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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, which are mainly provided for and governed by Italian Legislative Decree no. 30 of 2005 (hereinafter "Intellectual Property Code" or "IPC") and the Italian Civil Code (hereinafter "CC").

In particular:

- **Patents for inventions** (Articles 45 to 80 and 81-*bis* to 81-*octies* of the IPC; Articles 2584 to 2591 of the CC).

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

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

SPCs are granted to prevent the protection of these particular patents from being shortened in a meaningful way due to the timeframe required for the process of

obtaining a marketing authorization.

- **Utility model patents** (Articles 82 to 86 of the IPC; Article 2592 of the CC) protect models that increase the effectiveness, comfort 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. trademarks, 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 set out in either the IPC or the CC. These intellectual property rights are supplemented by European Union legal provisions within the Italian legal framework. 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 trademarks. 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 aims to protect the fairness of competition between market participants by prohibiting the use of confusingly similar signs or slavish imitation, for example.
- **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)

protect references to the names of specific territorial areas recognized as the locations 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, as set out in either the IPC or Italian Law no. 633 of 1941 (hereinafter "Italian Copyright Law" or "ICL") or the CC, namely:

- **Copyright**, which protects original works of authorship having creative character, even if they are created with the assistance of artificial intelligence tools, provided they are the result of the author's intellectual work. This includes software, works of industrial design having artistic value, and databases which, due to the selection or arrangement of their content, constitute the author's own intellectual creation.
- **Neighbouring rights** (Articles 72 to 102 of the ICL), which protect the rights of performers, producers of phonograms, producers of cinematographic or audio-visual works, sport events organizers, radio or television broadcasters, and authors of critical and scholarly editions of works in the public domain, as well as simple photographs;
- **Design rights** (Articles 31 to 44 of the ICP; Article 2593 CC; European Union Regulation no. 2002/6 as amended by EU Regulation no. 2024/2822 and EU Regulation no. 2025/73).

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

According to EU Regulation No. 2024/2822, goods may include any industrial or handicraft item, except a computer programme, regardless of whether they are embodied in a physical object or take the form of a non-physical entity. This includes packaging, sets of articles, graphic works or symbols, logos, typographic typefaces and graphical user interfaces.

Designs can be either national or EU community. EU designs can also be protected as unregistered designs if they meet the requirements set out 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 layout of the layers of a semiconductor product, where each drawing reproduces the entire or partial surface of the semiconductor product at any stage of its production process.
- **Database "*sui generis*" rights** (Articles 102-*bis* and 102-*ter* of the ICL) protect databases that demonstrate substantial qualitatively and/or quantitatively investment in obtaining, verifying or presenting their contents;
- **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 term equal to the period that elapsed between the filing date of the patent application and the granting of the first authorization to market the product, reduced by 5 years, provided that this period does not exceed 5 years. However, for certain medicinal products, the 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 the filing date (Article 85 of the IPC).
- Trademarks:

– Registered trademarks: 10 years from the filing date. This period can be extended in 10-year

increments by 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, they are only protected for as long as they are in use. The rights conferred are extinguished if the trademark is not used for a sufficient period of time to cause it to fade from the public consciousness.

- Other hallmarks are not subject to term limits, except for domain names, which usually require annual renewal to maintain registration.
- Copyright: for rights of economic exploitation, the term is equal to the author's life plus 70 years. Conversely, moral rights are perpetual.
- Neighbouring rights: duration is usually equal to 50 years from the event that established the right (e.g. the performance, fixation, event, etc.).
- Design rights:

– Registered designs: the initial term is 5 years from the filing date. This can be extended in 5-year periods up to a maximum 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 first commercially exploited anywhere in the world, or from the year of filing, whichever is sooner.
- Database rights: 15 years from the end of the year in which the database was completed. 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 remain valid for as long as they meet the legal requirements for protection. However, claims for compensation for the violation or 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 initial holder of the moral rights to the invention. These include the right to be recognized as the author of the invention, including the rights to file the patent and all the economic exploitation rights deriving therefrom. However, while moral rights cannot be assigned to third parties, the rights to file and exploit a patent can be.

While the general principle is that the right to a patent belongs to the inventor, 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.

If the inventive activity is specifically included in the employee's contract and is paid for, the patent rights belong to the employer. The employee retains the moral right to be recognized as the inventor.

If inventing is not a specific contractual duty but an invention is made within the employer's field of activity, the patent rights also belong to the employer. However, in this case, the employee is entitled to receive fair compensation if the employer or its successors obtain a patent for the invention or exploit it. The amount of 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 employer's field of activity, the rights belong to the employee. In this scenario, the employer has the right to exploit the invention (exclusively or non-exclusively), to assign the patent, or to file the same patent in other jurisdictions, provided that an appropriate royalty/purchase price is paid to the employee.

– 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 a patent application within six months of being informed by the inventor of the creation of the invention, the inventor is entitled to file a application patent her/himself.

– Inventions created under a commission: unless the contract explicitly states otherwise, the rights to the invention belong to the party that has commissioned it, particularly if the purpose of the contract was to create that specific invention.

- Utility model patents and semiconductor topographies rights: in light of the express reference to the provisions related to patents in Articles 86 and 89 of the IPC, the ownership parameters set out for patent rights also apply 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 who filed the relevant trademark application; – Unregistered trademarks: the first owner is the person or entity that uses the sign as a trademark consistently and sufficiently.

- Other Hallmarks: the first owner is the entity using the sign, except for corporate and domain names, which must be registered.
- GIs, AO and TSG: the first owner is the "collective" (i.e. any association of producers or processors of the same product) that applied for the relevant protection.
- Copyright: the author is the initial owner of the work and of the moral and economic rights related to it. However, specific categories of works exist, such as cinematographic rights, for which the rights of economic exploitation vest in the producer, provided that the author of the plot, script and score, and the director, are considered co-authors.

With regard to software, databases and industrial designs that are protected by copyright and developed by employees during their employment, the employer or customer is the first owner of the economic exploitation rights, unless otherwise agreed.

The rights to any other copyright-protected work created during an employment relationship or as a work-for-hire are vested in the employer or in the commissioning party if this is specified in the contract and is appropriate to the nature and purpose of the work in question.

- 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 author of the design is the first owner of the design rights. However, if the design was created by an employee in the course of the employment relationship, or as a work-for-hire, the rights are vested in the employer. This does not affect the designer's right to be recognized as the author or to be mentioned in the registration certificate.
- Database rights: the first owner is the maker of the database, i.e. the entity that undertook the investments necessary for its development.
- Plant variety rights: the first owner of a new variety is the breeder. However, if the new variety was created during an employment relationship or as part of a contract, the first owner is the employer/customer, unless the breeder's moral rights are affected.
- 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 in section A 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 the right to file the patent or develop the invention has been assigned 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 submitted to the Italian Intellectual Property Office ("Ufficio Italiano Brevetti e Marchi" – "UIBM"), directly or via the Chambers of Commerce. It must include a request form, a detailed

description of the invention, one or more claims defining the scope of protection, any necessary drawings, and an abstract. Unless the applicant states otherwise, the application will be kept secret for 18 months after filing.

After verifying that the application meets the formal requirements, the UIBM confirms that the subject matter is patentable, legal and sufficiently disclosed. A prior art search is then carried out by the EPO, after which the applicant is entitled to review the patent search report and file a reply with any necessary remarks or amendments to the description or claims of the application at least 3 months before the 18-months secrecy period expires.

The UIBM then examines the merits of the patent application. If the application meets all the patentability requirements, a patent will be granted. Otherwise, the application will be rejected and the applicant will have 60 days from receipt of the decision to file an appeal with the Board of Appeal ("Commissione dei Ricorsi"). In turn, the BOA's decision 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. Once a European Patent has been granted, the proprietor must file a request for a Unitary Patent within 1 month of its publication of the grant in the European Patent Bulletin.

- **Utility model patent** applications can be filed by the inventor or their assignees. The registration process is substantially identical to that for patent applications. However, no prior art reports are drafted.
- **SCP** applications can be filed by the owner of the relevant patents with the UIBM within 3 months of receiving the marketing authorization for the medicinal or plant protection product.
- **Semiconductor topographies** applications can be filed with the UIBM by the author or their assignees, or if the subject matter has been developed during an employment relationship or under commission, by the employer or customer. The UIBM will verify that the application refers to a semiconductor product and that the topography drawings are duly filed and comply with the requirements set out in the IPC.
- **Registered trademark** applications can be filed with the UIBM (directly or via the Chambers of Commerce) or the European Union Intellectual Property Office (EUIPO) by individuals or entities intending to use a sign to distinguish

goods or services offered in commerce.

After verifying the application's admissibility, the relevant office will evaluate it, considering 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 no successful opposition is filed, the trademark application will be granted, and the registration will be published in the Official Gazette.

- **GLs, AO and TSG**: applications can be filed by either the collective producing/processing the relevant products or, in special circumstances, by an individual or entity.

Applications are submitted to the Ministry of Agriculture, Food Sovereignty and Forestry and to the relevant Region(s). A public assessment meeting is held to verify the production and processing methods referred to in the product specification. Following this meeting, the product specification (which may have been amended) is published in the Official Gazette, after which there is a 30-day opposition period in which any interested party is entitled to file an opposition. If appropriate, at the end of the opposition phase, the Ministry will submit the application to the European Commission. The Commission will then examine the application and publish it on the European Union Official Gazette. There is then a 3-month period during which any interested party can file an opposition. If appropriate, following this procedure, the EC will grant the relevant right.

- **Registered design** applications can be filed by the designer, their assignees, or their employer/customer (see A.3) with the UIBM for domestic designs or the EUIPO for 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 and up to a maximum of fifty designs.

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

The UIBM and the EUIPO only examine applications for formal compliance, to establish whether the subject

matter constitutes a design and whether the drawings accurately depict the scope of the applicant's desired protection. They also verify that 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 with the UIBM by its developer, assignees, or the employer/customer (see A.3). The application must be accompanied by a description and a picture of the new variety.

While the UIBM carries out a formal verification of the application, the Ministry of Agriculture, Food Sovereignty and Forestry evaluates the substantive requirements and submits a binding opinion to the UIBM. Third parties are entitled to submit observations, and the applicant is granted a 6 months period to respond.

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 of the Ministry of Agriculture, Food Sovereignty and Forestry's opinion by the UIBM. 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 most intellectual property rights, there is no formal procedure that allows third parties to submit observations or oppose applications during the registration process.

Consequently, while anyone can send informal comments to the UIBM, the Office is under no obligation to examine them or to forward them to the applicant.

However, a formal system for third-party intervention is

provided for: oppositions relating to trademarks, GIs, and AOs. Finally, specific provisions for observations are in place 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 an application, it is possible to appeal before the Board of Appeals within 60 days of receiving the decision. If the Board of Appeals upholds the refusal, the decision can be appealed to the Italian Supreme Court. This final appeal is limited to points of law only and does not allow for a re-examination of the facts. It must be made within 60 days of the decision being communicated to the interested party.

If the EUIPO refuses an application for an EUTM or EU design, the applicant can appeal the decision to 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 (firstly before the EU General Court, and then before the Court of Justice). The deadline for filing the appeals is 2 months from the communication of the decision.

The EU Regulation no. 2025/73 specifies 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 fee is 50 EUR, plus 45 EUR for each claim in excess of ten. The prior art search conducted by the EPO is free if the claims are translated into English while its cost amounts to 200 EUR if they are not.

If the application is submitted in hard copy format, the application fees depend on the number of pages in the application. They range from 120 EUR for fewer than 10 pages to 600 EUR for 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 also cover the first four annuity payments.

The fees for the following annuities are as follows:

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

Unitary Patents:

In addition to the filing fees for the European Patent application on which the Unitary Patent is based, the annual maintenance fees for the Unitary Patent are as follows:

- 2nd year: 35 EUR;
- 3rd year: 105 EUR;
- 4th year: 145 EUR;
- 5th year: 315 EUR;
- 6th year: 475 EUR;
- 7th year: 630 EUR;
- 8th year: 815 EUR;
- 9th year: 990 EUR;
- 10th year: 1,175 EUR;
- 11th year: 1,460 EUR;
- 12th year: 1,775 EUR;
- 13th year: 2,105 EUR;
- 14th year: 2,455 EUR;
- 15th year: 2,830 EUR;
- 16th year: 3,240 EUR;
- 17th year: 3,640 EUR;
- 18th year: 4,055 EUR;
- 19th year: 4,455 EUR;
- 20th 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 subsequent years: 2,476 EUR.

Utility models: if the application is filed electronically, the application fee is 50 EUR; if it is filed in hard copy format,

the application fee is 120 EUR.

These fees cover the first five annuities. The second five annuities cost 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 fee is 337 EUR;
- Renewal fees: 67 EUR for one class and 34 EUR for each additional class. For collective and certification trademarks, the renewal fee is 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:
 - 2nd five-year term: 30 EUR;
 - 3rd five-year term: 50 EUR;
 - 4th five-year term: 70 EUR;
 - 5th five-year term: 80 EUR.

EU designs:

- Application fees (including publication): 350 EUR (single design) and 125 EUR for each design from the 2nd to the 10th.
- Renewal fees (per each design whether included or not in a multiple registration):
 - 1st renewal (years 6-10): 150 EUR;
 - 2nd renewal (years 11-15): 250 EUR;
 - 3rd renewal (years 16-20): 400 EUR;
 - 4th renewal (years 21-25): 700 EUR.

Semiconductor topography rights: application fee is equal to 1011 EUR.

Plant varieties rights: application fee is equal to 236 EUR and the annuities are the following:

- 1st year: 101 EUR;
- 2nd year: 135 EUR;
- 3rd year: 168 EUR;
- 4th year: 202 EUR;
- 5th year: 236 EUR;
- 6th year: 270 EUR;
- 7th year: 303 EUR;
- 8th year: 337 EUR;
- 9th year: 371 EUR;
- 10th year: 404 EUR;
- 11th year: 438 EUR;
- 12th year: 472 EUR;
- 13th year: 505 EUR;
- 14th year: 539 EUR;
- 15th year: 573 EUR;
- 16th year: 607 EUR;
- 17th year: 640 EUR;
- 18th year: 674 EUR;
- 19th year: 708 EUR;
- 20th 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 result in the intellectual property right lapsing. However, two main remedies are available to the right holder: a grace period and *restitutio in integrum*.

The former is an automatic six-months period beginning 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 rights are reinstated as if the fee had been paid on time.

If the six-months grace period is also missed, the only remaining option is to file a request for *restitutio in integrum* within one year of the missing original renewal deadline being missed. This is an exceptional measure and is not automatically granted. The proprietor must prove that they took all due care required by the circumstances and that the failure to meet the deadline occurred despite this.

11. What are the requirements to assign ownership of each of the intellectual property rights described in section A?

In Italy, the requirements for assigning ownership of intellectual property rights vary depending on the type of right in question. The main 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, and it can be based on verbal agreements or conclusive acts. However, a written agreement is always strongly recommended to provide legal certainty and for evidentiary purposes. Notably, a trademark assignment must not deceive the public. This means that transferring the mark cannot create confusion regarding the origin, nature, or quality of the goods or services it represents.

The requirements are stricter for copyright and its neighbouring rights. The transfer of economic rights must be proven in writing. Therefore, a written contract is necessary for the assignee 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, an assignment must be recorded with the relevant intellectual property office (e.g., the UIBM in Italy or the EUIPO for EU-wide rights).

Although the consequences of failing to register are significant, this does not affect the validity of the assignment itself between the two parties involved. The main consequence of failing to register is that the assignment cannot be enforced against third parties. In the event of a dispute between different assignees, the first registered assignee will prevail.

13. What are the requirements to licence a third party to use each of the intellectual property rights described in section A?

There are no specific formal requirements for granting a license to a third party to use intellectual or industrial property rights. However, trademark licenses must not mislead the public regarding the origin or specific characteristics of the goods or services that are protected by 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, as with assignment agreements, it is highly advisable to record a license in the relevant registries in order to make it effective against third parties that have acquired rights on the same title. Furthermore, recordal enables an exclusive licensee to demonstrate their standing to enforce the IP rights against third party infringers in Italian courts.

License agreements for copyright and neighbouring rights are not subject to mandatory registration, 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, under the Italian legal system, exclusive and non-exclusive licensees are granted significantly different rights with regard to the enforcement of the licensed intellectual property.

With regard to industrial property rights, exclusive licensees can enforce their IP rights directly against third parties who are allegedly infringing them, provided they have requested consent from the licensor. If the licensor provides consent or does not respond within a reasonable timeframe, the exclusive licensee may proceed with enforcement. They also have the right to intervene in infringement proceedings brought by the licensor in order to obtain compensation for any damage suffered. 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, however, are only entitled to enforce the licensed rights with the express consent of the right holder. Their right is shared with the licensor (and possibly other licensees), so their legal interest is considered indirect. The licensor retains the primary right and responsibility to enforce the intellectual property rights.

Both exclusive and non-exclusive licensees can be provide consent to enforcement in advance within the license agreement itself.

Both exclusive and non-exclusive licensees may take action for unfair competition, if the relevant and contractual conditions are met.

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

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 trademarks or other distinctive signs, or using them, are 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, or using them, are 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);
- Where the aforementioned offences are committed systematically or through organised activities and means, they are sanctioned with imprisonment of two to six-years and a fine of 5,000 to 50,000 euros (Article 474-ter of the ICC).
- The detention for sale, offer for sale or place on the market of goods bearing counterfeit trademarks or distinctive signs are sanctioned with imprisonment of up to two-years and a

fine of up to 20,000 EUR (Article 474 of the ICC);

- The detention for sale, offer for sale or placing on the market of works of authorship or of industrial goods bearing trademarks or other distinctive signs that could deceive the public as to their origin, provenance or quality, are sanctioned with imprisonment of up to two years and a fine of up to 20,000 EUR (Art. 517 of the ICC);
- Except in the cases provided for in Articles 473 and 474 of the ICC, the manufacture, importation into the country, detention for sale, offer for sale or place on the market of goods produced by infringing industrial property rights, are sanctioned with imprisonment of up to two years and a fine of up to 20,000 EUR (Article 517 *ter* of the ICC);
- Counterfeiting of protected geographical indications or designations of origins for agri-food, handcrafted and industrial products, or the importation, detention for sale, and offer for sale of such counterfeit products, are sanctioned with imprisonment of one to four-years and a fine of 10,000 to 50,000,000 EUR (Article 517-*quater* of the ICC).
- Using counterfeit or misleading distinctive signs during agricultural, industrial or commercial activities, with the intention of misleading the public about the origin, provenance, quality or quantity of food products or their ingredients, is sanctioned with imprisonment of three to eighteen-months and a fine of up to EUR 20,000 (Article 517 *septies* of the ICC).

In the aforementioned cases, the counterfeit goods are confiscated in accordance with Article 474-*bis* of the ICC.

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

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

alternative dispute resolution.

In Italy, intellectual property right holders can take civil action to enforce their rights in both interlocutory proceedings and on the merits before the specialized IP courts. Furthermore, with regard to Unitary Patents, relevant rights can be enforced before the Unified Patent Court (Milan Division), provided that the subject matter of the Unitary Patent falls within the scope of Class "A" ("Human Necessities"), excluding patents with SPCs.

In the context of electronic media networks, copyright and neighbouring rights holders can apply to the Communications Regulatory Authority (AGCOM) to remove infringing content. AGCOM's powers were recently increased by Italian Law no. 93/2023, which came into effect on August 8th 2023 and introduced *inaudita altera parte* measures, especially for the protection of live broadcasted events. The recipient of an order issued under Law no. 93/2023 must block access to the infringing content within 30 minutes of receiving notice of the order.

Alternative dispute resolution processes are not widely used in Italy and they are not mandatory. That said, arbitration is used more frequently than mediation if the parties agree to submit disputes to an arbitration body.

Finally, the Italian registration authority for the ccTLD .it (Registro.it) has implemented a reallocation procedure in the area of domain name disputes.

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

The duration and costs of the procedures mentioned *sub* E.17 depend on the complexity of the case and the type of intellectual property right being 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 proceedings at the Milan Division of the Unified Patent Court, the UPC's 2025

annual report indicates an average duration of approximately 398 days (about 13 months) for infringement actions and 384 days (about 13 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 the case of 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 handled by Specialized Sections within the main Italian Civil Courts, including those in Turin, Milan, Rome, Naples, etc.. For infringement actions, the venue is the Specialized Section of the Court in which the respondent is domiciled (*forum rei*) or in which the infringement occurred (*forum commissi delicti*). For action seeking a declaration of the invalidity of registered intellectual property rights, the venue is the Specialized Section of the Court in which the right holder has elected domicile, as stated in the relevant application or title.

Interlocutory proceedings begin with the submission of a request for preliminary measures. The Court will process the application and assign a judge, who will issue a decree granting any requested measures *ex parte* (if appropriate) and set a date for the hearing. The decree will generally also set a deadline for serving the application and decree on the respondent, as well as a deadline for the respondent to appear in the proceedings (which may be directly at the hearing itself). After the hearing, depending on the case, the Judge can either take the case under review or authorize the filing of further briefs and/or appoint a Court Technical Expert to examine technical issues (common in patent infringement cases). If supplementary briefs are exchanged or a Court Expert opinion is filed, the Judge will usually schedule a final hearing before taking the case under review. The Judge will then render a decision. Interlocutory decisions are subject to an appeal, called *reclamo*, which must be filed

within 15 days of the decision being made. The “*reclamo*” decision is final and cannot be further appealed.

In Italy, prior to the introduction of Decree-Law No. 100/2026 on June 12th, 2026, urgent interlocutory measures and measures designed to anticipate the effects of the judgment on the merits – including injunctions – could remain in force even if proceedings on the merits were not initiated within 31 days of the interlocutory order. Following the reform, if the applicant does not start proceedings on the merits within this time-period, the measures will cease to have effect if the losing party files a specific application within 30 days of the deadline for starting proceedings on the merits expiring.

The proceedings on the merits begin with the defendant being summoned to appear before the court at a hearing scheduled at least 120 days after the writ is served in Italy, or 150 days if it is served abroad. A Judge *rappporteur* is assigned to the case, and may confirm or modify the hearing date as necessary. The defendant must file their defence statement at least 70 days before the first hearing. Within 15 days of the deadline, the Judge must carry out preliminary checks. After the defendant has filed their answer and statement of defense, three procedural briefs are exchanged (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. Following the initial hearing, the Judge will make decision regarding evidentiary requests (e.g. the admissibility of witness testimony) and, if necessary, appoint a Court Technical Expert (a common occurrence in patent infringement and invalidity proceedings). At the end of the evidentiary phase, the *rappporteur* Judge will schedule a hearing to refer the case to the panel of the three-Judge panel 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 their 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 a hearing to discuss the case before the panel of Judges.

The first instance Court usually renders its judgement within 60 days; however, this term is not mandatory. A decision of the first instance Court can be appealed to the Court of Appeal within 6 months of publication or 30 days of service of the decision on the losing party. The Court of Appeal's decision can be appealed before the Italian Supreme Court within 6 months from publication or 60 days from service of the judgement.

Additionally, proceedings concerning Unitary Patents are subject to the Rules of Procedure of the Unified Patent Court, which provide for different rules in cases of infringement, non-infringement, or invalidity, and allow for summary proceedings. The UPC's judicial panels are multinational 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, which is 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 aims, amongst others, to identify the main issues and facts relating to the dispute, clarify the parties' positions and explore any settlement possibilities with them.

(iii) oral procedure:

Oral procedure consists of one hearing (or, in exceptional cases, more than one hearing), during which the parties present their oral arguments and witnesses/experts are examined by the Court. Once the oral procedure is complete, the Court will issue its decision on the merits.

(iv) award of damages procedure:

This procedure consists of separate proceedings to determine the amount of damages awarded to the successful party. It commences with an application to be lodged within 1 year from the final decision on the merits being served. The unsuccessful party must file their defence 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 to recover the costs of the dispute. These proceedings must

be initiated within 1 month of the decision being served. The unsuccessful party in the proceedings on the merits shall be permitted to submit a written response to the successful party's application.

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

In addition, at any time, the Court may refer a matter to 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 afore-mentioned application.
- ii. oral procedure, that can be initiated if the Court decides to summon 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. According to this regulation, the right holder (or, in specific cases, their exclusive licensee) can file a domestic or EU application for action (AFA). The AFA is valid throughout the EU. It 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) to confirm that the goods are counterfeit, a period which may be extended by an additional 10 working days. If they are, the holder of the AFA may request their destruction. If the holder of the AFA fail to do so, 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 they fail 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, mediation must be attended before most civil and commercial disputes can proceed to court. However, this obligation does not apply to disputes involving IP infringement.

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

In Italy, intellectual property disputes may be resolved through non mandatory out-of-court procedures such as mediation or arbitration.

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

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

- **Patents and utility models:** in the case of product patents, the claimant must prove the manufacturing, use, commercialization and importation of the patented product. To prove infringement of a process patent, the claimant must demonstrate either the direct application of the patented process or the commercialization of the product obtained by applying the patented process.

This can be demonstrated either through literal infringement, whereby all features are identical, or under the doctrine of equivalents, whereby a feature in the accused product differs only insubstantially from a claimed feature.

Evidence typically includes purchasing 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 if 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 this despite making all reasonable efforts, then infringement of the patent is presumed, and the burden of proof shifts to the alleged infringer to prove otherwise.

- **Trademarks:** if there is no similarity between the conflicting signs and the goods to which they apply, the claimant must demonstrate that there is a likelihood of confusion on the part of the relevant public. This requires evidence that the defendant is using a sign identical to, or similar to, the claimant's mark for goods or services identical to, or similar to, those covered by the mark.

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 reputation of the famous mark (dilution or tarnishment).

Evidence may include samples of the infringing products, photographs of them being used in commerce, advertising materials and, in some cases, consumer survey data.

- **Other hallmarks** are protected against the risk of confusion for the public. Therefore, in addition to using the conflicting sign, the right holder must prove that there is 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 demonstrate that the defendant's design creates the same overall impression for an "informed user" as the protected design. For unregistered EU designs, it is also necessary to prove that the infringing product was copied from the protected design. Evidence can include side-

by-side comparisons of the products, design drawings, and catalogues.

- **Semiconductor topography rights:** the right holder must prove that the topography has been reproduced, fixed to a semiconductor product, or used for commercial purposes in a product in which the topography has been fixed.
- **Database "sui generis" rights:** the right holder must demonstrate that the database contents have been systematically and repeatedly extracted or reused.
- **Plant variety rights:** the right holder must demonstrate that the alleged infringer has performed one of the prohibited activities (*g.* the production or reproduction of the variety, the offering for sale, sale or export/import) with reference to its plant variety rights, or to a variety that is essentially derived therefrom (*i.e.* having the same essential characters deriving from the genotype).
- **Copyright and Neighbouring rights:** the claimant must prove that defendant has reproduced, distributed or publicly performed the work without authorization. This involves demonstrating that the defendant's work is a reproduction of the claimant's original, creative work. Evidence usually consists of samples of the infringing work and technical expert reports in disputes concerning software.
- **Trade Secrets:** the claimant must prove both of the following: (i) the information met the criteria of a trade secret (*i.e.* it was confidential, had commercial value and was subject to reasonable measures to keep it confidential); and (ii) the defendant unlawfully acquired, used, or disclosed the information. A distinctive feature of trade secrets disputes in Italy is that proof of the defendant's unlawful acquisition, use or disclosure of the information can be provided indirectly via presumptions.
- **Unfair competition claims:** the claimant must prove that the defendant committed an act of unfair competition by the defendant (*g.* slavish imitation, use of confusingly similar distinctive signs or conduct contrary to professional fairness). However, it is worth noting that, once an act of unfair competition has been established, 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. This expert will investigate the technical matters, review submissions from the parties' own technical experts and provide the court with a detailed written report. While not legally binding, the expert's opinion carries significantly weight in the final decision.

The UPC system is different. Its judicial panels are multinational composition and often include both legally qualified judges and technically qualified judges. According to the UPC's 2025 annual report, the court has appointed 80 technically qualified judges from various fields of technology. These judges are allocated to cases based on the specific technology of the patent in question, thereby 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 extensive discovery mechanisms. However, there are targeted mechanisms 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) evidences of infringing products evidences of an infringing process, as well as evidences demonstrating the extent of the

infringement. These are intended to be used by the right holder in a subsequent proceedings to demonstrate infringement of their rights or to quantify damages.

– Order for disclosure: during proceedings, a party can request the judge to order the opposing party to produce specific documents relevant to the case. Furthermore, a party that has demonstrated infringement can request the judge to order the infringing party to disclose accounting and other records demonstrating the extent of the infringement in order to calculate the 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?

Evidence is generally filed with the Court in documentary form and is available for examination by both parties and the Judge. Unless the law provides it with a specific evidentiary value (e.g. oath, judicial confession, public deeds, etc.), the Judge is free to evaluate the evidence.

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

Other evidence, such as witness testimony and questioning the person responsible for the infringing acts, requires the Judge's authorisation. If an authorization is given, the Judge will perform the task directly. During witness examination, the other party is permitted to "indirectly" cross-examine the witness by submitting questions to the Judge to direct to the witness. Similarly, the Judge may request that the witness provide clarifications. During questioning, the Judge may request information about the origin, distribution and provision network of the infringing goods and services. The other party may also request 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. For example, for a patent this could be based on a lack of novelty or inventive step, and 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 the 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 it is not brought within five years of the claimant becoming 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 in section A?

In Italy, 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 initiate court proceedings to seek a declaration of the invalidity of a registered IP right. For registered rights such as patents and trademarks, the Public Prosecutor can also initiate actions to declare a right invalid in the public interest, although this occurs in very few cases.

However, important distinctions exist, particularly with regard to 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 someone 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)?

In principle, the validity of an intellectual property right can be challenged at any time during its term, including after expiration, as a defence in an infringement lawsuit concerning acts that occurred while the right was in force.

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

After a right is granted, challenges may be subject to certain limitations. For instance, a prior trademark owner who knowingly tolerates 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") cannot be challenged on that basis. Finally, an action to revoke a trademark for non-use may be unsuccessful 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 as part of a legal action described *sub* 19.

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

- non-patentable subject matter (*g.* discoveries, scientific theories, mathematical models, the presentation of information, software, and plans, principles and methods for intellectual activities, commercial and gaming activities are not patentable);
- lack of novelty;
- obviousness to a person skilled in relevant field of technology;
- the invention is not suitable for industrial application;
- the invention contravenes public order or accepted principles of morality;
- insufficient disclosure of the invention;

- extension beyond the content of the original application;
- the patent application was filed by an entity that was not entitled to so;
- failure to pay the relevant annuities in due time (this results in the patent being extinguished).

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 must be protected by an active patent;
 - the product must have been authorised for commercialization as a medicinal or plant protection product has been authorized by the relevant authorities, and this must be the first authorization for the product;
 - the products must 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 only be challenged in Court in ordinary proceedings on the merits (E.19) as a defence to an infringement claim brought by the claimant, if the following requirements are not met:

- secrecy;
- the economic value of the information due to its secrecy; and
- adoption of adequate protection measures.

Trademarks can be challenged:

- before the UIBM:
 - during the opposition phase of the registration procedure, if there is a lack of novelty in relation to earlier trademark registrations, GIs and AOs.

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

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

European Union trademarks can be challenged before the EUIPO.

The following are grounds for invalidity:

- the sign cannot constitute a trademark. In particular, in the case of registered shape marks, the validity of the trademark can be challenged if the sign consists exclusively of the shape which (i) results from the nature of the goods themselves, (ii) is necessary to obtain a technical result, (iii) gives substantial value to the goods;
- 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 in Courts in an action on the merits by establishing that they lack the requirements for protection (see A.1.c).

Design rights can be challenged:

- before the Court (for Italian registered designs)

and EU unregistered designs) 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, subsequently, the Court of Justice of the European Union.

The grounds for invalidating 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 dimensions for 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 the author's creative effort;
- is common or generally known in the semiconductor products industry;
- is filed by an unauthorized entity;
- has been filed after the two-year term has expired from its first commercial exploitation anywhere in the world;

Furthermore, a topography can be declared invalid if:

- the applicant did not declare the date of the first commercial exploitation, where appropriate;
- the application is not sufficiently specific to 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 does not meet 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, a plant variety can be declared invalid if the application was 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 in section A, for example, declaratory relief or licences of right?

Any interested party is entitled to initiate proceedings for a declaration of non-infringement before the Court, in both proceedings on the merits and interlocutory proceedings. The purpose of this action is to obtain a judicial declaration recognizing the absence of infringement of intellectual property rights in relation to certain conduct. An interested party is typically someone who can demonstrate that they have a legitimate concern about being the target of an infringement action (usually, receiving of a warning letter is sufficient).

Certain intellectual property rights, such as patents and utility models, may be subject to compulsory licenses in certain circumstances.

In particular, a compulsory license can be granted to any interested applicant if the invention or the model is not implemented in a manner consistent with the "needs of the country" within 3 years of the patent being granted or 4 years of the application being filed (whichever expires later). Another ground for a compulsory license arises if the holder of an earlier patent refuses to grant a voluntary licence on fair terms to the holder of a subsequent dependent patent, provided that the second invention constitutes a significant technical advance of considerable economic importance in relation to the first.

Application for compulsory license must be filed with the Ministry of the Enterprises and Made in Italy.

The same provisions apply to new plant variety rights. However, applications for compulsory licenses for new variety rights shall be filed with 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 in section A?

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 evidence 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.
- Withdrawal: a court order compelling the alleged infringer to actively recall the infringing products from the channels of commerce. This 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 which is 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, in order to preserve evidence of the infringement.

Final remedies: these are granted in the final judgment on the merits, 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. These are typically calculated using 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; or 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.
- Penalty payment: a sum of money fixed by the court and payable by the infringer for each subsequent breach of the order, or for each day's delay in enforcing it.
- Publication of the judgment: the court can order an excerpt of the judgment to 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 usually required to reimburse the successful party for their legal fees and court costs. However, 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, usually amounting to 1036 EUR (518 EUR for interlocutory proceedings), and administrative fees totalling 27 EUR.

These costs are increasingly significant before the Unified Patent Court. In particular, the fixed fee is 14,600 EUR for each type of action, except for applications to determine damages, whose fixed fees are 4,000 EUR, and for applications to preserve evidence, for an order for inspection, or for an order to freeze assets, whose fees are 5,000 EUR.

There are also additional value-based fees, ranging from 0 EUR for actions up to (and including) 500,000 EUR to 430,300 EUR for actions valued at more than 50,000,000 EUR.

Other specific fees can be found in the following table: https://www.unifiedpatentcourt.org/sites/default/files/upc_documents/Consolidated%20Table%20of%20Court%20fees_EN.pdf.

Legal fees vary depending on the complexity of the case and the intellectual property right(s) involved in the dispute.

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 the case of particularly complex or novel matters), legal fees are awarded according to charts

issued by Ministry of Justice. These charts usually reflect fees that are lower than those actually incurred by parties involved in intellectual property disputes.

There are no mechanisms enabling or requiring security for costs.

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