



***The trademark invalidity and
revocation proceedings before
the Italian Patent and
Trademark Office ("UIBM")***

*The new administrative procedure
before the Italian PTO that will enter
into force on 29 December 2022*

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Introduction

As from December 29, 2022 invalidity and revocation proceedings against Italian trademark registrations can be filed before the Italian Patent and Trademark Office. Compared to the usual judicial proceedings, with the introduction of this purely administrative procedure a significant reduction on timing, costs and procedural complexity is expected.

How it will work

The proceedings before the Italian Patent and Trademark Office will be conducted in a manner similar to the opposition proceedings:

- An application must be filed with the Italian PTO to which the documentation on the basis of which the invalidity or revocation of a trademark is requested – such as an indication of the goods and/or services for which the application is filed, the grounds, any earlier trademarks, the date on which the revocation matured, etc. – is attached.
- Once the application is filed, the Office will proceed with the examination of the admissibility of the application.

How it will work

- After this examination, the Office will notify the parties of the start of the proceedings and inform them of the possibility of reaching an agreement within a time limit of two months, starting from the date of communication of the start of the proceedings. Said deadline may be extended several times up to one year upon the joint request of the parties.
- If no agreement is reached, the Office will grant the holder of the contested trademark a 60-day time limit to file its observations and possibly to request proof of use of the earlier trademarks.

(This is an innovation compared to opposition proceedings, as usually the Opponent would first file a brief and then the Applicant could reply, also by requesting the proof of use of the earlier marks).

How it will work

- At the end of the 60 days granted to the holder of the contested trademark, if the latter has filed its observations, the Office will forward them to the Applicant, assigning it a 60-day time limit to reply. After the expiry of said deadline, the Office will grant the holder of the trademark a further 60 days to file any counter-reply.
- If the trademark holder does not submit any observations, the Office will proceed with the decision.
- The Italian PTO will issue its decision within 24 months from the filing date of the application.

For the sake of brevity, the points listed above are only a summary of the new administrative procedure before the Italian PTO.

Should you prefer a more comprehensive overview of the new procedure, or any clarifications thereon, the Firm remains at your disposal.

We send our best regards.