

Newsalert

IP, TMT and Data Protection Department

EUIPO comments on the Sky v. SkyKick case / Italy publishes the decree regulating the registration in the special register of historic trademarks and identifying the relevant logo

Latest news on trademarks matters

1. Observations of the European Union Intellectual Property Office on the Sky v SkyKick case (C-371/18)

On 29 January 2020, the Court of Justice of the European Union ("CJEU") delivered its decision on a trademark lawsuit in the Sky v. SkyKick case (C-371/18), following a preliminary referral by the English High Court of Justice (here is the link to our comment of the decision).

In the Sky v. SkyKick case, the CJEU ruled, inter alia, on the possibility of declaring a sign invalid, in whole or in part, (i) on the grounds of insufficient clarity and precision of the specifications of the goods and services for which the trademark was applied for, and (ii) on the grounds of bad faith, based on the sole circumstance that the trademark owner filed the application without any intent to use the trademark for the specified goods and services (or part of them).

In relation to these issues, the European Union Intellectual Property Office ("EUIPO") endorsed the indications of the CJEU as well as its practical implications as regards the regulation of EU trademarks registration.

According to the European Office, the CJEU decision reassures EU trademark owners who - in line with EUIPO's own practice - will not be exposed to the risk of having their sign declared invalid due to lack of clarity and precision in the indication of the goods and services targeted for protection.

Also, the EUIPO welcomed the clarifications provided by the CJEU on the circumstances required for a trademark to be considered as filed in bad faith, with the consequent risk of a declaration of invalidity of the sign, and took the opportunity to convey certain practical caveats to EU trademarks applicants. Most notably, the European Office warned the applicants against the practice of including, in trademark applications, goods and services which are not consistent with their commercial needs for the sole purpose of extending the scope of exclusive protection or for purposes other than those falling within the functions of a trademark. In the EUIPO's view, trademark applicants who do not comply with this principle could face invalidity actions on the ground of bad faith and be subject to total or partial invalidation of their registration.

2. Publication of the Ministerial Decree that regulates registration in the "special register of historic trademarks of national interest" and identifies the relevant logo in the Official Gazette

On 24 February 2020, the Ministerial Decree of the Ministry of Economic Development dated 10 January 2020 ("MD") was published in the Italian Official Gazette. The MD sets forth "Regulation of the registration in the special

register of historic trademarks of national interest and identification of the «Historic trademark of national interest» logo”, and implements the provisions set forth under Art. 31, paragraph 1, letters a) and b) of Legislative Decree No. 34 of 30 April 2019, converted with amendments by Law No. 58 of 28 June 2019.

The latter Law introduced in the Italian legal system the **possibility, for the owners or the exclusive licensees of trademarks used for at least fifty years** in the marketing of products or services by a national manufacturing company “of excellence” which has been historically linked to the Italian national territory, **to apply for registration in the special register as well as to use the “historic trademark of national interest” logo** (here is the link to our comment on the matter).

As regards the rules governing registration in the special register of trademarks of national interest pursuant to Art. 185-bis of the Italian Industrial Property Code (the “**Register**”), the MD provides that the same shall be requested by filing an application containing the following information:

- (i) **the applicant ID data as well as the qualification thereof** (i.e. owner or exclusive licensee). Where the application is submitted by the exclusive licensee only and no evidence of the trademark owner’s consent is provided, the Italian Patent and Trademark Office will grant both parties the right to provide further elements of proof, in any case giving precedence to the owner's orientation;
- (ii) **details of the first registration and subsequent renewals of the trademark or**, in case a non-registered trademark is concerned, **the documentation certifying its effective and continuous use**, pursuant to Art. 178, paragraph 4, of the Italian Industrial Property Code, for at least fifty years (such documentation being, for example, packaging samples, labels, price lists, catalogues, invoices, shipping or export documents, photographs, newspaper advertisements and written declarations, etc.);
- (iii) **a self-certification** (“dichiarazione sostitutiva”) that the trademark applied for registration in the Register is used to market products or services by a national manufacturing company “of excellence” which has been historically linked to the Italian national territory.

The examination of applications submitted according to the foregoing indications will occur within **sixty days**, in the case of a registered trademark, or within **one hundred and eighty days**, in the case of an unregistered trademark.

According to the MD, **the registration will have unlimited duration and will not be subject to renewal.**

Also, the MD specifies that the “historic trademark of national interest” logo - which **does not constitute a new kind of industrial property right** - may be used solely for commercial and promotional purposes with reference to the products and services to which the trademark included in the Register refers, **provided that any such use complies with the graphic representation and the indications of use contained in Annex A** to the MD.

Lastly, the definition of the procedural matters and the deadline for the submission of applications for inclusion in the Register is referred to a specific measure to be adopted by the Director General for the Protection of Industrial Property - Italian Patent and Trademark Office of the Ministry of Economic Development.

Below is a reproduction of the “historic trademark of national interest” logo contained in Annex A to the MD:



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