled to file an opposition (see A.7). If a successful opposition is not filed, the trademark application will be granted and the registration will be published in the Official Gazette.

**GIs, AO and TSG:** an application can be filed either by the collective that is producing/processing the relevant products or, under special circumstances, by a single individual/entity.

The application is filed before the Ministry of Agriculture, Food Sovereignty and Forestry and to the relevant Region(s). A public assessment meeting is called to verify the production/processing methods referred to in the product specification. After this meeting, the product specification (which may have been modified) is published in the Official Gazette and there is a 30-day period in which any interested party is entitled to file an opposition. At the end of the opposition phase, if appropriate, the Ministry will submit the application to the European Commission, which will examine the application and, within 6 months, publish it on the European Union Official Gazette. At that point, there is a 3-month period in which any interested party is entitled to file an opposition. Following this procedure, if appropriate, the EC will grant the relevant right.

**Registered design** applications can be filed by the designer, her/his assignees or the employer/customer (see A.3) before the UIBM (domestic designs) or the EUIPO (EU designs). The applicant may seek protection for multiple designs in a single application, up to a maximum of fifty designs and provided that they are intended for products falling under the same class of products according to the Locarno Classification.

The application shall be filed along a representation of the design. The option to submit a physical sample has been eliminated by EU Regulation 2025/73.

The UIBM and the EUIPO limit the examination of the application to formalities, assessing whether the subject matter constitutes a design, if from the drawings it is possible to identify the limits of the protection sought by the applicant and if the design complies with the requirements of public order and accepted principles of morality. Neither the UIBM nor the EUIPO conduct a prior art search.

**Plant variety right** application can be filed by its developer, the assignees or employer/customer (see A.3), before the UIBM. A description and a picture of the new variety shall be attached to the application.

The UIBM carries out a formal verification of the application while the substantive requirements are evaluated by the Ministry of Agriculture, Food Sovereignty and Forestry, which submit a binding opinion to the UIBM. Third parties are entitled to file observations and the applicant shall be granted a period 6 months to reply.

## 6. How long does the registration procedure usually take?

- **Patents** and **Utility model patents**: 24 months.
- **SCPs**: there is no publicly available data, but the procedure usually takes 3-5 months.
- **Semiconductor topographies**: 90 days.
- **Registered trademarks**: before the UIBM – 9 months, which can be reduced to 4 months with the "FastTrack Procedure". Before the EUIPO, the registration procedures last approximately from 5-8 months ("FastTrack Procedures" are available as well).
- **GIs, AO and TSG**: approximately 2 years.
- **Registered designs**: usually a few months.
- **Plant variety rights**: 90 days from the receipt by the UIBM of the Ministry of Agriculture, Food Sovereignty and Forestry's opinion. Usually the file is submitted by the UIBM to the Ministry within 6 months from the application.

## 7. Do third parties have the right to take part in or comment on the registration process?

For the majority of intellectual property rights, there is no formal opposition or observation procedure that allows third parties to intervene in the registration process.

Consequently, although anyone can send informal comments to the UIBM, the Office has no obligation to

examine them or to forward them to the applicant.

A formal system for third-party intervention is, however, provided for: oppositions for trademarks, GIs, and AOs. Finally, specific provisions for observations are provided for the registration of trademarks and new plant varieties.

## 8. What (if any) steps can the applicant take if registration is refused?

If the UIBM refuses to grant an application, it is possible to lodge an appeal before the Board of Appeals within 60 days from the communication of the decision. If the Board of Appeals upholds the refusal, its decision can be further appealed to the Italian Supreme Court. This final appeal is limited to points of law only, not a re-examination of the facts, within 60 days from communication of the decision to the interested party.

If the EUIPO refuses to grant an application for an EUTM or EU design, the applicant can appeal the decision before the EUIPO's own Board of Appeal.

Decisions of the EUIPO Boards of Appeal can be challenged before the Court of Justice of the European Union (first before the EU General Court, and then the Court of Justice). The deadline for filing the appeals are 2 months from the communication of the decision.

The EU Regulation no. 2025/73 has specified that time limits and rules on representation apply to the entire territory of the European Economic Area (EEA), rather than just the European Union.

## 9. What are the current application and renewal fees for each of these intellectual property rights?

### Patents:

- Domestic Patents

If the application is filed electronically, the application fees are equal to 50 EUR, plus 45 EUR for each claim in excess of the tenth. The prior art search is conducted by the EPO, and has no cost if the claims are translated into English, and a cost of 200 EUR if the claims are not translated into English.

If the application is filed in hard copy format, the application fees depend upon the number of pages of the application and varies from 120 EUR (less than 10 pages) to 600 EUR (more than 50 pages) plus 45 EUR for each claim in excess of the tenth. The prior art search is

conducted by the EPO, and has no cost if the claims are translated into English, and a cost of 200 EUR if the claims are not translated into English.

These application fees cover the first four annuity payments as well.

The fees for the following annuities are the following:

- 5<sup>th</sup> year: 60 EUR;
- 6<sup>th</sup> year: 90 EUR;
- 7<sup>th</sup> year: 120 EUR;
- 8<sup>th</sup> year: 170 EUR;
- 9<sup>th</sup> year: 200 EUR;
- 10<sup>th</sup> year: 230 EUR;
- 11<sup>th</sup> year: 310 EUR;
- 12<sup>th</sup> year: 410 EUR;
- 13<sup>th</sup> year: 530 EUR;
- 14<sup>th</sup> year: 600 EUR;
- 15<sup>th</sup> and following years: 650 EUR.

### Unitary Patents:

In addition to the filing fees concerning the European Patent application that serves as basis for the Unitary Patent, the annual fees for the maintenance of the Unitary Patent are the following:

- 2<sup>nd</sup> year: 35 EUR;
- 3<sup>rd</sup> year: 105 EUR;
- 4<sup>th</sup> year: 145 EUR;
- 5<sup>th</sup> year: 315 EUR;
- 6<sup>th</sup> year: 475 EUR;
- 7<sup>th</sup> year: 630 EUR;
- 8<sup>th</sup> year: 815 EUR;
- 9<sup>th</sup> year: 990 EUR;
- 10<sup>th</sup> year: 1,175 EUR;
- 11<sup>th</sup> year: 1,460 EUR;
- 12<sup>th</sup> year: 1,775 EUR;
- 13<sup>th</sup> year: 2,105 EUR;
- 14<sup>th</sup> year: 2,455 EUR;
- 15<sup>th</sup> year: 2,830 EUR;
- 16<sup>th</sup> year: 3,240 EUR;
- 17<sup>th</sup> year: 3,640 EUR;
- 18<sup>th</sup> year: 4,055 EUR;
- 19<sup>th</sup> year: 4,455 EUR;
- 20<sup>th</sup> year: 4,855 EUR.

SPCs: 404 EUR. The annual fees are progressive:

- 1st year: 708 EUR;
- 2nd year: 1,048 EUR;
- 3rd year: 1,456 EUR;
- 4th year: 1,932 EUR;
- 5th and following years: 2,476 EUR.

**Utility models:** if the application is filed electronically, the application fees amount to 50 EUR, otherwise if the application is filed in hard copy format, the application fees amount to 120 EUR.

These fees cover the first five annuities. The second five annuities amount to 500 EUR.

#### **Trademarks:**

- **Domestic trademarks:**
  - Application fees: 101 EUR for one class and 34 EUR for each additional class. For collective and certification trademarks, the fees are 337 EUR;
  - Renewal fees: 67 EUR for one class and 34 EUR for each additional class. For collective and certification trademarks, the fees are 202 EUR.
- **European Union trademarks:**
  - Application fees: for individual trademarks 850 EUR (electronic filing) or 1,000 EUR (hardcopy filing); for collective or certification trademarks 1,500 EUR (electronic filing) or 1,800 EUR (hardcopy filing). These fees cover one class. For the second class there is an additional 50 EUR fee, and for each subsequent class the fee is 150 EUR.
  - Renewal fees are identical to application fees.
- **International trademarks:** basic application/renewal fees is equal to 135 EUR, plus WIPO fees (depending upon the designated countries and the classes).

#### **Design rights:**

- **Domestic designs:**
  - Application fees: single design 50 EUR (electronic filing) or 100 EUR (hardcopy filing); multiple designs 100 EUR (electronic filing) or 200 EUR (hardcopy filing);
  - Renewal fees:
    - 2<sup>nd</sup> five-year term: 30 EUR;
    - 3<sup>rd</sup> five-year term: 50 EUR;
    - 4<sup>th</sup> five-year term: 70 EUR;
    - 5<sup>th</sup> five-year term: 80 EUR.

#### **EU designs:**

- Application fees (including publication): 350 EUR (single design) and 175 EUR for each design from the 2<sup>nd</sup> to the 10<sup>th</sup> and 80 EUR for each design from the 11<sup>th</sup> design onward.
- Renewal fees (per each design whether included or not in a multiple registration):
  - 1st renewal (years 6-10): 400 EUR;
  - 2nd renewal (years 11-15): 500 EUR;
  - 3rd renewal (years 16-20): 600 EUR;

- 4th renewal (years 21-25): 700 EUR.

**Semiconductor topography rights:** application fees are equal to 1011 EUR.

**Plant varieties rights:** application fees are equal to 236 EUR and the annuities are the following:

- 1<sup>st</sup> year: 101 EUR;
- 2<sup>nd</sup> year: 135 EUR;
- 3<sup>rd</sup> year: 168 EUR;
- 4<sup>th</sup> year: 202 EUR;
- 5<sup>th</sup> year: 236 EUR;
- 6<sup>th</sup> year: 270 EUR;
- 7<sup>th</sup> year: 303 EUR;
- 8<sup>th</sup> year: 337 EUR;
- 9<sup>th</sup> year: 371 EUR;
- 10<sup>th</sup> year: 404 EUR;
- 11<sup>th</sup> year: 438 EUR;
- 12<sup>th</sup> year: 472 EUR;
- 13<sup>th</sup> year: 505 EUR;
- 14<sup>th</sup> year: 539 EUR;
- 15<sup>th</sup> year: 573 EUR;
- 16<sup>th</sup> year: 607 EUR;
- 17<sup>th</sup> year: 640 EUR;
- 18<sup>th</sup> year: 674 EUR;
- 19<sup>th</sup> year: 708 EUR;
- 20<sup>th</sup> year: 741 EUR.

### **10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?**

Failure to pay renewal fees by the due date will cause the intellectual property right to lapse. However, there are two main remedies available to the right holder: grace period and restitutio in integrum.

The first one is an automatic six-month period that begins on the day after the original renewal deadline. During this period, the rights can be renewed by paying the standard renewal fee plus a late payment surcharge. If the payment is made within this timeframe, the right is reinstated as if the fee had been paid on time.

If the six-month grace period is also missed, the only remaining remedy is to file a request for restitutio in integrum. This is an exceptional measure and is not automatically granted. The proprietor must prove that the failure to meet the deadline occurred despite taking all due care required by the circumstances.



### 11. What are the requirements to assign ownership of each of the intellectual property rights described above?

In Italy, the requirements for assigning ownership of intellectual property rights depend on the specific type of right being transferred. A primary distinction is made between industrial property rights and copyright.

As a general rule, the assignment of industrial property rights does not require a specific form to be valid between the signing parties. However, a written agreement is always strongly recommended for legal certainty and proof. There is a specific requirement for trademarks: the assignment must not deceive the public. This means the transfer of the mark cannot create confusion about the origin, nature, or quality of the goods or services it represents.

For copyright and its neighbouring rights, the requirements are stricter. The assignment of the economic rights of use must be proven in writing. Therefore, a written contract is necessary to enforce the transfer.

### 12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Yes, for industrial property rights such as patents, trademarks, and designs, there is a requirement to record an assignment with the relevant intellectual property office (e.g., the UIBM in Italy or the EUIPO for EU-wide rights).

The consequences of failing to register are significant, although they do not affect the validity of the assignment itself between the two parties involved. The primary consequence of failing to register is that the assignment is not enforceable against third parties.

### 13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

There are no specific requirements for granting a license to a third party to use intellectual or industrial property rights. However, trademark licenses must not be deceptive to the public as to the origin of or specific characteristics of the goods/services that are protected under the trademark.

### 14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

License agreements for industrial property rights are not subject to mandatory registration. However, similarly to assignment agreements, recordal of a license in the relevant registries is highly advisable in order to make them effective against third parties that have acquired rights on the same title. Further, recordal is useful for an exclusive licensee to demonstrate their standing to enforce the IP rights against third party infringers before Italian courts.

License agreements for copyright and neighbouring rights are not subject to mandatory recordal and Articles 138 and 139 of the IPC do not apply.

### 15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

Yes, in the Italian legal system, exclusive and non-exclusive licensees are given significantly different rights regarding the enforcement of the licensed intellectual property.

With reference to industrial property rights, exclusive licensees are entitled to enforce the IP right directly against third parties, after having requested consent from the licensor. In the event the licensor provides consent or does not respond in a reasonable timeframe, the exclusive licensee may proceed with enforcement. Therefore, exclusive licensees do have the right to initiate infringement proceedings against third parties. This is because the law recognizes that they have a direct and personal interest in protecting the exclusivity of the market granted to them by the license.

Non-exclusive licensees are entitled to enforce the licensed rights only with the express consent of the right holder. In fact, their right is shared with the licensor (and possibly other licensees), so their legal interest is considered indirect. The primary right and responsibility to enforce the intellectual property rights remains with the licensor.

Consent to enforcement by both exclusive and non-exclusive licensees can be provided in advance within the license agreement itself.

As to copyright and neighbouring rights, according to Italian case law, both exclusive and non-exclusive licensees are entitled to enforce the licensed intellectual property rights in certain circumstances.

## 16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

With reference to trademarks, patents, designs and other industrial property rights, the Italian Criminal Code (hereinafter "ICC") provides for specific criminal sanctions in cases of IP infringement.

In particular:

- Counterfeiting of trademarks or other distinctive signs is sanctioned with imprisonment of six-months to three-years and a fine of 2,500 to 25,000 EUR (Article 473 of the ICC);
- Counterfeiting of patents or industrial designs is sanctioned with imprisonment of one to four-years and a fine of 3,500 to 35,000 EUR (Article 473 of the ICC);
- Import of counterfeit goods is sanctioned with imprisonment of one to four-years and a fine of 3,500 to 35,000 EUR (Article 474 of the ICC);
- Possession, or offering, for sale of counterfeit goods, manufacturing or offering for sale of goods or works of authorship bearing trademarks or other distinctive signs capable of deceiving the purchaser, counterfeiting or alteration of geographical indications or appellations of origins for agri-food products, are sanctioned with up to two-years imprisonment and a fine of up to 20,000 EUR (Articles 474, 517, 517-ter and 517-quater of the ICC);

Furthermore, in the aforementioned cases, the counterfeit goods are confiscated pursuant to Article 474-bis of the ICC.

Criminal proceedings can be brought ex officio or ex parte by means of filing of criminal complaints. Once filed, they are carried out by the public prosecutor's office. The complainant cannot withdraw complaint for crimes that are prosecutable ex officio. In the other cases, the compliant can be withdraw before the conviction.

## 17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office

## proceedings, administrative proceedings, alternative dispute resolution.

Intellectual property right holders are entitled to bring actions to enforce their rights before the specialized IP courts, both in interlocutory proceedings and on the merits. Furthermore, with reference to Unitary Patents, relevant rights can be enforced before the Unified Patent Court (Division of Milan), provided that the Unitary Patent subject matter falls under the scope of Class "A" ("Human Necessities", with exclusion of patents with SPCs).

Furthermore, with reference to copyright and neighbouring rights, it is worth noting that – in the context of electronic media networks – right holders can apply to the Communications Regulatory Authority (AGCOM) to remove content that is infringing their proprietary rights. AGCOM's powers were recently increased by Italian Law no. 93/2023 – going into effect on August 8th, 2023 – which introduced *inaudita altera parte* measures, especially for the protection of live broadcasted events. The addressee of an order issued under Law no. 93/2023 must block access to the infringing content within 30 minutes of receipt of notice of the order.

Alternative dispute resolution processes are not widely used in Italy jurisdiction, and they are not mandatory. That said, arbitration is used more frequently than mediation, provided that the parties have agreed or agrees to submit disputes to an arbitration body.

Finally, in the area of domain name disputes, the Italian registration authority for the ccTLD .it ([Registro.it](https://www.registro.it)) has implemented a reallocation procedure.

## 18. What is the length and cost of such procedures?

The duration and costs of the procedures mentioned *sub* E.17 depend upon the complexity of the case, the type of intellectual property right enforced and the type of procedure brought.

In particular:

- interlocutory proceedings before civil courts last from 3/5 months to 1 year;
- civil court proceedings on the merits last approximately:
  - 2-3 years before First Instance Courts;
  - 1-4 years before Courts of Appeal; and
  - 3-5 years before the Italian Supreme Court;

Regarding the average length of Unified Patent Court (Division of Milan) proceedings, the UPC's 2024 annual report indicates an average duration of approximately 406 days (about 13.5 months) for infringement actions and 384 days (about 12.5 months) for revocation actions at first instance. Although specific statistics for the Milan division alone are not available, it is expected to operate in line with these general system-wide timelines.

- AGCOM proceedings last approximately 65 days (or 25 days in case of a shortened procedure). The duration of interlocutory proceedings is approximately 5 days.

There is insufficient data on the average length of ADR procedures.

**19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.**

In Italy, pursuant to the Legislative Decree no. 168 of 2003, intellectual property litigation is adjudicated by Specialized Sections created within the main Italian Civil Courts. The Specialized IP Sections are within major Italian Courts (e.g., in Turin, Milan, Rome, Naples).

For infringement actions, the venue is the Specialized Section of the Court where the respondent has its domicile (*forum rei*) or where the infringement occurred (*forum commissi delicti*). For action seeking a declaration of invalidity of registered intellectual property rights, the venue is the Specialized Section of the Court where the right holder has elected domicile, as stated in the relevant application or title.

Interlocutory proceedings start with the filing of a request for preliminary measures. The Court will process the application and assign a judge, which will issue a decree that grants any requested measures *ex parte* (if appropriate) and indicate a hearing date. Generally, the decree will also set a deadline for service of the application and decree on the respondent and a deadline for the respondent to appear in the action (which may be directly at the hearing itself). After the hearing, depending upon the case, the Judge can either take the case under reserve, or authorize the filing of further briefs and/or appoint a Court Technical Expert to examine technical issues (common for patent infringement actions). If there is an exchange of supplementary briefs or the filing of a

Court Expert opinion, the Judge will usually schedule a final hearing before taking the case under reserve. Then the Judge will render a decision. Interlocutory decisions are subject to an appeal (called a *reclamo*), which must be filed within 14 days of the decision. The "*reclamo*" decision is final and cannot be further appealed.

Proceedings on the merits start with the service of a writ of summons on the defendant to appear before the Court at a hearing that shall be scheduled at least 150 days service. A Judge rapporteur is assigned to the case, and will confirm or modify the hearing date as necessary. The defendant must file its statement of defence at least 70 days before the first hearing. Within 15 days before the expiration of this term, the Judge must carry out preliminary verifications. After the defendant's answer and statement of defense is filed, there is also an exchange of three procedural briefs (used to (i) specify or modify the party's claims and to reply to the opposing party's arguments, (ii) to file evidence and (iii) to file evidence in rebuttal) which are filed respectively 40, 20 and 10 days before the first hearing. After the first hearing, the Judge will issue a decision on evidentiary requests (e.g. the admissibility of witness testimony) and, if necessary, appoint a Court Technical Expert (common in patent infringement and invalidity actions). At the end of the evidentiary phase, the Judge rapporteur will schedule a hearing to refer the case to the panel of the three Judges that will decide the merits of the case. The final filing deadlines are as follows: 60 days before the referral hearing the parties may file a concluding brief summarizing its pleadings; 30 days before the hearing they may file a final brief; and 15 days before the hearing, the parties may file a rebuttal. Finally, each party may request the scheduling of a hearing for the final discussion of the case before the panel of Judges.

The decision of the first instance Court is usually rendered within 120 days; however, this term is not mandatory. The first instance decision can be challenged before the Court of Appeal within 6 months from publication or 30 days from service of the decision on the losing party. Court of Appeal's decision can be appealed before the Italian Supreme Court within the same deadlines.

In addition to the above, it is worth noting that proceedings concerning Unitary Patents are subject to the Rules of Procedure of the Unified Patent Court which provides for different rules in case of infringement, non-infringement or invalidity actions, allowing summary proceedings as well. The UPC's judicial panels have a multinational composition and often include both legally qualified and technically qualified judges with experience in the relevant field of technology. Decisions of the Court

of First Instance can be appealed before the UPC Court of Appeal, located in Luxembourg.

### **Proceedings on the merits**

In proceedings on the merits consist of the following stages:

(i) written procedure.

This stage differs according to the type of action brought by the applicant:

- In infringement actions written procedure consists of:
  - a statement of claim;
  - a statement of defence (to be lodged within 3 months from the service of the statement of claims);
  - a reply to the statement of defence (to be lodged within 2 months from the service of the statement of claims);
  - a rejoinder to the reply to the statement of defence (to be lodged within 1 month from the service of the reply to the statement of defence).

The statement of defence may also include a counterclaim for revocation. In this event the original claimant is entitled to lodge, within 2 months from the service of the counterclaim, a defence to the counterclaim and the counterclaimant may lodge, within 2 months from the service of the defence to the counterclaim, a reply to the defence to the counterclaim. Finally, the original claimant may lodge a rejoinder to the defence to the counterclaim, within 1 month from the service of the reply to the defence to the counterclaim.

In addition to the above, in its defence to the counterclaim, the original claimant may also lodge an application to amend the enforced patent. In this case the defendant may lodge a defence to the application to amend the patent within 2 months from the service of the application. The patent owner may file its reply to the defence within 1 month from its service and the defendant may file its rejoinder within 1 month from the service of the reply.

- In invalidity actions written procedure consists of:
  - a statement for revocation;
  - a defence to revocation (to be lodged within 2 months from the service of the statement for revocation);
  - a reply to the defence to revocation (to be lodged within 2 months from the service of the previous deed);
  - a rejoinder to the reply to the defence to revocation (to be lodged within 1 month from the

service of the previous deed).

The defence to revocation may also contain an application to amend the patent or an infringement counterclaim. In this case, the same terms described above for the amendment procedure apply (also with reference to the infringement counterclaim) to the lodging of the subsequent briefs (defence, reply and rejoinder).

- In non-infringement actions the written procedure consists of:
  - a statement for a declaration of non-infringement;
  - a defence to the above-mentioned declaration (to be lodged within 2 months after the service of the statement);
  - a reply to the defence referred to above (to be lodged within 1 month from the service of the defence);
  - a rejoinder to the afore-mentioned reply (to be lodged within 1 month from the service of the reply).

(ii) interim procedure:

The interim conference is aimed, amongst others, at the identify the main issues and facts pertaining to the dispute, clarify the position of the parties and explore with them any settlement possibilities.

(iii) oral procedure:

Oral procedure consists of one hearing (or in exceptional cases more hearings) where the parties submit their oral submissions and witnesses/experts are examined by the Court.

At the end of the oral procedure, the Court issues its decision on the merits.

(iv) award of damages procedure:

This procedure consists of separate proceedings for the determination of the amount of damages ordered for the successful party and commence with an application that shall be lodged within 1 year from the service of the final decision on the merits. The unsuccessful party shall lodge within 2 months from the service of the application file its defence. Then each party may file, respectively, a reply to the defence and a rejoinder to the reply. Both briefs shall be filed within 1 month from the service of the previous brief.

(v) costs decisions procedure:

Finally, separate proceedings shall be commenced in order to recover the costs of the disputes. This action



shall be brought within 1 month from the service of the decision. The unsuccessful party of the proceedings on the merits shall be allowed to comment in writing the application of the successful party.

Decisions of the Court of First Instance can be appealed before the Court of Appeal within 2 months of the service of the final decision (or 15 days in case of particular orders issued by the First Instance Court).

Finally, at any state, the Court can refer a question before the Court of Justice of the European Union.

#### Summary proceedings

Summary proceedings consist of two different stages:

- i. written procedure, commencing with an application for provisional measures (also *inaudita altera parte* – i.e. without the other party being heard). The defendant – when involved in the proceedings – shall be allowed to lodge an objection to the aforementioned application.
- ii. oral procedure, that can be initiated if the Court decides to summons the parties.

### **20. What customs procedures are available to stop the import and/or export of infringing goods?**

The main procedure is customs surveillance, which is governed by European Union Regulation no. 2013/608. Pursuant to this regulation the right holder (or in specific cases its exclusive licensee) is entitled to file a domestic or EU application for action (AFA). The AFA is valid throughout the EU. The application provides details of the IP right and information to help officials identify counterfeit goods. If customs identify a suspicious shipment, they detain it and notify the right holder.

The right holder then has 10 working days (or 3 working days, if the goods are perishable), which may be extended by an additional 10 working days. If the goods are confirmed to be counterfeit, the holder of the AFA may request destruction. If the holder of the AFA fails to provide confirmation, the goods are released.

The addressee of the shipment can either adhere to or oppose the destruction of the goods within 10 working days (or 3 working days, if the goods are perishable). If the addressee does fails to do so, Customs will proceed with destroying the goods.

### **21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.**

In Italy, for most civil and commercial disputes it is mandatory to attempt mediation before a court case can proceed. However, this obligation does not apply to disputes involving IP infringement.

### **22. What options are available to settle intellectual property disputes in your jurisdiction?**

With reference to intellectual property disputes, there are no mandatory out-of-court enforcement options or dispute resolution mechanisms.

### **23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?**

To establish infringement, a claimant must first prove they are the legitimate owner or exclusive licensee of a valid IP right. Subsequently, the requirements and evidence differ by right:

**Patents and utility models:** the claimant must prove the manufacturing, use, commercialization, importation of the patented product or the application of the patented process as well as the commercialization of the product directly obtained applying the patented process.

This can be established through literal infringement (all features are identical) or under the doctrine of equivalents (a feature in the accused product is insubstantially different from a claimed feature).

Evidence typically includes the purchase of the infringing product, technical expert reports analyzing its features, and, crucially, evidence gathered via a court-ordered inspection (description order). For process patents, the burden of proof may shift to the defendant under certain conditions. In particular, if the product obtained by applying the patented process is new or there is a substantial probability that the contested (and identical) product has been manufactured by using the patented process and the right holder has not been able to prove it despite all due reasonable efforts, the infringement of the patent is presumed and the burden of proof shifts to the alleged infringer to prove the contrary.



**Trademarks:** the claimant must demonstrate a likelihood of confusion on the part of the relevant public. This involves showing that the defendant is using a sign that is identical or similar to the claimant's mark on goods or services that are identical or similar.

For trademarks with a strong reputation, infringement can also be established by proving that the defendant's use takes unfair advantage of, or is detrimental to, the distinctive character or repute of the famous mark (dilution or tarnishment).

Evidence includes samples of the infringing products, photographs of their use in commerce, advertising materials, and sometimes consumer survey data.

**Other hallmarks** are protected against the risk of confusion for the public. Therefore, besides the use of the interfering sign, the right holder shall prove the existence of a risk of confusion.

**GIs and AO:** it is necessary to prove:

- use of the GI or AO for comparable products that are not covered by the relevant registration;
- the misuse, imitation or evocation of the GI or AO, also accompanied by expressions such as "style", "type", "as produced in", "similar", ;
- any practice that misleads the public as to the true origin of the product.

**TSG:** it is necessary to prove the misuse, imitation or evocation of the TSG, as well as any other practice that misleads the consumer.

**Designs:** the claimant must show that the defendant's design produces the same overall impression on an "informed user" as the protected design. For unregistered EU designs, it is also a requirement to prove that the infringing product was the result of copying the protected design. Evidence includes side-by-side comparisons of the products, design drawings, and catalogues.

**Semiconductor topography rights:** the right holder must prove the reproduction of its topography, the fixation of the topography to a semiconductor product or the use for commercial purposes of the product in which the topography has been fixed.

**Database "sui generis" rights:** the right holder must prove the systematic and reiterated extraction or re-use of the contents of the database.

**Plant variety rights:** the right holder must prove that the alleged infringer performed one of the prohibited activities (g. the production or reproduction of the variety,

the offering for sale, selling or the exportation/importation of the variety) with reference to its plant variety rights or to a variety that is essentially derived (i.e. having the same essential characters deriving from the genotype) therefrom.

**Copyright and Neighbouring rights:** the claimant must prove the unauthorized reproduction, distribution, public performance, or other act reserved to the right holder. This requires showing that the defendant's work is a copy of the claimant's original, creative work. Evidence usually consists of samples of the infringing work.

**Trade Secrets:** the claimant must establish that: (i) the information met the criteria of a trade secret (i.e., it was secret, had commercial value, and was subject to reasonable steps to keep it secret); and (ii) the defendant acquired, used, or disclosed the information unlawfully.

**Unfair competition claims:** the claimant must prove the act of unfair competition (g. slavish imitation, use of confusingly similar distinctive signs, acts contrary to professional fairness). However, it is worth noting that, once the act of unfair competition has been assessed, it is presumed that the liable party also acted with negligence.

**24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?**

**a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence?**

The approach differs between the Italian national courts and the Unified Patent Court (UPC):

Italian judges do not have a technical background. In cases involving complex technical issues (especially patent litigation), the judge will almost always appoint a neutral court-appointed technical expert. The expert investigates the technical matters, reviews submissions from the parties' own technical experts, and provides a detailed written report to the court. While not legally binding, the expert's opinion is highly influential on the

final decision.

The UPC system is different. Its judicial panels have a multinational composition and often include both legally qualified judges and technically qualified judges. According to the UPC's 2024 annual report, the court has appointed 75 technically qualified judges from various technical fields who are allocated to cases based on the specific technology of the patent at issue, ensuring that technical expertise is integrated directly into the judicial panel.

#### **b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?**

Italy does not have broad discovery mechanisms. However, targeted mechanisms are available to obtain evidence:

- Description orders: this is a powerful preliminary measure. A right holder can request a court order, often without prior notice to the other party (ex parte), authorizing a court bailiff and an expert to enter the alleged infringer's premises to find, inspect, photograph, and describe (and sometimes take samples of) infringing products or evidence of an infringing process. Such evidence is intended to be used by the right holder in a subsequent action to demonstrate infringement of their rights.
- Order for disclosure: during proceedings, a party can request the judge to order the opposing party to produce specific, identified documents relevant to the case. Further, a party that has demonstrated the existence of infringement can request the judge to order the infringing party to disclose accounting and other records that demonstrate the extent of the infringement, in order to calculate damages caused by the illicit activities.

#### **25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?**

Generally speaking, evidence is filed before the Court in documentary form and is available for examination by both parties and the Judge. The Judge is free to evaluate the evidence, unless the law provides them with a specific evidentiary value (e.g. oath, judicial confession, public deeds, etc.).

Parties are given an opportunity to comment on and/or rebut evidence filed by the other party, to ensure that the basic pillars of adversarial proceedings are respected.

Other evidence, such as witnesses testimony, is subject to the Judge's authorisation and, if given, performed directly by the Judge. During witness examination, the other party is allowed to "indirectly" cross-examine the witness, submitting questions to the Judge to direct to the witness. Similarly, the Judge may request the witness to provide clarifications.

#### **26. What defences to infringement are available?**

A defendant in an infringement action has several available defences, including:

- Invalidity of the IP right: the most common defence is a counterclaim that the IP right is invalid and should be revoked (e.g.: for a patent, this could be based on a lack of novelty or inventive step; for a trademark, a lack of distinctive character).
- Exhaustion of rights: a defence stating that the specific goods were already placed on the market in the European Economic Area by the IP right holder or with their consent, thereby exhausting their right to control further distribution of those specific goods.
- Statutory limitations and exceptions: arguing that the activity is permitted by law, such as for private, non-commercial use; experimental purposes; or rights of prior use.
- Extinction: a claim for damages is barred if not brought within five years from the date the claimant became aware of the infringement and the identity of the infringer.
- License/consent: a contractual defence arguing that the right holder authorized the activity through a license agreement.

#### **27. Who can challenge each of the intellectual property rights described above?**

The right to challenge an intellectual property right in Italy depends on the nature of the right and the grounds for the challenge.

As a general rule, any party with a legitimate interest can file a court action to seek a declaration of invalidity of a registered IP right. For registered rights like patents and trademarks, the Public Prosecutor can also initiate invalidity actions in the public interest.

However, there are important distinctions, especially for trademarks:

- Challenges on absolute grounds: any interested party can challenge a trademark on absolute grounds (e.g., the mark is descriptive, non-distinctive, or contrary to public policy).
- Challenges on relative grounds: a challenge based on a conflict with a prior right (a relative ground), such as an earlier trademark, can only be brought by the owner of that prior right.

Similarly, an action to revoke a patent because the application was filed by a person not entitled to it can only be brought by the person who is legitimately entitled to the invention.

## 28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

As a matter of principle, the validity of an intellectual property right can be challenged at any time from its registration through its entire term, and even after expiration as a defence in an infringement lawsuit concerning acts that occurred while the right was in force.

During the registration process, specific mechanisms are available for certain rights. For trademarks and Geographical Indications (GIs), there is a time-limited window (typically three months after publication) for owners of prior rights to file a formal opposition. Additionally, for trademarks, any third party can submit observations during the examination phase, arguing against registration on absolute grounds.

After a right is granted, challenges may be subject to certain limitations. For example, the owner of a prior trademark who has knowingly tolerated the use of a later registered mark for five consecutive years loses the right to challenge it (known as acquiescence). Similarly, a trademark that was initially not distinctive but has acquired distinctiveness through use ("secondary meaning") can no longer be challenged on that basis. Finally, a revocation action for non-use of a trademark may be defeated if the owner resumes good-faith use of the mark before the action is filed.

## 29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual

### property rights?

**Patents for invention** and **utility model patents** can be challenged only in Court within an action on the merits described *sub* 19.

The grounds for invalidity of patents (and, where applicable, of utility model patents) are:

- non-patentable subject matter (g. discoveries, scientific theories, mathematical models, information presentation, software, and plans, principles and methods for intellectual activities, games and commercial activities are not patentable);
- lack of novelty;
- obviousness for the person skilled in the art;
- invention not suitable for industrial application;
- contrariety to public order or accepted principles of morality;
- insufficient disclosure of the invention;
- extension beyond the content of the original application;
- patent application filed by an entity not entitled to it;
- failure to pay the relevant annuities in due time (this is a cause for extinction of the patent).

If one or more patent claims are declared invalid, the right holder is entitled to file a limitation in order to preserve its/their validity.

**Supplementary Protection Certificates – SPCs** can be challenged in Court during an action on the merits (see E.19).

The grounds for invalidity are the following:

- lack of one of the prescribed requirements, which are:
  - the product shall be protected by a patent in force;
  - the commercialization as medicinal or plant protection product has been authorized by the relevant authorities and it is the first authorization for said product;
  - the products shall not be subject to a prior SPC.
- extinction of the patent prior to its natural expiration;
- the underlying patent is declared invalid or is limited such that the product for which the certificate was issued is no longer protected by the patent.

**Rights in trade secrets, confidential information and know-how** can be challenged only in Court in ordinary proceedings on the merits (E.19) if the following requirements are not met:

- secrecy;
- economic value of the information because of its

- secrecy; and
- adoption of adequate protection measures.

**Trademarks** can be challenged:

before the UIBM:

- during the opposition phase in the registration procedures for lack of novelty vis-à-vis earlier trademark registrations, GIs and AOs.

If an opposition is filed, the applicant can submit arguments and require, if appropriate, the opponent to file proof of use of its earlier trademark. The applicant has 60 days to appeal the decision issued by the UIBM before the Board of Appeal (*Commissione dei Ricorsi*). The Board of Appeals' decision can be appealed before the Italian Supreme Court within 60 days from communication of the decision.

- after registration for absolute or relative grounds, except for registration in bad faith. The main features of this procedure are similar to those used in the opposition procedure, including the right to appeal the decisions and appeal deadlines.
- in Court for all grounds and according to the ordinary proceedings on the merits (see E.19).

European Union trademarks can be challenged before the EUIPO.

The grounds for the invalidity are the following:

- the sign cannot constitute a trademark;
- lack of distinctive character;
- contrariety to the law, public order and accepted principles of morality;
- deceptiveness;
- lack of novelty;
- infringement of third parties' rights (g. copyright or image rights);
- bad faith registration.

Furthermore, a trademark can be revoked in case of:

- vulgarization;
- non-use for five years;
- supervening contrariety to the law, public order and accepted principles of morality;
- supervening deceptiveness.

**Copyright** and **Neighbouring rights** can be challenged by proving that they lack the requisites for protection (see A.1.c).

**Design rights** can be challenged:

- before the Court (Italian registered designs and EU unregistered designs) in Court in an action on the merits (see E.19);
- before the EUIPO (community registered designs), which can be challenged before the Board of Appeals and, in turn, the Court of Justice of the European Union.

The grounds for invalidity of a design are the following:

- lack of novelty;
- lack of individual character;
- contrariety to public order or accepted principles of morality;
- the design of an element of a complex product is not visible during its normal use;
- the design serves a technical function or consists of a necessary shape and/or dimension for its linking to another product;
- registration filed by an unauthorized entity;
- infringement of third parties' trademarks or copyrights.

**Semiconductor topography rights** can be challenged in Court in an action on the merits (see E.19) if the topography:

- does not constitute the result of a creative effort of its author;
- is common or generally known in the semiconductor products industry;
- is filed by an unauthorized entity;
- has been filed after the expiration of the two-year term from its first commercial exploitation, which may occur anywhere in the world;

Furthermore, the topography can be declared invalid if:

- the applicant did not declare, where appropriate, the date of the first commercial exploitation;
- the application is not sufficiently specific and does not enable the identification and the evaluation of the relevant requirements.

**Database "sui generis" rights** can be challenged in Court in an action on the merits (see E.19) if the database lacks the relevant requirements (see A.1.c);

**Plant varieties rights** can be challenged in Court in an action on the merits (see E.19) if the variety is not:

- new;
- distinguishable from any other known variety;
- uniform in the characteristics relevant for the protection;
- stable.

Furthermore, the plant variety can be declared invalid if the application has been filed by an unauthorized entity.

Finally, the plant variety rights can be revoked if the right holder does not pay the relevant annuities (see B.9).

### 30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

Any interested party is entitled to bring an action for declaration of non-infringement before the Court, both in proceedings on the merits and in interlocutory proceedings. This action is aimed at obtaining a judicial declaration recognizing the absence of infringement of intellectual property rights in relation to certain conduct. An interested party is usually considered to be one that can demonstrate to have a reasonable concern that they will be the target of an infringement action (usually, the receipt of a warning letter is sufficient).

On the other hand, certain intellectual property rights, namely patents and utility models, may be subject to compulsory licenses if the invention or the model are not implemented in a manner consistent with the "needs of the Country", within 3 years from grant of the patent or 4 years from the filing of the application (whichever expires later). The relevant application for the compulsory license shall be filed before the Ministry of the Enterprises and Made in Italy.

The same provisions apply to new plant variety rights. However, the relevant application for the compulsory license shall be filed before the Ministry of Agriculture, Food Sovereignty and Forestry instead.

### 31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

The remedies for IP infringement are divided into two main categories: interim remedies, which are available on an urgent basis while a case is pending, and final remedies, which are awarded at the conclusion of a full trial on the merits.

- **Interim remedies:** these are urgent measures granted by a court at the beginning of or during a lawsuit to provide swift relief. They are granted upon a showing of a *prima facie* case of infringement and a risk of irreparable damage. The most common interim remedies are:

- Preliminary injunction: a court order compelling the alleged infringer to immediately cease the infringing activity. The order is often supported by a penalty payment for any violation.
- Seizure: a court order to seize the allegedly infringing products from the infringer's premises or from the market to prevent their further distribution.
- Description order: an evidence-gathering tool, often granted without prior notice to the other party (*ex parte*). A court-appointed officer is authorized to access the infringer's premises to inspect, photograph, and describe the infringing items or processes to preserve evidence of the infringement.

- **Final remedies:** these are granted in the final judgment once the court has definitively found that an infringement has occurred. The most common final remedies are:

- Permanent injunction: a final and permanent order prohibiting the infringer from continuing the infringing acts.
- Damages: the court orders the infringer to pay monetary compensation for the harm caused. Damages are typically calculated based on one of the following methods, with the court often awarding the higher amount: the right holder's lost profits, the restitution of the infringer's profits, a reasonable royalty that the infringer would have paid for a license.
- Withdrawal and destruction of goods: a final order for the definitive removal of the infringing products from all channels of commerce and for their destruction at the infringer's expense.
- Publication of the judgment: the court can order that an excerpt of the judgment be published in newspapers or industry magazines at the infringer's expense. This serves to inform the public and restore the right holder's reputation.
- Award of legal costs: the losing party is typically ordered to reimburse the successful party for its legal fees and court costs, although the amount awarded is calculated according to statutory scales and may not cover the full costs incurred.

### 32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

The costs of enforcement proceedings consist of the official court fees, which are usually equal to 1036 EUR



(518 EUR for interlocutory proceedings), and administrative fees, which amount to EUR 27.

Before the Unified Patent Court these costs are increasingly significant. In particular, fixed fees amount to 11,000 EUR for each type of action, except for application to determine damages whose fixed fees are 3,000 EUR.

However, there are some additional value-based fees depending on the value of the action which ranges from 0 EUR if the value of the action is up to (and including) 500,000 EUR to 325,000 EUR if the value of the action is more than 50,000,000 EUR.

Other specific fees can be found at the following table [https://www.unified-patent-court.org/sites/default/files/upc\\_documents/ac\\_05\\_08072022\\_table\\_of\\_court\\_fees\\_en](https://www.unified-patent-court.org/sites/default/files/upc_documents/ac_05_08072022_table_of_court_fees_en)

[final\\_for\\_publication\\_clean.pdf](#).

The legal fees vary depending upon the complexity of the case and the intellectual property right(s) involved in the disputes.

While court and administrative fees, as well as the expenses for the Court Technical Expert, are usually awarded to the prevailing party (a different allocation may be imposed in case of particularly complex or new matters), the legal fees are awarded according to charts issued by Ministry of Justice, which usually are lower than the actual fees incurred by the parties in intellectual property disputes.

There are no mechanisms enabling or requiring security for costs.

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