

Legislative Decree No 30¹ of 10 February 2005
Industrial Property Code, pursuant to Article 15 of Law No 273 of 12 December 2002, updated following Legislative Decree No 131 of 13 August 2010.

Chapter I
GENERAL PROVISIONS AND BASIC PRINCIPLES
THE PRESIDENT OF THE REPUBLIC

Having regard to Articles 76 and 87 of the Constitution;

Having regard to Law No 273 of 12 December 2002 laying down measures to promote private initiative and the development of competition, as amended by Article 2(8) of Law No 186 of 27 July 2004, converting into law, with amendments, Decree-Law No 136 of 28 May 2004, and as further amended by Article 2 of Law No 306 of 27 December 2004, converting into law, with amendments, Decree-Law No 266 of 9 November 2004, and in particular Article 15 thereof, delegating to the Government for the reorganisation of the provisions on industrial property;

Having regard to Article 14 of Law No 400 of 23 August 1988 governing the activities of Government and the Order of the Presidency of the Council of Ministers;

Having regard to Royal Decree No 1127 of 29 June 1939;

Having regard to Royal Decree No 244 of 5 February 1940;

Having regard to Royal Decree No 1411 of 25 August 1940;

Having regard to Royal Decree No 1354 of 31 October 1941;

Having regard to Royal Decree No 929 of 21 June 1942;

Having regard to Decree No 795 of the President of the Republic of 8 June 1948;

Having regard to Presidential Decree No 540 of 30 June 1972;

Having regard to Decree No 974 of the President of the Republic of 12 August 1975;

Having regard to Decree No 32 of the President of the Republic of 8 January 1979;

Having regard to Decree No 338 of the President of the Republic of 22 June 1979;

Having regard to Law No 194 of 3 May 1985;

Having regard to Law No 620 of 14 October 1985;

Having regard to Law No 60 of 14 February 1987;

Having regard to Law No 70 of 21 February 1989;

Having regard to Law No 349 of 19 October 1991;

Having regard to Decree No 595 of the President of the Republic of 1 December 1993;

Having regard to Decree No 360 of the President of the Republic of 18 April 1994;

Having regard to Presidential Decree No 391 of 18 April 1994;

Having regard to Law No 890 of 21 December 1984;

Having regard to Legislative Decree No 164 of 12 April 2001;

Having regard to paragraphs 8, 8-bis, 8-ter and 8-quater of Article 3 of Decree-Law No 63 of 15 April 2002, converted, with amendments, by Law No 112 of 15 June 2002;

Having regard to the Decree of the Minister for Economic Development of 17 October 2002, published in Official Gazette No 253 of 28 October 2002;

Having regard to the preliminary deliberation of the Council of Ministers, adopted at its meeting of 10 September 2004;

After hearing the opinion of the Council of State, expressed at the General Meeting of 25 October 2004;

Having obtained the opinion of the Unified Conference, as referred to in Article 8 of Legislative Decree No 281 of 28 August 1997, expressed at the sitting of 28 October 2004;

Having obtained the opinions of the competent committees of the Chamber of Deputies, expressed on 22 December 2004 and of the Senate of the Republic, expressed on 21 December 2004;

Having regard to the deliberation of the Council of Ministers, adopted at its meeting of 23 December 2004;

The proposal of the Minister for Economic Development, in consultation with the Ministers for Justice, Economy and Finance, Foreign Affairs and Public Affairs;

And m a n a

the following legislative decree:

Art. 1.

Industrial property rights

1. For the purposes of this Code, the term industrial property includes trademarks and other distinctive signs, geographical indications, designations of origin, designs and designs, inventions, utility models, topographies of semiconductor products, confidential business information and new plant varieties.

Art. 2.

Establishment and acquisition of rights

1. Industrial property rights are acquired by patenting, registration or in other ways provided for in this Code. Patenting and registration give rise to industrial property titles.

2. Inventions, utility models, new plant varieties are patented.

3. Trade marks, designs and topographies of semiconductor goods shall be registered.

4. Distinctive signs other than the registered trade mark, confidential company information, geographical indications and designations of origin are protected by legal requirements.

5. The administrative activity of patenting and registration is a constitutive assessment and gives rise to certificates subject to a special invalidity and revocation procedure on the basis of the rules contained in this Code.

Art. 3.³

Treatment of the foreigner

1. Nationals of each State which are party to the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976 or of the World Trade Organisation and nationals of States not members of the said Conventions, but who are domiciled or have an actual industrial or commercial establishment in the territory of a State which is party to the Paris Union Convention for the Protection of Industrial Property, shall be accorded the same treatment as those covered by this Code. With regard to new plant varieties, the treatment accorded to Italian nationals is granted to nationals of a State party to the International Convention for the Protection of New Plants UPOV, Geneva text of 19 March 1991, ratified by Law No 110 of 23 March 1998. In the case of topographies of semiconductor products, the treatment accorded to Italian nationals shall be granted to nationals of another State only if the protection afforded by that State to Italian nationals is similar to that provided for in this Code.

2. Nationals of States not party to the Paris Union Convention for the Protection of Industrial Property, or of the World Trade Organisation or, as regards new plant varieties, to the International Convention for the Protection of New Plants, shall be accorded, in respect of the matters covered by this Code, the treatment accorded to Italian nationals if the State to which the citizen belongs accords to Italian nationals reciprocity of treatment.

3. All the benefits that the international conventions signed and ratified by Italy recognise to the foreigner in the territory of the State, for the matters referred to in this Code, are automatically extended to Italian citizens.

4. The right to obtain under international conventions the registration in Italy of a trade mark registered previously abroad, to which reference is made in the application for registration, lies with the proprietor of the trade mark abroad, or his successor in law.

5. Legal persons of corresponding nationality shall be equated with citizens.

Art. 4.

Priorities

1. Any person who has duly filed, in or for a State party to an international convention ratified by Italy which recognises the right of priority, an application for industrial property or its successor in title shall enjoy a right of priority from the first application for the filing of an application for an invention patent, utility model, plant variety right, registration of a design or a trade mark, in accordance with the provisions of Article 4 of the Paris Union Convention.

2. The priority period shall be twelve months for invention patents and utility models and plant varieties, six months for designs and trademarks.

3. The right of priority shall be recognised as capable of giving rise to any deposit having the value of a regular national deposit, i.e. to determine the date on which the first application was lodged, under the national law of the State in which it was made, or under bilateral or plurilateral agreements, whatever the further fate of such an application.

Art. 5.

Exhaustion

1. The exclusive powers conferred by this Code on the holder of an industrial property right shall be exhausted once the products protected by an industrial property right have been marketed by the holder or with his consent in the territory of the State or territory of a Member State of the European Community or the European Economic Area.

2. However, this limitation of the holder's powers shall not apply where there are legitimate grounds for the holder to object to the further marketing of the products, in particular where the status of the products is altered or altered after their placing on the market.

3. The exclusive powers conferred by the right in respect of a protected variety, varieties essentially derived from the protected variety where it is not, in turn, a variety essentially derived, varieties which are not clearly distinguished from the protected variety and varieties whose production requires the repeated use of the protected variety, do not extend to acts concerning:

a) propagating material or vegetative propagation, whatever its form,

b) the product of the harvest, including whole plants and parts thereof where such material or product has been disposed of or marketed by the same breeder or with its consent in the territory of the Member State or Member State of the European Community or of the European Economic Area, unless such acts involve a new reproduction or multiplication of the protected variety or an export of the material of the variety which allows it to be reproduced in a State which does not protect the variety of the genus or plant species to which it belongs, unless the exported material is intended for final consumption.

Art. 6.

Communion

1. If an industrial property right belongs to several subjects, the relative faculties are governed, unless otherwise agreed, by the provisions of the Civil Code relating to communion as compatible.

1-bis. In the case of law belonging to several parties, the filing of the patent or registration application, the continuation of the patent or registration procedure, the submission of the application for renewal, where provided for, the payment of the maintenance rights in life, the submission of the Italian translation of the claims of a European patent application or the text of the European patent granted or maintained in an amended or limited form and the other proceedings before the Italian Patent and Trademark Office may be carried out by each of those parties in the interests of all.

Chapter II
RULES RELATING TO THE EXISTENCE, SCOPE AND EXERCISE OF THE RIGHTS OF
INDUSTRIAL PROPERTY

Section I

Brands

Art. 7.

Subject of registration

1. All signs liable to be represented graphically, in particular words, including names of persons, drawings, letters, figures, sounds, the shape of the product or of the packaging thereof, combinations or shades of colour, may be the subject of registration as a trade mark, provided that they are capable of distinguishing the goods or services of an undertaking from those of other undertakings.

Art. 8.

Portraits of people, names and well-known signs

1. Portraits of persons may not be registered as trademarks without their consent and, after their death, without the consent of their spouse and children; in their absence or after their death, parents and other ascendants, and, in the absence or after the death of the latter, relatives up to the fourth degree included.

2. Personal names other than those of the person applying for registration may be registered as trademarks, provided that their use is not such as to affect the reputation, credit or decorum of those who have the right to bear such names. However, the Italian Patent and Trademark Office has the right to make the registration subject to the consent provided for in paragraph 1. In any case, the registration will not prevent those entitled to the name from making use of it in the company chosen by him, under the conditions set out in Article 21(1).

3. If notorious, they may be registered or used as a trademark only by the right holder, or with the consent of the latter, or the subjects referred to in paragraph 1: the names of persons, the signs used in the artistic, literary, scientific, political or sporting fields, the names and acronyms of events and those of bodies and associations not having economic purposes, as well as the emblems characteristic of these.

Art. 9.

Shape Marks

1. Signs consisting exclusively of the shape imposed by the nature of the goods, the shape of the product necessary to obtain a technical result, or the shape which gives substantial value to the product may not be registered as a trade mark.

Art. 10.

Coats of arms

2. The coat of arms and other signs referred to in the relevant international conventions, in the cases and under the conditions referred to in those conventions, and signs containing symbols, emblems and coats of arms of public interest may not be registered as a trade mark, unless the competent authority has authorised their registration.

3. In the case of a trade mark containing words, figures or signs with political meaning or of high symbolic value, or containing heraldic elements, the Italian Patent and Trademark Office shall, prior to registration, send the copy of the mark and whatever may be necessary to the public authorities concerned, or competent, to hear the notice thereof, in accordance with the provisions of paragraph 4.

4. The Italian Patent and Trademark Office has the right to provide in accordance with paragraph 2 in any case in which there is doubt that the trade mark may be contrary to law, public order or good morality.

5. If the administration concerned, or competent, referred to in paragraphs 2 and 3, expresses a notice contrary to the registration of the trade mark, the Italian Patent and Trademark Office shall reject the application.

Art. 11.

Collective brand

1. Persons who perform the function of guaranteeing the origin, nature or quality of certain goods or services may obtain registration for specific marks as collective marks and have the right to grant the use of the marks to producers or traders.

2. Regulations on the use of collective marks, controls and penalties should be annexed to the application for registration; regulatory amendments must be communicated by the holders to the Italian Patent and Trademark Office in order to be included in the documents annexed to the application.

3. The provisions of paragraphs 1 and 2 are also applicable to foreign collective marks registered in the country of origin.

4. By way of derogation from Article 13(1), a collective mark may consist of signs or indications which may serve in trade to designate the geographical origin of the goods or services. In that case, however, the Italian Patent and Trademark Office may, by reasoned measure, refuse registration where the trade marks applied for may create situations of unjustified privilege or otherwise undermine the development of other similar initiatives in the region. The Italian Patents and Trademark Office may request notice from the public administrations, categories and bodies concerned or competent in this regard. The registration of the collective mark consisting of a geographical name does not authorise the proprietor to prohibit third parties from using the name in trade, provided that such use is in accordance with the principles of professional correctness.

5. Collective marks are subject to all other provisions of this Code as they do not conflict with their nature.

Art. 12.⁴

News

1. Signs which, at the date of filing of the application, may not be registered as a trade mark:

a) are they identical or similar to a sign already known as a trade mark or distinctive sign of goods or services manufactured, marketed or supplied by others for identical or similar goods or services, if due to the identity or similarity between the signs and the identity or affinity between the goods or services there is a likelihood of confusion on the part of the public, which may also consist of a risk of association between the two signs. The trade mark is also considered to be known under Article 6-bis of the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976, known to the public concerned, also by virtue of the reputation acquired in the State through the promotion of the trade mark. Previous use of the sign, where it does not amount to a reputation of it, or amounts to a purely local reputation, does not remove the novelty, but the third party pre-user has the right to continue the use of the mark, including for the purposes of advertising, within the limits of local circulation, despite the registration of the mark itself. The previous use of the sign by the applicant or his predecessor is not an obstacle to registration;

b) are they identical or similar to a sign already known as a company, name or business name, teaches and domain name used in the economic activity, or other distinctive sign adopted by others, if, because of the identity or similarity between the signs and the identity or affinity between the business activity carried out by the latter and the goods or services for which the trade mark is registered, there may be a likelihood of confusion on the part of the public, which may also consist of a risk of association between the two signs? The previous use of the sign, when it does not amount to notoriety of it, or amounts purely local notoriety, does not remove the novelty. The previous use of the sign by the applicant or his predecessor is not an obstacle to registration;

c) are identical to a trade mark already registered by others in the State or effective in the State following an application filed on an earlier date or having effect from an earlier date under a right of priority or valid seniority claim for identical goods or services;

d) are identical or similar to a trade mark already registered in the State or with effect in the State, following an application lodged at an earlier date or having effect from an earlier date on the basis of a right of priority or a valid seniority claim for identical or similar goods or services, if due to the identity or similarity between the signs and the identity or affinity between the goods or services there is a likelihood of confusion on the part of the public, which may also consist of a risk of association between the two signs;

e) are identical or similar to a trade mark already registered in the State or with effect in the State, following an application filed on an earlier date or having effect from an earlier date on the basis of a right of priority or a valid seniority claim for goods or services which are also unrelated, where the earlier mark enjoys in the Community, if Community, or in the State, renown and where the use of the next without due cause would unduly take advantage of the distinctive character or reputation of the earlier sign or would adversely affect them;

f) are identical or similar to a trade mark already known within the meaning of Article 6-bis of the Paris Convention for the Protection of Industrial Property, for even unrelated goods or services when the conditions set out in point (e) are met.

2. In the cases referred to in points (c), (d) and (e), the earlier mark which has expired for more than two years or three years in the case of a collective mark or can be considered to have been terminated for non-use within the meaning of Article 24 at the time of lodging the application or the objection of invalidity shall not remove the novelty.

3. For the purposes referred to in paragraph 1, points (c), (d) and (e), the earlier applications shall be treated as the earlier registered marks, subject to the subsequent registration.

Art. 13.

Distinctive ability

1. Signs devoid of distinctive character and in particular:

a) those which consist exclusively of signs which have become commonly used in the current language or the constant uses of trade;

b) those consisting exclusively of generic names of goods or services or descriptive indications referring to them, such as signs which in the market may serve to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of manufacture of the product or service or other characteristics of the product or service.

2. By way of derogation from paragraph 1, signs which, as a result of their use, have acquired distinctive character prior to the application for registration may be registered as a trade mark.

3. The trade mark may not be declared invalid if, prior to the lodging of the application or the objection of invalidity, the sign which is the subject of it, as a result of its use, has acquired distinctive character.

4. The trade mark shall expire if, as a result of the activity or inactivity of its proprietor, the trade mark has become a generic name of the product or service or has in any event lost its distinctive capacity.

Art. 14.

Lawfulness and rights of third parties

1. The following may not be registered as a trade mark:

a) signs contrary to law, public order or morality;

b) signs capable of misleading the public, in particular as to the geographical origin, nature or quality of the goods or services;

c) signs whose use would constitute a violation of a third party's copyright, industrial property or other exclusive right.

2. The trade mark shall expire:

- a) is it likely to mislead the public, in particular as to the nature, quality or provenance of the goods or services, due to the manner and context in which it is used or with his consent, for the goods or services for which it is registered;
- b) has it become contrary to the law, public order or morality?
- c) omission by the proprietor of the controls provided for in the regulatory provisions on the use of the collective mark.

Art. 15.

Effects of registration

1. The exclusive rights considered by this code are conferred upon registration.
2. The effects of the first registration shall take effect from the date of filing of the application. As a matter of fact, the effects of the renewal start from the date of expiry of the previous registration.
3. Without prejudice to Article 20(1)(c), registration shall have effect limited to the goods or services indicated in the registration and related goods or services.
4. Registration shall last 10 years from the date of filing of the application, except in the case of waiver by the holder.

5. The waiver becomes effective with its entry in the trade mark register and must be reported in the Official Bulletin.

Art. 16.⁵

Refurbishment

1. Registration may be renewed for the same earlier mark, with regard to the same kind of goods or services under the International Classification of Goods and Services resulting from the Nice Agreement, Geneva text of 13 May 1977, ratified by Law No 243 of 27 April 1982.
2. The renewal takes place for periods of ten years. 3. The renewal of the registration of a trade mark which has been transferred for part of the goods or services shall be carried out separately from the respective proprietors.
4. The start and duration of the registration for trademarks registered with the World Intellectual Property Organisation in Geneva shall remain unchanged.

Art. 17.⁶

International registration

1. For the registration of trademarks with the World Intellectual Property Organisation in Geneva (WIPO), the provisions in force under international conventions remain firm.
2. International trade marks registered at the World Intellectual Property Organisation (WIPO) in Geneva under the Madrid Agreement on the International Registration of Trade Marks, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976, and its Protocol, adopted in Madrid on 27 June 1989, ratified by Law No 169 of 12 March 1996, bearing the designation of Italy as the country in which protection is sought, must comply with the requirements for national trade marks under this Code.
3. The Italian Patent and Trademark Office shall carry out the examination of international trade marks designating Italy in accordance with the provisions applicable to national trade mark applications.

Art. 18.

Temporary protection

1. Within the limits and under the conditions set out in paragraph 2, temporary protection may be granted by decree of the Minister for Economic Development to new marks affixed to the goods or materials relating to the provision of services contained in national or international exhibitions, official or officially recognised, held in the territory of the State or in a foreign State which accords reciprocity of treatment.

2. Temporary protection shall trace the priority of registration, in favour of the holder or his successor, to the day of delivery of the product or material relating to the performance of the service for the exhibition, and shall always have the effect that the application for registration is filed within six months of the date of delivery and, in any event, no later than six months from the date of the opening of the exhibition.

3. In the case of exposure held in a foreign State, if a shorter period is established there, the application for registration must be filed within that period.

4. Among several identical or similar trade marks for identical or similar goods or services submitted for exhibition on the same day, priority lies with the trade mark for which the application for registration was filed first.

5. The dates referred to in paragraphs 2, 3 and 4 must be indicated by the person concerned and mentioned in the certificate of registration, subject to their verification by the Italian Patent and Trademark Office.

Art. 19.

Right to registration

1. You may obtain a trade mark registration if you use it or intend to use it, in the manufacture or trade in goods or in the provision of services of your undertaking or undertakings over which you have control or use it with your consent.

2. The person who has made the application in bad faith cannot obtain a trade mark registration.

3. The administrations of the State, regions, provinces and municipalities may also obtain trade mark registrations, including distinctive graphic elements drawn from the cultural, historical, architectural or environmental heritage of the relevant territory; in the latter case, the proceeds from the exploitation of the brand for commercial purposes, including that carried out through licensing and merchandising activities, shall be allocated to the financing of institutional activities or to cover any past deficits of the institution.

Art. 20.

Rights conferred by registration

1. The rights of the proprietor of the registered trade mark consist of the right to make exclusive use of the trade mark. The holder has the right to prohibit third parties, unless their consent, from using in the economic activity:

a) a sign identical to the trade mark for goods or services identical to those for which it was registered;

b) a sign identical or similar to the registered trade mark, for identical or similar goods or services, if, because of the identity or similarity between the signs and the identity or affinity between the goods or services, there is a likelihood of confusion on the part of the public, which may also consist of a risk of association between the two signs;

c) a sign which is identical or similar to the trade mark registered for goods or services which are also unrelated, if the registered trade mark enjoys a state of renown and if the use of the sign without due cause makes it possible to unduly take advantage of the distinctive character or reputation of the mark or adversely affects them.

2. In the cases referred to in paragraph 1, the proprietor of the trade mark may in particular prohibit third parties from affixing the sign to the goods or their packaging; to offer the goods, to place them on the market or to hold them for those purposes, or to offer or provide the services marked by

the sign; to import or export goods bearing the sign itself; use the sign in commercial correspondence and advertising.

3. The trader may affix his trademark to the goods he puts for sale, but he cannot delete the mark of the manufacturer or trader from which he received the products or goods.

Art. 21.

Limitations of trade mark law

1. Registered trademark rights do not allow the proprietor to prohibit third parties from using in the economic activity, provided that the use complies with the principles of professional correctness:

a) their name and address;

b) particulars relating to the species, quality, quantity, destination, value, geographical origin, when the product was manufactured or the service was provided or other characteristics of the product or service;

c) the trade mark if it is necessary to indicate the destination of a product or service, in particular as accessories or spare parts.

2. It is not permitted to use the trade mark in a manner contrary to the law, nor, in particular, to create a likelihood of confusion on the market with other signs known as hallmarks of undertakings, goods or services of others, or to mislead the public, in particular as to the nature, quality or provenance of the goods or services, due to the manner and context in which it is used, or by injuring another copyright, industrial property, or other exclusive right of third parties.

3. It is prohibited for anyone to make use of a registered trade mark after its registration has been declared void, when the cause of invalidity entails the illegality of the use of the mark.

Art. 22.

Unity of distinctive signs

1. It is prohibited to adopt as a company, name or business name, teach and domain name of a site used in the economic activity or other distinctive sign a sign equal to or similar to another trade mark if, due to the identity or affinity between the business activity of the owners of those signs and the goods or services for which the mark is adopted, there is a likelihood of confusion on the part of the public which may also consist of a risk of association between the two signs.

2. The prohibition referred to in paragraph 1 extends to the adoption as a company, name or business name, teaches and domain name of a site used in the economic activity or other distinctive sign of a sign equal to or similar to a trade mark registered for goods or services also not related, which enjoys in the State of renown if the use of the sign without due cause makes it possible to unduly take advantage of or harm the distinctive character or reputation of the mark.

Art. 23.

Transfer of the brand

1. The trade mark may be transferred for all or part of the goods or services for which it has been registered.

2. The trademark may also be licensed non-exclusively for all or part of the goods or services for which it has been registered and for all or part of the territory of the State, provided that, in the case of a non-exclusive licence, the licensee expressly undertakes to use the trade mark to distinguish goods or services equal to those which are marketed or supplied in the territory of the State under the same trademark by the proprietor or other licensees.

3. The proprietor of the trade mark may assert the right to exclusive use of the trade mark against the licensee who infringes the provisions of the licence agreement relating to the duration of the trade

mark; the manner in which the trade mark is used, the nature of the goods or services for which the licence is granted, the territory in which the trade mark may be used, or the quality of the products manufactured and the services provided by the licensee.

4. In any event, the transfer and license of the trademark must not result in deception in those characteristics of the goods or services which are essential in the appreciation of the public.

Art. 24.

Use of the brand

1. Under penalty of revocation, the mark must be the subject of genuine use by the proprietor or with his consent, for the goods or services for which it has been registered, within five years of registration, and such use must not be suspended for an uninterrupted period of five years, unless the non-use is justified by a legitimate reason.

1-bis. In the case of an international trade mark designating Italy and registered under the Madrid Agreement for the International Registration of Trade Marks, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976 or its Protocol of 27 June 1989, ratified by Law No 169 of 12 March 1996, the period referred to in paragraph 1 shall run from the date on which the Italian Patent and Trademark Office expires for making the provisional refusal referred to in Article 171 or, where the registration has been provisionally refused, from the date on which the Italian Patent and Trademark Office confirms the protection of the international registration in Italy definitively.

2. For the purposes referred to in this Article, the use of the mark in modified form shall be treated as the use of the mark in a modified form which does not alter its distinctive character and the affixing in the State of the trade mark to the goods or their packaging for the purpose of exporting them.

3. Except in the case of rights acquired on the trade mark by third parties by filing or use, revocation may not be enforced if genuine use of the mark has commenced or resumed genuine use of the mark between the expiry of the five-year period of non-use and the lodging of the application or exception for revocation. However, if the proprietor makes preparations for the commencement or resumption of use of the mark only after he has known that the application or exception of revocation is to be submitted, such commencement or resumption shall not be taken into account unless carried out at least three months before the application is lodged or the exception of revocation; however, that period is only relevant if it has expired after the expiry of the five-year period of non-use.

4. Nor will the revocation for non-use take place if the proprietor of the unused trade mark is, at the same time, the proprietor of another or other similar trade marks still in force of at least one of which is actually used to distinguish the same goods or services.

Art. 25.

Nullity

1. The trade mark is null and void:

a) if it does not meet any of the requirements laid down in Article 7 or if there is one of the impediments provided for in Article 12;

b) if it is contrary to the provisions of Articles 9, 10, 13, 14(1) and 19(2);

c) if it is contrary to the provisions of Article 8;

d) in the case of Article 118(3)(b).

Art. 26.

Decadence

1. The brand decays:

a) by vulgarisation within the meaning of Article 13(4);

b) for illegality which has occurred pursuant to Article 14(2);

c) for non-use within the meaning of Article 24.

Art. 27.

Forfeiture and partial nullity

1. If the grounds for revocation or invalidity of a trade mark exist only for part of the goods or services for which the trade mark is registered, the revocation or invalidity concerns only that part of the goods or services.

Art. 28.

Validation

2. The proprietor of an earlier trade mark within the meaning of Article 12 and the proprietor of a right of pre-use which amounts to a reputation which is not purely local, which has, during five consecutive years, tolerated, being aware of it, the use of an equal or similar later registered mark, shall not apply for the declaration of invalidity of the later trade mark or oppose the use of the later trade mark for goods or services in respect of which that mark was used on the basis of its earlier mark or foreclosure, unless the later trade mark has been applied for in bad faith. The proprietor of the later mark may not oppose the use of the earlier mark or the continuation of the pre-use.

3. The rules of paragraph 1 also apply to the case of a registered trademark in violation of Articles 8 and 14, paragraph 1, letter c).

Section II

Geographical indications

Art. 29.

Subject of protection

1. Geographical indications and designations of origin identifying a country, region or locality shall be protected when they are adopted to designate a product originating therein and whose quality, reputation or characteristics are due exclusively or essentially to the geographical environment of origin, including natural, human and traditional factors.

Art. 30.

Protection

2. Without prejudice to the rules of unfair competition, without prejudice to the relevant international conventions and without prejudice to trade mark rights previously acquired in good faith, the use of geographical indications and designations of origin and the use of any means in the description or presentation of a product indicating or suggesting that the product originates from a place other than the actual place of origin or that the product has the characteristics of products originating from a place designated by a geographical indication shall be prohibited, without prejudice to the relevant international conventions on trade mark rights acquired in good faith.

3. The protection referred to in paragraph 1 does not make it possible to prohibit third parties from using their name or the name of their originator in the business in the economic activity, unless that name is used in such a way as to deceive the public.

Section III

Designs and models

Art. 31.

Subject of registration

1. The appearance of the whole or part of the product as a design may be registered, in particular

from the characteristics of the lines, contours, colours, shape, surface structure or materials of the product itself or its ornament, provided that they are new and have an individual character.

2. A product means any industrial or artisanal object, including, inter alia, components which must be assembled to form a complex product, packaging, presentations, graphic symbols and typographical characters, excluding computer programs.

3. A complex product means a product consisting of several components that can be replaced, allowing disassembly and a new assembly of the product.

Art. 32.

News

1. A design shall be new if no identical design has been disclosed before the date of submission of the application for registration, or, where priority is claimed, prior to the date of the application for registration. Designs are considered identical when their characteristics differ only in irrelevant details.

Art. 33.

Individual character

1. A design is of an individual character if the overall impression on the informed user differs from the general impression on that user by any design that has been disclosed before the date of submission of the application for registration or, where priority is claimed, before the date of the application for registration.

2. When determining the individual character referred to in paragraph 1, the margin of freedom from which the author has benefited in carrying out the design shall be taken into account.

Article 33-a

Lawfulness

1. A design contrary to public policy or morality may not be registered; the design cannot be considered contrary to public policy or morality solely because it is prohibited by a legal or administrative provision.

2. A design which constitutes improper use of one of the elements listed in Article 6-ter of the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976, or signs, emblems and coats of arms other than those covered by that article and which are of particular public interest in the State may not be registered.

Art. 34.

Disclosure

1. For the purposes of Articles 32 and 33, the design shall be deemed to have been disclosed if it has been made available to the public as a result of registration or otherwise, or if it has been exposed, marketed or otherwise made public, unless such events could reasonably be known by the specialised circles of the sector concerned, operating in the Community, in the course of normal commercial activity, before the date of submission of the application for registration or, where priority is claimed, before the date of its date.

2. The design shall not be deemed to have been made available to the public solely because it has been disclosed to a third party under explicit or implicit confidentiality.

3. For the purposes of applying Articles 32 and 33, the design disclosed by the author or his successor in law or by any third party shall not be deemed to have been made available to the public by virtue of information or acts carried out by the author or his successor in law within 12 months prior to the date of submission of the application for registration or, where priority is claimed, during the 12 months preceding the date of the application.

4. Nor shall it constitute disclosure, for the purposes of Articles 32 and 33, that the design was made available to the public during the 12 months preceding the date of submission of the application or the priority date, if this results, directly or indirectly, from an abuse committed against the author or his successor.

Art. 35.

Complex product

1. The design applied or incorporated into the component of a complex product shall meet the requirements of novelty and individual character only:

a) if the component, once incorporated into the complex product, remains visible during normal use, i.e. during use by the final consumer, excluding maintenance, servicing and repair;

b) whether the visible characteristics of the component themselves meet the requirements of novelty and individuality.

Art. 36.

Technical function

1. Those characteristics of the appearance of the product which are determined solely by the technical function of the product may not be registered as designs.

2. The characteristics of the appearance of the product which must necessarily be reproduced in their exact shapes and dimensions may not be registered by design in order to enable the product in which the design is incorporated or to which it is applied to be joined or mechanically connected with another product, or to be incorporated into it or around or in contact with it, so that each product can perform its function. However, designs which meet the requirements of novelty and individual character may be registered when they are intended to allow the combination or multiple connection of interchangeable products in a modular system.

Art. 37.

Duration of protection

1. The registration of the design shall last five years from the date of submission of the application. The holder may obtain the extension of the duration for one or more periods of five years up to a maximum of twenty-five years from the date of submission of the application for registration.

Art. 38.

Right to registration and effects

1. Exclusive rights to designs shall be granted by registration.

2. The right to registration is vested in the author of the design and his successors in law.

3. Unless otherwise agreed, registration for designs, which are the work of employees, as such work falls within their duties, is the responsibility of the employer, without prejudice to the employee's right to be recognised as the author of the design and to have his name included in the registration certificate.

4. The effects of the registration shall start from the date on which the application with the relevant documentation is made available to the public.

5. The Italian Patents and Trademark Office shall make available to the public the application for registration with graphic reproductions or samples and any descriptions after filing, provided that the applicant has not excluded accessibility in the application for a period not exceeding thirty months from the date of filing or priority.

6. In respect of persons to whom the application with the reproduction of the design and any description has been notified by the applicant, the effects of the registration shall take effect from the date of such notification.

Art. 39.

Multiple registration

1. By a single application, registration may be sought for several designs, provided that they are intended to be implemented or incorporated into objects in the same class as the International Classification of Designs, formed pursuant to the provisions of the Locarno Agreement of 8 October 1968, as subsequently amended, ratified by Law No 348 of 22 May 1974.

2. Without prejudice to paragraph 1 and Article 40, an application for several registrations or a single registration for several designs shall not be permitted. If the application is not admissible, the Italian Patent and Trademark Office shall invite the person concerned, by giving him a deadline, to limit the application to the eligible party, with the right to submit, for the remaining designs, as many applications that will take effect from the date of the first application.

3. Registration of several models or designs may be limited at the request of the proprietor to one or more of them.

4. An application or registration in respect of a design which does not meet the requirements of validity, at the request of the proprietor, may be maintained in an amended form, if the Italian Patent and Trademark Office verifies that in that form the design retains its identity. The amendment may also result from partial waiver by the holder or from the note on the certificate of registration of a judgment declaring the partial invalidity of the registration.

Art. 40.

Contemporary recording

1. If a design meets the requirements of registrability and at the same time increases the usefulness of the object to which it refers, the patent per utility model and the registration per design may be applied for at the same time, but both protections cannot be combined in a single title.

2. If the application for registration includes an object whose shape or design gives it a new and individual character and at the same time increases its usefulness, the restriction procedure referred to in Article 39(2) shall apply by making the necessary amendments.

Art. 41.

Rights conferred by the design

1. The registration of a design gives the owner the exclusive right to use it and to prohibit third parties from using it without his consent.

2. In particular, the manufacture, offer, marketing, import, export or use of a product in which the design is incorporated or to which it is applied or the holding of that product for those purposes shall constitute acts of use.

3. The exclusive rights conferred by the registration of a design shall extend to any design which does not produce in the informed user a different general impression.

4. When determining the extent of protection, account shall be taken of the author's margin of freedom in the realisation of the design.

Art. 42.

Limitations on design law

1. The rights conferred by the registration of the design shall not extend:

- a) acts carried out in private and for non-commercial purposes;
- b) acts carried out for the purpose of experimentation;

c) acts of reproduction necessary for quotations or educational purposes, provided that they are compatible with the principles of professional correctness, do not unduly prejudice the normal use of the design and the source is indicated.

2. The exclusive rights conferred by the registration of the design shall not be exercised in

respect of:

- a) the furnishing and installation of naval and air locomotion vehicles registered in other countries temporarily entering the territory of the State;
- b) the importation into the State of spare parts and accessories for the repair of the means of transport referred to in point (a);
- c) to carry out repairs on the aforementioned means of transport.

Art. 43.⁷

Nullity

1. Registration is nothing:

- a) if the design cannot be registered in accordance with Articles 31, 32, 33, 34, 35 and 36;
- b) if the design is contrary to public policy or to good morality; the design cannot be considered contrary to public policy or morality solely because it is prohibited by a legal or administrative provision;
- c) if the holder of the registration was not entitled to obtain it and the author did not avail himself of the powers granted to him by Article 118;
- d) if the design conflicts with an earlier design which has been made known after the date of submission of the application or, where priority is claimed, after the date of the latter but whose exclusive right runs from an earlier date as a result of Community, national or international registration or the application for that design;
- e) if the design is such that its use would constitute an infringement of a distinctive sign or of a work of ingenuity protected by copyright;
- f) if the design constitutes improper use of one of the elements listed in Article 6-ter of the Paris Union Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976, or signs, emblems and coats of arms other than those covered by that article and which are of particular public interest in the State.

2. The invalidity of the registration of the design which is the subject of earlier rights pursuant to paragraphs 1(d) and (e) may be promoted only by the holder of those rights or by his successors in law.

3. The invalidity of the registration of a design constituting improper use of one of the elements listed in Article 6-ter of the Paris Convention for Industrial Protection or of signs, emblems and coats of arms which are of particular public interest in the State may be relied upon only by the person concerned for use.

Art. 44.⁸

Duration of the right of economic use by copyright

1. The rights of economic use of industrial designs protected under Article 2, first paragraph, number 10, of Law No 633 of 22 April 1941, last the entire life of the author and until the end of the sixtieth⁹ calendar year after his death or after the death of the last of the co-authors.

2. Suppressed
3. Suppressed

Section IV

Inventions

Art. 45.

Subject matter of the patent

1. Inventions of every sector of technology, which are new and involving inventive activity and are suitable for industrial application, may be the subject of patents for invention.

2. The following shall not be considered as inventions within the meaning of paragraph 1, in particular:

- a) discoveries, scientific theories and mathematical methods;
- b) plans, principles and methods for intellectual, gaming or commercial activities and computer programs;

c) presentations of information.

3. The provisions of paragraph 2 exclude the patentability of what is named therein only to the extent that the patent application or patent concerns discoveries, theories, plans, principles, methods, programmes and presentations of information considered as such.

4. The following shall not be the subject of a patent:

a) methods for surgical or therapeutic treatment of the human or animal body and methods of diagnosis applied to the human or animal body;

b) plant varieties and animal breeds and essentially biological processes for the production of animals or plants, including new plant varieties in respect of which the invention consists exclusively of the genetic modification of another plant variety, even if that modification is the result of a genetic engineering process.

5. The provision of paragraph 4 shall not apply to microbiological processes and products obtained by these processes, and to products, in particular substances or compositions, for the use of any of the specified methods.

5-bis. Biotechnological inventions referred to in Article 81d may not be the subject of *apatent*.

Art. 46.

News

1. An invention is considered new if it is not included in the state of technology.

2. The state of the technique shall consist of everything which has been made available to the public in the territory of the State or abroad before the date of filing of the patent application, by means of a written or oral description, use or any other means.

3. The content of Italian patent applications or European patent applications designating Italy, as filed, which have a filing date prior to that referred to in paragraph 2 and which have also been published or made available to the public on that date or later, shall also be regarded as being included in the state of the art.

4. The provisions of paragraphs 1, 2 and 3 do not exclude the patentability of a substance or composition of substances already included in the state of the art, provided that they are based on a new use.

Art. 47.

Unenforceable disclosures and internal priorities

1. For the purposes of Article 46, disclosure of the invention shall not be taken into account if it occurred within the six months preceding the date of filing of the patent application and results directly or indirectly from an obvious abuse of the applicant or his or her predecessor.

2. Disclosure in official or officially recognised exposures under the Convention on International Expos signed in Paris on 22 November 1928, as amended, shall also not be taken into account.

3. For inventions for which priority has been claimed under international conventions, the state of the relevant technique under Articles 46 and 48 must be assessed by reference to the date on which the priority dates.

4. I'm sorry. For invention patents and utility models, the national filing in Italy also gives rise to the right of priority over a subsequent national application filed in Italy, in relation to elements already contained in the application for which priority is claimed.¹⁰

Art. 48.

Inventive Activity

1. An invention is considered to involve inventive activity if, for an expert in the branch, it is not evident from the state of the technique. Where the state of the technique includes documents referred to in paragraph 3 of Article 46, these documents shall not be taken into account for the appreciation of inventiveness.

Art. 49.

Industriality

1. An invention is considered to have an industrial application if its object can be manufactured or used in any kind of industry, including agriculture.

Art. 50.

Lawfulness

1. Inventions whose implementation is contrary to public policy or morality may not be the subject of patents.

2. The implementation of an invention cannot be regarded as contrary to public policy or morality solely because it is prohibited by a legal or administrative provision.

Art. 51.

Sufficient description

1. The application for the grant of a patent for industrial invention must be accompanied by the description, claims and drawings necessary for its intelligence.

2. The invention must be described in a sufficiently clear and complete manner for each expert in the branch to be able to implement it and must be distinguished by a title corresponding to its object.

3. If an invention relates to a microbiological process or a product obtained by such a process and involves the use of a micro-organism not accessible to the public and which cannot be described in such a way as to enable every expert in the branch to implement the invention, the rules laid down in Article 162 shall be observed in the patent application.

Art. 52.

Claims

1. The claims indicate, specifically, what is intended to be the subject of the patent.

2. The limits of protection are determined by claims; however, the description and the drawings serve to interpret the claims.

3. The provision of paragraph 2 shall be construed in such a way as to ensure at the same time fair protection to the holder and reasonable legal security to third parties.

3-bis. In order to determine the scope of the protection conferred by the patent, account shall be taken of any element equivalent to an element indicated in the claims.

Art. 53.

Effects of Patenting

1. The exclusive rights considered by this code are conferred with the grant of the patent.

2. The effects of the patent shall run from the date on which the application with the description, claims and drawings, if any, is made available to the public.

3. After the period of eighteen months from the date of filing of the application or the priority date, or 90 days after the date of filing of the application, if the applicant has stated in the application

that he wishes to make it immediately accessible to the public, the Italian Patents and Trademark Office shall make the application available to the public with the annexes.

4. In respect of persons to whom the application with the description, claims and drawings has been notified by the applicant, the effects of the industrial invention patent shall run from the date of such notification.

Art. 54.¹¹

Effects of the European patent application

1. The protection conferred by the European patent application pursuant to Article 67(1) of the European Patent Convention of 5 October 1973, ratified by Law No 260 of 26 May 1978, shall start from the date on which the proprietor made available to the public, through the Italian Patent and Trademark Office, a translation of the claims into Italian or has notified it directly to the alleged infringer. Except as provided for in Article 46(3), the effects of the European patent application shall be regarded as void by origin where the application has been withdrawn or rejected or where the designation of Italy has been withdrawn.

Art. 55.¹²

Effects of the designation or election of Italy

1. The international application filed under the Patent Cooperation Treaty, ratified by Law No 260 of 26 May 1978 and containing the designation or election of Italy, is equivalent to a European patent application in which Italy has been designated and produces its effects under the conditions and conditions laid down for Euro-PCT applications by the European Patent Convention of 5 October 1973, ratified by Law No 260 of 26 May 1978 and its implementing rules.

Art. 56.

Rights conferred by the European patent

1. The European patent granted for Italy confers the same rights and is subject to the same regime as Italian patents from the date on which the mention of the grant of the patent is published in the European Patent Bulletin. Where the patent is subject to opposition or limitation proceedings, the scope of protection established by the grant or maintenance decision in amended form or by the restriction decision shall be confirmed from the date on which the reference to the decision concerning the opposition or limitation is published.

2. Counterfeits are assessed in accordance with the relevant Italian legislation.

3. The proprietor must provide the Italian Patent and Trademark Office with a translation into Italian of the text of the patent granted by the European Office and of the text of the patent maintained in an amended form following the opposition or restricted procedure following the limitation procedure.

4. The translation, declared perfectly in conformity with the original text by the patent holder or his authorised representative, must be filed within three months of the date of each of the publications referred to in paragraph 1.

5. In the event of non-compliance with the provisions of paragraphs 3 and 4, the European patent shall be considered, from its origin, to be without effect in Italy.

Art. 57.¹³

Text of the authentic European patent or application

1. The text of the European patent application or of the European patent, drawn up in the language of procedure before the European Patent Office, shall be authentic as regards the extension of protection, subject to Article 70(2) of the European Patent Convention of 5 October 1973, ratified

by Law No 260 of 26 May 1978.

2. However, the translation into Italian of documents relating to the application lodged or the European patent granted shall be considered authentic in the territory of the State if it confers less extensive protection than that conferred by the text drawn up in the language of procedure of the European Patent Office.

3. The provision referred to in paragraph 2 shall not apply in the case of nullity action.

4. A corrected translation may be submitted at any time by the holder of the application or patent; it has effect only after it has been made available to the public at the Italian Patent and Trademark Office or notified to the alleged infringer.

5. Anyone who, in good faith, has begun to implement an invention in Italy or has made effective preparations for this purpose without that implementation constituting infringement of the application or of the patent in the text of the translation initially submitted, may continue, free of charge, to exploit the invention in his company or for the needs of it even after the corrected translation has taken effect.

Art. 58.¹⁴

Transformation of the European patent application

1. The European patent application, in which Italy has been designated, may be converted into an Italian patent application for industrial invention:

a) in the cases provided for in Article 135(1)(a) of the European Patent Convention of 5 October 1973, ratified by Law No 260 of 26 May 1978;

b) in the event of non-compliance with the period laid down in Article 14(2) of the European Patent Convention, where the application was originally filed in Italian.

2. The conversion into a national application by utility model of a rejected, withdrawn or withdrawn European patent application or of the revoked European patent whose object has the patentability requirements laid down by Italian legislation for utility models is permitted.

3. Those who request the transformation referred to in paragraph 1 shall be allowed to request at the same time any conversion into a utility model application pursuant to Article 84.

4. If a regular request for conversion pursuant to paragraphs 1, 2 and 3 has been sent to the Italian Patent and Trademark Office, the patent application shall be deemed to have been filed in Italy on the same date as the European patent application; the documents annexed to that application which have been lodged with the European Patent Office shall be deemed to have been lodged in Italy on the same date.

Art. 59.

Primacy of the European patent in the event of cumulation of protections

1. Where, for the same invention, an Italian patent and a European patent valid in Italy have been granted to the same inventor or his successor with the same filing or priority date, the Italian patent, in so far as it protects the same invention as the European patent, shall cease to have effect on the date on which:

a) the deadline for promoting opposition to the European patent has expired without opposition being lodged;

b) the opposition procedure was definitively concluded with the maintenance of the European patent;

c) the Italian patent has been granted, if that date is later than that referred to in points (a) or (b).

2. The provisions of paragraph 1 shall remain valid even if, subsequently, the European patent is annulled or terminated.

3. Upon expiry of the period referred to in paragraph 1, the person who has brought an action to

protect the Italian patent may request its conversion into the corresponding action to protect the European patent, without prejudice to the rights arising from the Italian patent for the earlier period.

Art. 60.

Duration

1. The patent for industrial invention lasts twenty years from the date of filing of the application and may not be renewed or extended.

Art. 61.¹⁵

Supplementary certificate for medicinal products and plant protection products

1. Without prejudice to the provisions for supplementary certificates referred to in Article 81(1) to (4), supplementary certificates for medicinal products and supplementary certificates for plant protection products shall be granted by the Italian Patent and Trademark Office on the basis of Regulations (EC) No 469/2009, (EC) No 1901/2006 and (EC) No 1610/96 and shall have the effect provided for in those Regulations.

Art. 62.

Moral Right

1. The right to be recognised as the author of the invention may be asserted by the inventor and, after his death, by his spouse and descendants up to the second degree; in their absence or after their death, by their parents and other ascendants, and in absence, or after the death of them, by their relatives up to the fourth degree included.

Art. 63.

Property rights

2. The rights arising from industrial inventions, except the right to be recognised as an author, are alienable and communicable.

3. The right to patent by industrial invention belongs to the author of the invention and his successors.

Art. 64.

Employee Inventions

1. Where the industrial invention is made in the performance or performance of a contract or employment or employment relationship, in which the inventive activity is envisaged as the subject of the contract or relationship and for that purpose paid, the rights deriving from the invention shall belong to the employer, except for the right of the inventor to be recognised as the author.

2. If remuneration is not provided for and established, in return for inventive activity, and the invention is made in the performance or performance of a contract or employment or employment relationship, the rights arising from the invention belong to the employer, but the inventor, without prejudice to the right to be recognised as an author, is entitled, if the employer or his successors in law obtain the patent or use the invention under industrial secrecy, a fair prize for determining the importance of the invention, the duties performed and the remuneration received by the inventor, and the contribution he has received from the employer's organisation. In order to ensure the timely conclusion of the patent acquisition procedure and the consequent award of the fair prize to the inventor, an early examination of the application for the grant of the patent may be granted at the request of the organisation of the employer concerned.

3. If the conditions laid down in paragraphs 1 and 2 are not met and the industrial invention falls

within the scope of activity of the employer, the employer shall have the right of option for the exclusive or non-exclusive use of the invention or for the acquisition of the patent, as well as for the right to apply for or acquire, for the same invention, patents abroad for payment of the fee or price, to be determined by deduction of a sum corresponding to the aid that the inventor has received from the employer in order to obtain the invention. The employer may exercise the right of option within three months from the date of receipt of the notification of the filing of the patent application. The relationships established with the exercise of the option shall be terminated by law, if the consideration due is not paid in full upon expiry.

4. Without prejudice to the jurisdiction of the ordinary court to ascertain the existence of the right to fair premium, fee or price, if no agreement is reached on the amount of the same, even if the inventor is an employee of State administration, the determination of the amount shall be provided by a panel of arbitrators, composed of three members, appointed by each of the parties and the third party appointed by the first two, or, in the event of disagreement, by the President of the specialised section of the competent court where the service provider habitually performs his duties. The provisions of Articles 806 et seq. of the Code of Civil Procedure shall apply as compatible.

5. The panel of arbitrators may also be seised on the basis of the assessment of the existence of the right to fair premium, fee or price, but, in that case, the enforceability of its decision is subject to that of the judgment on the establishment of the law. The arbitration panel must proceed with fair appreciation. If the determination is manifestly unfair or erroneous, the determination is made by the judge.

6. For the purposes of paragraphs 1, 2 and 3, the industrial invention for which the patent is applied for within one year after the inventor left the private company or the public administration within the scope of which the invention falls shall be considered made during the performance of the contract or employment or employment relationship.

Art. 65.

Inventions of researchers from universities and public research bodies

1. By way of derogation from Article 64, where the employment relationship exists with a university or a public administration having as one of its institutional research purposes, the researcher shall be the sole holder of the rights deriving from the patentable invention of which he is the author. In the case of several authors, employees of universities, public administrations or other public administrations, the rights deriving from the invention belong to all in equal parts, unless otherwise agreed. The inventor shall submit the patent application and notify the administration thereof.

2. Universities and public administrations, within the framework of their autonomy, determine the maximum amount of the fee, relating to licences to third parties for the use of the invention, payable to the same university or public administration or to private funders of research, as well as any further aspect of mutual relations.

3. In any case, the inventor is entitled to no less than fifty percent of the proceeds or canons of exploitation of the invention. In the event that universities or public administrations do not make the determinations referred to in paragraph 2, they shall be responsible for thirty per cent of the proceeds or fees.

4. Five years after the date of issue of the patent, where the inventor or his successors have not commenced industrial exploitation, unless this arises from causes beyond their control, the public administration of which the inventor was employed at the time of the invention automatically acquires a free, non-exclusive right to exploit the invention and the related property rights or to have them exploited by third parties, except for the right of the inventor to be recognised as an author.

5. The provisions of this Article shall not apply in cases of research financed, in whole or in part, by private entities or carried out in the context of specific research projects financed by public entities other than the university, body or administration belonging to the researcher.

Art. 66.

Patent law

1. Patent rights for industrial invention consist of the exclusive right to implement the invention and to profit from it in the territory of the State, within the limits and under the conditions laid down in this Code.

2. In particular, the patent confers on the holder the following exclusive rights:

a) if the subject of the patent is a product, the right to prohibit third parties, unless the holder consents, to produce, use, market, sell or import for such purposes the product in question;

b) if the subject of the patent is a proceeding, the right to prohibit third parties, unless the holder consents, to apply the procedure, and to use, market, sell or import for such purposes the product directly obtained by the procedure in question.

Art. 67.

Patent procedure

1. In the case of a process patent, any product identical to that obtained by means of the patented procedure shall be presumed to be obtained, unless otherwise proved, by means of that procedure, alternatively:

a) if the product obtained by the process is new;

b) if there is a substantial likelihood that the identical product has been manufactured by means of the procedure and if the patent holder has failed through reasonable efforts to determine the procedure actually implemented?

2. For the purposes of proof to the contrary, account must be taken of the defendant's legitimate interest in the protection of his manufacturing and commercial secrets.

3. Where the holder of a patent relating to a new industrial method or process administers to others the means uniquely intended to implement the subject-matter of the patent, it shall also be presumed that he has also licensed to make use of that method or process, provided that no agreement to the contrary exists.

Art. 68.

Limitations of patent law

1. The exclusive right conferred by patent law does not extend, whatever the object of the invention:

a) acts carried out in private and for non-commercial purposes, or experimentally;

b) studies and trials aimed at obtaining, including in foreign countries, a marketing authorisation for a drug and the consequent practical requirements, including the preparation and use of pharmacologically active raw materials strictly necessary for this purpose;

c) to the extemporaneous preparation, per unit, of medicinal products in prescription pharmacies, and to medicinal products thus prepared, provided that no industrially manufactured active ingredients are used.

1-bis. Without prejudice to the provision of paragraph 1, companies wishing to produce specialty pharmaceutical products outside the patent cover may initiate the registration procedure for the product containing the active substance one year before the expiry of the supplementary coverage or, failing that, the patent coverage of the active substance, taking into account any possible extension.

2. A patent for industrial invention, the implementation of which involves that of inventions protected by previous patents for industrial inventions still in force, cannot be implemented or used without the consent of the owners of those inventions.

3. Any person who, during the twelve months prior to the date of filing of the patent application or the priority date, has made use of the invention in his company may continue to use the invention within the limits of pre-use. This faculty can only be transferred together with the company in which

the invention is used. Proof of pre-use and its extension shall be borne by the pre-user.

Art. 69.

Burden of implementation

1. The industrial invention that is the subject of a patent must be implemented in the territory of the State to such an extent that it does not result in serious disproportion with the needs of the country.

2. Inventions concerning objects which for the first time appear in an official or officially recognised exhibition held in the territory of the State shall be deemed to have been implemented from the time the objects were introduced there until the closure of that exhibition, provided that they have been exhibited for at least ten days or, in the case of a shorter exposure, throughout the period thereof.

3. The introduction or sale in the territory of the State of objects produced in States other than those which are members of the European Union or the European Economic Area or those members of the World Trade Organisation shall not constitute implementation of the invention.

Art. 70.

Compulsory licence for non-implementation

1. After three years from the date of issue of the patent or four years from the date of filing of the application, if the patent holder or his successor in law, directly or through one or more licensees, has failed to implement the patented invention by producing in the territory of the State or by importing objects produced in a Member State of the European Union or the European Economic Area or in a Member State of the World Trade Organisation, or has implemented it to such an extent as to be seriously disproportionate to the needs of the country, a compulsory licence may be granted for the non-exclusive use of that invention, in favour of any interested party who so requests it.

2. The compulsory licence referred to in paragraph 1 may also be granted, if the implementation of the invention has been suspended or reduced to such an extent as to result in serious disproportion with the needs of the country for more than three years.

3. A compulsory licence shall not be granted if the failure or insufficient implementation is due to causes beyond the will of the patent holder or his successor. This does not include the lack of financial means and, where the product is spread abroad, the lack of demand in the internal market for the patented product or obtained by the patented procedure.

4. The grant of the compulsory licence shall not exempt the holder of the patent or his successor from the burden of implementing the invention. The patent expires, if the invention has not been implemented within two years from the date of grant of the first compulsory licence or has been to such an extent as to result in serious disproportion with the needs of the country.

Art. 71.

Employee patent

1. Compulsory licence may be granted if the invention protected by the patent cannot be used without prejudice to the rights relating to a patent granted on the basis of a previous application. In such a case, the licence may be granted to the holder of the later patent to the extent necessary to exploit the invention, provided that it represents, with respect to the subject matter of the previous patent, an important technical progress of considerable economic importance.

2. The licence thus obtained is not transferable except in conjunction with the patent on the dependent invention. The holder of the patent on the main invention is entitled, in turn, to the grant of a compulsory licence on reasonable terms on the patent of the dependent invention.

Art. 72.

Common provisions

1. Any person applying for a compulsory licence under Articles 70 and 71 must prove that he

has previously applied to the holder of the patent and that he has not been able to obtain from him a contractual licence on equal terms.

2. The compulsory licence may only be granted against the payment, by the licensee and to the proprietor of the patent or his successors in law, of fair compensation and provided that the applicant for the licence provides the necessary guarantees with regard to the satisfactory implementation of the invention in accordance with the conditions laid down in that licence.

3. A compulsory licence may not be granted where it appears that the applicant has infringed the patent, unless it proves his or her good faith.

4. The compulsory licence may be granted for the exploitation of the invention directed primarily at the supply of the internal market.

5. The compulsory licence shall be granted for a period not exceeding the remainder of the patent and, unless there is the consent of the proprietor of the patent or his successor in law, may be transferred only with the company of the licensee or with the particular branch of the licensee in which the licence is used.

6. The granting of the compulsory licence does not affect the exercise, including by the licensee, of the legal action concerning the validity of the patent or the extension of the rights deriving therefrom.

7. In the decree granting the licence, the scope of the duration, the modalities for the implementation, the guarantees and the other conditions to which the concession is subject in relation to the purpose of the licence, the measure and the methods of payment of the remuneration are determined. In the event of opposition, the measure and method of payment of the compensation shall be determined in accordance with Article 80.

8. The conditions of the licence may, by decree of the Ministry of Economic Development, be changed at the request of each of the interested parties, if there are valid reasons in this regard.

9. Article 80 shall apply to the modification of the remuneration.

10. In the event that the holder of the patent for whom a compulsory licence has been granted or his successor in law grants to third parties the use of the patent on terms more advantageous than those laid down for the compulsory licence, the same conditions shall be extended to the compulsory licence, at the request of the licensee.

Art. 73.

Revocation of the compulsory licence

1. The compulsory licence is revoked by decree of the Ministry of Economic Development, if the conditions laid down for the implementation of the invention are not fulfilled or if the holder of the licence has not paid the compensation to the extent and in the manner prescribed.

2. The compulsory licence shall also be revoked by decree of the Ministry of Economic Development if and when the circumstances leading to the grant cease to exist and are unlikely to occur again or upon mutual request of the parties.

3. The revocation may be requested by the patent holder with an application submitted to the Italian Patents and Trademark Office, who shall promptly notify it by registered letter with acknowledgment of receipt to the holder of the compulsory licence, who, within sixty days from the date of receipt of the registered letter, may oppose the revocation, with an application submitted to the Italian Patent and Trademark Office. The provisions of Article 199(3), (4), (5), (6) and (7) shall apply.

4. In the event of revocation, the person who had obtained the licence may implement the invention under the same conditions, within the limits of the pre-use or in those resulting from serious and effective preparations.

Art. 74.

Military Inventions

1. The provisions relating to the granting of compulsory licences for failure or insufficient implementation of inventions, or on an employed patent, shall not apply to patented inventions belonging to the military administration or those subject to the obligation of secrecy by the military administration.

Art. 75.

Forfeiture for non-payment of fees

1. The patent for invention expires for non-payment within six months of the expiry date of the annual fee due, subject to compliance with the provisions of paragraphs 2, 3 and 4.

2. After the month of expiry of the annual fee and also the following six months in which payment is allowed with the application of a right of late payment, and in any case the time limit for payment of the law has expired, the Italian Patent and Trademark Office shall notify the person concerned, by registered notice, that it is not made within the prescribed period of payment of the right due. The Italian Patents and Trademark Office, after thirty days from the date of communication above, acknowledges in the register of patents, with appropriate annotation, that the patent has been forfeited for failure to pay the annual right, publishing in the Official Bulletin the news of the revocation itself.

3. The proprietor of the patent, if he proves that he has made the payment in due time, may, by appeal to the Appeals Board, request the annulment of the aforementioned revocation note and the correction of the publication within six months of the date of publication of the Official Bulletin. The Commission shall, after hearing the interested party or its representatives, take account of any written observations. Both the application and the operative part of the judgment must be noted in the patent register and published in the Official Bulletin.

4. After the publication referred to in paragraph 2 and six months after the date of such publication, or if the application has been dismissed, the patent shall be deemed to have been terminated in respect of anyone from the end of the last year for which the right has been effectively paid.

Art. 76.

Nullity

1. The patent is null and void:

a) if the invention is not patentable under Articles 45, 46, 48, 49 and 50;

b) if, pursuant to Article 51, the invention is not described in a sufficiently clear and complete manner to enable an expert person to implement it;

c) if the subject matter of the patent extends beyond the content of the initial application or the protection of the patent has been extended;

d) if the holder of the patent was not entitled to obtain it and the right holder has not availed himself of the powers granted to him by Article 118.

2. If the grounds for nullity affect only partially the patent, the relevant partial nullity judgment entails a corresponding limitation of the patent itself, and in the case provided for in Article 79(3) establishes the new claims resulting from the limitation.

3. The null and void patent may have the effect of a different patent which contains the requirements of validity and which would have been desired by the applicant if the applicant had known its invalidity. The request for conversion can be submitted in any state and grade of judgment. The judgment establishing the requirements for the validity of the different patent provides for the conversion of the invalid patent. The proprietor of the converted patent, within six months of the res

judicata of the conversion judgment, shall submit an application for correction of the text of the patent. The Office, having verified the correspondence of the text to the judgment, shall make it accessible to the public.

4. If the conversion results in the extension of the original duration of the invalid patent, licensees and those who had made serious and effective investments to use the subject matter of the patent shall be entitled to obtain a compulsory, free, non-exclusive licence for the longer period.

5. The European patent may be declared invalid for Italy under this Article and also when the protection conferred by the patent has been extended.

Art. 77.

Effects of nullity

1. The declaration of invalidity of the patent has retroactive effect, but does not affect:

a) acts of enforcement of judgments of infringement which have already been made for res judicata;

b) contracts relating to the invention concluded before the res judicata of the judgment declaring nullity in so far as they have already been executed. In this case, however, the court may, having regard to the circumstances, grant a fair refund of amounts already paid in performance of the contract;

c) payments already made under Articles 64 and 65 by way of fair premium, fee or price.

Art. 78.

Renunciation

1. The holder may waive the patent by document received from the Italian Patents and Trademark Office, to be noted on the patent register.

2. Where, in relation to the patent, acts or judgments conferring or ascertaining the property rights of third parties in the patent or judicial applications requesting the attribution or establishment of such rights are transcribed, the waiver shall be without effect unless accompanied by the written consent of the third parties.

Art. 79.

Limitation

1. The patent may be limited at the request of the proprietor, to whom the modified description, claims and designs must be joined.

2. If the Italian Patents and Trademark Office accepts the application, the applicant shall comply with the regulatory provisions relating to the republishment of the patent and the payment of the related rights, where applicable.

3. In a judgment of invalidity, the proprietor of the patent has the right to submit to the court, in any state and degree of judgment, a reformulation of the claims that remain within the limits of the content of the patent application as initially filed and does not extend the protection conferred by the patent granted.

3-bis. Where there is both a limitation of the European patent following a limitation procedure under the European Patent Convention and a limitation of the European patent itself with effect in Italy following a national procedure, the scope of protection conferred by the patent shall be determined taking into account each of the limitations that have occurred.

4. The Italian Patent and Trademark Office publishes in the Bulletin the news of the limitation of the patent.

Art. 80

License of law

1. The applicant or the proprietor of the patent in the application or with application also of the authorised representative to the Italian Patents and Trademark Office, if it is not transcribed exclusive license, may offer the public license for the non-exclusive use of the invention.

2. The effects of the licence shall start from notification to the holder of acceptance of the offer, even if compensation is not accepted.

3. In the latter case, a panel of arbitrators, composed of three members, appointed by each of the parties and the third party appointed by the first two or, in the event of disagreement, by the Chairman of the Board of Appeal, shall provide for the determination of the measure and method of payment of the remuneration. The arbitration panel must proceed with fair appreciation. If the determination is manifestly unfair or erroneous, or if one of the parties refuses to appoint its arbitrator, the determination shall be made by the judge.

4. Compensation may be modified in the same way as in determining the original fee if facts have been produced or revealed which make the remuneration already fixed appear to be manifestly inadequate.

5. The applicant or holder of the patent who has offered the public license on the patent shall be entitled to a reduction to half of the annual rights.

6. The reduction referred to in paragraph 5 shall be granted by the Italian Patent and Trademark Office. The offer declaration shall be recorded in the Register of Patents, published in the Bulletin and its effects shall continue until it is revoked.

Art. 81.¹⁶

Supplementary certificate pursuant to Law No 349 of 19 October 1991 and voluntary license on active substances mediated by the Minister

1. To supplementary protection certificates granted under Law No 349 of 19 October 1991, the legal regime with the same exclusive rights and obligations as the patent shall apply. The supplementary certificate of protection shall have the same effects as the patent to which it relates, limited to the part or parts of it covered by the marketing authorisation.

2. The effects of the supplementary protection certificate shall run from the moment the patent reaches the end of its legal duration and extends for a period equal to the period between the date of filing of the patent application and the date of the decree granting the first authorisation to place the medicinal product on the market.

3. The duration of the supplementary protection certificate may in any case not exceed 18 years from the date on which the patent reaches the end of its legal duration.

4. In order to progressively adjust the duration of the supplementary and patent cover to that provided for in Community legislation, the provisions of Law No 939 of 19 October 1991 and Council Regulation (EEC) No 1768/1992 of 18 June 1992 are implemented by means of a reduction in supplementary protection of six months for each calendar year, from 1 January 2004, until full alignment with European legislation.

5. Third parties wishing to produce active ingredients covered by supplementary protection certificates granted pursuant to Law No 349 of 19 October 1991 are allowed to initiate a procedure with the holders of those certificates at the Ministry of Economic Development for the issue of voluntary non-exclusive licences for consideration in accordance with the legislation in force in this field.

6. The licences referred to in paragraph 5 are in any case valid only for export to countries in which the patent protection and the supplementary protection certificate does not exist, has expired or in which the export of the active substance does not constitute infringement of the relevant patent in accordance with the regulations in force in the countries of destination.

7. The licence shall cease to have effect after the expiry of the supplementary certificate to which it refers.

Section IV-*a*
Biotechnological inventions

Art. 81-*bis*.

Postponement

1. The provisions of Section IV on industrial inventions also have an effect on biotechnological inventions, as they are not derogated from the rules set out in Section IVa.

Art. 81-*b*.

Definitions

1. For the purposes of this Code:

a) biological Material: material containing genetic information, self-produced or capable of reproduction in a biological system;

b) microbiological process: any process in which microbiological material is used, which involves intervention on microbiological material or which produces a microbiological material.

2. A process of production of plants or animals is essentially biological when it consists entirely of natural phenomena such as crossing or selection.

3. The concept of plant variety is defined in Article 5 of Council Regulation (EC) No 2100/94 of 27 July 1994.

Art. 81-*c*.

Patentability

1. They are patentable as long as they have the requirements of novelty and inventive activity and are susceptible to industrial application:

a) a biological material, isolated from its natural environment or produced by a technical process, even if pre-existing in its natural state;

b) a technical process by which biological material is produced, processed or used, even if pre-existing in its natural state;

c) any new use of a biological material or a technical process relating to biological material;

d) an invention relating to an element isolated from the human body or otherwise produced by a technical process, even if its structure is identical to that of a natural element, provided that its industrial function and application are specifically indicated and described. By technical procedure we mean what only man is capable of implementing and which nature itself is unable to accomplish;

e) an invention concerning plants or animals or a plant set, characterised by the expression of a particular gene and not by its entire genome, if their application is not technically limited to the production of a particular plant variety or animal species and are not used, for their production, only essentially biological processes, in accordance with the procedures laid down in Article 170-*a* (6).

Art. 81-*quinquies*.

Exclusions

1. Without prejudice to the exclusions referred to in Article 45(4), the following shall be excluded from patentability:

a) the human body, from the moment of conception and at the various stages of its development, as well as the mere discovery of one of the elements of the body itself, including the sequence or partial sequence of a gene, in order to ensure that patent law is exercised with respect for fundamental

rights on the dignity and integrity of man and the environment;

b) inventions whose commercial exploitation is contrary to human dignity, public order and morality, to the protection of health, the environment and life of humans and animals, to the preservation of plants and biodiversity and to the prevention of serious environmental damage, in accordance with the principles contained in Article 27(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). This exclusion concerns, in particular:

1) any technological process of human cloning, whatever the technique used, the maximum stage of planned development of the cloned organism and the purpose of cloning;

2) the procedures for modifying the germinal genetic identity of the human being;

3) any use of human embryos, including human embryonic stem cell lines;

4) procedures for modifying the genetic identity of animals, which may cause suffering without substantial medical benefit to humans or animals, and animals resulting from such processes;

5) inventions concerning genetic screening protocols, the exploitation of which leads to discrimination or stigmatisation of human subjects on a genetic, pathological, racial, ethnic, social and economic basis, or with eugenic and non-diagnostic purposes; a simple DNA sequence, a partial sequence of a gene, used to produce a protein or partial protein, unless an indication and description of a function useful for the assessment of the industrial application requirement is provided and the corresponding function is specifically claimed; each sequence is considered autonomous for patent purposes in the case of sequences superimposed only in parts not essential to the invention.

2. However, any technical process using human embryonic cells is excluded from patentability.

Art. 81-sexies.

Extension of protection

1. The protection conferred by a patent relating to a biological material having, as a result of the invention, certain properties extends to all biological materials derived from it by reproduction or multiplication in identical or differentiated form and having the same properties.

2. The protection conferred by a patent relating to a process allowing the production of biological material which, as a result of the invention, has certain properties extends to biological material directly obtained by that process and to any other biological material derived from biological material directly obtained by reproduction or multiplication in identical or differentiated form and endowed with the same properties.

3. Without prejudice to Article 81d(1)(a), the protection conferred by a patent on a product containing or consisting of genetic information shall extend to any material in which the product is incorporated and in which the genetic information is contained and performs its function.

Art. 81-septies.

Limits on the extension of protection

1. The protection referred to in Article 81-e shall not extend to biological material obtained by reproduction or multiplication of biological material marketed in the territory of the State by the patent holder or with his consent, where the reproduction or multiplication necessarily results from the use for which the biological material has been marketed, provided that the material obtained is not subsequently used for other reproductions or multiplications.

Art. 81-g.

Compulsory license

2. The Italian Patents and Trademark Office issues a compulsory license also in favour of:

a) the breeder, for the non-exclusive exploitation of the invention protected by the patent, where such a licence is necessary for the exploitation of a plant variety;

b) the holder of a patent concerning a biotechnological invention for the use of the plant variety right.

3. The licence referred to in paragraph 1 shall be issued in accordance with the procedures and conditions laid down in Articles 71 and 72, insofar as they are compatible.

4. In the event of a compulsory licence, the patent holder and the holder of the plant variety right shall be entitled to a licence under conditions which, in the absence of agreement between the parties, are determined by the Italian Patent and Trademark Office.

5. The issue of the licence referred to in paragraph 1 shall be subject to proof by the applicant:

a) who applied in vain to the holder of the patent or plant variety right to obtain a contractual licence;

b) that the plant variety or invention constitutes significant technical progress, of considerable economic interest compared to the invention indicated in the patent or the protected plant variety.

Section V Utility Models

Art. 82.

Subject matter of the patent

1. New models capable of giving particular effectiveness or convenience of application or use to machines, or parts thereof, tools, tools or objects of use in general, such as new models consisting of particular conformations, arrangements, configurations or combinations of parts, may be the subject of patents by utility model.

2. The patent for machines as a whole does not include the protection of individual parts.

3. The effects of the utility model patent extend to models that achieve equal utility, as long as they use the same innovative concept.

Art. 83

The right to patenting

1. The right to the patent belongs to the author of the new utility model and its successors.

Art. 84.

Alternative patenting

1. It is permitted to apply for an industrial invention patent under this Code to apply for a utility model patent at the same time, if the former is not accepted or only partially accepted.

2. If the application has as its object a model rather than an invention or vice versa, the Italian Patent and Trademark Office shall invite the person concerned, by giving him a time limit, to amend the application itself, which, however, takes effect from the date of original submission.

3. If the utility model patent application also contains an invention or vice versa, Article 161 shall apply.

Art. 85.

Duration and Effects of Patenting

1. The utility model patent lasts ten years from the date of submission of the application.

2. The rights conferred and the effect of the patent shall be regulated in accordance with Article 53.

Art. 86.

Postponement

1. The provisions of Section IV on industrial inventions, in addition to such inventions, also explain their effect in the field of utility models, as they are applicable.

2. In particular, provisions on employee inventions and compulsory licensing are extended to utility model patents.

Section VI
Topographies of semiconductor products

Art. 87

Subject of protection

1. Each finished or intermediate product is semiconductor produced:
 - a) consisting of a set of materials comprising a layer of semiconductor material;
 - b) containing one or more layers composed of conductive material, insulating or semiconductor, arranged according to a predetermined three-dimensional scheme;
 - c) intended to perform, solely or jointly with other functions, an electronic function.
2. The topography of a semiconductor product is a series of related drawings, however fixed or coded:
 - a) representing the three-dimensional scheme of the layers of which a semiconductor product is composed;
 - b) in which series each image reproduces in whole or in part a surface of the semiconductor product at any stage of its manufacture.

Art. 88.

Requirements of protection

1. Topographies resulting from the creative intellectual effort of their author that are not common or familiar in the semiconductor product industry may be the subject of exclusive rights.
2. Topographies resulting from the combination of common or family elements may also be the subject of exclusive rights, provided that, as a whole, they meet the requirements of paragraph 1.

Art. 89.

Right to protection

1. The exclusive rights in the topographies of semiconductor products which meet the protection requirements lie with the author and his successors.
2. Where the topography is created in the context of an employment or employment relationship, Article 64 shall apply.
3. If the topography is created in the performance or performance of a contract other than a contract of employment, the right to protection is, unless the contract itself provides otherwise, the topography.

Art. 90.

Content of rights

1. The exclusive rights in the topographies of semiconductor products consist of the power to:
 - a) reproduce in any way or form, in whole or in part, the topography;
 - b) exploit commercially, or hold or distribute for marketing purposes, or import a topography or semiconductor product in which the topography is fixed.
2. Commercial exploitation consists of selling, renting, leasing or any other method of commercial distribution or offering for such purposes.

Art. 91.

Limitation of exclusive rights

1. The protection granted to topographies of semiconductor products does not extend to the concepts, processes, systems, techniques or information encoded, incorporated into the topography themselves.

2. The exclusive rights referred to in Article 90 shall not extend to reproductions made in private, experimentally, for the purpose of teaching, analysing or evaluating topography and the concepts, procedures, systems or techniques included in the topography.

3. Exclusive rights may not be exercised in respect of topographies created by third parties on the basis of an analysis or evaluation carried out in accordance with paragraph 2, where such topographies meet the requirements of protection.

Art. 92.

Registration

1. The topography of semiconductor products shall be protected provided that:

a) registration is required in Italy or, if the topography has been the subject of previous commercial exploitation anywhere in the world, registration is required within two years from the date of the first exploitation, provided that that date is specified in a written declaration. For these purposes, commercial exploitation shall not include exploitation under conditions of confidentiality in which there has been no further distribution to third parties, unless the exploitation of topography takes place in accordance with the conditions of confidentiality imposed by the adoption of measures deemed necessary for the protection of the essential interests of national security and which relate to the production or trade in arms, ammunition and war material;

b) at the time of the first commercial exploitation or registration request, the owner of the topography is an Italian citizen or legal person or, if foreign, complies with the requirements set out in Article 3 of Chapter I.

2. The right to apply for registration expires 15 years after the date of first fixing or codification of the topography, if it has not been commercially exploited in any part of the world for the same period. These effects by commercial exploitation shall be understood as that which does not include exploitation in condition of confidentiality according to the indications contained in paragraph 1(a).

Art. 93.

Validity and duration of protection

1. The exclusive rights referred to in Article 90 shall arise on the first, in order of time, of the following dates:

a) the date of the first commercial exploitation of the topography anywhere in the world;

b) on the date on which the application for registration was lodged in due form.

2. The exclusive rights referred to in paragraph 1 shall be extinguished ten years after the first, in order of time, of the following dates:

a) the end of the calendar year in which the topography was first commercially exploited anywhere in the world;

b) the end of the calendar year in which the application for registration was lodged in due form.

3. For the purposes of this Article, commercial exploitation shall mean that which does not include exploitation under conditions of confidentiality according to the indications contained in Article 92(1)(a).

Art. 94.

Reference to reserve

1. The topography, the semiconductor product and its outer casing may bear a mention consisting of:

- a) the T sign enclosed by a circle;
- b) the date on which the topography was first commercially exploited;
- c) the name, name or initials of the rightholder on the topography.

2. This mention proves that the topography has been registered, i.e. the claim of ownership of the topography or the intention to apply for registration within two years from the date of the first commercial exploitation.

3. The reference may not be made on products for which the application for registration has not been submitted within two years of the date of the first commercial exploitation anywhere in the world or has been definitively refused.

Art. 95.

Counterfeiting

1. Infringement of the exclusive rights in the topographies of semiconductor products constitutes the exercise, without the consent of the owner, of the following activities, including by intermediary person:

- a) reproduction in any way and by any means of topography;
- b) fixation by any means of topography in a semiconductor product;
- c) the use, importation and holding for marketing purposes and the marketing or distribution of the semiconductor product in which the topography is fixed.

2. The importation, distribution, marketing or use of counterfeit semiconductor products made without knowing or having a valid reason to consider the existence of the exclusive rights referred to in Article 90 shall not constitute acts of infringement.

3. In the case referred to in paragraph 2 it is permissible to continue the activity undertaken, within the limits of the contracts already concluded and existing stocks, but the owner of the exclusive rights is entitled to payment of a fair consideration, starting from the moment he has adequately notified the buyer in good faith that the topography has been reproduced illegally. In the absence of agreement between the parties, the provisions laid down in Section IV for the right licence shall apply to the determination and manner of payment of fair consideration at the market price.

Art. 96.

Compensation for damage and fair compensation

1. Any person who, after registration of the topography or after the notice of the person who has submitted the application for registration, if accepted, carries out the acts referred to in Article 95, shall be liable for damages in accordance with the provisions of Chapter III.

2. If the acts referred to in paragraph 1 take place between the first act of commercial exploitation of the semiconductor product with reserve mention and the registration of the topography, the person responsible shall only pay a fair compensation to the holder of the registered topography.

3. If the acts referred to in points (a) and (b) of paragraph 1 of Article 95 take place after the first act of commercial exploitation of a semiconductor product without reservation, the holder of the registered topography shall be entitled to fair compensation and the infringer shall be entitled to obtain a licence under fair conditions to continue to exploit the topography within the limits of the use made before it was registered. Where the holder of the registration refuses to issue a contractual licence, the mandatory licensing provisions set out in Section IV, including those relating to the determination of the measure and method of payment of compensation in the event of opposition, shall apply as compatible.

4. If you have purchased a semiconductor product without knowing or having a valid reason to believe that the product is protected by registration, you have the right to continue the commercial exploitation of the product. However, for acts carried out after having known or had valid reasons to believe that the semiconductor product is protected, the payment of fair compensation is due. The originator of the buyer referred to in this paragraph retains the same rights and obligations.

5. For the purposes of this Article, commercial exploitation shall mean that which does not include exploitation under confidentiality, in accordance with the indications referred to in point (a) of Article 92(1).

Art. 97.

Nullity of registration

1. An application for a judicial declaration of invalidity of the registration of the topography may be made at any time and by anyone interested in it, if it is omitted, does not exist or is absolutely uncertain one of the following requirements:

- a) the protection requirements referred to in Article 88;
- b) the owner of the topography is not one of the subjects referred to in Article 92, paragraph 1, letter b);
- c) registration has not been requested in Italy within the period laid down in Article 92(1)(a) and, in the case of topographies whose commercial exploitation began in the two-year period preceding 18 March 1989, registration was not requested by 18 March 1990;
- d) the date of the first act of exploitation has not been specified in a written declaration;
- e) the application for registration and its annexes shall not allow the identification of the topography and the assessment of the requirements referred to in point (a).

Section VII

Secret information

Art. 98.

Subject of protection

1. The protection of company information and technical and industrial experience, including commercial experience, is subject to the legitimate control of the holder, where such information:

- a) are secret, in the sense that they are not as a whole or in the precise configuration and combination of their elements generally known or easily accessible to experts and operators in the sector;
- b) have economic value as secret;
- c) are subject, by the persons to whose legitimate control they are subject, to measures that are reasonably appropriate to keep them secret.

2. Data relating to tests or other secret data, the processing of which entails a considerable commitment and the submission of which is subject to the authorisation of the placing on the market of chemical, pharmaceutical or agricultural products involving the use of new chemicals, shall also be protected.

Art. 99.

Protection

1. Without prejudice to the rules of unfair competition, the legitimate holder of the information and business experience referred to in Article 98 shall have the right to prohibit third parties, without their own consent, from acquiring, disclosing to third parties or improperly using such information and experience, unless they have been obtained independently from the third party.

Section VIII

New plant varieties

Art. 100.

Subject matter of the law

1. A plant set of a botanical taxon of the lowest known grade which, whether or not in full compliance with the conditions for conferring the breeder's right, may be the subject of the law on a new plant variety:

- a) defined by characters resulting from a certain genotype or a certain combination of genotypes;
- b) distinct from any other plant set by the expression of at least one of those characters;
- c) considered as an entity with respect to its suitability to be reproduced in a consistent manner.

Art. 101.

Constitutor

1. For the purposes of this Code, the breeder shall mean:

- a) the person who created or discovered and developed a variety;
- b) the person who is the employer of the person mentioned above or who has commissioned the work of that person;
- c) the person entitled or entitled to do so by the persons referred to in points (a) and (b).

Art. 102.

Requirements

1. The breeder's right shall be conferred when the variety is new, distinct, homogeneous and stable.

Art. 103.

News

1. The variety shall be deemed to be new when, on the date of filing of the breeder's application, the material for breeding or vegetative propagation or a harvesting product of the variety has not been sold or otherwise transferred to third parties by the breeder or with his consent, for the purpose of exploiting the variety:

- a) in Italy for more than one year from the date of filing of the application;
- b) in any other state for more than four years or, in the case of trees and vines, for more than six years.

Art. 104.

Distinction

1. The variety is deemed to be distinct when it is clearly distinguished from any other variety whose existence, at the date of filing of the application, is known to be known.

2. In particular, another variety is known to be known when:

- a) an application for the grant of the breeder's right or entry in an official register has been filed for it in any country, provided that the application has the effect of conferring the breeder's right or entry in the official register of varieties;
- b) it is present in public collections.

Art. 105.

Homogeneity

1. The variety shall be deemed to be homogeneous where it is sufficiently uniform in its relevant characteristics and relevant for the purposes of protection, subject to the foreseeable variation as a result of the particularities related to its sexual reproduction and its vegetative multiplication.

Art. 106.

Stability

1. The variety shall be deemed to be stable where the characters relevant and relevant for the purposes of protection remain unchanged as a result of subsequent reproductions or multiplications or, in the case of a particular breeding or multiplication cycle, at the end of each cycle.

Art. 107.

Content of the breeder's law

1. The authorisation of the breeder shall be required for the following acts in relation to the propagating or propagating material of the protected variety:

- a) production or reproduction;
- b) conditioning for reproduction or multiplication;
- c) offer for sale, sale or any other form of marketing;
- d) export or import;
- e) detention for one of the purposes listed above.

2. The authorisation of the breeder shall be required for the acts referred to in paragraph 1 in relation to the product of the harvest, including whole plants and parts of plants, obtained by unauthorised use of reproductive or propagating material of the protected variety, unless the breeder has been able to reasonably exercise his right in relation to the said reproductive or propagating material. The use is presumed to be unauthorised unless proven otherwise.

3. The provisions of paragraphs 1 and 2 shall also apply to:

- a) varieties essentially derived from the protected variety, where the protected variety is not, in turn, a variety essentially derived;
- b) varieties which are not clearly distinguished from the protected variety in accordance with the requirement of distinction;
- c) varieties whose production requires the repeated use of the protected variety.

4. For the purposes of point (a) of paragraph 3, a variety shall be considered to be essentially derived from another variety, defined as an initial variety, where:

a) derives mainly from the initial variety or from a variety which in turn is predominantly derived from the initial variety, while retaining the expressions of the essential characteristics resulting from the genotype or combination of the genotypes of the initial variety;

b) it is clearly distinguished from the initial variety and, with the exception of the differences generated by the derivation, is consistent with the initial variety in the expression of the essential characteristics resulting from the genotype or combination of the genotypes of the initial variety.

5. Essentially derived varieties may be obtained, inter alia, by selection of a natural or induced mutant or by a somaclonal variant, by selection of an individual variant among plants of the initial variety, by retrocrossing or by transformation through genetic engineering.

6. During the period between the publication of the application and the grant of the right, the breeder is entitled to a fair remuneration by the person who, during that period, carried out the acts which, once the right has been granted, require the authorisation of the breeder.

Art. 108.

Limitations of the breeder's law

1. The breeder's right does not extend to acts carried out in the private sphere, for non-

commercial purposes; acts carried out on an experimental basis; acts carried out for the purpose of creating other varieties, and, where the provisions of Article 107(3) are not applicable, to acts referred to in Article 107(1) and (2) in respect of those other varieties.

2. Without prejudice to the provisions of Article 107(1), any person wishing to carry out the multiplication, with a view to certification, of material coming from varieties covered by a plant variety for a new plant variety, is required to notify the holder of the right in advance.

Art. 109.

Duration of protection

1. The breeder's right granted under this Code shall last 20 years from the date of its grant. For trees and vines this right lasts thirty years from the date of its grant.

2. The effects of the right shall run from the date on which the application, together with the descriptive elements, is made available to the public.

3. In respect of the persons to whom the application, together with the descriptive elements, has been notified by the breeder, the effects of the right shall run from the date of such notification.

Art. 110.

Moral Right

1. The right to be considered as the author of the new plant variety may be asserted by the author himself and, after his death, by his spouse and descendants up to the second degree; in their absence or after their death, by their parents and other ascendants, and in absence, or after the death of them, by their relatives up to the fourth degree included.

Art. 111.

Property rights

2. The rights arising from the establishment of new plant varieties, except the right to be recognised as their author, are alienable and communicable.

3. Where the new plant variety is created in the context of an employment or employment relationship, Article 64 shall apply.

Art. 112.

Nullity of the right

1. The breeder's right shall be void if it is established that:

a) the conditions laid down in the rules on novelty and distinction were not actually met when the breeder's right was conferred;

b) the conditions laid down in the rules on homogeneity and stability have not actually been met when the breeder's right was conferred, where the breeder's right was conferred essentially on the basis of information or documents provided by the breeder;

c) the breeder's right has been conferred on those who were not entitled and the person entitled has not availed himself of the powers granted to him by Article 118.

Art. 113.

Forfeiture of law

1. The breeder's right expires when it is established that the conditions relating to homogeneity and stability are no longer met.

2. The right shall also expire if the breeder, after formal notice by the competent administration:

- a) does not submit, within 30 days, the information, documents or material deemed necessary for the monitoring of the maintenance of the variety;
- b) has not paid the rights due for the maintenance of its right;
- c) it does not propose, in the event of cancellation of the name of the variety after the conferment of the right, another appropriate name.

3. In the cases referred to in paragraph 2, letters a) and c), the revocation shall be declared by the Italian Patent and Trademark Office, on the proposal of the Ministry of Agricultural, Food and Forestry Policy.

Art. 114.

Denomination of the variety

1. The variety must be designated with a name intended to be its generic designation.
2. The name must allow the variety to be identified. It cannot consist solely of figures, unless it is a practice established for the designation of certain varieties. It must not be liable to mislead or create confusion as to its characteristics, the value or the identity of the variety or the identity of the breeder. In particular, it must be different from any other name which designates, in the territory of a Member State of the European Union for the protection of new plant varieties (UPOV), a pre-existing variety of the same plant species or of a similar species, unless that other variety no longer exists and its name has not taken on any particular importance.
3. Rights acquired beforehand by third parties are not affected.
4. The name must be the same as that already registered in one of the States Parties to the Union for the Protection of New Plant Varieties (UPOV) to designate the same variety.
5. The registered name satisfying the requirements of paragraphs 1, 2, 3 and 4 shall be registered.
6. The name deposited and registered and the variations thereto shall be communicated to the competent authorities of the States Parties to the UPOV.
7. The registered name must be used for the variety even after the expiry of the breeder's right, in so far as, in accordance with the provisions of paragraph 3, previously acquired rights do not oppose such use.
8. A trade mark, trade name or such indication may be associated with the variety name, provided that the varietal name is easily recognizable in any event.

Art. 115.

Compulsory licenses and expropriations

1. The breeder's right may be subject to compulsory non-exclusive licences only for reasons of public interest, as referred to in paragraph 3.
2. Compulsory licences shall apply, in so far as they are compatible with the provisions of this section, the mandatory licensing rules set out in Section IV, including those relating to the determination of the measure and method of payment of compensation in the event of opposition.
3. By ministerial decree, special, non-exclusive compulsory licences may be granted, at any time, by payment of fair compensation to the holder of the breeder's right, for the use of new protected plant varieties which may be used for human or livestock consumption, as well as for therapeutic uses or for the production of medicinal products.
4. The licences provided for in paragraph 3 shall be granted on the basis of the opinion of the Ministry of Agricultural, Food and Forestry Policy, which decides on the conditions laid down for the granting of licences.
5. The licence granting decree may provide for an obligation on the holder of the right to make the necessary propagation or propagation material available to the licensee.

6. The expropriation takes place, for the new plant varieties, after hearing the Ministry of Agricultural, Food and Forestry Policy.

Art. 116.

Postponement

1. The provisions of Section IV shall apply to new plant varieties in so far as they do not conflict with the provisions of this Section.

Chapter III

JUDICIAL PROTECTION OF INDUSTRIAL PROPERTY RIGHTS

Section I

Procedural provisions

Art. 117.

Validity and membership

1. Registration and patenting shall not affect the exercise of actions concerning the validity and ownership of industrial property rights.

Art. 118.

Claim

1. Anyone entitled under this Code may submit an application for registration or a patent application.

2. If, by a judgment which has the force of *res judicata*, it is established that the right to registration or a patent belongs to a person other than the person who filed the application, the latter may, if the industrial property title has not yet been issued and within three months of the *res judicata* of the judgment:

a) assume in its own name the patent application or the application for registration, effectively having the status of applicant;

b) filing a new patent or registration application, the effect of which, in so far as its content does not exceed that of the first application or refers to an object substantially identical to that of the first application, dates back to the date of filing or priority of the initial application, which in any event ceases to have effect; filing, in the case of the trade mark, a new application for registration whose effect, in so far as the mark contained therein is substantially identical to that of the first application, dates back to the date of filing or priority of the initial application, which in any event ceases to have effect;

c) obtain the rejection of the application.

3. If the patent has been granted or the registration has been made in the name of a person other than the right holder, the patent may alternatively:

a) obtain by judgment the transfer on his behalf of the patent or of the certificate of registration from the date of filing;

b) assert the invalidity of the patent or registration granted in the name of those who were not entitled to it.

4. After the period of two years from the date of publication of the grant of the patent by invention, by model of utility, for a new plant variety, or from the publication of the grant of the registration of the topography of semiconductor products, without the person entitled to have availed himself of one of the powers referred to in paragraph 3, nullity may be claimed by any interested party.

5. The rule in paragraph 4 shall not apply to trade mark and design registrations.

6. Without prejudice to the application of any other protection, registration of a company domain name granted in violation of Article 22 or a request in bad faith may be revoked or transferred to it by the registration authority at the request of the rightholder.

Art. 119.

Paternity

1. The Italian Patent and Trademark Office does not verify the accuracy of the designation of the inventor or the author, nor the legitimacy of the applicant, without prejudice to the verifications provided for by law or international conventions. Before the Italian Patents and Trademark Office it is presumed that the applicant is the holder of the right to registration or to the patent and is entitled to exercise it.

2. An incomplete or incorrect designation may be rectified only on application accompanied by a declaration of consent of the person previously designated and, where the application is not submitted by the applicant or holder of the patent or registration, also by a declaration of consent of the latter.

3. If a third party submits to the Italian Patent and Trademark Office an enforceable judgment according to which the applicant or the proprietor of the patent or registration is required to designate him as inventor or author, the Office shall record it on the register and notify it in the Official Bulletin.

Art. 120.¹⁷

Jurisdiction and competence

1. Actions relating to industrial property whose titles are granted or are being granted shall be brought before the judicial authority of the State, irrespective of the nationality, domicile or residence of the parties. If the action for invalidity or infringement is brought when the licence has not yet been granted, the judgment may be delivered only after the Italian Patent and Trademark Office has proceeded to the application for concession, examining it with precedence over applications lodged at the earlier date. The court shall, having regard to the circumstances, order the suspension of the trial, once or several times, fixing by the same measure the hearing at which the trial is to continue.¹⁸

2. The actions referred to in paragraph 1 shall be brought before the court of the place where the defendant is resident or domiciled and, if they are unknown, of the place where the defendant is staying, except as provided for in paragraph 3. Where the defendant has no residence, domicile or residence in the territory of the State, actions shall be brought before the court of the place where the plaintiff is resident or domiciled. Where neither the claimant nor the defendant has jurisdiction in the territory of the State of residence, domicile or stay, the judicial authority of Rome shall have jurisdiction.

3. The indication of domicile made with the application for registration or patenting and recorded in the register shall be the election of an exclusive domicile, for the purposes of determining jurisdiction and any service of documents of proceedings before ordinary or administrative courts. The place of residence thus elected can be modified only with a special request for replacement to be entered on the register by the Italian Patents and Trademark Office.

4. The jurisdiction in matters of industrial property rights belongs to the courts expressly indicated for this purpose by Legislative Decree No 168 of 27 June 2003.

5. Community trade mark and design courts within the meaning of Article 91 of Regulation (EC) No 40/94 and Article 80 of Regulation (EC) No 2002/6 shall mean those referred to in paragraph 4.

6. Actions based on facts which infringe the law of the plaintiff may also be brought before the judicial authority with a specialised section in whose constituency the facts were committed.

6-bis. The rules of jurisdiction and jurisdiction set out in this Article shall also apply to actions for negative assessment, including on a precautionary basis.

Art. 121.

Distribution of the burden of proof

1. The burden of proving the nullity or revocation of the industrial property title rests in any case on the person who contests the title. Without prejudice to Article 67, the burden of proving counterfeiting shall be borne by the holder. Proof of revocation of the mark for non-use can be provided by any means including simple presumptions.

2. Where a party has provided serious indications of the merits of its claims and has identified documents, elements or information held by the other party confirming such evidence, it may obtain that the court has provided the evidence or requests the information from the other party. It may also require the court to order the other party to provide evidence for the identification of the persons involved in the production and distribution of the goods or services which constitute infringement of industrial property rights.¹⁹

2-bis. In the event of an infringement committed on a commercial scale by means of acts of piracy referred to in Article 144, the court may also order, at the request of the party, the presentation of the banking, financial and commercial documentation held by the other party.²⁰

3. The court, when taking the above measures, shall take the appropriate measures to ensure the protection of confidential information, after consulting the other party.

4. The judge infers arguments of proof from the answers given by the parties and of unjustified refusal to comply with the orders.

5. In the matters covered by this Code, the technical consultant of its own motion may receive the documents relating to the questions put by the court even if not yet produced in question, making them known to all parties. Each party may appoint more than one consultant.

Art. 121-bis.

Right of information

1. The Judicial Authority, both in interim and substantive proceedings, may order, upon a justified and proportionate request of the applicant, information on the origin and distribution networks of goods or the provision of services which infringe a right under this Act by the infringer and by any other person who:

a) has been found in possession of goods which are subject to infringement of a right, on a commercial scale; has been surprised to use services that are infringing a right, on a commercial scale;

b) was surprised to provide on a commercial scale services used in activities of infringement of a right;

c) has been indicated by the persons referred to in points (a) or (b) as a person involved in the production, manufacture or distribution of such products or in the provision of such services.

2. The information referred to in paragraph 1 may include, inter alia, the name and address of the producers, manufacturers, distributors, suppliers and other previous holders of the products or services, as well as of wholesalers and retailers, as well as information on the quantities produced, manufactured, delivered, received or ordered, as well as the price of the products or services concerned.

3. The information is acquired through interrogation of the subjects referred to in paragraph 1.

4. The applicant shall provide a specific indication of the persons to be questioned and the facts on which each of them is to be questioned.

5. The court, granted the questioning, requests from the subjects referred to in paragraph 1 the information indicated by the party; it may also address to them, ex officio or at the request of a party, any questions which it deems useful in clarifying the circumstances in which the questioning takes place.

6. Articles 249, 250, 252, 255 and 257(1) of the Code of Civil Procedure shall apply.²¹

Art. 122.²²

Legitimation to the action of nullity and revocation

1. Without prejudice to the provisions of Article 118(4), an action seeking to obtain a declaration of revocation or invalidity of an industrial property title may be brought by any person having an interest in it and promoted of its own motion by the public prosecutor. By way of derogation from Article 70 of the Code of Civil Procedure, the intervention of the public prosecutor is not mandatory.²³

2. An action for a declaration of invalidity of a trade mark for the existence of earlier rights or because the use of the trade mark would constitute an infringement of another's copyright, industrial property or other exclusive right of third parties, or because the trade mark constitutes an infringement of the right to name or portrait or because the registration of the trade mark was made in the name of the non-beneficiary, may be brought only by the proprietor of the earlier rights and by his successor or by the right holder.

3. Action for a declaration of invalidity of a design for the existence of the earlier rights referred to in Article 43(1)(d) and (e) or because registration was made on behalf of the non-entitled person or because the design constitutes improper use of one of the elements listed in Article 6-ter of the Paris Union Convention for the Protection of Industrial Property — Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976, or designs, emblems and coats of arms which are of particular public interest in the State, may, respectively, be exercised only by the holder of the earlier rights and by his successor in law or by the entitled person or by those who have an interest in the use.

4. The action for revocation or invalidity of an industrial property title is exercised in contradiction of all those who are registered in the register as holders of it.

5. Judgments declaring the nullity or revocation of an industrial property title are recorded in the register by the Italian Patent and Trademark Office.

6. A copy of the application of any civil proceedings in the matter of²⁴ industrial property titles must be communicated to the Italian Patents and Trademark Office, by those who promote the proceedings.

7. If the above communication has not been done, the judicial authority shall, at any stage of the proceedings, before deciding on the substance, provide that such communication is to be made.

8. The Registrar must send to the Italian Office patents and trademarks a copy of each ruling in the matter of title i²⁵ of industrial property.

Art. 123.

Effectiveness erga omnes

1. The revocations or invalidities, even partial, of an industrial property title shall be effective in respect of all persons when they are declared by a judgment which has the force of *res judicata*.

Art. 124.

*Remedial measures and civil sanctions*²⁶

1. By the judgment establishing the infringement of an industrial property right, the inhibition of the manufacture, trade and use of the goods constituting infringement of the law and the order for definitive withdrawal from trade of the same goods may be ordered against those who own or otherwise have the availability of such goods. The prohibition and the definitive withdrawal order from trade may also be issued against any intermediary, who is a party to the trial and whose services are used to infringe an industrial property right

2. By ruling the injunction, the court may fix a sum due for each infringement or non-compliance subsequently found and for any delay in the execution of the order.

3. The judgment establishing the infringement of an industrial property right may be ordered to destroy all the things constituting the infringement, if there are no particular grounds against it, at the expense of the infringer. The destruction of the thing cannot be ordered and the rightholder can only obtain compensation for damages, if the destruction of the thing is detrimental to the national economy. If the products constituting infringement of industrial property rights are liable, after

appropriate modification, of lawful use, may be ordered by the court, instead of final withdrawal or destruction, their temporary withdrawal from trade, with the possibility of reintegration following the adjustments imposed to ensure compliance with the law.²⁸

4. By the judgment establishing the infringement of industrial property rights, it may be ordered that the objects produced imported or sold in violation of the right and the specific means which serve unequivocally to produce them or to implement the method or process protected are to be assigned in ownership to the right holder, without prejudice to the right to compensation for damage.

5. It is also in the power of the court, at the request of the owner of the objects or means of production referred to in paragraph 4, taking into account the remaining duration of the industrial property title or the particular circumstances of the case, order the seizure, at the expense of the infringer, until the end of the title, the objects and the means of production. In the latter case, the holder of the industrial property right may request that the seized objects be awarded to him at the price which, in the absence of agreement between the parties, will be determined by the executing court, after hearing, if necessary, an expert.

6. Of things constituting infringement of the industrial property right, removal or destruction cannot be disposed of, nor can it be prohibited from their use when they belong to those who use them personally or domestically. When applying sanctions, the judicial authority shall take into account the necessary proportion between the seriousness of the infringements and the penalties, as well as the interest of third parties.

7. On the objections arising in carrying out the measures referred to in this article, it shall decide, by order not subject to encumbrance, after hearing the parties, taking summary information, the court which delivered the judgment containing the above measures.

Art. 125.³⁰

Compensation for damage and return of profits of the infringer

1. Compensation due to the injured party shall be settled in accordance with the provisions of Articles 1223, 1226 and 1227 of the Civil Code, taking into account all relevant aspects, such as the negative economic consequences, including loss of income, of the rightholder harmed, the benefits achieved by the infringer and, in appropriate cases, elements other than economic ones, such as the non-material damage caused to the rightholder by the infringement.

2. The judgment granting compensation for damages may make it liquidated in an overall sum determined on the basis of the documents of the case and the presumptions resulting therefrom. In this case, the loss of profit is in any event determined in an amount not less than that of the fees that the infringer would have to pay if he had obtained a licence from the injured rightholder.

3. In any case, the holder of the injured right may request the repayment of the profits made by the infringer, as an alternative to compensation for lost profits or in so far as they exceed such compensation.

Art. 126.

Publication of the judgment

1. The court may order that the precautionary order or the judgment establishing the infringement of industrial property rights be published in full or in summary or in the sole part of the exhibition, having regard to the seriousness of the facts, in one or more newspapers indicated by it, at the expense of the unsuccessful party.

Art. 127.³¹

Criminal and administrative sanctions

1. Suppressedor³²

1-bis. Anyone who refuses without justified reason to answer the court's questions under Article

121-bis or provides it with false information shall be punished by the penalties provided for in Article 372 of the Penal Code, reduced by half.³³

2. Any person who affixes, on an object, words or indications which do not correspond to the truth, tending to make the object believe that the object is protected by a patent, design or topography or to make it believe that the mark that distinguishes it has been registered, is punishable by an administrative penalty from EUR 51.65 to EUR 516.46.

3. Unless the act constitutes a criminal offence, it shall be punished by an administrative penalty of up to EUR 2 065,83, even where there is no harm to the third party, any person who uses a registered trade mark, after its registration has been declared void, where the ground for invalidity entails the illegality of the use of the trade mark, or abolishes the mark of the manufacturer or trader from whom he received the goods or goods for commercial purposes.

Art. 128.³⁴

Preventive technical advice

1. The applications for carrying out the prior technical advice provided for in Article 969-bis of the Code of Civil Procedure shall be submitted to the President of the specialised section of the court competent for the substantive judgment, in accordance with the provisions of the same article, as compatible.

Art. 129.

Description and seizure

1. The holder of an industrial property right may request the description or seizure, and also the seizure subject to the description, of some or all objects constituting infringement of that right, as well as the means used to produce them and the evidence relating to the alleged infringement and its extent. Appropriate measures shall be taken to ensure the protection of confidential information.

2. The court shall, after hearing the parties and, where necessary, take summary information, make an order and, if it provides a description, shall authorise any samples of the objects referred to in paragraph 1 to be taken. In cases of special urgency, and in particular where any delay could cause irreparable damage to the rightholder or when the convening of the other party could prejudice the implementation of the order for description or seizure, it shall arrange the application by reasoned decree.

3. Subject to the requirements of criminal justice, the objects in which the infringement of an industrial property right is found to have been infringed may not be seized, but only described, as long as they appear in the enclosure of an official or officially recognised exhibition held in the territory of the State, or in transit from or through it.

4. Description and seizure procedures shall be governed by the rules of the Code of Civil Procedure concerning precautionary proceedings, since they are compatible and not derogated from this Code. For the purposes of confirming, amending or withdrawing the description and any precautionary measures requested in conjunction with or subject to the description, the court shall fix the discussion hearing taking into account the description in order to assess the outcome.

Art. 130.³⁵

Execution of description and seizure

1. The description and seizure are carried out by a judicial officer, with the assistance, where necessary, of one or more experts and also with the use of technical means of verification, photographic or other.

2. Interested parties may be authorised to attend the operations also through their representatives and to be assisted by technicians of their trust.

3. After the end of Article 675 of the Code of Civil Procedure, the description and seizure

operations already initiated may be completed, but no further operations may be initiated on the basis of the same measure. It is without prejudice to the right to request the court to order further measures of description or seizure in the course of the proceedings on the merits.

4. The description and seizure may concern objects belonging to persons who are also not identified in the application, provided that they are articles produced, offered, imported, exported or marketed by the party to whom the said measures have been issued and provided that such articles are not used for personal use.

5. The minutes of the seizure and description operations, with the appeal and the order, must be notified to the third party to whom the objects on which description or seizure have been carried out belong, within fifteen days of the date of conclusion of the operations themselves, under penalty of ineffectiveness.

Art. 131.

Inhibitory

1. The holder of an industrial property right may request the prohibition of any imminent infringement of his right and the continuation or repetition of the infringements in place, and in particular may request that the inhibition of the manufacture, trade and use of the goods constituting infringements of the law be ordered, and the order for withdrawal from trade of the same property against those who own or otherwise have the availability, in accordance with the rules of the Code of Civil Procedure concerning precautionary proceedings. The prohibition and the order to withdraw from trade may be requested, on the same conditions, against any person whose services are used to infringe an industrial property right

1-bis. Suppressed

1-ter. Suppressed

1. quater. Suppressed

2. By ruling the injunction, the court may fix a sum due for each infringement or non-compliance subsequently found and for any delay in the execution of the order.

Art. 132.

Anticipation of the precautionary protection and the relationship between the precautionary judgment and the judgment on the merits

1. The measures referred to in Articles 126, 128, 129, 131 and 133 may also be granted during patenting or registration, provided that the application has been made available to the public or to persons to whom the application has been notified.

2. If the court in granting the precautionary order does not set the time limit within which the parties are to initiate the substantive judgment, the latter must be initiated within a period of twenty working days or thirty-one calendar days if they represent a longer period. The period shall run from the date of delivery of the order if it took place at the hearing or, otherwise, from its communication. Where additional precautionary measures have been sought in addition to or subject to the description, reference shall be made for the purposes of calculating the time-limit to the order of the designated court, which also adjudicates on such further measures.

3. If the judgment on the merits is not initiated within the mandatory period referred to in paragraph 2, or if after its inception is terminated, the precautionary measure loses its effectiveness.

4. The provisions referred to in paragraph 3 shall not apply to emergency measures issued pursuant to Article 700 of the Code of Civil Procedure and to other precautionary measures capable of anticipating the effects of the substantive judgment. In such cases, each party may initiate the substantive judgment.

5. In all precautionary proceedings, the court may order technical advice for the purposes of obtaining summary technical information.

Art. 133.

Precautionary Protection of Domain Names

1. The judicial authority may order, on a precautionary basis, in addition to the inhibition of the use in the economic activity of the illegally registered domain name, also its provisional transfer, subject, if deemed appropriate, to the provision of adequate security by the beneficiary of the measure.

Art. 134.³⁷

Rules on competence

1. The specialised sections provided for in Legislative Decree No 168 of 27 June 2003 are devolved:

a) legal proceedings in the field of industrial property and unfair competition, with the exception of cases which do not interfere, even indirectly, with the exercise of industrial property rights, as well as in matters relating to the exercise of industrial property rights within the meaning of Law No 287 of 10 October 1990 and Articles 81 and 82 of the Treaty establishing the European Community, the knowledge of which is of the ordinary court, and in general in matters of connection, including improper, with those of the specialised chambers;

b) disputes in matters governed by Articles 64, 65, 98 and 99 of this Code;

c) disputes concerning compensation for the expropriation of industrial property rights, of which the ordinary court is familiar;

d) disputes concerning the measures of the Council of the order referred to in Chapter VI of which the ordinary court is familiar.

Art. 135.³⁸

Board of Appeals

1. Against orders of the Italian Patent and Trademark Office which reject all or part of an application or application refusing transcription or preventing the recognition of a right and in the other cases provided for in this Code, an appeal may be appealed within a period of sixty days from the date of receipt of the communication of the order to the Appeals Commission.

2. The Board of Appeals shall consist of a Chairperson, an Deputy Chairperson and eight members chosen from among the magistrates of not less than that of Appeal Counsellor, after consulting the Superior Council of the Judiciary, or from among the professors of legal subjects of the universities or of the State's higher institutes.

3. The Commission is divided into two sections, chaired by the President and the Deputy Chair. The President, the Deputy Chairman and the Members of the Commission shall be appointed by decree of the Minister for Economic Development, and shall last for two years. The assignment is renewable.

4. To the Commission referred to in paragraph 2 may be aggregated technicians chosen by the President from among the professors of universities and institutes and from among the consultants in industrial property, enrolled in the Order with proven experience as technical consultants ex officio, to report on individual questions submitted to it. The aggregated technicians have no deliberative vote.

5. The choice of the members of the Commission, as well as of the technicians, may fall on both officials in service and on retired officials, without prejudice to the categories of officials within which the choice is to be made.

6. The Board of Appeals shall be assisted by a secretariat whose members are appointed by the same decree setting up the Commission, or by a separate decree. The members of the secretariat must be chosen from among the officials of the Italian Patent and Trademark Office and the economic treatment is that established by the current legislative, regulatory or contractual legislation.

7. The Appeals Commission has an advisory function of the Ministry of Economic Development in the field of industrial property. This function is exercised at the request of the Ministry

of economic development. The meetings of the Commission in consultation shall not be valid unless there is an absolute majority of its members having a deliberative vote.

8. The remuneration for the members of the Commission, the members of the Commission secretariat and the technicians aggregated to the Commission shall be determined by decree of the Minister for Economic Development, in agreement with the Minister for Economic Affairs and Finance.

Art. 136.³⁹

Procedure before the Commission of Appeals

1. The appeal must be served both to the Italian Patent and Trademark Office and to the other parties to whom the act refers directly within sixty days from the date on which the person concerned received the communication, or had knowledge of it, or, in the case of documents not required individual communication, from the day on which the deadline for publication expired, whether this is provided for by law or regulation, except for the obligation to supplement with the additional notifications to the other parties concerned, which are ordered by the Board of Appeals. The appeal, with proof of the notifications, with a copy of the contested measure where in the applicant's possession and with the documents the applicant wishes to rely on in court, must be lodged, within 30 days of the last notification, at the offices referred to in Article 147 or sent directly, by registered mail, to the Secretariat of the Appeals Commission, with the Italian Patent and Trademark Office.

2. Together with the application, proof of payment of the unified contribution referred to in Article 9 of Presidential Decree No 115 of 30 May 2002 must be presented.

3. The original of the application must be combined with as many free paper copies as the members of the Commission and the counterparts, without prejudice, however, to the power of the President of the Commission to request a greater number of copies from the interested parties.

4. Failure to produce a copy of the contested measure and the documentation in support of the action does not imply revocation. The Italian Patent and Trademark Office, within 30 days of the expiry of the time limit for filing the action, must produce, by inserting it in the appropriate file kept by the Commission's secretariat, any contested measure and the acts and documents on the basis of which the document was issued, those cited therein, and those which the office considers useful for the proceedings.

5. The President of the Commission shall assign the appeal to the relevant section. The President or the Deputy President shall appoint a rapporteur from among the members assigned to the Section and, in the case of technical issues, may also appoint one or more Deputy Rapporteurs, chosen from among the aggregated technicians.

6. The President, or the rapporteur delegated by him, shall set the time limits, in any event not exceeding sixty days, for the submission of the statements and replies of the counterparties and for the filing of the relevant documents.

7. After expiry of the time limits referred to in paragraph 6, the Commission may order the means of inquiry it deems appropriate, laying down the detailed rules for their recruitment. The President, or the rapporteur delegated by him, during the course of the investigation, may hear the parties for any clarification. Where the means of inquiry are not necessary, or, in any event, after the completion of them, the President shall set the date for discussion before the Commission.

8. The sections of the Commission, when deciding on appeals, shall judge with the intervention of a President and two members having a deliberative vote.

9. The Commission may request clarifications and documents from the Italian Patent and Trademark Office.

10. The applicant, or his authorised representative if there is any, who requests it in good time and in any event at least two days before the debate shall be entitled to be admitted orally to state his reasons. The claimant may stand trial in person or may be assisted by a lawyer or an authorised representative with the participation of a technician. The Office may bring proceedings as a Respondent Administration with an official of its own. When the sitting was opened, the rapporteur

reported on the appeal. Subsequently, the parties, or their representatives, shall explain their reasons and, in the event of a request by the members of the Commission, the Director of the Italian Patent and Trademark Office or the official of the same office, designated by him to represent him, shall provide the information and documents requested.

11. Any interested party may submit to the Commission explanatory statements before the end of the proceedings. If new facts influencing the decision emerge during the discussion, they must be challenged by the parties.

12. The Commission is always entitled to order the means of inquiry which it considers appropriate and also has the power, in any event, to order the postponement of the decision, or even the debate, to another sitting.

13. The Commission shall decide after the parties have departed.

14. If the Board of Appeal considers the action inadmissible or inadmissible, it shall declare it by judgment; if he acknowledges that the appeal is unfounded, he shall reject it by judgment; if it upholds the action, it annuls the act in whole or in part and takes the consequent measures.

15. The rapporteur, or another member of the Commission, is responsible for drawing up the judgment and setting out the reasons for the decision.

16. The judgment shall be notified, by registered mail, by the Commission secretariat, to the person concerned or to his authorised representative, if appointed, and shall be published in the Official Bulletin, in the sole part of the presentation, without prejudice to the Commission's right to order that judgments be published in full in that bulletin where they concern matters of principle and where publication is not liable to be detrimental.

17. If the applicant, alleging serious and irreparable harm resulting from the enforcement of the contested measure, or from the inert conduct of the Italian Patent and Trademark Office, during the time necessary to reach a decision on the appeal, requests the adoption of precautionary measures which, in the circumstances, appear to be more suitable for ensuring the effects of the decision on the appeal on time, the Appeals Board decides on the application by an order issued in the Chamber of Council. Before the precautionary application is dealt with, in cases of extreme seriousness and urgency, such as not even allowing deferral until the date of the Chamber of Council, the applicant may, at the same time as the application for interim measures or with a separate application notified to the counterparties, request the President of the Appeals Commission, or the Chamber to which the appeal is assigned, to order interim protective measures. The President shall provide by reasoned decree, even in the absence of adversarial action. The decree is effective until the ruling of the College, to which the precautionary application is submitted in the first useful Chamber of Council. In the decision of the application for interim measures, the Board of Appeals, having ascertained the completeness of the adversarial and the investigation and where the conditions are met, after hearing the parties constituted on this point, may determine the substance of the judgment in accordance with the preceding paragraphs.

18. An application for revocation or amendment of the precautionary measures granted and the re-application of the provisional application rejected shall be admissible only if they are justified in relation to the facts which have occurred.

19. In the event that the administration has failed to comply with the precautionary measures granted, or has only partially complied with it, the interested party may, by reasoned application and served on the other parties, request the Commission for the appropriate implementing provisions. The Board of Appeals shall exercise the powers inherent in the judgment of compliance with the *res judicata* referred to in Article 27(1)(4) of the Consolidated Text of the Laws on the Council of State, approved by Royal Decree No 1054 of 26 June 1924, as subsequently amended, and shall order the enforcement of the precautionary order specifying the procedures and, where appropriate, the person to take action.

Art. 137.

Enforcement and seizure of industrial property rights

1. Industrial property rights may be enforced.
2. The rules laid down in the Code of Civil Procedure for the execution of movable property

shall apply to enforcement.

3. The attachment of the industrial property title shall be effected by a document notified to the debtor, by means of a bailiff. The act must contain:

a) the declaration of attachment of the industrial property title, after mentioning the elements capable of identifying it;

b) the date of the title and its dispatch in enforceable form; the sum for which the execution is carried out;

d) the surname, name and domicile, or residence, of the creditor and debtor;

e) the surname and name of the bailiff.

4. The debtor, from the date of service, assumes the obligations of the judicial seizer of the industrial property title, also with regard to any fruits. The fruits, accrued after the date of notification, resulting from the grant of use of the industrial property right, shall be combined with the proceeds from the sale, for the purposes of subsequent allocation.

5. With regard to the service of the attachment document, the rules contained in the Code of Civil Procedure for the service of quotations are observed. If the person to whom the attachment document is to be served has no domicile or domicile in the State, nor is he in that elected domicile, the service shall be carried out at the Italian Patent and Trademark Office. In the latter case, a copy of the document shall be displayed in the Register of the Office and inserted in the Official Bulletin.

6. The act of foreclosure of the industrial property right must be transcribed, under penalty of ineffectiveness, within eight days of notification. After the transcription of the act of attachment of the industrial property right, and as long as the foreclosure itself explains effect, the foreclosures subsequently transcribed are valid as an opposition to the sale price, when they are notified to the creditor in progress.

7. The sale and award of foreclosed industrial property rights shall be made in accordance with the corresponding rules laid down in the Code of Civil Procedure as applicable, subject to the special provisions of this Code.

8. The sale of the industrial property right cannot be made unless at least thirty days have elapsed since foreclosure. A period of twenty days for sale shall run from the decree fixing the day of the sale. The court, for the sale and award of industrial property rights, provides for the special forms it deems appropriate in individual cases, also providing for the announcement of the sale to the public, also in derogation from the rules of the Code of Civil Procedure. For this purpose, the judge may determine that the announcement is posted on the premises of the Chamber of Commerce and in those of the Italian Patents and Trademark Office and published in the Bulletin of Industrial Property Rights.

9. The award report must contain the details of the right to industrial property right the results of the relevant titles.

10. The immediate creditor, in enforcement of industrial property rights, must notify at least ten days before the sale to the creditors holding the rights of guarantee, transcribed, the act of attachment and the decree fixing the day of sale. The latter creditors must lodge, at the Registry of the competent judicial authority, their applications for placement with supporting documents within 15 days of the sale. Anyone interested in it may examine these applications and documents.

11. After the period of fifteen days, provided for in paragraph 10, the court, at the request of one of the parties, shall fix the hearing at which it will propose the status of graduation and distribution of the price obtained from the sale and any fruits. At the hearing, the court ascertained compliance with the provisions of paragraph 10, where the parties did not agree on the distribution of the proceeds of the fruits, graduation between the creditors and the distribution of that proceeds of the fruits themselves, in accordance with the relevant rules laid down in the Code of Civil Procedure for the enforcement of securities. Claims with default, if any or conditional, become due in accordance with the rules of the Civil Code.

12. The successful tenderer of the industrial property right has the right to obtain the cancellation of the transcripts of the guarantee rights on the corresponding title, by depositing, with the Italian Patent and Trademark Office, a copy of the award report and certified by the Registrar of the payment of the award price, in compliance with the rules for the cancellation of transcripts.

13. Industrial property rights, even if they are being granted or registered, may be seized. The provisions on enforcement laid down in this Article and those on seizure laid down in the Code of Civil Procedure shall apply to the seizure procedure.

14. Disputes concerning the enforcement and seizure of industrial property rights shall be brought before the judicial authority of the competent State in accordance with Article 120.

Art. 138.

Transcription

1. They must be made public by transcription with the Italian Patent and Trademark Office:

a) acts between live, for consideration or free of charge, which transfer in whole or in part the rights in industrial property rights;

b) acts between live, for consideration or free of charge, constituting, modifying or transferring personal or remnant rights of enjoyment of special privileges or security rights, established in accordance with Article 140 relating to those securities;

c) the acts of division, of companies, of transaction, of renunciation, relating to the rights set out in points (a) and (b);

d) the foreclosure report;

e) the award report following forced sale;

f) the suspension report of the sale of part of the industrial property rights forfeited to be returned to the debtor, in accordance with the Code of Civil Procedure;

g) the decrees of expropriation for reasons of public utility;

h) judgments declaring the existence of the acts referred to in points (a), (b) and (c) where those acts have not previously been transcribed. Judgments declaring nullity, annulment, termination, termination or revocation of a transcribed document must be noted in the margins of the transcription of the document to which they relate. In addition, legal claims for the purposes of obtaining the judgments referred to in this Article may be transcribed. In such a case, the effects of the transcript of the judgment date from the date of transcription of the document instituting the proceedings;

i) wills and acts proving that there has been a legitimate succession and the relevant judgments;

l) judgments of industrial property rights claim and related legal claims;

m) judgments ordering the conversion of null industrial property rights and the related legal claims;

n) proceedings for the purposes of obtaining the judgments referred to in this Article. In that case, the effects of the transcript of the judgment date from the date of transcription of the document instituting the proceedings.

2. The transcript is subject to payment of the required fee.

3. In order to obtain the transcription, the applicant must submit a specific transcription note, in the form of an application, attaching an authentic copy of the authentic instrument or the original or authentic copy of the authenticated private writing or any other documentation provided for in Article 196.

4. The Italian Patents and Trademark Office, having examined the formal legality of the documents, proceeds, without delay, to the transcription with the date of submission of the application.

5. The order of the transcripts is determined by the order for submission of applications.

6. Omissions or inaccuracies which do not lead to absolute uncertainty as to the act to be transcribed or the industrial property title to which the act relates shall not result in the invalidity of the transcription.

Art. 139.

Effects of transcription

1. The acts and judgments, with the exception of the wills and other acts and judgments referred

to in points (d), (i) and (l) of Article 138, until they are transcribed, shall not have effect in respect of third parties who in whatever capacity have acquired and legally retained rights over the industrial property title.

2. In the conflict of several purchasers of the same industrial property right from the same owner, the person who first transcribed his title of purchase is preferred.

3. The transcript of the foreclosure record, as long as its effectiveness lasts, suspends the effects of the further transcripts of those acts and judgments. The effects of such transcripts shall cease after the transcript of the award report, provided that it takes place within three months of the date of the award.

4. Wills and acts proving that there has been a legitimate succession and the relevant judgments shall be transcribed only to establish the continuity of transfers.

5. Acts which transfer, in whole or in part, or modify the rights inherent in an application or a European patent, provided that they have been registered in the European Patent Register or transcribed in the Italian Register of European Patents, shall be enforceable against third parties.

Art. 140.

Warranty rights

1. The security rights on industrial property securities must be constituted for credits of money.

2. In the contest of multiple warranty rights, the grade is determined by the order of the transcripts.

3. The cancellation of the transcripts of the guarantee rights is carried out following the production of the act of consent of the creditor with certified signature or when the cancellation is ordered by a judgment which has the force of *res judicata* or following the satisfaction of the rights assisted by guarantee following enforcement.

4. For cancellation is due the same right prescribed for the transcription.

Art. 141.

Expropriation

1. With the exception of trademark rights, industrial property rights, even if they are being registered or patented, may be expropriated by the State in the interest of the military defense of the country or for other reasons of public utility.

2. Expropriation may be limited to the right of use for the needs of the State, subject to mandatory licensing provisions as compatible.

3. With the above expropriation, when it is carried out in the interest of the military defense of the country and concerns industrial property titles of Italian holders, it is also transferred to the expropriating administration the right to apply for industrial property titles abroad.

Art. 142.⁴⁰

Decree of Expropriation

1. The expropriation is ordered by decree of the President of the Republic, on the proposal of the competent Minister, in agreement with the Ministers of Economic Development and Economy and Finance, after consulting the Council of Ministers, if the measure concerns the military defense of the country or, in other cases, the Appeals Committee.

2. The decree of expropriation in the interests of the military defense of the country, when issued before the printing of the certificate of patent or registration, may contain the obligation and establish the duration of the secrecy on the subject of the industrial title.

3. Violation of secrecy shall be punished in accordance with Article 262 of the Criminal Code.

4. The expropriation order shall set the compensation payable to the holder of the industrial

property right, determined on the basis of its market value, after hearing the Appeals Commission.

5. Judicial protection before the administrative court is governed by the Code of Administrative Process.⁴¹

Art. 143.

Expropriation allowances

1. Where the holder of the expropriated right does not accept the indemnity fixed in accordance with Article 142 and in the absence of agreement between the holder and the proceeding administration, the indemnity shall be determined by a panel of arbitrators.

2. The inventor or the author, who proves that he has lost his right of priority abroad due to the delay of the negative decision of the Ministry on expropriation, shall be granted a fair compensation, in accordance with the rules relating to the expropriation allowance.

3. The expropriation decrees must be entered in the Register of Industrial Property Titles by the Italian Patent and Trademark Office.

Section II

Measures against piracy

Art. 144.

Acts of piracy

1. For the purposes of the rules contained in this section, acts of piracy include obvious counterfeiting of registered trademarks, designs and infringements of others' industrial property rights systematically carried out maliciously.

Art. 144-bis.⁴²

Seizure Preservation

1. Where the injured party relies on the existence of circumstances liable to affect the satisfaction of compensation for the damage, the judicial authority may order, pursuant to Article 671 of the Code of Civil Procedure, the preservation of the movable and immovable property of the alleged infringer, including the blocking of its bank accounts and other assets until the presumed amount of the damage competes. To that end, the judicial authority may order the communication of the banking, financial or commercial documentation or authorise access to the relevant information.

Art. 145.

National Anti-Counterfeiting Council

1. The National Anti-Counterfeiting Council is established at the Ministry of Economic Development, with the function of guiding, stimulating and coordinating the strategic actions undertaken by each administration, in order to improve the overall action to combat counterfeiting at national level.

2. The National Anti-Counterfeiting Council shall be chaired by the Minister for Economic Development or a representative appointed by him. In order to ensure the representation of public and private interests and to ensure the necessary synergies between public administration and business, the Council shall be composed of a representative of the Ministry of Economic Development, a representative of the Ministry of Economy and Finance, a representative of the Ministry of Foreign Affairs, a representative of the Ministry of Defence, a representative of the Ministry of Food and Forestry, a representative of the Ministry of Interior, a representative of the Ministry of Justice, a representative of the Ministry of Cultural Heritage and Activities, a representative of the Ministry of

Labour and Social Policies, a representative of the Ministry of Health, and a representative of the Department of Public Service and a representative appointed by ANCI. The Council may invite representatives of other public administrations as well as the categories of businesses, workers and consumers to participate in its work.

3. The methods of operation of the National Anti-Counterfeiting Council are defined by decree of the Minister for Economic Development, in agreement with the Ministers of Economy and Finance, Foreign Affairs, Defence, Agricultural, Food and Forestry Policy, Interior, Justice, Cultural Goods and Activities, Work and Social Policies and Health. The secretarial activities are carried out by the Directorate-General for Combating Counterfeiting — Italian Patents and Trademark Office.

4. Participation in the National Anti-Counterfeiting Council shall not give rise to remuneration, emoluments, allowances or reimbursements of expenses. The implementation of paragraphs 1, 2 and 3 shall be carried out within the framework of the human, financial and instrumental resources available under current legislation.

Art. 146.⁴³

Actions against piracy

1. If it is known, the Ministry of Economic Development shall report to the Public Prosecutor's Office, responsible for the territory, for the initiatives within its competence, cases of piracy.

2. Without prejudice to the repression of criminal offences and the application of the national and Community legislation in force on the matter, which falls within the competence of the customs authorities, the Ministry of Economic Development, through the Prefect of the province concerned and the mayors, limited to the municipal territory, may also order the administrative seizure of counterfeit goods of their own motion and, after three months, after authorisation by the judicial authority referred to in paragraph 3, proceed to its destruction, at the expense of the offender. It shall be without prejudice to the right to retain samples to be used for judicial purposes.

3. Competent to authorise destruction shall be the president of the section referred to in Article 120, in whose territory the act of piracy is carried out, at the request of the State or municipal administration which ordered the seizure.

4. Opposition to the destruction measure referred to in paragraph 2 shall be brought before the specialised section of the Tribunal competent for territory in the forms referred to in Articles 22 and 23 of Law No 689 of 24 November 1981, as subsequently amended. The time limit for appeal shall run from the date of service of the measure or from the date of its publication, in extract, in the Official Gazette of the Italian Republic.

Chapter IV

ACQUISITION AND MAINTENANCE OF INDUSTRIAL PROPERTY RIGHTS AND RELATED PROCEDURES

Section I

Questions in general

Art. 147.

Filing of applications and applications

1. All applications, applications, documents, documents and appeals referred to in this Code, with the exception of the provisions of international conventions and agreements, shall be filed with the Italian Patent and Trademark Office with the Chambers of Commerce, Industry and Crafts and with the public offices or bodies determined by decree of the Minister for Economic Development. By decree of the same Minister, with respect to the provisions contained in Legislative Decree No 82 of 7 March 2005, the procedures for filing are determined, including those to be implemented by

means of other means of communication. Upon receipt of the above-mentioned offices or bodies, they issue the attestation of the filing and within the next ten days shall forward to the Italian Patent and Trademark Office, in the forms indicated in the decree, the documents filed and the related attestation.

2. The offices or entities entitled to receive deposits are required to take the necessary measures to ensure compliance with professional secrecy.

3. The employees of the Italian Patent and Trademark Office may not apply for patents for industrial inventions or become assignees to the Italian Patent and Trademark Office, unless two years after they have ceased to belong to their office.

3-bis. The applicant or his authorised representative, if any, shall in each application indicate or elect his domicile in the State for all communications and notifications to be made under this Code.

Art. 148.

Admissibility and supplementation of applications and date of filing

1. Applications for patent, registration and renewal referred to in Article 147(1) shall not be admissible if the applicant is not identifiable or cannot be reached and, in the case of first filing marks, even where the application does not contain the reproduction of the mark or the list of goods or services. Inadmissibility, except as provided for in paragraph 3, shall be declared by the Italian Patent and Trademark Office.

2. The Italian Patent and Trademark Office shall invite the applicant to make the necessary supplements, subject to a right of delay in the event of late payment, within two months from the date of notification if it finds that:

a) the application for industrial inventions and utility models shall not include a document capable of being assimilated to a description or missing part of the description or drawing referred to therein, or the application contains, in place of the description, a reference to an earlier application of which the number, date of filing, state in which the filing took place and the identification data of the applicant are not provided;

b) at least one specimen of the description with at least one specimen of the photographs referred to therein shall be attached to the application for plant variety;

c) no graphic or photographic reproduction is attached to the application for models and drawings;

d) a document permitting their identification shall not be attached to the application for topographies;

e) documents proving payment of the fees prescribed within the time limit referred to in Article 226 shall not be delivered;

e-bis) is not indicated a domicile in Italy or an authorised representative.

3. If the applicant fulfils the invitation of the office within the time limit referred to in paragraph 2 or spontaneously integrates it, the Office shall recognise the date of the filing, which shall be valid for all purposes, the date of receipt of the requested supplement and shall notify the applicant thereof. If the applicant fails to comply with the invitation of the office within the time limit referred to in paragraph 2, unless, within that period, the Office has expressly waived the missing part of the description or design referred to in point (a) of paragraph 2, the Office shall declare the application inadmissible pursuant to paragraph 1.

4. However, if the supplement concerns only proof of payment of the fees within the prescribed period or the indication of the domicile or the authorised representative in Italy and this proof or indication is delivered within the period referred to in paragraph 2, the Office shall recognise the date of filing that of receipt of the application as the date of filing.

5. All applications, applications and appeals referred to in Article 147, together with the attached acts, must be drawn up in Italian. Documents in a language other than Italian, translation into Italian must be provided. The translation may be declared in conformity with the original text by the applicant or an authorised representative. If the description is presented in a language other than the Italian

language, the translation into Italian must be lodged within the time limit set by the Office.

5-bis. The Office shall, upon application, issue a copy or an authentic copy of the documents or references produced at the time of filing. The Italian translation, if submitted subsequently, shall be attached upon request.

Art. 149.

Filing of European patent applications

1. European patent applications may be filed with the Italian Patent and Trademark Office in accordance with the implementing regulation.

2. The provisions of Article 198(1) and (2) shall apply. For the purpose of applying these provisions, the application must be accompanied by a summary in Italian which fully defines the characteristics of the invention, as well as a copy of any drawings.

3. The Italian Patent and Trademark Office shall immediately inform the European Patent Office of the filing of the application.

Art. 150.

Transmission of the European patent application

1. Applications for a European patent whose object, in the opinion of the Military Patent Service of the Ministry of Defence, is manifestly not liable to be bound by secrecy on grounds of military defence, shall be forwarded, by the Italian Patent Office, to the European Patent Office as soon as possible and, in any event, within six weeks from the date of filing.

2. In the event that applications for a European patent are deemed to have been withdrawn in accordance with Article 77(5) of the European Patent Convention, the applicant may, within three months from the date of receipt of the communication, request the conversion of the application into an Italian patent application for industrial invention.

3. Without prejudice to the provisions protecting secrecy on inventions of interest in the military defence of the country, the Italian Patent and Trademark Office, if twenty months have not yet elapsed from the date of filing or priority, shall forward a copy of the request for transformation referred to in paragraph 2 to the central services of the other States indicated in the application, attaching a copy of the European patent application produced by the applicant.

Art. 151.⁴⁴

Filing of the international application

1. Italian natural and legal persons and those having their domicile or registered office in Italy may file international applications for the protection of inventions with the Italian Patent and Trademark Office, which acts as receiving office within the meaning of Article 10 of the Patent Cooperation Treaty of 19 June 1970, ratified by Law No 260 of 26 May 1978.

2. The application may be submitted to the Italian Patents and Trademark Office in accordance with the implementing regulation; the date of filing of the application shall be determined in accordance with Article 11 of the Patent Cooperation Treaty.

3. The international application may also be filed with the European Patent Office, in its capacity as receiving office, within the meaning of Article 151 of the European Patent Convention of 5 October 1973, ratified by Law No 260 of 26 May 1978 and at the World Intellectual Property Organisation of Geneva as a receiving office, in accordance with the provisions of Article 198(1) and (2).

Art. 152.⁴⁵

International Application Requirements

1. The international application must comply with the provisions of the Patent Cooperation Treaty of 19 June 1970, ratified by Law No 260 of 26 May 1978 and its Implementing Regulation.
2. For the sole purpose of applying Article 198(1) and (2), the application must be accompanied by a summary in Italian which fully defines the characteristics of the invention, as well as a copy of any drawings.
3. The international application and each of the attached documents, with the exception of those proving payment of taxes, must be filed in one original and two copies. The missing copies are prepared by the Italian Patent and Trademark Office at the expense of the applicant.

Art. 153.⁴⁶

Secrecy of international demand

1. The Italian Patents and Trademark Office, unless the applicant consents, shall make the application available to the public only after the international publication has taken place or the designated office has received the communication referred to in Article 20 of the Patent Cooperation Treaty of 19 June 1970, ratified by Law No 260 of 26 May 1978, or the copy referred to in Article 22 of the same Treaty or, in any case, 20 months from the date of priority.
2. The Italian Patents and Trademark Office may give notice that it has been designated, revealing only the name of the applicant, the title of the invention, the date of filing and the number of the international application.

Art. 154.⁴⁷

Transmission of international application

1. The Italian Patent and Trademark Office shall transmit to the International Office and to the authorities responsible for seeking the international application within the time limits laid down in Rules 22 and 23 of the Regulation implementing the Patent Cooperation Treaty.
2. If 15 days before the date of expiry of the time limit for the transmission of the original copy of the international application, laid down in Rule 22 of the Regulation implementing the Patent Cooperation Treaty, the Ministry of Defence has received the imposition of the obligation of secrecy, the Office shall notify the applicant thereof and be wary of the obligation of secrecy.
3. Within 90 days of the date of communication referred to in paragraph 2, the conversion of the international application into a national application on the same date as the international application may be requested; if the conversion is not requested, the application shall be deemed to have been withdrawn.

Art. 155.⁴⁸

Filing of international applications for designs

1. Italian natural and legal persons or those having their domicile or effective organisation in Italy may file international applications for the protection of designs directly with the International Office or with the Italian Patent and Trademark Office, pursuant to Article 4(1) of the Hague Agreement on the International Deposit of Industrial Designs of 6 November 1925, as subsequently revised, ratified by Law No 744 of 24 October 1980, and hereinafter called: I agree.
2. The application to the Italian Patents and Trademark Office can also be sent by registered mail with acknowledgment of receipt.
3. The date of filing of the application is that of Article 6(2) of the Agreement.
4. The international application must comply with the provisions of the Agreement and its Implementing Regulation, as well as with the administrative instructions issued by the International Bureau, and be drawn up in French or English on forms prepared by the International Bureau.

Art. 156.⁴⁹

Application for trade mark registration

1. The application for registration of a trade mark must contain:

- a) identification of the applicant and also of the authorised representative, if there is;
- b) any claim of priority or of the date on which the application takes effect following the conversion of a previous Community application or for international registration pursuant to the Protocol relating to the Madrid Agreement for the International Registration of Marks of 27 June 1989, ratified by Law No 169 of 12 March 1996;
- c) the reproduction of the mark;
- d) the list of goods or services which the trade mark is intended to distinguish, grouped according to the classes of the classification provided for in the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks, Geneva text of 13 May 1977, ratified by Law No 243 of 27 April 1982.

2. Where there is an authorised representative, the application must be accompanied by the act of appointment pursuant to Article 201.

Art. 157.

Application for registration of a collective mark

1. In addition to the documents referred to in Article 156(1) and (2), the application for collective trade mark registration must also include a copy of the regulations referred to in Article 11.

Art. 158.

Division of the application for trade mark registration

1. Each application must have as its object only one trade mark.

2. If the application concerns more than one trade mark, the Italian Patent and Trademark Office will invite the person concerned, by assigning a time limit, to limit the application to a single mark, with the right to submit, for the remaining marks, as many applications, which will take effect from the date of the primitive application.

3. Each application for registration, having as its object several goods or services, may be divided by the applicant into several partial applications, in which the products or services of the initial application are divided, in the following cases:

- a) before the decision of the trade mark registration office;
- b) during each procedure to object to the decision of the trade mark registration office;
- c) during each appeal procedure against the decision concerning the registration of the trade mark.

4. Partial applications shall retain the date of filing of the initial application and, where appropriate, the benefit of the right of priority.

5. Recourse to the Appeals Board shall suspend the time limit set by the Office.

Art. 159.⁵⁰

Application for brand renewal

1. The application for the renewal of a trade mark must be made by the proprietor or his successor in law.

2. Suppressed

3. Where there is an authorised representative, the application must be accompanied by the act of appointment pursuant to Article 201.

4. For trade marks registered on the basis of an application for conversion of a Community trade mark application or a Community trade mark submitted pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark and subsequent amendments, or on the

basis of an application for conversion of an international registration, submitted pursuant to Article 9-quinquies of the Protocol relating to the Madrid Agreement on the International Registration of Trade Marks of 27 June 1989, ratified by Law No 169 of 12 March 1996, the effects of the first registration, for the purposes of renewal, shall start respectively from the date of filing of the Community trade mark application or the date of international registration.

5. Suppressed

6. If the application for renewal or the fees paid relate only to part of the goods or services for which the trade mark has been registered, registration shall be renewed only for the goods or services concerned.

Art. 160.

Patent application by invention and utility model

1. The application must contain:

a) identification of the applicant and the authorised representative, if any;

b) the indication of the invention or model, in the form of a title, expressing briefly, but with precision, the characters and purpose.

2. The same application may not contain the application for more than one patent or a single patent for multiple inventions or models.

3. The application must be joined by:

a) the description and claims referred to in Article 51;

b) drawings of the invention, where possible;

c) the designation of the inventor;

d) where there is an authorised representative, the act of appointment in accordance with Article 201;

e) in the event of a priority claim, the related documents.

4. The description of the invention or model must begin with a summary that has only technical information purposes and must be followed by one or more claims. They must be submitted, if they have not been included in the description at the time of filing, within two months of the date of the application. In this case, the date of deposit already recognised shall remain unaffected.

Art. 161.

Uniqueness of invention and division of demand

1. Each question must have as its object only one invention.

2. If the application includes more than one invention, the Italian Patent and Trademark Office will invite the person concerned, by assigning a time limit, to limit that application to a single invention, with the right to submit, for the remaining inventions, as many applications, which will take effect from the date of the primitive application. This option may be exercised by the applicant, even in the absence of an invitation from the Italian Patent and Trademark Office, before the latter has granted the patent.

3. Recourse to the Appeals Board shall suspend the time limit set by the Office.

Art. 162.

Storage, access and new storage of biological material

1. Where an invention relates to biological material not accessible to the public and which cannot be described in the patent application in such a way as to enable an expert to implement the invention itself or involves the use of such material, the description shall be considered sufficient, within the meaning of Article 51(3), only if:

a) the biological material has been deposited with an approved filing body no later than the date

of submission of the patent application. At least international filing bodies which have acquired this qualification under Article 7 of the Treaty of Budapest of 28 April 1977, ratified by Law No 610 of 14 October 1985 on the international recognition of the deposit of micro-organisms for the purposes of the patent procedure, shall be recognised, hereinafter referred to as: 'Treaty of Budapest';

b) on the characteristics of the biological material filed, the application filed shall provide all relevant information available to the depositor;

c) the patent application shall specify the name of the filing body and the registration number of the filing.

2. The particulars referred to in paragraph 1, letter c) may be communicated within a period of 16 months from the date of filing of the application or previously in the case of early accessibility to the public or notification to third parties pursuant to Article 53(3) and (4).

3. Without prejudice to Article 53(2), (3) and (4), access to stored biological material shall be guaranteed by the release of a sample. At the request of the depositor, the sample shall be issued only to an independent expert:

a) from the date of accessibility to the public pursuant to Article 53(3) until the patent is granted;

b) for a period of 20 years from the date of filing of the patent application, in the event of refusal or withdrawal of the patent application.

4. Delivery shall take place only if the applicant undertakes for the duration of the patent's effects:

a) not to make available to third parties samples of the biological material deposited or of materials derived therefrom; e

b) to use samples of the biological material deposited or materials derived therefrom exclusively for experimental purposes, unless the applicant or the patent holder explicitly waives that undertaking.

5. The designated expert shall be jointly and severally liable for the abuses committed by the applicant.

6. If biological material deposited under this Article is no longer available from the approved storage facility, a new storage of the material under the same conditions as provided for in the Budapest Treaty shall be permitted.

7. Each new deposit must be accompanied by a declaration signed by the depositor stating that the biological material which is the subject of the new deposit is identical to that in the initial deposit.

Art. 163.

Application for supplementary certificate for medicinal products and plant protection products

1. The application for a certificate must be filed with the Italian Patent and Trademark Office with reference to the authorisation to place the product on the market.

2. The Italian Patent and Trademark Office shall publish at least the following data concerning the application for a certificate:

a) name and address of the applicant;

b) number of the basic patent;

c) title of the invention;

d) the number and date of the marketing authorisation and the indication of the product the identity of which results from the authorisation;

e) where applicable, the number and date of the first marketing authorisation in the community.

Art. 164.

Application for plant variety rights

1. Applications for plant variety rights must include:

a) identification of the applicant and also of the authorised representative, if there is;

- b) the indication in Italian and Latin of the genus or species to which the variety belongs;
 - c) the proposed name, specifying whether it is a code or a fictional name;
 - d) the name and nationality of the author of the plant variety;
 - e) any claim of priority;
 - f) the list of attached documents.
2. The application must be joined by:
- a) description of the plant variety. In the case of a hybrid variety, at the request of the breeder, the information on the genealogical components shall not be made available to the public by the receiving office;
 - b) photographic reproduction of the plant variety and its specific characteristics;
 - c) any information and documentation deemed useful for the examination of the application, and, in particular, the results of the crop examinations that may have already been undertaken in Italy or abroad. The documentation drawn up in a foreign language shall be accompanied by a translation into Italian, declared compliant by the applicant or his authorised representative;
 - d) the declaration referred to in Article 165;
 - e) documents proving any priorities claimed;
 - f) where there is an authorised representative, the act of appointment in accordance with Article 201;
 - g) suppressed.
3. The documents referred to in points (d) and (e) of paragraph 2 may be lodged thereafter, but no later than six months after the application has been lodged. The documents referred to in paragraph 2(c) may be submitted at a later date but no later than the date of commencement of the trials of cultivation of the variety.
4. The variety is described in such a way as to clearly highlight how it has been obtained and what are the morphological or physiological characteristics that differentiate it from other known similar varieties.
5. The description shall also indicate the name proposed by the breeder.
6. In the case of a variety essentially derived within the meaning of Article 107(4), the initial variety shall be indicated. In the case of genetically modified varieties, the origin and nature of the genetic modification shall be indicated.

Art. 165.

Declaration by the breeder

1. The breeder declares that:
- a) the variety of which it seeks protection shall constitute, to its knowledge, a new plant variety within the meaning of Article 103 and shall comply with the requirements of that standard;
 - b) has obtained the authorisation of the holders of other new plant varieties that may be required for the production of that requested variety;
 - c) undertakes to supply, at the request of the competent bodies of the Ministry of Agricultural, Food and Forestry Policy, referred to below with the abbreviation MIPAF, and within the terms laid down by them, the material for breeding or vegetative propagation of the variety intended to allow the examination of the variety;
 - d) has been filed for the same variety of applications for protection in other States and what has been the outcome;
 - e) waiver of any trade mark used if it is identical to the name proposed for the variety.

Art. 166.

Application for varietal denomination

1. The proposed designation for the new variety:
- a) it must comply with the provisions of Article 63 of Regulation (EC) No 2100/94 of

Regulation (EC) No 637/2009 and in the light of the guidelines of the Management Board of the Community Plant Variety Office;

- b) it must not be contrary to law, public order and morality;
- c) it must not contain geographical names.

Art. 167.

Application for registration of designs

1. The application must contain:

- a) identification of the applicant and also of the authorised representative, if there is;

- b) an indication of the design in the form of a title and, where appropriate, an indication of the characteristics of the products intended to be claimed.

2. The application must be joined by:

- a) the graphical reproduction of the design, or the graphical reproduction of industrial products the manufacture of which is to be the subject of the exclusive right, or a sample of those products in the case of industrial products having essentially only two dimensions;

- b) the description of the design, if necessary for the intelligence of the design;

- c) where there is an authorised representative, the act of appointment in accordance with Article 201;

- d) in the event of a priority claim, the related documents.

Art. 168.

Application for registration of topographies

1. Each application shall have as its object a single topography of a semiconductor product and, where it indicates a date of first commercial exploitation, correspond to the topography existing on that date.

2. The following must be attached to the application for registration:

- a) documentation enabling the identification of topography, in accordance with the requirements of the Regulation;

- b) a declaration attesting the date of the first act of commercial exploitation of the topography where that date is earlier than the date of the application for registration. If the applicant is a person other than the person who carried out the first act of commercial exploitation, he must declare the legal relationship with the latter;

- c) where there is an authorised representative the act of appointment in accordance with Article 201;

- d) any designation of the author(s) of the topography.

3. The use of foreign technical terms which have become of current use in the specific sector is permitted.

Art. 169.

Claim of Priority

1. Where the priority of a filing is claimed pursuant to Article 4, a copy of the priority application shall be combined with the name of the applicant, the extent and extent of the industrial property right and the date on which the filing took place.

2. If the filing has been made by others, the applicant must also provide proof of being a successor or having the cause of the first depositor. The document of assignment of the right of priority may consist of a declaration of assignment or transfer within the meaning of Article 196, paragraph 1, letter a).

3. Where separate applications have been filed abroad, on different dates, for the different parts

of the same trade mark and of those parts, the right of priority is sought for each of them, even if they constitute a single whole, a separate application must be filed. Where several registrations or deposits of those different parts of the same trade mark are claimed by a single application, Article 158(1) and (2) shall apply to new separate applications.

4. When separate applications have been filed, on different dates, for the various parts of the same invention, the right of priority may be claimed with a single question whether there is unity of invention. If multiple deposits are claimed with a single application and the inventive unit is not found, Article 161 shall apply to new separate applications.

5. Where the Ministerial Decree for the Temporary Protection of New Marks affixed to goods or materials relating to the provision of the service, which has appeared in an exhibition and claims the rights of priority for such temporary protection, has taken place, the applicant must attach to the application for registration a certificate from the Executive or Governing Board or the Exhibition Chair, having the content prescribed in the relevant Regulation.

5-bis. A priority claim that has not been filed at the time of filing the patent or utility model application may also be made later within 16 months of the date of the first priority claimed. Within the same period, the applicant may correct the data of a previous declaration of priority, provided that, where that correction changes the date of the first priority claimed, and this date is earlier than that originally indicated, the time limit shall run from the actual date of that priority, instead of the date originally indicated. A priority claim which has not been made at the time of submission of the application for a design or a trade mark may be lodged within the next one month for designs and two months for trade marks from the date of submission of that application.

5-ter. The application for correction referred to in paragraph 5-bis relating to a previous declaration of priority must in any case be filed within four months from the date of filing of the patent application by industrial invention or utility model.

6. The patenting or registration shall be carried out without mentioning the priority if, within six months of the date of filing of the application, the documents referred to in paragraph 1 are not produced in the form required. For inventions and utility models, the time limit for filing such documents shall be sixteen months from the date of the earlier application, the priority of which is claimed, if that period is more favourable to the applicant.

7. If the priority of a deposit made to the effects of the international conventions in force is refused, the industrial property title must be noted in the same way as the refusal.

8. The priority claim in the application for a new plant variety right shall be refused if it is made after 12 months from the date of filing of the first application and if the applicant is not entitled to it. Where priority is refused, no mention shall be made in the right.

Art. 170.⁵¹

Examination of applications

1. The purpose of the examination of applications, for which formal regularity has been granted, is to verify:

a) for brands: whether Article 11 may apply in the case of collective marks; if the word, figure or sign may be registered as a trade mark in accordance with Articles 7, 8, 9, 10, 13(1) and 14(1)(a) and (b); whether the conditions laid down in Article 3 are met;

b) in the case of inventions and models of utility that the subject matter of the application complies with the provisions of Articles 45, 50 and 82, including the requirements of validity, where the search for precedence is regulated by ministerial decree and in any case where the absence of them is absolutely evident on the basis of the same declarations and allegations of the applicant or is certain in the same way as the well-known;

c) for designs that the subject-matter of the application complies with the requirements of Articles 31 and 33-a;

d) for plant varieties, the validity requirements laid down in Section VIII of Chapter II of the Code and compliance with the provisions of Article 114 of that Section. The examination of these

requirements shall be carried out by the Ministry of Agricultural, Food and Forestry Policy, which shall issue a binding opinion, using the commission referred to in paragraphs 3-bis et seq. The Commission shall act in accordance with the procedural rules laid down by the relevant operating regulation. In order to ascertain whether the requirements remain, the Ministry of Agricultural, Food and Forestry Policy may ask the holder or his successor for the reproduction or propagation material necessary to carry out the control;

e) in the case of topographies of semiconductor products, that the subject-matter of the application complies with that laid down in Article 87, excluding the validity requirements until the examination has been regulated by ministerial decree.

2. For trade marks relating to agricultural and agri-food products of first processing using geographical designations, the Office shall forward the specimen of the mark and any other documentation to the Ministry of Agricultural, Food and Forestry Policy, which shall deliver the opinion within ten days from the date of receipt of the relevant request.

3. If the above conditions are not met, the Italian Patent and Trademark Office shall provide pursuant to Article 173(7).

4. I'm sorry. The binding opinion on the validity requirements laid down in Section VIII of Chapter II of the Code and on compliance with the provisions of Article 114 shall be expressed by the Ministry of Agricultural, Food and Forestry Policies by means of an Advisory Commission composed of:

- a) director-General for Competitiveness for Rural Development of the Ministry of Agricultural, Food and Forestry Policy, which chairs it;
- b) head of the Office of Biotechnologies, Seeds and Variety Registers of the Ministry of Agricultural, Food and Forestry Policy, which, in the event of the President's impediment, takes over;
- c) head of the Italian Patents and Trademark Office, competent in the field of rights for new plant varieties;
- d) technical examiner of the Italian Patents and Trademark Office;
- e) official of the Office of Biotechnology, Seeds and Variety Registers of the Ministry of Agricultural, Food and Forestry Policy;
- f) director of an institute for agricultural research and experimentation appointed by the Minister of Agricultural, Food and Forestry Policy.

3-ter. For the members referred to in points (b) to (f) of paragraph 3-bis, the appointment of an alternate shall be required.

3-quater. The duties of Secretary of the Commission shall be performed by the official of the Ministry of Agricultural, Food and Forestry Policy referred to in paragraph 1(e).

3-quinques. The commission, without new or increased burdens on the State budget, lasts in office for 3 years and its components can be confirmed; the participation takes place free of charge without payment of emoluments and its operation is provided within the human, financial and instrumental resources available under current legislation.

3-sexies. At the reasoned request of the Chair, they may be called upon to be a member of the committee, from time to time and for the examination of specific issues, qualified experts in the matter.

3-septies. Before giving its opinion, the committee may, on its own initiative or at their request, hear the interested parties or their representatives.

3-octies. The opinion shall be accompanied by an indication of the trials, methodologies and inspections carried out, as well as the results obtained and any findings and observations of the applicant.

3-nonies. By decree of the Minister for Economic Development, in agreement with the Minister for Agricultural, Food and Forestry Policy, the implementing provisions of the Industrial Property Code on new plant varieties are defined, including the provisions relating to the appointment and operation of the commission referred to in paragraph 3-bis.

Art. 170-bis

Compliance with biotechnological inventions

1. The Italian Patents and Trademark Office, when assessing the patentability of biotechnological

inventions, in order to guarantee the provisions of Article 81-d(1)(b) may request the opinion of the National Committee for Biosafety and Biotechnology.

2. The origin of the biological material of animal or plant origin, which is the basis of the invention, is declared at the time of the patent application both in reference to the country of origin, allowing to ascertain compliance with the legislation on import and export, and in relation to the biological organism from which it was isolated.

3. A patent application relating to an invention which has as its object or uses biological material of human origin must be accompanied by the express, free and informed consent to such collection and use of the person from whom the material was taken, in accordance with the legislation in force.

4. The patent application relating to an invention, which has as its object or uses biological material containing micro-organisms or genetically modified organisms, must be accompanied by a declaration ensuring compliance with the obligations relating to such modifications, arising from national or Community legislation, and in particular from the provisions referred to in paragraph 6 and in Legislative Decree No 206 of 12 April 2001 and No 224 of 8 July 2003.

5. In the field of biotechnological inventions, the farmer uses patented material of plant origin for his own reproduction or propagation on his farm, in accordance with Article 14 of Council Regulation (EC) No 2100/94 of 27 July 1994.

6. By decree of the Minister for Agricultural Food and Forestry Policy, in consultation with the Ministers of Health and Economic Development, the scope and modalities for the exercise of the derogation provided for in Article 11(2) of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 concerning the sale or other form of marketing of livestock or other breeding material of animal origin by the patent holder or with his consent shall be regulated. In particular, the Decree provides for the prohibition of the further sale of livestock on the basis of a commercial production activity, unless the animals with the same properties have been obtained by exclusively organic means and without prejudice to the possibility of direct sale by the farmer to persons living in the normal agricultural activity.

7. If the Italian Patent and Trademark Office finds that the biotechnological invention is not patentable or that the declarations referred to in paragraphs 2, 3 and 4 have not been filed, the Italian Patent and Trademark Office shall, in accordance with Article 173(7), reject the application.

Art. 170b

Sanctions

1. Unless the fact constitutes a criminal offence, anyone, in order to patent an invention, uses biological material of human origin, being aware that it has been taken or used for such purposes without the express consent of those who can dispose of it, is punishable by an administrative pecuniary penalty of between 100,000 and EUR 1 000 000.

2. Unless the act constitutes a criminal offence, any person, in the declaration referred to in Article 170- *bis*, paragraph 2, falsely attests the provenance of biological material of animal or plant origin, shall be punished by an administrative fine of EUR 10,000 to 100,000.

3. Any person, in the patent application for an invention using biological material containing micro-organisms or genetically modified organisms, attests, contrary to the truth, that compliance with the legal obligations concerning such modifications is punishable by an administrative fine of between EUR 10,000 and EUR 100,000.

4. Within the minimum and maximum limits laid down in this Article, administrative pecuniary penalties shall be determined in their entirety, taking into account, in addition to the criteria set out in Article 11 of Law No 689 of 24 November 1981, the different potential detrimental to the protected interest that each infringement presents in the abstract, the specific personal qualities and the financial advantage that the infringement may bring to the offender or to the person or entity in whose interest he acts.

5. The reduced payment referred to in Article 16 of Law No 689 of 24 November 1981 shall not apply to administrative pecuniary penalties provided for in this Article.

Art. 171.⁵²

International Trade Marks Examination

1. The Italian Patent and Trademark Office shall carry out the examination of international trade marks designating Italy in accordance with the rules relating to national trade marks, pursuant to Article 170(1)(a).

2. If the Italian Patent and Trademark Office considers that the trade mark cannot be registered in whole or in part, or if an opposition has been lodged by third parties pursuant to Article 176: It provides, pursuant to Article 5 of the Madrid Agreement for the International Registration of Trade Marks, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976 or its Protocol of 27 June 1989, ratified by Law No 169 of 12 March 1996, to issue a provisional refusal of international registration and notify the World Intellectual Property Organisation.

3. The provisional refusal pursuant to paragraph 2 shall be issued within one year for international registrations based on the Madrid Agreement for the International Registration of Trade Marks and eighteen months for those based on the relevant Protocol. The terms shall run from the dates indicated in the International Conventions respectively.

4. In the event of a provisional refusal, the protection of the trade mark is the same as that of a trade mark application filed with the Italian Patent and Trademark Office.

5. Within the time limit fixed for this purpose by the Italian Patent and Trademark Office, the holder of an international registration for which a provisional refusal has been communicated to the World Intellectual Property Organisation, through an authorised representative appointed pursuant to Article 201, may submit his deductions, or request a copy of the notice of opposition on the basis of which the provisional refusal was issued. In the latter case, if the holder of the international registration requests a copy within the prescribed period, the Office shall notify the parties of the notice referred to in Article 178(1) and shall apply the other rules on the opposition procedure referred to in Articles 178 et seq.

6. If within the period referred to in paragraph 5, the holder of the international registration fails to submit his deductions, or does not request a copy of the notice of opposition in the prescribed manner, the Italian Patent and Trademark Office shall issue the final refusal.

7. The Italian Patent and Trademark Office communicates to the World Intellectual Property Organisation final decisions concerning international trademarks designating Italy.

8. In the event that the mark designating Italy under the Madrid Protocol is subsequently removed in whole or in part at the request of the office of industrial property of origin, its proprietor may file an application for registration for the same sign with the Italian Patent and Trademark Office. This application shall take effect from the date of international registration, with any recognised priority, or from the date of registration of the territorial extension concerning Italy.

9. The application shall be lodged within the mandatory period of three months from the date of removal of the international registration and may concern only the goods and services included therein in relation to Italy.

10. The provisions in force for national applications shall apply to the application.

Art. 172.

Withdrawal, corrections, supplementation of the application

1. The applicant may always withdraw the application during the examination procedure and in the case of trade marks, including during the opposition procedure, before the Italian Patent and Trademark Office has granted the licence.

2. The applicant, before the Italian Patents and Trademark Office has granted the licence or decided on an application or opposition, or in any event before the Appeals Board, in cases where an appeal has been lodged, may correct, in the non-substantial aspects, the original application or any other application relating to it, and, in the case of an application for a patent for an invention or utility model, to supplement also by new examples or limit the description, claims or designs originally filed and, in the case of a trade mark application, to limit or specify the goods and services originally listed.

3. The applicant, at the invitation of the Italian Patents and Trademark Office, must complete or correct the documentation where it is necessary for the intelligence of the industrial property right or to better determine the scope of the protection sought.

4. Where the findings referred to in point (d) of Article 170(1) are necessary, the Ministry of Agricultural, Food and Forestry Policy shall invite the applicant to submit the material for breeding or propagating the variety and, in the case of hybrid varieties, may also request, where necessary, the delivery of the material of the herd components. The institutes and bodies designated for the inspection shall issue receipts of the material delivered to them. If the material is delivered in insufficient or qualitatively unsuitable quantities, the above-mentioned institutes and bodies shall draw up appropriate minutes to be sent to the Ministry of Agricultural, Food and Forestry Policy.

5. The Ministry of Agricultural, Food and Forestry Policy, in consultation with the bodies and bodies responsible for the tests, may, also at the request of the application holder or third parties, order that visits to the fields be carried out in order to have the interested parties read the evidence. The bodies and bodies responsible for the tests shall, where they deem it necessary, invite the application holder to visit the test fields. At the end of the tests, the designated body or body shall submit a report on the results obtained to the Ministry of Agricultural, Food and Forestry Policy, which, in case of doubt as to the results, may order that the tests be repeated. The Ministry of Agricultural Food and Forestry Policy, on the basis of the examination report, draws up the official description of the variety. The Office, received by the Ministry of Agricultural, Food and Forestry Policy, forwards it to the breeder, giving it a deadline for comments.

6. The Italian Patent and Trademark Office must keep the documentation relating to the initial application, indicate the date of receipt of the amendments or additions and adopt any other appropriate precautionary measures.

Art. 173.⁵³

Reliefs

1. The findings giving rise to the examination of the applications and applications must be communicated to the person concerned with the allocation of a deadline for reply not less than two months from the date of receipt of the communication.

2. The comments of third parties and the findings to which the application for a new plant variety right is examined shall be communicated to the person concerned with the allocation of a period of not more than six months for the reply. Where the finding concerns the name, the new proposal shall be accompanied by a supplementary statement including the declaration referred to in point (e) of paragraph 1 of Article 165. The Office and the Ministry of Agricultural, Food and Forestry Policy shall inform each other of the observations and findings sent to the applicant and the replies received.

3. Where, due to irregularities in the award of the mandate referred to in Article 201, failure to comply with the findings results in the rejection of the applications and related applications, the finding must be communicated to the applicant.

4. Where the time limit has expired without a reply to the findings, the application or application shall be dismissed by order, to be notified to the holder of the request or of the application by registered letter with acknowledgment of receipt. However, if the issue concerns the claim of a right of priority, the failure to reply will only result in the loss of that right.

5. The application for a plant variety right shall be refused:

a) in case of failure to respond to the findings of the Office and the Ministry of Agricultural, Food and Forestry Policy within the prescribed time limits;

b) in case of non-delivery of the materials for the varietal tests pursuant to Article 165(1)(c), unless the non-delivery was due to force majeure;

c) in case of absence of one of the requirements laid down in Article 170(1)(d).

6. If the application for a new plant variety right is not accepted or if it is withdrawn, the

compensation due for the roadworthiness tests shall be reimbursed only when the abovementioned roadworthiness tests have not already started.

7. Before rejecting in whole or in part an application or application related to it, for reasons which have not been the subject of a complaint pursuant to paragraph 1, the Italian Patent and Trademark Office shall assign the applicant a period of two months to comment. Once that period has expired, if no observations have been submitted or the Office considers that it cannot accept those submitted, the application or application shall be rejected in whole or in part.

8. In the case of applications for international patents, the Italian Patent and Trademark Office, having made the assessment referred to in Article 14 of the Patent Cooperation Treaty of 19 June 1970, ratified by Law No 260 of 26 May 1978, invites the applicant to make any corrections, setting a period not exceeding three months for this purpose, subject to compliance with the deadline for transmitting the original copy of the international application, provided for in Rule 22 of the Regulation implementing the Patent Cooperation Treaty. The Italian Patent and Trademark Office declares that the application is withdrawn in the cases provided for in Article 14 of the Patent Cooperation Treaty.

9. If the application is successful, the Italian Patent and Trademark Office shall grant the licence.

10. The files of documents and documents relating to applications for patenting or registration, as well as collections of industrial property titles and collections of applications shall be kept by the Italian Patent and Trademark Office until ten years after the corresponding rights have been terminated. After the expiry of that period, the Office may destroy the files even without the opinion of the Central State Archives, after computer acquisition on non-alterable devices of the originals, documents and documents contained therein.

Section II

Comments on trade marks and oppositions registration of trademarks

Art. 174.

Comments and oppositions to the registration of the trade mark

1. Trade mark applications deemed to be registrable pursuant to Article 170(1)(a), trade mark registrations made in accordance with the procedure referred to in Article 179(2) and international trade marks, designating Italy, may be the subject of observations and oppositions in accordance with the rules referred to in the following articles.

Art. 175.

Submission of comments from third parties

1. Any interested party may, without thereby assuming the status of party in the registration procedure, refer to the Italian Patent Office and Trademarks written observations, specifying the reasons for which a trade mark must be excluded ex officio from registration.

2. The comments, if deemed relevant and relevant, shall be communicated by the Italian Patent and Trademark Office to the applicant who may submit his or her deductions within 30 days from the date of communication.

3. In the case of an international trade mark, the observations shall be considered by the Italian Patent and Trademark Office only for the purpose of the examination referred to in Article 170(1)(a).

Art. 176.

Deposit of opposition

1. Persons entitled under Article 177 may submit to the Italian Patent and Trademark Office opposition against the acts referred to in points (a), (b) and (c), which, under penalty of inadmissibility, must be written, substantiated and documented within the mandatory period of three months:

a) from the date of publication of an application for registration, which is deemed to be registrable in accordance with Article 170(1)(a), or deemed to be registrable on the basis of a final

judgment;

b) from the date of publication of the registration of a trade mark, the application of which has not been published pursuant to Article 179(2);

c) from the first day of the month following the publication of the international brand in the *Gazette de l'Organisation Mondiale de la Propriété Intellectuelle des Marques Internationales*.

2. The opposition, which may concern only one application or registration of a trade mark, is admissible only if it is drafted in Italian and must contain, under penalty of inadmissibility:

a) in relation to the mark objected to the opposition, the identification of the applicant, the number and date of the application for registration and the goods and services against which the opposition is lodged;

b) in relation to the mark or right of the opposing party, the identification of the earlier trade mark(s) referred to in points (d) and (e) of Article 12(1), as well as the goods and services on which the opposition is based or the right referred to in Article 8;

c) the grounds on which the opposition is based.

3. The opposition shall be deemed to have been withdrawn if there is no proof of payment of the rights of opposition within the time limits and in the manner laid down in the decree referred to in Article 226.

4. The person lodging the opposition must deposit within the mandatory period of two months from the date of expiry of the deadline for reaching a conciliation agreement referred to in Article 178(1):

a) copy of the application or certificate of registration of the trade mark on which the opposition is based, where these are not national applications or certificates and, where appropriate, the documentation relating to the right of priority or seniority which it enjoys, as well as their translation into Italian; in the case of seniority, it must have already been claimed in connection with the application or registration of a Community trade mark;

b) any other documentation proving the facts adduced;

c) the documentation necessary to demonstrate the standing to lodge an opposition, if the earlier mark does not appear in its name from the Register held by the Italian Patents and Trademark Office;

d) the act of appointment in accordance with Article 201, if an authorised representative has been appointed.

5. The opposition may invoke the grounds for refusal of the trade mark provided for in Article 12(1)(c) and (d), for all or part of the goods or services for which registration has been sought, and the lack of consent to registration by the rightholders referred to in Article 8.

Art. 177.

Legitimisation of the opposition

1. They are entitled to the opposition:

a) the proprietor of a trade mark already registered in the State or effective in the State from an earlier date;

b) the person who has filed in the State for registration of a trade mark earlier or having effect in the State from the earlier date on the basis of a right of priority or a valid seniority claim;

c) the licensee of the exclusive use of the trademark;

d) the persons, bodies and associations referred to in Article 8.

Art. 178.

Examination of the opposition and decisions

1. Within two months of the expiry of the period referred to in Article 176(1), the Italian Patent

and Trademark Office, verifying the admissibility and admissibility of the opposition pursuant to Articles 148(1) and 176(2), shall communicate such opposition to the applicant for registration with the notice, including to the opposing party, of the right to reach a conciliation agreement within two months from the date of the communication, which may be extended at the joint request of the parties up to the maximum period laid down in the implementing regulation of this Code.

2. In the absence of an agreement pursuant to paragraph 1, an applicant who has received the documentation referred to in Article 176(2) and (4) (a), (b) and (c) may submit his or her deductions in writing within the time limit set for this purpose by the Office.

3. During the opposition proceedings, the Italian Patent and Trademark Office may, at any time, invite the parties to submit further documents, deductions or observations on the basis of the submissions, deductions and observations of the other parties within the period laid down by it.

4. At the request of the applicant, the opponent who has been the proprietor of an earlier trade mark registered for at least five years shall provide the documents capable of proving that that mark has been the subject of genuine use, by himself or with his consent, for the goods and services for which it has been registered and on which the opposition is based, or that there are legitimate grounds for non-use. In the absence of such evidence, to be provided within sixty days of the date of notification of the application by the Italian Patent and Trademark Office, the opposition shall be rejected. If genuine use is proved only in respect of part of the goods or services for which the earlier mark has been registered, it shall, for the sole purpose of examining the opposition, be regarded as registered only for that part of the goods or services.

5. The applicant's application to obtain proof of genuine use of the mark must be submitted no later than the date of submission of the first deductions pursuant to paragraph 2.

6. In the case of oppositions relating to the same mark, the oppositions subsequent to the first mark shall be joined to it.

7. At the end of the opposition proceedings, the Italian Patent and Trademark Office shall uphold the opposition itself by rejecting the application for registration in whole or in part if it appears that the trade mark cannot be registered in respect of all or part of the goods and services indicated in the application; otherwise, he rejects the opposition. In the case of international registration, the Italian Patent and Trademark Office shall issue partial or total final refusal or reject the opposition by notifying the World Intellectual Property Organisation (WIPO).

Art. 179.⁵⁴

Extension of protection

1. If the applicant intends to extend the protection of the trade mark abroad under the Madrid Agreement for the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976, or in a foreign state requiring the prior registration of the Italian trade mark, the Italian Patent and Trademark Office, even if an opposition has already been lodged, shall register and make the relevant annotations.

2. If the trade mark application referred to in paragraph 1 has not already been published, the publication of the registration shall, in that case, be accompanied by the notice that such publication is the initial time limit for the opposition. The acceptance of the opposition determines the total or partial removal of the mark.

Art. 180.

Suspension of opposition proceedings

1. The opposition proceedings are stayed:

a) during the period granted to the Parties, with a view to reaching a conciliation agreement, pursuant to Article 178(1);

- b) if the opposition is based on a trade mark application, until the registration of that mark;
 - c) if the opposition is based on an international trade mark, until the time-limits for refusing or lodging an opposition against the registration of that mark have expired, or the relevant examination or opposition proceedings have been concluded;
 - d) if the opposition is lodged against a national trade mark under review following comments referred to in Article 175(2) until the relevant review procedure has been concluded;
 - e) if a judgment on the invalidity or revocation of the trade mark on which the opposition is based or relating to the right to registration under Article 118 is pending until the judgment becomes *res judicata*, where the applicant lodges an application for registration;
- e-bis) in the other cases provided for in the Regulation implementing this Code.

2. At the request of the applicant for registration, the suspension referred to in point (e) of paragraph 1 may subsequently be revoked.

3. If the opposition is suspended pursuant to paragraph 1, letters b), c), d) and f), the Italian Patent and Trademark Office shall examine the trade mark application or registration of the international trade mark with priority.

3-bis. The Italian Patent and Trademark Office shall first examine the trade mark application if it appears to be the ground on the basis of which an opposition to a Community trade mark application or an action for revocation of a Community registration has been brought.

Art. 181.

Termination of the opposition procedure

1. The opposition procedure shall be terminated if:
- a) the mark on which the opposition is based has been declared null or void by a judgment which has the force of *res judicata*;
 - b) the Parties have reached the agreement referred to in Article 178(1);
 - c) the opposition shall be withdrawn;
 - d) the application or registration, subject to opposition, shall be withdrawn or rejected by final decision;
 - e) the person who has lodged an objection shall cease to be entitled under Article 177.

Art. 182.

Appeal

1. The measure by which the Italian Patent and Trademark Office declares inadmissible, inadmissible or terminates the opposition procedure or upholds, even partially, or rejects the opposition, shall be communicated to the parties, who, within the period referred to in Article 135(1), have the right to appeal to the Board of Appeals, referred to in Article 135.

Art. 183.

Appointment of examiners

2. Oppositions are decided by officials appointed for a period of two years by decree of the Director-General among the members of the career directive or management of the Italian Patent and Trademark Office and with a degree in law. Examiners who have participated in the examination of applications or registrations of trade marks who are objected to may not decide on the above-mentioned oppositions.

3. The appointment of judge, referred to in paragraph 1, renewable and remunerated with remuneration to be established by decree of the Minister for Economic Development, in agreement with the Minister for Economic Affairs and Finance, is reserved to those who, meeting the requirements of paragraph 1, have attended with favourable results, a special training course to be

organised by the Italian Patent and Trademark Office.

4. If the number of officials appointed pursuant to paragraphs 1 and 2 is inadequate in relation to the opposition filed, officials may also be appointed from the staff of the Ministry of Economic Development, with equal requirements and training, or experts with known knowledge of the subject.

5. The total number of officials designated for the examination of oppositions may not exceed 30 units.

Art. 184.

Entry into force of the opposition procedure

1. The rules on opposition proceedings enter into force by the subsequent decree of the Minister for Economic Development, which lays down the detailed rules for its application.

Section III Advertising

Art. 185.

Collection of industrial property titles

1. The original industrial property titles must be signed by the manager of the competent office or by an official delegated by him.

2. Industrial property titles are marked, depending on the type, by a sequence number, according to the date of the concession, and contain:

a) the date and number of the application;

b) the surname, first name, domicile of the holder and, in the case of plant varieties, of the breeder, the name or company name and registered office, in the case of a legal person;

c) the surname, first name, domicile of the authorised representative, if there is;

d) the surname and name of the inventor or author;

e) the extremes of the priority claimed;

f) in the case of plant varieties, the genus or species belonging to the new plant variety and its name.

3. The originals of the industrial property titles are assembled in special collections. All references to the register of trademarks or patents contained in the Code shall be understood as made to the originals, in paper or computer form, of the corresponding titles gathered in the collections.

4. A certified copy of the industrial property title shall be sent to the holder. In the case of plant variety rights, the office shall inform the MIPAF of the concession.

Art. 186.

Visions and publications

1. The collection of industrial property rights and the collection of applications can be consulted by the public, with the authorisation of the Italian Patents and Trademark Office, following an application.

2. The Italian Patents and Trademark Office, without prejudice to the deadlines established for the accessibility of applications to the public, shall make available to the public free of charge, so that the files relating to an application, a patent, a registration or an application may be consulted, subject to the limitations provided for in the Implementing Regulation.

3. The Italian Patents and Trademark Office may allow copies of applications, descriptions, claims and designs, as well as other documents which are permitted to be viewed to the public, to those who apply subject to those precautions that are deemed necessary to avoid any failure or deterioration of the documents available to the public.

4. Copies for which authentication of conformity with the specimen made available to the public is requested must be in compliance with the stamp duty. However, the Ministry of Economic

Development may stipulate that copying or in any case reproduction, including photographic reproduction, of the documents and documents referred to above shall be provided exclusively by the Office, subject to payment of the secretarial fees.

5. Copies of extracts of industrial property titles and certificates relating to information to be extracted from the relevant documentation, as well as duplicates of the originals, are made exclusively by the Italian Patent and Trademark Office following an application indicating the order number of the title of which the copy or extract is requested.

6. The certification of authenticity of the copies is subject to stamp duty and to the payment of the secretarial fees to be paid to the Italian Patent and Trademark Office for each sheet and for each drawing board.

7. The measure of the rights provided for in this Code shall be established by decree of the Minister for Economic Development, in agreement with the Minister for Economic Affairs and Finance. The rates for copying and photographic reproduction are determined in the same way, to which the Italian Patents and Trademark Office provides.

8. Industrial property titles, divided by classes, transcripts and judgments referred to in Article 197(6), shall be published, at least monthly, in the Official Bulletin provided for each type of title by Articles 187, 188, 189 and 190. The publication will contain the key indications included in each title and, respectively, in the transcription applications. The Bulletin may also contain both the analytical indices of industrial property rights, as well as the alphabetical indices of the holders and in it may also publish the summaries of the descriptions.

9. The Bulletin is made available electronically and can be distributed free of charge to the Chambers of Commerce, as well as to the bodies indicated in a list to be drawn up by the Minister for Economic Development.

Art. 187.

Official Trade Marks Bulletin

1. The Official Trade Mark Bulletin, to be published at least monthly by the Italian Patent and Trademark Office, contains at least the following information relating to:

- a) applications deemed to be registrable pursuant to Article 170(1)(a), indicating any priority;
 - b) applications resulting from the application for conversion of a Community trade mark with an indication of the date of filing of the relevant application;
 - c) registrations;
 - d) records accompanied by the notice referred to in Article 179(2);
 - e) renewals;
 - f) requests for transcription of the acts indicated by this code and transcripts made;
- F-bis) applications subject to opposition and applications refused as a result of opposition;
F-ter) judgments referred to in Article 197(6).

2. The identification data of applications and registrations, in addition to the specific data referred to in points (a), (b), and (d) of paragraph 1, and their numbers and dates, shall be those referred to in Article 156.

3. The Official Bulletin is accompanied by analytical indices, at least alphabetical for holders, numerals and classes.

Art. 188.⁵⁵

Official Bulletin of New Plant Varieties

1. The communication to the public provided for in Article 30 of the International Convention for the Protection of New Plants (UPOV) — Geneva text of 19 March 1991, ratified by Law No 110 of 23 March 1998, is made by publishing an “Official Bulletin of New Plant Varieties” published by the Office.

2. The Bulletin shall be at least six-monthly frequency and shall contain:

a) the list of applications for rights, by species, indicating, beyond the number and date of filing of the application, the name and address of the applicant and the name of the author if a person other than the applicant, the proposed name and a brief description of the plant variety for which protection is sought;

b) the list of rights granted, by gender and species, indicating the number and date of filing of the corresponding application, the name and address of the holder and the definitively assigned varietal name;

B-bis) judgments referred to in Article 197(6);

c) any other information in the public interest.

3. The Bulletin is sent free of charge, in exchange, to the competent offices of the other Member States of the Union pour la protection des obtentions plants (U.P.O.V.)

Art. 189.

Official bulletin of invention patents and utility models, registrations of drawings and models, topographies of semiconductor products.

1. The Official Bulletin of invention patents and utility models, registrations of designs and models, topographies of semiconductor products, to be published at least monthly by the Italian Patent and Trademark Office, contains at least the following information relating to:

a) patent applications or registrations indicating any priority or request for deferral of accessibility to the public;

b) patents and registrations granted;

c) patents and patents for non-payment of annual maintenance fees;

d) patents and registrations licensed to the public;

e) patents and registrations subject to a decree of expropriation or compulsory license;

f) patents and registrations subject to conversion;

g) requests for transcription of the acts referred to in Article 138 and transcripts made;

g-bis) judgments referred to in Article 197(6).

2. The identification data of applications, patents and registrations, in addition to those specified in paragraph 1, letters a), d), and e), and their numbers and dates, are those referred to in Articles 160, paragraph 1, 167, paragraph 1, 168, paragraphs 1 and 2, letters b) and d).

3. The Official Bulletin is accompanied by analytical indices, at least alphabetical for holders, numerals and classes.

Art. 190.⁵⁶

Official bulletin of supplementary certificates for medicinal products and plant protection products

1. The Official Bulletin of applications and supplementary certificates for medicinal products and plant protection products, to be published at least monthly by the Italian Patent and Trademark Office, contains at least the information provided for in Article 11 of Council Regulations No 1768/92 of 18 June 1992 and (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996.

Section IV Terms & Conditions

Art. 191.

Expiry of the deadlines

2. The time limits provided for in this Code may be extended upon application submitted before their expiry to the Italian Patent and Trademark Office, unless the time limit is indicated as unavoidable.

3. Unless otherwise provided for in the implementing regulation of this Code, on reasoned request the extension may be granted up to a maximum of six months from the date of expiry or communication by which the Italian Patent and Trademark Office has set the deadline or two months from the date of receipt by the instant of the communication with which the Office grants the extension, if that period expires subsequently, or refuses it.

Art. 192.

Continuation of the procedure

1. Where the applicant for an industrial property right has not complied with a time limit in relation to a procedure before the Italian Patent and Trademark Office, the procedure shall be resumed at the request of the applicant without the non-compliance with the time limit leading to the loss of the right to industrial property or other consequence.

2. The request for continuation of the procedure must be submitted within two months of the expiry of the period not observed or of the extension period provided for in Article 191(2), where the extension has been requested, and must be accompanied by proof that it has completed within the same period as omitted within the period previously expired. The request must prove the payment of the fee provided for the continuation of the procedure in Table A annexed to the Decree of the Minister for Economic Development of 2 April 2007, published in Official Gazette No 81 of 6 April 2007.

3. The provision in this Article shall not apply to the time-limit for claiming the right of priority, to time limits relating to the opposition procedure, to the time limit for lodging an appeal to the Board of Appeal, to the period for the submission of the priority document, to the period for supplementing the application or for the production of translation within the meaning of Article 148, to the deadline for payment of the retention rights for industrial property rights by default, the time limits laid down for the reinstatement of the right referred to in Article 193 and the deadline for submitting the English translation of the claims of the patent application referred to in Article 8 of the Decree of the Minister for Economic Development of 27 June 2008 on the search for precedence, published in Official Gazette No 153 of 2 July 2008.

Art. 193.

Reintegration

1. An applicant or holder of an industrial property title who, despite having used the diligence required by the circumstances, has not been able to observe a time limit in respect of the Italian Patent and Trademark Office or the Appeals Commission, shall be reinstated in his rights if the non-compliance has the direct consequence of the rejection of the application or an application relating to it, or the revocation of the industrial title or the loss of any other right or right of appeal.

2. Within two months of the end of the case justifying the non-compliance, the act omitted must be completed and the application for reinstatement must be submitted with an indication of the facts and justifications and with the appropriate documentation. The application shall not be admissible if one year has elapsed from the date of expiry of the period not observed. In the event of non-payment of a right of maintenance or renewal, the one-year period shall start on the day on which the payment of the right is in any case useful. In this case, a statement of proof of payment of the due fee, including the right of late payment, must also be attached.

3. Before the application is rejected, the applicant or the holder of the industrial property right may, within the time limit set by the Office, submit its arguments or deductions.

4. The provisions of this article shall not apply to the time limits referred to in paragraph 2, to the time limit set for the division of applications for patenting and registration, as well as for the submission of the divisional application and for the submission of documents opposing the registration of trade marks.

5. If the applicant for registration or the patent, despite having used the diligence required by the circumstances, has not been able to comply with the priority period, it shall be reinstated in his right if the priority is claimed within two months of the expiry date of that period. This provision shall also apply in case of non-compliance with the deadline for producing the priority document.

6. Any person in good faith who has made serious and effective preparations or has begun to use the object of another's industrial property right during the period between the loss of the exclusivity or the right to acquire it and the reinstatement pursuant to paragraph 1 may:

a) in the case of invention, utility model, design, new plant variety or topography of semiconductor products, implement them free of charge within the limits of pre-use or as resulting from preparations;

b) in the case of a trade mark, request reinstatement of the costs incurred.

Chapter V SPECIAL PROCEDURES

Art. 194.

Expropriation procedure

1. The expropriation order shall be sent in copy to the Italian Patent and Trade Mark Office and notified, in the form provided for for the service of civil procedural documents, to the interested parties. Once the notification has been made, the rights which have been the subject of the expropriation are acquired by the expropriating administration, which is certainly entitled to use them. Any charge for payment of the fees required for the maintenance of the industrial property right shall also be transferred to the administration itself. Except in the case that publication may be detrimental to the decrees of expropriation and those amending or revoking the previous decrees, the Italian Patent and Trademark Office shall inform the Official Bulletin and record in the title or application.

2. The decree to expropriate the sole use of the industrial property right must indicate the duration of the expropriation. In the event that the sole use of the industrial property right has been expropriated, the patenting and registration, as well as the publication of the relevant titles, shall be carried out in accordance with the ordinary procedure.

3. For the sole purpose of determining the compensation to be paid for expropriation, if no agreement is reached on the amount of the same, a Board of Arbitrations composed of three members, appointed one by each of the parties and the third appointed by the first two, or, in case of disagreement, by the President of the specialised section of the Tribunal of Rome. Arbitrators must be chosen from among those who have acquired professionalism and experience in the field of industrial property. The provisions of Article 806 et seq. of the Code of Civil Procedure shall apply as compatible.

4. The Board of arbitrators must proceed with fair appreciation taking into account the loss of the competitive advantage that would be derived from the expropriated patent.

5. The costs of arbitrage, fees due to arbitrators and expenses and defence fees shall be settled in the award, which also determines who and to what extent the relative burden should be borne. That burden is, in any event, on the expropriated person when the compensation is paid less than that originally offered by the administration.

6. The determination of the arbitrators may be challenged before the specialised section of the Court of Rome, which quantifies the compensation. The time limit for the appeal shall be 60 days from the date on which the determination of the compensation is communicated to the parties.

Art. 195.

Transcription questions

1. Applications for transcription must be drawn up in accordance with the requirements of the Decree of the Minister for Economic Development.

2. The application must contain:

- a) the surname, name and domicile of the beneficiary of the requested transcript and of the authorised representative, if there is;
- b) the surname and name of the owner of the industrial property right;
- c) the nature of the act or the reason justifying the requested transcript;
- d) the listing of the industrial property rights covered by the required transcript;
- e) in the case of a change of ownership, the name of the State of which the new applicant or holder is a national, the name of the State of which the new applicant or holder is domiciled, or the name of the State in which the new applicant or new holder has an actual and serious industrial or commercial establishment.

Art. 196.

Transcription procedure

1. The application for transcription referred to in paragraph 2 of Article 195 shall be accompanied by:

a) copy of the act resulting from the change of ownership or of the act constituting or modifying or terminating the personal or remnant rights of enjoyment or guarantee referred to in paragraph 1, letters a), b), c) and i) of Article 138, or copy of the minutes and judgments referred to in paragraph 1, letters d), e), f), g) and h) of Article 138, observe the rules of the law on the register where necessary, either an extract from the act itself or, in the event of a merger, a certification issued by the Register of Companies or other competent authority, or, in the case of assignment or licensing, a declaration of assignment, transfer or licence signed by the transferor and the transferee with the listing of the rights covered by the transfer or concession. The Italian Patent and Trademark Office may request that the copy of the document or extract be certified in conformity with the original by a public official or any other competent public authority;

b) the document proving payment of the required fees.

2. Only one request is sufficient where the transcript relates to more than one industrial property right both in the state of application and granted to the same person, provided that the beneficiary of the change of ownership or of the rights of use or guarantee or of the act to be transcribed is the same for all licences and that the numbers of all applications and licences concerned are indicated in that request.

3. Where there is an authorised representative, the act of appointment pursuant to Article 201 shall also be joined.

4. The register for each transcript shall indicate:

- a) the date of submission of the application, which is the date of the transcription;
- b) the surname, name and domicile of the successor in question, or the name and place of business, in the case of a company or a moral entity, as well as the surname, name and domicile of the authorised representative, where there is one;
- c) the nature of the rights to which the transcript relates.

5. The documents and judgments, submitted for transcription, are kept by the Italian Patents and Trademark Office.

6. Requests for cancellation of transcripts must be made in the same form and in the same manner as for applications for transcription. Cancellations must be effected by margin annotation.

7. If, for the transcription of the security rights, it is necessary to convert the amount of the credit into national currency, such conversion will be made on the basis of the exchange rate of the day on which the guarantee was granted.

Art. 197.

Annotations

1. Suppressed

2. Changes in the name or domicile of the holder of the industrial property right or his authorised representative, if any, shall be brought to the attention of the Office for the record in the register referred to in Article 185.

3. An application for a change of name or address shall be drawn up in a single copy in accordance with the requirements of the Implementing Regulation.

4. A single request is sufficient when the amendment concerns more than one industrial property rights both in the state of application and granted.

5. The provisions of paragraphs 1, 2 and 3 shall apply to the change of name or address of the authorised representative referred to in Article 201.

6. Declarations of renunciation, even partial, of an industrial property right signed by the proprietor and judgments declaring the nullity or revocation of industrial property rights received by the Italian Patent and Trademark Office must be noted on the collection of the originals and must be reported in the Official Bulletin.

Art. 198.⁵⁷

Military secretion procedures

1. Persons residing in the territory of the State may not, without the authorisation of the Ministry of Economic Development, lodge exclusively with offices of foreign States or the European Patent Office or the International Bureau of the World Intellectual Property Organisation as the receiving office, their applications for the grant of patents by invention, utility model or topography, where such applications concern objects that might be useful for the defense of the country, or file them with those offices before 90 days have elapsed from the date of filing in Italy, or from the date of submission of the application for authorisation. The above Ministry shall provide for authorisations, subject to authorisation from the Ministry of Defence. The authorisation must be deemed to have been granted after the ninety-day period has not taken place. The provisions of this paragraph shall not apply to inventions made as a result of international agreements ratified by national law.

2. Unless the act constitutes a more serious offence, the violation of the provisions of paragraph 1 shall be punishable by a fine of not less than EUR 77.47 or by arrest. If the infringement is committed when the authorisation has been refused, the arrest shall apply in an amount of not less than one year.

3. The Italian Patent and Trademark Office immediately makes available to the Patent and Intellectual Property Service of the Ministry of Defence patent applications for industrial inventions, utility models and topographies of semiconductor products received to it.

4. If the above Service considers that the applications relate to inventions, models or topographies useful for the defense of the country, even officers or officials outside the Service expressly delegated by the Minister of Defence may view, at the Office's premises, the descriptions, claims and drawings attached to the applications.

5. All persons who have read applications and documents relating to patents or who have been informed of them for reasons of office are bound by the obligation of secrecy.

6. Within 90 days of the date of filing of applications, the Ministry of Defence may apply to the Italian Patent and Trademark Office for the deferral of the grant of the industrial property title and any relevant publication. The Office shall notify the person concerned of the request and be wary of the obligation of secrecy.

7. If, within eight months of the date of filing of the application, the competent Ministry has not sent to the Office and to the applicant, since he has indicated his domicile in the State, the information that he wishes to proceed with the expropriation shall be followed by the ordinary procedure for granting the industrial property title. Within that period, the Ministry of Defence may request that the granting of the industrial title and any relevant publication be further deferred for a period not exceeding three years from the date of filing of the application. In such a case, the inventor or his

successor shall be entitled to an allowance for the determination of which the expropriation provisions apply.

8. For utility models, the further deferral provided for in paragraph 7 may be requested for a period not exceeding one year from the date of filing of the application.

9. At the request of foreign States which agree on the treatment of reciprocity, the Ministry of Defence may request, for a period of more than three years, the deferral of the grant of the patent and of any publication relating to the invention for patent applications already filed abroad and subject to a bond of secrecy therein.

10. Any allowances shall be borne by the requesting foreign State.

11. The invention must be kept secret after the notification of the request for deferral and for the duration of the deferral itself, as well as during the execution of the expropriation and after the relevant decree if it carries the obligation of secrecy.

12. The invention must also be kept secret in the case referred to in paragraph 6, after the determination to promote expropriation with the imposition of secrecy has been communicated to the interested party.

13. The obligation of secrecy shall cease if the Ministry of Defence so permits.

14. Violation of secrecy shall be punished under Article 262 of the Criminal Code.

15. The Ministry of Defence may request that patent applications for industrial inventions of dependent or supervised bodies be kept secret.

16. If, by reason of an interesting invention, the Ministry of Defence requests or, in the event of deferral referred to in paragraph 6, allows the grant of the patent, the relative procedure shall be carried out, at the request of the Ministry, in secret form. In this case no publication is made and views in this code are not allowed.

17. In the case of exhibitions to be held in the territory of the State, the Ministry of Defence has the right, through its own officials or officers, to carry out a detailed examination of the objects and found delivered for the exhibition that can be considered useful for the military defense of the country and also has the right to take information and ask for clarification on the objects and found themselves.

18. Exhibition organisers must deliver to those officials or officers complete lists of items to be exposed to industrial inventions not protected under this Code.

19. The officials and officers referred to in paragraph 17 may impose on the entity the prohibition on the exposure of objects useful for the military defense of the country.

20. The Ministry of Defence, by registered letter with acknowledgment of receipt, must notify the Presidency of the exhibition and the parties concerned of the prohibition of exposure, warning them of the obligation of secrecy. The Presidency of the exhibition must keep the objects subject to the prohibition of exposure with the obligation of secrecy as to their nature.

21. In the event that the prohibition of exposure is imposed after the objects have been exposed, the objects themselves must immediately be withdrawn without, moreover, imposing the obligation of secrecy.

22. It is without prejudice, in any case, to the power of the Ministry of Defence, for objects that refer to inventions recognised as useful for the military defense of the country, to proceed with the expropriation of the rights deriving from the invention, model or topography in accordance with the rules on expropriation contained in this Code.

23. If the ban on exposure is not respected, those responsible for the abusive exposure are punished with an administrative penalty from EUR 25.00 to EUR 13 000.00.

Art. 199.

Compulsory licensing procedure

1. Anyone wishing to obtain the compulsory licence referred to in Articles 70 and 71 of Chapter II, Section IV, for the non-exclusive use of an industrial invention or utility model must submit a reasoned application to the Italian Patents and Trademark Office, indicating the extent and method of payment of the compensation offered. The Office shall promptly inform the patent holder and those

who have acquired patent rights on the basis of transcribed or annotated documents of the application by registered letter with acknowledgment of receipt.

2. Within sixty days from the date of receipt of the registered letter, the patent holder and all those entitled to it on the basis of transcribed or annotated documents may oppose the acceptance of the application or declare that they do not accept the measure and methods of payment of the compensation. The opposition must be motivated.

3. In case of opposition, within forty-five days from the date of expiry of the deadline for the submission of the same, the Italian Patent and Trademark Office shall convene for an attempt to conciliate the instant, the holder of the patent and all those who have rights on the basis of documents transcribed or annotated. The notice of convocation is sent to the aforementioned subjects by registered letter with acknowledgment of receipt or by other means, including computer, provided that such methods guarantee a sufficient certainty of receipt of the communication.

4. In the convocation, the Italian Patent and Trademark Office must immediately communicate and transmit a copy of the oppositions lodged.

5. The applicant may submit written counter-claims to the Italian Patent and Trademark Office no later than the fifth day before the date of the meeting.

6. Within forty-five days following the date of the conciliation attempt, the Ministry of Economic Development shall grant the licence or reject the application.

7. The time limit for the conclusion of the proceedings shall be one hundred and eighty days from the date on which the application is lodged.

Art. 200.

Voluntary licensing procedure on active substances

1. An application for a voluntary licence on active substances, together with a certificate proving that the fees have been paid to the extent laid down in the Decree of the Minister for Economic Development referred to in Article 226, shall contain the following information:

- a) name or business name and domicile or registered office of the applicant for the voluntary licence;
- b) name of the active substance;
- c) details of protection, number of the patent and the supplementary certificate of protection;
- d) indication of the Italian pharmaceutical workshop, regularly authorised by the Ministry of Health in accordance with the law, where the active ingredient is intended to be produced.

2. The applicant must forward, by registered letter with acknowledgment of receipt or by other means ensuring receipt of the communication, to the Italian Patent and Trademark Office (UIBM) application, with attached translation in English, accompanied by the elements referred to in paragraph 1.

3. The UIBM shall promptly notify, by registered mail with acknowledgment of receipt or by other means ensuring receipt of the communication, of the request to interested parties and to those who have acquired rights over the patent or supplementary protection certificate on the basis of transcribed or annotated documents.

4. If within ninety days of the date of receipt of the application, which can be extended by agreement between the parties, they reach an agreement on the basis of a limited royalty, a copy of the application shall be transmitted, in a similar manner, to the Ministry of Economic Development — UIBM. If the Office fails to notify the parties within 30 days, the voluntary licensing agreement shall be deemed to have been finalised.

5. In the event that the parties inform the UIBM that an agreement could not be reached, the Office shall initiate the conciliation procedure referred to in paragraphs 6 et seq.

6. The Ministry of Economic Development appoints, by its decree, a commission to assess applications for voluntary licences for which an agreement between the parties could not be reached.

7. The committee shall consist of six members and as many alternates of which:
- a) two representatives of the Ministry of Economic Development;
 - b) a representative of the Ministry of Health;
 - c) a representative of the Italian Medicines Agency;
 - d) a representative of the CCP holders, on a proposal from the most representative trade associations;
 - e) a representative of the producers of pharmaceutical active ingredients, on the proposal of the most representative trade associations.
8. The commission referred to in paragraphs 6 and 7, within thirty days from the date of communication received by the UIBM of the non-agreement reached between the parties, shall convene them, in order to identify a hypothesis of an agreement aimed at balancing the needs of the parties themselves, ensuring, in any case, a fair remuneration of the entity issuing the voluntary licence, by indicating a limited royalty, established with criteria that take into account the needs of international competition of active ingredients producers.
9. If, despite the ministerial mediation, the licence agreement is not concluded, the Ministry of Economic Development, where it meets the legal requirements, shall order the documents of the procedure to be forwarded to the Competition and Market Authority.

Chapter VI PROFESSIONAL ORDERING

Art. 201.

Representation

1. No one is required to be represented by an authorised representative in the proceedings before the Italian Patent and Trademark Office; natural and legal persons may act by means of one of their employees even if they are not authorised or by means of an employee of another related company within the meaning of Article 205(3).
2. The appointment of one or more authorised representatives, if it is not made in the application, or by a separate document, authentic or authenticated, can be made by a special letter of assignment, subject to the payment of the required fee.
3. The act of appointment or the letter of appointment may concern one or more applications or in general the professional representation for each procedure before the Italian Patent and Trademark Office and the Board of Appeal. In this case, in any subsequent application, application and appeal, the authorised representative must refer to the power of attorney or letter of assignment.
4. The mandate may only be conferred on authorised representatives registered in a register established by the Council of the Order of Industrial Property Consultants for this purpose.
5. Deleted.⁵⁸
6. The mandate may also be conferred on a lawyer registered in his professional register.

Art. 202.

Register of Consultants

1. Without prejudice to the provisions of Article 201, the representation of natural or legal persons in proceedings before the Italian Patent and Trademark Office and the Board of Appeal may be recruited only by qualified consultants registered in a register established by the Council of the Order and called the Register of Authorised Industrial Property Consultants and by those registered in the registers of lawyers.
2. The Register consists of two sections, respectively called Patents Section and Trade Mark Section, reserved, the former, to consultants acting on patents for inventions, utility models, designs

and models, new plant varieties, topographies of semiconductor products and the second to authorised consultants agents in the field of designs, trademarks and other distinctive signs and geographical indications.

3. The members of the Register constitute the order of industrial property consultants.

4. Supervision of the exercise of the profession is exercised by the Ministry of Economic Development, through the Italian Patents and Trademark Office.

Art. 203.⁵⁹

Registration Requirements

1. Any natural person who:

a) has the enjoyment of civil rights in national law and is a person of good civil and moral conduct;

b) is an Italian national or a national of the Member States of the European Union or a national of foreign countries in respect of which a reciprocity regime applies;

c) having a professional domicile in Italy or in the European Union if he is a national of a Member State of that Member State, the requirement of a professional domicile in Italy is not required if he is a national of non-Community States who allow Italian nationals to register on corresponding registers without that requirement;

d) has passed the qualification examination referred to in Article 207 or has passed the aptitude test provided for industrial property consultants in paragraph 2 of Article 6 of Legislative Decree No 115 of 27 January 1992.

2. Registration is made by the Council of the order upon submission of an application accompanied by documents proving that the requirements referred to in paragraph 1 or including self-certifications required by law are fulfilled. Registration is promptly communicated by the Council to the Italian Patents and Trademark Office.

3. The subjects indicated in paragraph 5 of Article 201 who exercise the temporary representation activity are automatically considered to be included in the register of industrial property consultants for the purpose of exercising the rights and for compliance with the obligations provided for in professional law as compatible, but they do not participate in the meeting of the members of the register and cannot be elected as members of the Board of the Order.

4. The persons referred to in paragraphs 1 and 3 and who have a professional domicile in a Member State of the European Union are required to elect domicile in Italy pursuant to and for the purposes of Article 120(3) of this Code.

Art. 204.

Professional title covered by the activity

1. The title of industrial property consultant is reserved for persons registered in the register of qualified consultants. Persons registered only in the patent section must use the title in the form of patent advisor and persons registered only in the trademark section must use the title in the form of a trademark advisor. Persons registered in both sections may use the title of Industrial Property Consultant without further specification.

2. The persons referred to in Article 202 shall carry out on behalf of any natural or legal person all the requirements laid down in the rules governing the services relating respectively to patents for inventions, utility models, designs for new plant varieties, for topographies of semiconductor products or to the subject matter of trade marks, designs and geographical indications, depending on the section in which they are entered. They can certify the conformity of translations into Italian and any document and document from abroad to be produced at the Italian Patents and Trademark Office.

3. They may also, on mandate and on behalf of the interested parties, carry out any other function that is similar, connected, consequent to the provisions of paragraph 2.

4. If more than one qualified consultant is entrusted with the assignment, they may, unless otherwise provided, act separately. If the assignment is assigned to more than one qualified consultant, established in association or company, the task shall be deemed to be conferred on each of them in so

far as it acts within that association or company.

Art. 205.

Incompatibility

1. The registration in the register of authorised industrial property consultants and the exercise of the profession of industrial property consultant are incompatible with any public or private employment or office with the exception of the employment or office relationship held by companies, offices or specialised services in the field, whether autonomous or organised within bodies or undertakings, and teaching activities in any form exercised; by the exercise of trade, by the profession of notary, professional journalist, mediator, exchange agent or tax collector.

2. Registration in the Register of authorised industrial property consultants and the exercise of the profession of industrial property consultant is compatible, unless otherwise provided and subject to the provisions of paragraph 1, with the registration in other professional registers and with the exercise of the relevant profession.

3. Authorised industrial property consultants, who carry out their activities in offices or services organised within bodies or enterprises, or within consortia or groups of undertakings, may operate exclusively on behalf of and on behalf of:

- a) the institution or undertaking on which they depend;
- b) undertakings belonging to the consortium, or group in which they are permanently incorporated;
- c) undertakings or persons who are with bodies or undertakings or groups or consortia, in which the authorised consultant is included, in systematic collaboration relationships, including research, production or technological exchanges.

Art. 206.⁶⁰

Obligation of professional secrecy

1. The industrial property consultant has the obligation of professional secrecy and Article 200 of the Code of Criminal Procedure applies to him.

Art. 207.

Qualification Examination

1. Approval shall be granted after passing an examination before a committee composed for each session:

- a) the Director of the Italian Patents and Trademark Office or his delegate acting as President;
- b) by a member of the Board of Appeal, appointed by the Board of Appeal to serve as Vice-President;
- c) two university professors, respectively, of legal and technical subjects, appointed by the Minister for Economic Development;
- d) by four authorised industrial property consultants, appointed by the Council referred to in Article 215, of which two are chosen from among the employees of entities or undertakings and two who exercise the profession independently;
- e) alternate members who may replace those referred to in points (b), (c) and (d), if they are impossible.

2. Any person who:

- a) has achieved:
 - 1) an equivalent degree or university degree in any foreign country;
 - 2) a diploma or qualification issued by a Member State of the European Union which includes a certificate that the candidate has successfully completed a post-secondary course of at least three years or of equivalent part-time duration, in a university or higher education institution or in another

institution of the same level of training, provided that the course of studies has a technical and professional orientation relating to the activity of industrial property consultant in the field of patents of invention and models or in the field of trade marks and designs depending on the required qualification;

b) has completed at least two years of effective professional traineeship with companies, offices or services specialised in industrial property, documented in an appropriate manner.

3. Any person who has passed the qualification examination as a qualified consultant at the European Patent Office shall be eligible for the qualification examination for registration in the Patent Section.

4. The traineeship period shall be limited to eighteen months if the candidate for the qualification examination demonstrates that he/she has successfully attended a qualified training course for qualified patent or trademark consultants, depending on the required qualification.

5. The qualification examination for registration in the patents section and in the trade mark section, respectively, consists of written and oral tests, aimed at ascertaining the theoretical and practical preparation of the candidate in the specific field of industrial property rights, as well as at the level of technical, legal and linguistic culture, in accordance with the section concerned, in accordance with the procedures laid down in the regulation to be issued by decree.

6. The certification examination for registration in the patents section or the examination for registration in the trademark section is held every two years by decree of the Ministry of Economic Development.

Art. 208.

Exemption from the qualification exam

1. Those who, already employed by the Ministry of Economic Development or the Ministry of Defence, have served, for at least five years, with managerial duties at the Italian Patent and Trademark Office respectively, or the Patent and Intellectual Property Service, are exempt from the qualification examination.

2. Italian citizens who have served for at least five years as examiners at the European Patent Office are also exempted for registration in the Patent Section.

Art. 209.

Register of authorised industrial property consultants

1. The register established pursuant to Article 202 must contain for each member the surname, first name, place and date of birth, diploma, date of registration, professional domicile in Italy, which may also consist of the head office of the institution or undertaking on which it depends.

2. The date of registration determines seniority. Those who after the cancellation are again enrolled in the register have the seniority resulting from the first registration deducted the duration of the interruption.

Art. 210.

Cancellation from the register and suspension of right

1. The qualified consultant is deleted from the register:

- a) when one of the requirements for registration referred to in Article 203 has ceased to exist;
- b) where one of the cases of incompatibility referred to in Article 205 occurs;
- c) when requested by the person concerned.

2. The qualified consultant may request re-registration when the causes of cancellation have ceased without the need for re-examination.

3. The qualified consultant shall be declared suspended by law from the time of submission to the coercive or interdictive measures provided for in Chapters II and III of Chapter IV, Title I, of the

Code of Criminal Procedure up to that of the revocation of the measures, and in the event of non-payment within the fixed period, of the annual contribution, until the date of the ascertained fulfilment.

Art. 211.

Disciplinary sanctions

1. Qualified advisers are subject to censorship in case of abuse and minor deficiencies, suspension for no more than two years in the event of serious abuse; removal in the event of conduct which has seriously undermined professional reputation and dignity.

Art. 212.

Meeting of Members of the Register

2. The Assembly shall be convened by the President, upon deliberation by the Council of the Order. It is duly constituted on the first call with the presence of at least half of the members and on the second call, which may not take place on the same day as the first, with the presence of at least one sixth of the members if the members present and represented reach the presence of at least one fifth of the members. It shall act by an absolute majority of the votes.

3. Any qualified consultant registered in the register may be represented by another qualified consultant registered in the register by written delegation. The same participant may not represent more than five members.

4. The procedures for convening and holding the assembly are determined by decree of the Minister for Economic Development.

Art. 213.

Tasks of the Assembly

1. The Shareholders' Meeting shall meet at least once a year before the month of March, for the approval of the preventive and final accounts, for the determination of the amount of the annual contribution to be equal for all members and, if necessary, for the election of the Order Council, in which case the convocation must take place at least one month before the date of its expiry.

2. The Assembly shall also meet each time the Board of Order considers it necessary, as well as when requested in writing with an indication of the topics to be dealt with by at least one tenth of the members of the register.

Art. 214.

Assembly for the election of the Board of Order

1. The members of the Council of the Order referred to in Article 215 shall be elected by a simple majority of the secret votes validly cast by means of ballots containing a number of names not exceeding half plus one of the members to be elected. The ten candidates with the highest number of votes are elected. In case of parity, the oldest candidate for registration is preferred and, among those with equal age, the oldest.

2. Each category of consultants practising the profession independently, whether individually or in the context of self-employed companies, offices or services, on the one hand, and consultants engaged in specialised offices and services within the framework of entities or undertakings referred to in Article 205(3), on the other, may not be represented in the Board of the Order with more than eight members. Similarly, each section of the register may not be represented in the Council of the Order with more than seven members, registered exclusively to it.

3. Participations and votes by delegation are not allowed. The vote is allowed by letter.

4. The procedures for carrying out the voting, the voting and the proclamation of the elected shall be laid down by decree of the Minister for Economic Development.

Art. 215.

Council of the Order of Industrial Property Consultants

1. The order of industrial property consultants is governed by a Council that lasts for three years and is composed of ten members with no less than three years of seniority elected by the assembly. To replace the members that have ceased for any reason before the deadline, the candidates included in the ranking list who, after those elected, have obtained the highest number of votes, subject to the provisions of paragraph 2 of Article 214.

2. In the event of no timely renewal, the Order Council shall continue to function until the appointment of the new Council.

3. The Council of the Order shall meet validly with the presence of a majority of its members and shall act by an absolute majority. In the event of a tie, the vote of the President shall prevail. In this matter, the Council of the Order shall act with the presence of at least three-quarters of the members.

Art. 216.

Powers of the President of the Council of the Order

1. The Council of the Order shall appoint a President from among its members, who shall represent it: take the necessary measures in urgent cases, subject to ratification by the Council at the first subsequent meeting, and shall exercise the remaining powers conferred on it by this Code.

2. The President may delegate secretarial or treasury powers to the Council.

3. The Council shall also appoint from among its members a Vice-President, who shall replace the Chairperson in his absence or impediment, or upon delegation thereof for individual acts.

Art. 217.

Powers of the Council of Order

1. The Council of Order:

a) promptly provide for the obligations relating to registrations, suspensions and cancellations to be carried out in the register, giving immediate notice to the Italian Patents and Trademark Office;

b) supervises the protection of the professional title of industrial property consultant and proposes to the assembly the necessary initiatives for this purpose;

c) intervenes, at the mutual request of the parties, to settle the disputes arising between members of the register depending on the exercise of the profession;

d) proposes changes and updates to the professional rate;

e) at the request of the client or of the same qualified consultant, shall express an opinion on the extent of the obligations due to industrial property consultants for the services inherent in the exercise of the profession;

f) take disciplinary measures;

g) designates the four authorised industrial property consultants who are involved in forming the examination committee referred to in Article 207;

h) adopt the most appropriate initiatives to achieve the improvement and improvement of those enrolled in carrying out their professional activity;

i) establish its seat and provide the necessary means for its operation;

l) collects and administers the annual contribution of members;

m) prepares the preventive account and draws up the balance sheet of the management;

n) receive applications for admission to the qualification examination referred to in Article 207 and verify that they meet the conditions for admission;

o) maintain relations and cooperate with bodies and institutions operating in the field of industrial property or carrying out activities related to it, by formulating, where appropriate, proposals

or opinions;

p) performs the other tasks defined by decree of the Minister for Economic Development which are of a necessary instrumentality compared to those provided for in this Code;

P-bis) provides for registrations in the register of trainees and their updates.

Art. 218.

*Forfeiture of membership of the Council of Order, dissolution and failure
establishment of the Council of Orders*

1. The members who, without justifiable reasons, do not intervene three times in a row at the meetings of the Council of Order are declared to have fallen from office.

2. The Council may be dissolved by the Minister for Economic Development, if it is unable to function and in any event if more than four of the original components have ceased or fallen or if serious irregularities are established.

3. In the event of dissolution of the Council, its duties shall be assumed by a Commissioner appointed by the Minister for Economic Development. The Commissioner shall, within sixty days, hold new elections, for which the assembly must meet no earlier than thirty days and no later than sixty days from the date of the act of convocation.

Art. 219.

Meetings of the Council of the Order

1. The Board of Order shall be convened by the President at least once every six months or when it deems it appropriate, or when requested by a majority of the members. The deliberations of the Council shall be minuted by a member appointed as secretary at the beginning of each session.

Art. 220.

Disciplinary proceedings

1. Where information is received of facts likely to lead to the application of one of the disciplinary sanctions referred to in Article 211, the President shall appoint a rapporteur from among the members of the Council.

2. The Council shall, after contesting the facts preceding at least 10 days before the hearing of the person concerned, examine any written pleadings and documents, shall act by an absolute majority of those present; in the event of a tie of votes, the decision most favourable to the blame shall prevail.

3. If the person concerned fails to present himself or sends a statement of defence, he shall proceed in his absence unless a legitimate impediment has been established.

4. The deliberation must contain an indication of the facts, the reasons and the summary of the decision.

5. Members of the Council must abstain when the grounds set out in the first paragraph of Article 51 of the Code of Civil Procedure are applicable and may be rejected on the same grounds by application lodged with the Council secretariat before the discussion.

6. In any other case where there are serious reasons for convenience, members may request authorisation from the President of the Council of the Order to abstain.

7. The Board of Appeal shall decide on the objection.

Art. 221.

Appeal against the Order Council's measures

1. Any action taken by the Board of Appeal may be appealed to the Board of Appeal within the limitation period of one year from the date of notification of the order to the person concerned.

2. The Director of the Italian Patent and Trademark Office shall ensure the regularity of the work and the functioning of the Council and may have recourse, for any irregularities found, to the

Board of Appeal within thirty days from the date of notification of the resolution. The appeal has no suspensive effect.

Art. 222.

Professional rate

1. The Minister for Economic Development approves, by his decree, the amendments and updates to the professional tariff proposed by the Council of the Order, pursuant to Article 217(1)(d).

2. The carrying out of activities relating to professional law does not entail additional burdens on the State budget.

Chapter VII

MANAGEMENT OF SERVICES AND RIGHTS

Art. 223.

Tasks

1. Services related to the matter regulated by this Code shall be provided by the Italian Patent and Trademark Office.

2. Without prejudice to the institutional competences of the Ministry of Foreign Affairs in the field of industrial property and the coordination of the President of the Council of Ministers, the Italian Patent and Trademark Office of the Ministry of Economic Development shall promote and maintain relations with the relevant Community and international institutions and bodies, as well as with the national industrial property offices of the other States, and shall deal with the related issues by ensuring participation in the bodies and working groups.

3. The Italian Patent and Trademark Office shall also carry out the following additional tasks:

a) creation and management of databases and dissemination of patent information with particular reference to the update on the state of the art;

b) promotion of the technical and legal preparation of public administration personnel operating in the field of industrial property and technological innovation and those who carry out or intend to carry out the profession of industrial property consultant;

c) promoting culture and use of industrial property among potential users, in particular in small and medium-sized enterprises and lagging areas;

d) carrying out studies, research, surveys and publications related to the subject of industrial property and development of patent indicators for the competitive analysis of Italy, either on its own or in collaboration with public administrations, research institutes, associations, international bodies;

e) provision of services for consideration of non-institutional services at the request of private individuals, provided that they are compatible with the function and the institutional role assigned to it.

4. The Italian Patent and Trademark Office may conclude agreements with regions, chambers of commerce, industry, crafts and agriculture, public and private bodies aimed at carrying out its tasks.

Art. 224.⁶¹

Financial resources

1. The Italian Patents and Trademark Office provides for the performance of its tasks and the financing of the search for precedence with the budgetary resources entered in the estimate of the expenditure of the Ministry of Economic Development, with the fees directly collected for services rendered in the field of industrial property.

2. The Ministry of Economic Development shall pay 50 % of the fees referred to in paragraph 1 annually to the European Patent Office, as provided for in Article 39 of the Munich Convention of 5 October 1973, ratified by Law No 260 of 25 May 1978.

3. The Italian Patent and Trademark Office also carries out its duties with any payments and refunds made by international industrial property organisations in which Italy participates and with any other proceeds deriving from its activity.

Art. 225.⁶²

Concession and maintenance rights

1. For applications submitted to the Ministry of Economic Development for the purpose of obtaining industrial property titles, for concessions, oppositions, transcripts, renewal is due the payment of the stamp duty, as well as government concession fees and rights whose determination, in relation to each title or application and the interval of time to which they relate, is made by a special decree by the Minister for Economic Development, in agreement with the Minister for Economic Affairs and Finance.

2. The individual designation fee of Italy in the application for international trade mark registration, in the later designation or in the application for renewal applicable to foreign international trade marks seeking protection on Italian territory through the World Intellectual Property Organisation of Geneva, pursuant to the Protocol relating to the Madrid Agreement for the International Registration of Trade Marks of 27 June 1989, ratified by Law No 169 of 12 March 1996, shall be set at 90 % of the rights provided for the filing of the grant of a national trade mark or renewal.

Art. 226.

Terms and methods of payment

1. The payment of government concession fees and fees referred to in this Code shall be made in accordance with the terms and conditions laid down by the Minister for Economic Development, by its own decree.

Art. 227.

Rights for the maintenance of industrial property rights

1. All rights provided for the maintenance of industrial property rights must be paid in advance, within the month corresponding to the month in which the application was lodged, after the period covered by the previous payment. The application for trademark renewal must be filed within the 12 months preceding the last day of the month of expiry of the current decade.

2. Maintenance rights for invention patents, utility models and designs, where they have already accrued at the end of the month in which the grant certificate is issued or accrued by the end of the third month following, shall be payable within four months of the end of the month of that issue.

3. Maintenance rights for plant variety rights shall be payable for the duration of the right referred to in Article 109(1) from the date of the grant of the plant variety right and must be paid in advance within the month corresponding to that of the grant.

4. After the expiry period referred to in paragraphs 1 and 2, payment shall be allowed within the following six months with the application of a right of late payment, the amount of which shall be determined for each industrial property right by the Ministry of Economic Development, in agreement with the Ministry of Economic Affairs and Finance.

5. A delay in payment exceeding six months entails the revocation of the industrial property right.

6. More annual fees can be paid in advance.

7. In the case referred to in Article 6, paragraph 1, all persons are jointly and severally liable to pay the maintenance rights.

8. The payment of maintenance rights for European patents valid in Italy from the year following the year in which the grant of the European patent is published in the European Patent Bulletin shall apply the same payment terms as national patents and the rules set out in Article 230 on regularisation.

Art. 228.

Exemption and suspension of payment of fees

1. The inventor, who demonstrates that he is in poverty, may grant exemption from concession fees and suspension from payment of annual fees for the first five years. At the end of the fifth year, the inventor who intends to keep the patent in force must pay, in addition to the annual entitlement for the sixth year, even the arrears. Otherwise, the patent expires and the inventor is not required to pay the rights of previous years.

Art. 229.

Refundable rights

2. In the event of rejection or waiver of the application, before registration has been made or the patent has been granted, the rights paid shall be reimbursed, with the exception of the right of application. The right provided for for the deposit of opposition is refunded in the event of termination of the opposition pursuant to Article 181, paragraph 1, letter b).

3. Reimbursements of rights are authorised by the Ministry of Economic Development. Authorisation shall be issued ex officio where the rights to be reimbursed relate to a definitively rejected application for registration or patent. In any other case, reimbursement is made at the request of the person entitled, with direct application to the Ministry of Economic Development.

4. Refunds must be recorded in the register of patents and, where they relate to applications withdrawn or rejected, shall be entered in the register of applications.

Art. 230.

Incomplete or irregular payment

1. If for obvious error, or for other excusable reasons, a right is paid incompletely or in any case irregularly, the Italian Patents and Trademark Office may admit as useful the integration or regularisation of the payment even late.

2. If this is an annual right, the Italian Patent and Trademark Office shall provide only at the request of the person concerned. If the application is rejected, the person concerned may appeal to the Board of Appeal referred to in Article 135(1).

3. Suppressed

Chapter VIII

TRANSITIONAL AND FINAL PROVISIONS

Section I

Brands

Art. 231.⁶³

Previous questions

1. Applications for registration of a trade mark and applications for transcription lodged before the date of entry into force of Legislative Decree No 480 of 4 December 1992 shall be dealt with in accordance with the provisions contained therein. However, as regards formal regularity, they are subject to pre-existing rules.

Art. 232.⁶⁴

Limits to the exclusive right to the renowned trademark

2. The right to make exclusive use of a trade mark registered before the date of entry into force of Legislative Decree No 480 of 4 December 1992 and enjoying renown does not allow the proprietor to oppose further use in trade of a sign identical to or similar to the mark for goods or services not

similar to those for which it was registered.

Art. 233.⁶⁵

Nullity

3. Trade marks registered before the date of entry into force of Legislative Decree No 480 of 4 December 1992 are subject, as regards grounds for invalidity, to the earlier provisions of law.

4. The mark may not be declared invalid if, prior to the lodging of the principal or counterclaim for a declaration of invalidity, the sign, as a result of its use, has acquired distinctive character.

5. The invalidity of the mark may not be declared invalid if the earlier mark has expired for more than two years or three if it is a collective mark or can be considered to have been revoked for non-use prior to the lodging of the principal or counterclaim for invalidity.

6. For the purposes of applying Article 48 of Royal Decree No 929 of 29 June 1942, as replaced by Legislative Decree No 480 of 4 December 1992, the period of five years shall run from the date of its entry into force.

Art. 234.⁶⁶

Transfer and license of the brand

1. The provisions of Legislative Decree No 480 of 4 December 1992 governing the transfer and licensing of the trade mark shall also apply to trade marks already granted, but not to contracts concluded before the date of entry into force of Legislative Decree No 480 of 4 December 1992.

Art. 235.⁶⁷

Decadence for non-use

1. The provisions of Legislative Decree No 480 of 4 December 1992 governing revocation for non-use shall apply to trade marks already granted on the date of entry into force of that legislative decree, provided that they have not yet expired on that date.

Art. 236.⁶⁸

Decadence for deceptive use

1. The provisions of Legislative Decree No 480 of 4 December 1992, which govern the revocation of the mark for misleading use thereof, apply to trade marks already granted on the date of entry into force of the same legislative decree, in relation to a misleading use put in place after its entry into force.

Section II

Designs and models

Art. 237.⁶⁹

Previous questions

1. Applications for patents by ornamental design and applications for transcription filed before the date of entry into force of Legislative Decree No 95 of 2 February 2001 shall be dealt with in accordance with the provisions contained therein. The same applications are subject to the previous rules on formal regularity.

Art. 238.⁷⁰

Extension of the right

1. Patents for ornamental design granted before the date of entry into force of Legislative Decree

No 95 of 2 February 2001, provided that they have not expired or expired on the date of entry into force of the aforementioned legislative decree, may be extended up to a maximum period of twenty-five years from the date of filing of the patent application. Licensees and those who had made serious and effective investments to use the design are entitled to obtain a free and non-exclusive compulsory licence for the longest period of time. This option does not apply to patent counterfeiters who have not yet expired.

2. The concession fees paid in a single solution apply to the first two extensions. The taxes on government concessions relating to the fourth and fifth five years, as from 19 April 2001, are in the amount corresponding to the instalment of the third five-year period provided for in Article 10, Title IV, number 2(c) and (f) of the tariff indicated in the table annexed to Presidential Decree No 641 of 26 October 1972.

Art. 239.⁷¹

Limits on copyright protection

1. The protection afforded to designs under Article 2(10)) of Law No 633 of 22 April 1941 also includes works of the industrial design which, before 19 April 2001, were, or had become, in the public domain. However, third parties who had manufactured or marketed, during the 12 months prior to 19 April 2001, products made in accordance with the works of the industrial design at that time in the public domain are not liable for the infringement of copyright by continuing this activity even after that date, limited to the products they manufactured or purchased before 19 April 2001 and those which they manufactured within the five years following that date and provided that that activity remained within the limits of even quantitative pre-use.

Art. 240.⁷²

Nullity

1. Patents for ornamental designs granted before the date of entry into force of Legislative Decree No 95 of 2 February 2001 shall be subject, as regards grounds for invalidity, to the earlier provisions of law and, as regards the effects of the declaration of invalidity, to the rule referred to in Article 77 of this Code.

Art. 241.⁷³

Exclusive rights to components of a complex product

1. Until Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs is amended on a proposal from the committee pursuant to Article 18 of that directive, exclusive rights in respect of components of a complex product cannot be invoked to prevent the manufacture and sale of those components for the repair of the complex product in order to restore its original appearance.

Section III

New Vegetal Varieties

Art. 242.⁷⁴

Duration of the right

2. The provisions of Article 109 of this Code shall apply to patents for new plant varieties granted in accordance with Decree No 974 of the President of the Republic of 12 August 1975, which have not expired or expired on the date of entry into force of Legislative Decree No 455 of 3 November 1998.

3. Licensees and those who, on the date of entry into force of Legislative Decree No 455 of 3 November 1998, have made serious and effective investments in the use of the new plant varieties covered by the breeder's right are entitled to obtain compulsory free and non-exclusive licence for the longest period of time. This option does not apply to counterfeiters of rights that have not yet expired.

2-bis. Annual entitlements paid from the date of filing for the maintenance of applications and plant variety rights already filed or granted on 29 March 1999 shall be considered as valid payment of the corresponding annual entitlements due by the grant of the right in accordance with Article 25 of Legislative Decree No 455 of 3 November 1998.

Section IV Inventions Art. 243.⁷⁵

Inventions of researchers from universities and public research bodies

1. The inventions of employees whose employment relationship exists with a university or with a public administration having, among its institutional tasks, research purposes are subject to the rules laid down respectively by Article 24-bis of Royal Decree No 1127 of 29 June 1939, introduced by Law No 383 of 18 October 2001, by the original text of Article 65 of this Code and by the current text of that article, in force at the time when the inventions were obtained, even if it depends on research begun earlier.

Art. 243-bis

Report to Parliament on the legal protection of biotechnological inventions

1. The Minister for Economic Development, in consultation with the Ministers for Health, Agricultural, Food and Forestry Policy, Environment and Protection of Land and Sea, Education, University and Research and Labour and Social Policy, shall submit to Parliament each year a report on the application of the rules laid down in Section IV-bis of Chapter II of this Code.

Section V

Previous questions

Art. 244.

Processing of applications

1. Applications for patents or registrations and applications for transcription and annotation, even if already filed at the time of entry into force of this Code, shall be treated in accordance with the provisions contained therein. Applications referred to in Chapter IV, Section I, shall be subject to the pre-existing rules concerning the conditions of admissibility.

Section VI

Rules of Procedure

Art. 245.⁷⁶

Procedural provisions

1. The provisions of Chapters I and IV of Title II of Title III and the provisions of Articles 35 and 36 of Title V of Legislative Decree No 5 of 17 January 2003 shall apply to judicial proceedings and arbitration proceedings which have commenced by a document served or by filing the appeal six months after the entry into force of the Code.

2. Disputes capable of appeal in the matters referred to in Article 134, initiated after the date of

entry into force of this Code, shall remain devolved to the knowledge of the specialised chambers referred to in Legislative Decree No 168 of 27 June 2003, even if the court of first instance or the arbitration proceedings have commenced or have taken place in accordance with the rules previously in force, unless a ruling on jurisdiction has already taken place in the context of those proceedings.⁷⁷

3. The complaint procedures and substantive cases in the matters referred to in Article 134, which began after the date of entry into force of this Code, remain devolved to the knowledge of the specialised sections referred to in Legislative Decree No 168 of 27 June 2003, even if they concern precautionary measures granted in accordance with the rules previously in force.

4. The rules of procedure referred to in Article 136 concerning the judicial function of the Board of Appeal shall apply from one year after the entry into force of the Code.

5. The procedural rules laid down in Articles 137, 146, 194, 195, 196, 198, 199 and 200 shall apply with the entry into force of the Code.

Section VII Repeals

Art. 246.⁷⁹

Repeal provisions

1. The following provisions are repealed:

- a) Royal Decree No 1127 of 29 June 1939;
- b) Royal Decree No 244 of 5 February 1940;
- c) Royal Decree No 1411 of 25 August 1940;
- d) Royal Decree No 1354 of 31 October 1941;

e) Royal Decree No 929 of 21 June 1942;

f) Decree No 795 of the President of the Republic of 8 May 1948;

g) Article 34 of Decree No 3 of the President of the Republic of 10 January 1957;

h) Decree No 540 of the President of the Republic of 30 June 1972;

i) Decree of the Minister for Industry, Commerce and Crafts of 22 February 1973, published in the Official Gazette of the Italian Republic No 69 of 15 March 1973;

l) Decree No 974 of the President of the Republic of 12 August 1975, without prejudice to Article 18;

m) Decree of the Minister for Industry, Commerce and Crafts of 22 October 1976, published in the Official Gazette of the Italian Republic No 15 of 18 February 1977;

n) Decree No 32 of the President of the Republic of 8 January 1979;

o) Decree No 338 of the President of the Republic of 22 June 1979;

p) law No 194 of 3 May 1985;

q) law No 620 of 14 October 1985;

r) Decree of the Minister for Industry, Commerce and Crafts of 26 February 1986, published in Official Gazette of the Italian Republic No 104 of 7 May 1986;

s) law No 60 of 14 February 1987;

t) law No 70 of 21 February 1989;

u) Decree No 320 of the Minister for Industry, Commerce and Crafts of 19 July 1989, published in Official Gazette of the Italian Republic No 220 of 20 September 1989;

v) Decree No 122 of the Minister for Industry, Commerce and Crafts of 11 January 1991, published in Official Gazette of the Italian Republic No 85 of 11 April 1991;

Z) Law No 349 of 19 October 1991; legislative Decree No 480 of 4 December 1992; law No 302 of 26 July 1993;

AA) Decree No 595 of the President of the Republic of 1 December 1993;

BB) Decree No 360 of the President of the Republic of 18 April 1994;

CC) Decree No 391 of the President of the Republic of 18 April 1994;

DD) Law No 890 of 21 December 1984;
EE) Decree No 342 of the Minister for Industry, Commerce and Crafts of 30 May 1995, published in the Official Gazette of the Italian Republic No 192 of 18 August 1995;
FF) Legislative Decree No 198 of 19 March 1996; legislative Decree No 455 of 3 November 1998; legislative Decree No 447 of 8 October 1999;
DG) Legislative Decree No 95 of 2 February 2001;
HH) Legislative Decree No 164 of 12 April 2001;
II) Article 7 of Law No 383 of 18 October 2001;
ll) Legislative Decree No 26 of 2 February 2002;
mm) paragraphs 8, 8-bis, 8-ter and 8-quater of Article 3 of Law No 112 of 15 June 2002, converting, with amendments, Decree-Law No 63 of 15 April 2002;
nn) Decree of the Minister for Production Activities of 17 October 2002, published in Official Gazette No 253 of 28 October 2002;
OO) Article 17 of Law No 273 of 12 December 2002;
pp) paragraphs 72, 73, 79, 80 and 81 of Article 4 of Law No 350 of 24 December 2003;
QQ) Decree-Law No 3 of 10 January 2006 converted, with amendments, by Law No 78 of 22 February 2006 on the implementation of Directive 98/44/EC on the legal protection of biotechnological inventions;
RR) Article 18 of Decree No 974 of the President of the Republic of 12 August 1975 concerning rules for the protection of new plant varieties;
SS) paragraphs 10 to 13 of Article 19 of Law No 99 of 23 July 2009 laying down provisions for the development and internationalisation of enterprises, as well as in the field of energy.
This Decree, bearing the seal of the State, will be included in the Official Collection of Legislative Acts of the Italian Republic. Everyone is obliged to observe it and to observe it.
Given in Rome, 10 February 2005

CIAMPI

Berlusconi, President of the Council of Ministers

Marzano, Minister of Production Activities

Castelli, Minister of Justice

Siniscalco, Minister for Economic Affairs and Finance

Fini, Minister for Foreign Affairs

Baccini, Minister for Civil Service

See, the Seawatcher: Castles

¹ **Warning:**

- The text of the notes published here has been drawn up by the competent authority, in accordance with Article 10(2) and (3) of the Consolidated Text of the Provisions on the promulgation of laws, on the enactment of the decrees of the President of the Republic and on the official publications of the Italian Republic, approved by Presidential Decree No 1092 of 28 December 1985, for the sole purpose of facilitating the reading of the amended provisions of law or to which the reference is made. The value and effectiveness of the legislative acts transcribed here remain unchanged.

- For the EEC Directives, publication details are provided in the Official Journal of the European Communities (OJCE).

² **Notes to the premises:**

- Article 76 of the Constitution regulates the delegation to the Government of the exercise of the legislative function and provides that it can only take place with determination of guiding principles and criteria and only for limited time and for defined objects.

- Article 87(5) of the Constitution confers on the President of the Republic the power to promulgate laws and to issue decrees having the force of law and regulations.

- Law No 273 of 12 December 2002 on "Measures to promote private initiative and the development of competition" is published in the Official Gazette No 293 of 14 December 2002.

- Law No 186 of 27 July 2004 'Conversion into law, with amendments, of Decree-Law No 136 of 28 May 2004 laying down urgent provisions to ensure the functionality of certain sectors of public administration. Provisions for the re-determination of legislative powers and other related provisions' is published in the Official Gazette No 175 of 28 July 2004, Ordinary Supplement.

- Law No 306 of 27 December 2004 'Conversion into law, with amendments, of Decree-Law No 266 of 9 November 2004 extending or deferring deadlines provided for by legislative provisions. Provisions for the extension of time limits for the exercise of legislative powers' is published in the Official Gazette No 302 of 27 December 2004.

- The text of Article 14 of Law No 400 of 23 August 1988 'Rules of Government and Ordinance of the Presidency of the Council of Ministers' (published in the Official Gazette No 214 of 12 September 1988) is as follows: 'Article 14 (Legislative Decrees). — 1. Legislative decrees adopted by the Government pursuant to Article 76 of the Constitution shall be issued by the President of the Republic under the name of "Legislative Decree" and

indicating in the preamble the delegation law, the deliberation of the Council of Ministers and the other procedural requirements laid down by the delegation law. 2. The enactment of the legislative decree must take place within the time limit set by the delegation law; the text of the legislative decree adopted by the Government shall be forwarded to the President of the Republic, for issue, at least twenty days before its expiry. 3. If the legislative delegation refers to a plurality of distinct objects susceptible to separate discipline, the Government may exercise it by several successive acts for one or more of the aforementioned objects. In relation to the final deadline established by the delegation law, the Government periodically informs the Chambers of the following criteria in the organisation of the exercise of delegation. 4. In any case, if the deadline for the exercise of the delegation exceeds two years, the Government is required to request the opinion of the Chambers on the schedules of the delegated decrees. The opinion is delivered by the standing committees of the two chambers responsible for the matter within sixty days, specifically indicating any provisions not considered to correspond to the directives of the delegation law. The Government shall, within thirty days thereafter, examine the opinion, retransmit, with its observations and with any amendments, the texts to the Commissions for the final opinion which must be expressed within thirty days.'

- Royal Decree No 1127 of 29 June 1939 laying down the 'Text of Legislative Provisions on Patents for Industrial Inventions' is published in Official Gazette No 189 of 14 August 1939.

- Royal Decree No 244 of 5 February 1940 on the "Text of Regulatory Provisions on Patents for Industrial Inventions" is published in Official Gazette No 94 of 20 April 1940.

- Royal Decree No 1411 of 25 August 1940 on "Text of legislative provisions on patents for industrial models" is published in the Official Gazette No 247 of 21 October 1940.

- Royal Decree No 1354 of 31 October 1941 on the 'Text of regulatory provisions on industrial model patents' is published in the Official Gazette No 300 of 22 December 1941.

- Royal Decree No 929 of 21 June 1942 on the 'Text of Legislative Provisions on Registered Trade Marks' is published in the Official Gazette No 203 of 29 August 1942.

- The text of Decree No 795 of the President of the Republic of 8 May 1948, 'Text of Regulatory Provisions on Registered Trade Marks', is published in the Official Gazette No 148 of 28 June 1948, Ordinary Supplement.

- The text of Decree No 540 of the President of the Republic of 30 June 1972 'Simplification of administrative procedures in the field of patents for industrial inventions, utility models, ornamental designs and registration of trade marks' is published in Official Gazette No 249 of 22 September 1972.

- The text of Decree No 974 of the President of the Republic of 12 August 1975 'Rules for the Protection of New Plant Varieties, implementing the delegation referred to in Law No 722 of 16 July 1974' is published in Official Gazette No 109 of 26 April 1976.

- The text of Decree No 32 of the President of the Republic of 8 January 1979 'Rules of application for European patents and Community patents' is published in Official Gazette No 41 of 10 February 1979.

- The text of Decree No 338 of the President of the Republic of 22 June 1979 'Revision of national legislation on patents, pursuant to the delegation referred to in Law No 260 of 26 May 1978' is published in Official Gazette No 215 of 7 August 1979.

- Law No 194 of 3 May 1985 on 'Revision of rules of Presidential Decree No 32 of 8 January 1979 implementing Law No 260 of 26 May 1978 concerning the ratification and enforcement of international patent acts' is published in Official Gazette No 117 of 20 May 1985.

- Law No 620 of 14 October 1985 on the ratification and implementation of the act of revision of the International Convention for the Protection of Plant Varieties of 2 December 1961, as revised on 10 November 1972, signed at Geneva on 23 October 1978, and amendments to Decree No 974 of the President of the Republic of 12 August 1975 concerning rules for the protection of new plant varieties, is published in Official Gazette No 266 of 12 November 1985, Ordinary Supplement.

- Law No 60 of 14 February 1987 on the harmonisation of the rules on patents for industrial models and designs with the

provisions of the Hague Agreement of 6 November 1925 and subsequent revisions, ratified by Law No 744 of 24 October 1980, is published in the Official Gazette No 53 of 5 March 1987.

- Law No 70 of 21 February 1989 laying down 'Rules for the legal protection of topographies of semiconductor products' is published in Official Gazette No 52 of 3 March 1989.

- Law No 349 of 19 October 1991 on 'Provisions for the issue of a supplementary certificate of protection for medicinal products or components thereof, which is the subject of a patent', is published in Official Gazette No 258 of 4 November 1991.

- The text of Decree No 595 of the President of the Republic of 1 December 1993 on "Regulation amending the text of the regulatory provisions on patents for trade marks, approved by Decree No 795 of the President of the Republic of 8 May 1948", is published in Official Gazette No 47 of 26 February 1994.

- The text of Presidential Decree No 360 of 18 April 1994 on "Regulation simplifying the procedure for granting compulsory licences for non-exclusive use of the invention patent" is published in Official Gazette No 136 of 13 June 1994, an ordinary supplement.

- The text of Decree No 391 of the President of the Republic of 18 April 1994 laying down 'Regulation governing the procedure for granting patents of new plant varieties' is published in Official Gazette No 141 of 18 June 1994, Ordinary Supplement.

- Law No 890 of 21 December 1984 laying down 'Rules for the implementation of the Treaty on International Cooperation in Patent Matters' is published in Official Gazette No 356 of 29 December 1984.

- The text of Legislative Decree No 164 of 12 April 2001 laying down 'Additional provisions to Legislative Decree No 95 of 2 February 2001 implementing Directive 98/71/EC on the legal protection of designs' is published in Official Gazette No 106 of 9 May 2001.

- The texts of paragraphs 8, 8-bis, 8-ter and 8-quater of Article 3 of Decree-Law No 63 of 15 April 2002 on 'urgent financial and tax provisions on the collection, rationalisation of the system for the formation of the cost of pharmaceutical products, Community obligations and adjustments, securitisation, valorisation of assets and infrastructure financing' published in Official Gazette No 90 of 17 April 2002 and converted into law, with amendments, by Law No 112 of 15 June 2002 (Official Gazette No 139 of 15 June 2002) are as follows: Article 3 (Rationalisation of the cost system of pharmaceutical products). 1.-7. (Omissis). 8. In order to progressively adjust the duration of the supplementary patent coverage to that provided for in Community legislation, the provisions of Law No 349 of 19 October 1991 and Council Regulation (EEC) No 1768/1992 of 18 June 1992 are implemented by means of a reduction in 'complementary protection' of six months for each calendar year, from 1 January 2004, until full alignment with European legislation. Companies intending to produce pharmaceutical specialities outside the patent cover may initiate the registration procedure of the active substance containing the active substance one year before the expiry of the supplementary patent coverage of the active substance. 8-bis. Third parties wishing to produce active ingredients covered by the supplementary protection certificates referred to in Article 4 of Law No 349 of 19 October 1991 and Article 4-bis of the Royal Decree, introduced by Article 1 of Law No 349 of 1991, are permitted to initiate with the holders of those certificates, at the Ministry of Economic Development, a procedure for the granting of voluntary licences for consideration in accordance with the legislation in force in this field. 8-ter. The licences referred to in paragraph 8-bis are in any case valid only for export to countries in which the patent protection of the related active ingredients has expired, including any supplementary protection certificate, and in accordance with the regulations in force in the countries of destination. 8-quater. Within 45 days of the date of entry into force of the law converting this Decree, the Minister for Economic Development, after consulting the sectors concerned, shall define the criteria for the operation of the procedure referred to in paragraph 8-bis.'

- Article 8 of Legislative Decree No 281 of 28 August 1997 concerning 'Definition and extension of the powers of the Permanent Conference for relations between the State, regions and autonomous provinces of Trento and Bolzano and unification, for matters and tasks of common interest of the regions, provinces and municipalities, with the State-city and local autonomous conference', published in Official Gazette No 202 of 30 August 1997, is as follows: Article 8 (State-city and local autonomy conference and unified conference). — 1. The State-City and Local Autonomous Conference is unified for the subjects and tasks of common interest of the regions, provinces, municipalities and mountain communities, with the State-Regions Conference. 2. The State-City and Local Autonomous Conference shall be chaired by the President of the Council of Ministers or, by its delegation, by the Minister of the Interior or by the Minister for Regional Affairs; it also includes the Minister of Treasury and Budget and Economic Planning, the Minister for Finance, the Minister for Public Works, the Minister of Health, the President of the National Association of Municipalities of Italy — ANCI, the President of the Union Provinces of Italy — UPI and the President of the National Union Commons, Communities and Mountain Bodies — UNCEM. It also includes fourteen mayors appointed by ANCI and six provincial presidents appointed by UPI. Of the fourteen mayors appointed by ANCI five are the cities identified by Article 17 of Law No 142 of 8 June 1990. Other members of the Government, as well as representatives of state, local or public authorities, may be invited to meetings. 3. The State-City and Local Autonomous Conference shall be convened at least every three months, and in all cases the President shall see the need for it or if the President of ANCI, UPI or UNCEM so requests. 4. The unified Conference referred to in paragraph 1 shall be convened by the President of the Council of Ministers. The sittings shall be chaired by the President of the Council of Ministers or, on his behalf, by the Minister for Regional Affairs or, if such office is not conferred, by the Minister for the Interior.'

³ **Notes to Art. 3:**

- Law No 424 of 28 April 1976 on the ratification and implementation of international agreements on intellectual property, adopted in Stockholm on 14 July 1967, is published in Official Gazette No 160 of 19 June 1976, Ordinary Supplement.

- Law No 110 of 23 March 1998 on the ratification and implementation of the International Convention for the Protection of Plant Varieties, adopted in Paris on 2 December 1961 and revised in Geneva on 10 November 1972, 23 October 1978 and 19 March 1991, is published in Official Gazette No 91 of 20 April 1998, Ordinary Supplement.

Note to Article 12:

- For Law No 424 of 28 April 1976, see the note in Article 3.

⁵ **Note to Article 16:**

— Law No 243 of 27 April 1982 on the ratification and implementation of the act revising the Nice Agreement of 15 June

1957, revised in Stockholm on 14 July 1967 on the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Geneva on 13 May 1977, is published in Official Gazette No 130 of 13 May 1982, Ordinary Supplement.

⁶ **Notes to Article 17:**

- For Law No 424 of 28 April 1976, see the note in Article 3.
- Law No 169 of 12 March 1996 on the ratification and implementation of the Protocol relating to the Madrid Understanding concerning the international registration of trade marks, signed in Madrid on 27 June 1989, is published in Official Gazette No 76 of 30 March 1996, Ordinary Supplement.

⁷ **Note to Article 43:**

— For Law No 424 of 28 April 1976, see the note in Article 3.

⁸ **Notes to Article 44:**

— The wording of Articles 2(1), 10 and 103 of Law No 633 of 22 April 1941 on 'Protection of copyright and other rights related to its exercise', published in Official Gazette No 166 of 16 July 1941, is as follows: "Art. 2. — In particular, the following are included in the protection: 1-9. (Omissis). 10. The works of industrial design that present in themselves creative character and artistic value. 'Art. 103. — A general public register of works protected under this law is established at the Ministry of People's Culture. The Italian Society of Authors and Publishers (SIAE) takes care of the keeping of a special public register for cinematographic works. In these registers, the works subject to the obligation to be deposited shall be recorded with the name of the author, the producer, the date of publication and the other particulars laid down in the Regulation. The Italian Society of Authors and Publishers is also entrusted with the maintenance of a special public register for computer programs. This register shall record the name of the holder of the exclusive economic use rights and the date of publication of the programme, meaning publication of the first act of exercising the exclusive rights. The recording is evidence to the contrary of the existence of the work and of the fact of its publication. The authors and producers listed in the register shall be deemed, unless proven otherwise, to the authors or producers of the works attributed to them. For cinematographic works, the presumption applies to the entries in the register indicated in the second paragraph. The keeping of advertising registers is regulated in the Regulation. The registers referred to in this Article may be kept using IT means and tools.'

⁹ *Amended by Law No 46 of 6 April 2007.*

¹⁰ *Paragraph added by Article 19(1) of Law No 99 of 23 July 2009.*

¹¹ **Note to Article 54:**

— Law No 260 of 26 May 1978 on 'Ratification and enforcement of international patent acts signed in Strasbourg on 27 November 1963, in Washington on 19 June 1970, in Munich on 5 October 1973 and in Luxembourg on 15 December 1975' is published in Official Gazette No 156 of 7 June 1978, Ordinary Supplement.

¹² **Note to Article 55:**

— For Law No 260 of 26 May 1978, see the footnote to Article 54.

¹³ **Note to Article 57:**

— For Law No 260 of 26 May 1978, see the footnote to Article 54.

¹⁴ **Note to Article 58:**

— For Law No 260 of 26 May 1978, see the footnote to Article 54.

¹⁵ **Notes to Article 61:**

- For Law No 349 of 19 October 1991, see the footnote under the premises.
- Regulation (EEC) No 1768 of 18 June 1992 on the Council Regulation concerning the establishment of a supplementary protection certificate for medicinal products is published in the Official Journal of the European Community of 2 July 1992, No 182. It entered into force on 2 January 1993.

¹⁶ **Note to Article 81:**

— For Law No 349 of 19 October 1991, see the footnote under the premises.

¹⁷ **Notes to Article 120:**

- Legislative Decree No 168 of 27 June 2003 on 'Instituting specialised sections in the field of industrial and intellectual property at Tribunals and Courts of Appeal, pursuant to Article 16 of Law No 273 of 12 December 2002', is published in the Official Gazette No 159 of 11 July 2003.
- Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark is published in Official Journal No L 011 of 14 January 1994.
- Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs is published in Official Journal No L 003 of 5 January 2002.

¹⁸ *Amended by Article 19(2) of Law No 99 of 23 July 2009.*

¹⁹ *Amended by Article 14 of Legislative Decree No 140 of 16 March 2006.*

²⁰ *Paragraph added by Article 14 of Legislative Decree No 140 of 16 March 2006.*

²¹ *Article added by Article 15 of Legislative Decree No 140 of 16 March 2006.*

²² **Notes to Article 122:**

- The wording of Article 70 of the Code of Civil Procedure 'Intervention by the Public Prosecutor' is as follows: 'Article 70 (Intervention by the Public Prosecutor's Office).
- The public prosecutor must intervene under penalty of nullity which can be detected of its own motion: 1) in the cases which he himself may propose; (2) in matrimonial cases, including those relating to legal separation of spouses; 3) in cases concerning the status and capacity of persons; 4) (omissis); 5) in other cases provided for by law. He must intervene in any case before the Court of Cassation. Finally, it can intervene in any other case in which it sees a public interest.'

- For the law of 28 April 1976, n. 424, see the note to art. 3.
Legislative Decree No 30¹ of 10 February 2005

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Industrial Property Code, pursuant to Article 15 of Law No 273 of 12 December 2002, updated following Legislative Decree No 131 of 13 August 2010.

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²⁴ *The heading thus replaced by Article 16 of Legislative Decree No 140 of 16 March 2006.*

²⁵ *Paragraph thus replaced by Article 16 of Legislative Decree No 140 of 16 March 2006.*

²⁶ *Paragraph thus replaced by Article 16 of Legislative Decree No 140 of 16 March 2006.*

²⁷ *Period added by Article 16 of Legislative Decree No 140 of 16 March 2006.*

²⁸ *Article replaced by Article 17, Legislative Decree No 140 of 16 March 2006.*

Note to Article 125:

— Is the text of Articles 1223, 1226 and 1227 of the Civil Code: 'Article 1223 (Reimbursement of Damage). — Compensation for damage for non-performance or delay must thus include the loss suffered by the creditor as the loss of income, as they are immediate and direct consequence.' Article 1226 (Equitative assessment of damage). — If the damage cannot be proved in its precise amount, it shall be settled by the court with an equitable assessment.' 'Article 1227 (Competition of the negligent act of the creditor). — If the culpable act of the creditor helped to cause the damage, the compensation shall be reduced according to the gravity of the fault and the extent of the consequences resulting therefrom. Compensation is not due for damages that the creditor could have avoided using ordinary diligence.'

²⁹ **Notes to Article 127:**

— Is the text of Articles 473, 474 and 517 of the Criminal Code: Article 473 (Contraffaction, alteration or use of distinctive signs of works of ingenuity or industrial products). — Any person who counterfeits or alters the distinctive marks or signs, national or foreign, of the works of ingenuity or industrial products, or, without being involved in counterfeiting or alteration, makes use of those marks or signs counterfeited or altered, shall be punished by imprisonment of up to three years and with a fine of up to four million lire. The same penalty applies to those who counterfeit or alter industrial, national or foreign patents, designs or designs, or, without being involved in counterfeiting or alteration, make use of such patents, designs or models that have been counterfeited or altered. The above provisions shall apply provided that the rules of domestic laws or international conventions on the protection of intellectual or industrial property have been complied with.'. Article 474 (Introduction into the State and trade in products with false signs). — Anyone who, outside the cases of competition in the crimes provided for in the preceding article, introduces into the territory of the State for trade in, holds to sell, or otherwise puts for sale, or otherwise puts into circulation works of ingenuity or industrial products, with distinctive marks or signs, national or foreign, counterfeit or altered, shall be punished by imprisonment of up to two years and with a fine of up to four million lire. The provision of the last paragraph of the preceding article shall apply.'. 'Article 517 (Sales of industrial products with false signs). Any person who places for sale or otherwise puts into circulation works of the ingenuity or industrial products, with national or foreign names, trademarks or distinctive signs, liable to mislead the buyer as to the origin, provenance or quality of the work or product, shall be punished, if the fact is not foreseen as an offence by another provision of law, with imprisonment of up to one year or with a fine of up to two million.'

³⁰ *Paragraph repealed by paragraph 2 of Article 15 of Law No 99 of 23 July 2009, with the effect indicated therein.*

³¹ *Paragraph added by Article 18 of Legislative Decree No 140 of 16 March 2006.*

³² **Note to Article 128:**

— The wording of Article 675 of the Code of Civil Procedure is as follows: 'Article 675 (Term of effectiveness of the measure). — The order authorising the seizure shall lose effect if it is not carried out within 30 days from the date of delivery.'

³³ **Note to Article 130:**

— For the wording of Article 675 of the Code of Civil Procedure, see the footnote to Article 128.

³⁴ *Paragraph replaced by Article 19 of Legislative Decree No 140 of 16 March 2006.*

³⁵ *Amended by Article 19(5) of Law No 99 of 23 July 2009.*

³⁶ **Note to Article 135:**

— Royal Decree No 1127 of 29 June 1939 concerning 'Text of legislative provisions on patents for industrial inventions' is published in Official Gazette No 189 of 14 August 1939.

³⁷ **Notes to Article 136:**

- Article 9 of Decree No 115 of the President of the Republic of 30 May 2002 'Single text of the laws and regulations relating to the costs of justice'. (Text A), published in Official Gazette No 139 of 15 June 2002, ordinary supplement, is as follows: 'Article 9 (L) (Unified Contribution). — The unified contribution of registration in the civil proceedings, including insolvency proceedings and voluntary jurisdiction, for each court, and in the administrative process, in accordance with the amounts provided for in Article 13 and without prejudice to the exemptions provided for in Article 10, shall be payable.'

- The wording of Article 27(1)(4) of Royal Decree No 1054 of 26 June 1924 'Approval of the single text of the laws on the Council of State', published in Official Gazette No 158 of 7 July 1924, is as follows: '(4) of actions for compliance with the obligation of the administrative authority to comply, in so far as it concerns the case decided, with the res judicata of the Tribunals which has recognised the infringement of a civil or political right.'

³⁸ **Note to Article 142:**

— The wording of Article 23-bis of Law No 1034 of 6 December 1971 on the establishment of regional administrative courts, published in Official Gazette No 314 of 13 December 1971, is as follows: 'Art. 23-bis. — 1. The provisions of this Article shall apply in proceedings before administrative justice bodies concerning: a) measures relating to procedures for the award of design tasks and related technical-administrative activities; measures relating to procedures for the award, award and execution of public or public works, including calls for tenders and acts of exclusion of competitors, as well as those relating

to the procedures for the occupation and expropriation of the areas intended for the aforementioned works; measures relating to procedures for the award, award and execution of public services and supplies, including invitations to tender and acts excluding competitors; the measures taken by the independent administrative authorities; measures relating to procedures for the privatisation or disposal of public undertakings or assets, as well as those relating to the establishment, modification or abolition of companies, companies and institutions within the meaning of Article 22 of Law No 142 of 8 June 1990; F) the appointment orders, adopted after the decision of the Council of Ministers pursuant to Law No 400 of 23 August 1988; the dissolution of local authorities and related measures concerning the formation and functioning of the bodies. 2. The time limits laid down in the proceedings shall be reduced to half, except those for bringing an action. 3. Without prejudice to the application of the fourth paragraph of Article 26, the regional administrative court called upon to rule on the precautionary application, having established that the adversary was complete or ordered to supplement it pursuant to Article 21, if it considers, at a first examination, that the action shows the unlawfulness of the contested measure and the existence of serious and irreparable harm, it shall fix by order the date of discussion on the merits at the first hearing following 30 days from the date of filing of the order. If the Regional Administrative Court rejects the application for interim measures, if the Council of State reforms the order of first instance, the appeal ruling shall be forwarded to the Regional Administrative Court for the determination of the hearing on the merits. In such a case, the 30-day period shall run from the date of receipt of the order by the secretariat of the regional administrative court, which gives notice to the parties. 4. In the proceedings referred to in paragraph 3, the parties may deposit documents within fifteen days of the filing or receipt of the orders referred to in the same paragraph and may lodge written submissions within the next ten days. 5. With the orders referred to in paragraph 3, in cases of extreme gravity and urgency, the regional administrative court or the Council of State may order the appropriate precautionary measures, setting out the profiles which, on a summary examination, lead to a reasonable probability of the successful outcome of the appeal. 6. In the proceedings referred to in paragraph 1, the operative part of the judgment shall be published within seven days of the date of the hearing, by deposit with the secretariat. 7. The time limit for bringing an appeal against the judgment of the regional administrative court delivered in the proceedings referred to in paragraph 1 shall be thirty days from the date of service and one hundred and twenty days from the publication of the judgment. The party may, in order to obtain suspension of the execution of the judgment, appeal within 30 days of the publication of the operative part, subject to the reasons, to be proposed within thirty days of service and within 120 days of the notification of the publication of the judgment. 8. The provisions of this Article shall also apply to the Council of State in the event of an application for the suspension of the judgment appealed.”

³⁹ *Amendment made by Legislative Decree No 104/2010 of 2 July 2010 (Annex 3, Title I, Article 3(16)), with effect from 16 September 2010 pursuant to Article 2 of that measure.*

⁴⁰ *Article added by Article 20, Legislative Decree No 140 of 16 March 2006*

⁴¹ **Note to Article 146:**

— The texts of Articles 22 and 23 of Law No 689 of 24 November 1981 on amendments to the criminal system, published in the Official Gazette No 329 of 30 November 1981, ordinary supplement, are as follows: ‘Article 22 (Opposition to the order-injunction). — Against the order for payment and against the order ordering only confiscation, the persons concerned may lodge an objection before the court of the place where the infringement identified pursuant to Article 22-bis was committed, within 30 days from the date of service of the order. The period shall be 60 days if the person concerned resides abroad. The opposition shall be brought by appeal, to which the notified order is annexed. The appeal must also contain, where the opponent has not indicated one of his prosecutors, the declaration of residence or the election of domicile in the municipality where the court seised is located. If there is no indication of the prosecutor or the declaration of residence or the election of domicile, notifications to the applicant shall be effected by filing at the Registry. When a prosecutor has been appointed, notifications and communications in the course of the proceedings shall be made to him in accordance with the procedures laid down in the Code of Civil Procedure. The opposition shall not suspend the enforcement of the order, unless the court, acting on serious grounds, provides otherwise by an order which cannot be challenged.’ ‘Art. 23 (Judgement of opposition). — If the action is brought beyond the period laid down in the first paragraph of Article 22, the court declares that it is inadmissible by an order which can be appealed on a point of law. If the appeal is brought in a timely manner, the court shall fix the appearance hearing by decree, at the end of the appeal, ordering the authority which issued the contested order to lodge at the Registry, ten days before the scheduled hearing, a copy of the relationship with the documents relating to the finding and the challenge or service of the infringement. The appeal and the decree shall be notified by the Registry to the opposing party or, if it has been indicated, to his prosecutor, and to the authority which issued the order. The time limits laid down in Article 163-bis of the Code of Civil Procedure must be met between the date of service and the appearance hearing. The opponent and the authority that issued the order may stand in court in person; the authority issuing the order may also rely on specially appointed officials. If, at the first hearing, the opponent or his prosecutor does not appear without adducing any legitimate impediment, the judge shall, by order which may be appealed on a point of law, validate the contested measure, by charging the opposing party also for the costs subsequent to the opposition. In the course of the proceedings, the court shall, even of its own motion, have the means of proof which it deems necessary and may order the summons of witnesses even without the wording of chapters. As soon as the investigation has been completed, the court invites the parties to clarify the conclusions and to proceed at the same hearing to discuss the case, and immediately after the judgment by reading the operative part. However, after specifying the form of order sought, the court shall, if necessary, grant the parties a period not exceeding 10 days for the lodging of defence notices and shall refer the case back to the hearing immediately following the expiry of the time-limit for discussion and delivery of the judgment. The court may also draw up and read, together with the operative part, the reasoning of the judgment, which is immediately lodged at the Registry. All necessary notifications and communications shall be provided ex officio. The acts of the trial and the decision are exempt from any tax and tax. With the judgment, the court may reject the opposition by charging the opposing party with the costs of the proceedings or upholding it, annulling the order in whole or in part or modifying it also limited to the amount of the penalty due. The second paragraph of Article 113 of the Code of Civil Procedure does not apply in opposition proceedings before the Justice of the Peace. The court shall uphold the opposition where there is insufficient evidence of the opposing party’s liability. The judgment is unappealable, but it is appealable on a point of law.’

⁴² **Note to Article 151:**

— The text of Article 10 of the Cooperation Treaty of 19 June 1970, ratified by Law No 260 of 26 May 1978 on ‘Ratification and enforcement of international patent acts signed in Strasbourg on 27 November 1963, in Washington on 19 June 1970, in Munich on 5 October 1973 and in Luxembourg on 15 December 1975’, and published in the Official Gazette No 156 of 7 June 1978, ordinary supplement, is as follows: ‘Article 10 (Receiving Office). — The international application must be lodged with the prescribed receiving office, which controls it and treats it in accordance with this Treaty and the implementing regulation.’

⁴³ **Note to Article 152:**

— For Law No 260 of 26 May 1978, see the footnote to Article 54.

⁴⁴ **Note to Article 153:**

— The texts of Articles 20 and 22 of the Cooperation Treaty of 19 June 1970, ratified by Law No 260 of 26 May 1978, is as follows: ‘Article 20 (Communication to designated offices). — 1-a) The international application, together with the international research report (including any indication provided for in Article 17.2-b) or the declaration referred to in Article 17.2-a), shall be communicated, in accordance with the Implementing Regulation, to any designated office which has not waived, in whole or in part, that communication. 2. If the claims have been amended in accordance with Article 19.1), the communication must contain both the full text of the claims in the primitive form and in the modified form and the full text of the claims in the primitive form and specify the modifications made; it must also, if necessary, contain the declaration referred to in Article 19.1). 3. At the request of the designated office or the depositor, the international search authority shall send them, in accordance with the implementing regulation, copies of the documents mentioned in the international search report.”

‘Article 22 (Copies, translations and fees for designated offices). — 1. The applicant shall hand over to each designated office a copy of the international application (unless the communication referred to in Article 20 has already taken place) and a translation (as required) of that application and pays to him (where appropriate) the national tax at the latest on the expiry of a period of twenty months from the priority date. Where the name of the inventor and the other particulars required by the legislation of the designated State are not required at the time of filing a national application, the depositor must, if they do not already appear in the request, communicate them to the national office of that State or to the office acting for him at the latest on the expiry of a period of twenty months from the date of priority. 2. Notwithstanding the provisions of paragraph (1), where the international search authority declares, in accordance with Article 17.2-a), that no international search report will be drawn up, the time limit for the performance of the acts referred to in paragraph 1 of this Article shall be two months from the date of service of that declaration to the depositor. 3. The legislation of any Contracting State may lay down, for the performance of the acts referred to in paragraphs (1) and (2), time limits which expire after those referred to in those paragraphs.’

⁴⁵ **Notes to Article 154:**

- For the text of Article 22 of the Cooperation Treaty of 19 June 1970, see the footnote to Article 153.
- The text of Article 23 of the Cooperation Treaty of 19 June 1970 is as follows: ‘Article 23 (Suspension of the national procedure). — 1. No designated office shall process or examine the international application before the expiry of the applicable period in accordance with Article 22. 2. Notwithstanding the provisions of paragraph 1. any designated office may, at the express request of the applicant, process or examine the international application at any time.’

⁴⁶ **Notes to Article 155:**

— The text of Article 4(1) of the Hague Agreement of 6 November 1925, ratified by Law No 744 of 24 October 1980, ‘Ratification and implementation of the Hague Agreement on the International Deposit of Industrial Designs of 6 November 1925, revised in London on 2 June 1934 and in The Hague on 28 November 1960, by Protocol and Implementing Regulation, as amended and supplemented by the supplementary act of Stockholm of 14 July 1967’, published in the Official Gazette of 12 November 1980, an ordinary supplement, is as follows: “Art. 4. — 1. The international deposit may be made to the International Bureau: 1) directly, or (2) by means of the national administration of a Contracting State if the legislation of that State so permits. 2. The national legislation of each Contracting State may require that any international deposit, for which that State is deemed to be the State of origin, be submitted by its national administration. Failure to comply with such a requirement shall not invalidate the effects of the international deposit in the Contracting States.’

⁴⁷ **Notes to Article 156:**

- Law No 169 of 12 March 1996 on the ratification and implementation of the Protocol relating to the Madrid Understanding concerning the international registration of trade marks, signed in Madrid on 27 June 1989, is published in Official Gazette No 76 of 30 March 1996, Ordinary Supplement.
- Law No 243 of 27 April 1982 on the International Classification of Goods and Services for the Purposes of the Registration of Marks signed at Geneva on 13 May 1977 on the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Geneva on 13 May 1977, is published in the Official Gazette No 130 of 13 May 1982.

⁴⁸ **Notes to Article 159:**

- Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark is published in the Official Journal of the European Community of 14 January 1994, No L 11.
- The text of Article 9-quinques of the Protocol relating to the Madrid Agreement, ratified by Law No 169 of 12 March 1996, published in the Official Gazette No 76 of 30 March 1996, Ordinary Supplement, is as follows: ‘Article 9-quinques (Transformation of an international registration into national or regional applications).
- Where the international registration is withdrawn at the request of the Office of Origin pursuant to Article 6.4, as regards all or part of the goods and services listed in that registration, the person who was the holder of the international registration shall lodge an application for registration of the same mark with the Office of one of the Contracting Parties on whose territory the international registration was valid, that application shall be treated as if it had been filed on the date of the international registration in accordance with Article 3.4 or on the date of registration of the territorial extension in accordance with Article 3-ter.2 and, if the international registration had priority, that application will benefit from the same priority, provided that: such an application is filed within three months of the date on which the international registration has been removed, (ii) the goods

and services listed in the application are effectively covered by the list of goods and services included in the international registration in respect of the Contracting Party concerned, and (iii) such an application complies with all the requirements of the applicable legislation, including those relating to taxes.’

⁴⁹ **Note to Article 170:**

— The text of Article 18 of Decree No 974 of the President of the Republic of 12 August 1975 laying down ‘Rules for the protection of new plant varieties, pursuant to the delegation referred to in Law No 722 of 16 July 1974’, published in Official Gazette No 109 of 26 April 1976, is as follows: Article 18. — For opinions to be given by the Ministry of Agriculture and Forestry in accordance with the provisions of this Decree, an advisory commission appointed by decree of the Minister for Agriculture and Forestry shall be set up by the Ministry of Agriculture and Forestry. The committee shall consist of: 1) by a section president of the Council of State, designated by the President of the Council of State, who presides over it; 2) the Director-General for Agricultural Production of the Ministry of Agriculture and Forestry; 3) the Director-General for the Protection of Agricultural Products of the Ministry of Agriculture and Forestry; 4) by the Director-General for Mountain Economy and Forestry of the Ministry of Agriculture and Forestry; 5. by the Director of the Conservative Institute of Registers of Varieties of Seeds; 6) by the Director of the Central Patent Office; 7) by a full professor of the Faculty of Agriculture of a University, appointed by the Minister for Public Education; 8) by the director of an experimental agricultural institute, designated by the Minister for Agriculture and Forestry; 9) by a technical examiner of the Central Patent Office; 10) by an official of the Ministry of Health. The members referred to in numbers (2) to (6) may be replaced by officials of their departments; for the members referred to in numbers 7 to 10) an alternate shall be provided for. On the basis of a decision motivated by the Chair, they may also be called upon to be members of the committee for the examination of individual issues, including experts with particular qualifications, not exceeding three. The duties of Secretary of the Committee shall be exercised by an official of the Ministry of Agriculture and Forestry, of career directive, of not less than Section Director. The commission lasts a three-year term and its members can be confirmed. In the event of no timely renewal, the commission will continue to function until the new appointment decision. The committee may, before giving its opinion, hear the persons concerned or their representatives who must in any event be convened when they have requested it.”

⁵⁰ **Notes to Article 171:**

- For Law No 424 of 28 April 1976, see the note in Article 3.
- For Law No 169 of 12 March 1996, see the footnote to Article 156.

⁵¹ **Notes to Article 173:**

- The text of Article 14 of the Patent Cooperation Treaty of 19 June 1970 is as follows: ‘Article 14 (Irregularity in the international application). 1-a) The receiving office shall ensure that the international application: is signed in accordance with the Implementing Regulation; contain the required data relating to the depositor; contains a title; contains an extract; fulfils, to the extent provided for in the Implementing Regulation, the formal requirements laid down. (b) If the receiving office finds that one of these requirements is not met, it shall invite the applicant to correct the international application within the prescribed period; if the applicant does not comply, this application shall be deemed to have been withdrawn and the receiving office shall declare it. 2. Where the international application refers to designs which are not attached to the application, the receiving office shall notify the applicant thereof, who may deliver those drawings within the prescribed period; the date of the international filing shall then be that of the day on which such drawings arrive at the receiving office. Otherwise, any reference to such designs shall be regarded as non-existent. If the receiving office finds that the fees required by Article 3.4-iv) have not been paid within the prescribed period or that the fee required by Article 4.2) has not been paid for any of the designated States, the international application shall be deemed to have been withdrawn and the receiving office shall declare it; if the receiving office finds that the fee required by Article 4.2) has been paid within the period prescribed for one or some designated States (but not for all), the designation of those between those States for which the charge has not been paid within the prescribed period shall be deemed to have been withdrawn and the receiving office shall declare it. 4. If, after recognising the international application as an international filing date, the receiving office finds, within the prescribed period, that any of the conditions listed in points (i) to (iii) of Article 11.1) was not satisfied on that date, that application shall be regarded as withdrawn and the office shall declare it.’

- For the text of Article 22 of the Patent Cooperation Treaty of 19 June 1970, see the footnote to Article 153.

⁵² **Note to Article 179:**

— For Law No 424 of 28 April 1976, see the note in Article 3.

⁵³ **Note to Article 188:**

— The text of Article 30 of the International Convention for the Protection of New Plants (UPOV), ratified by Law No 110 of 23 March 1998, is as follows: Article 30 (Application of the Convention). — 1. (Application measures). Each Contracting Party shall take all necessary measures for the implementation of this Convention, and in particular: 1) provide for the legal remedies of the case that make it possible to effectively defend the rights of breeder; establish a service responsible for conferring the rights of breeder or instructing the service established by another Contracting Party to grant such rights; ensure, by means of periodic publications, the communication to the public of information concerning: applications for breeder’s rights, as well as the rights of breeder conferred and names proposed and approved. 2. (Conformity of legislation). It is understood that at the time of deposit of its instrument of ratification, acceptance, approval or accession, each State or intergovernmental organisation shall be able, in accordance with its own legislation, to apply the provisions of this Convention.’

⁵⁴ **Note to Article 190:**

- Regulation (EEC) No 1768 of 18 June 1992 establishing a supplementary protection certificate for medicinal products shall be published in the Official Journal of the European Community of 2 July 1992, No L 182. Regulation (EC) No 1610 of 23 July 1996 is published in the Official Journal of the European Community of 8 August 1996.

⁵⁷**Note to Article 198:**

- The text of Article 262 of the Criminal Code is set out. ‘Article 262 (Revelation of news of which disclosure has been

prohibited). — Anyone who reveals information, of which the competent authority has prohibited disclosure, shall be punished by imprisonment of not less than three years. If the act is committed in time of war, or has compromised the war preparation or efficiency of the state or military operations, the penalty shall be of imprisonment of not less than ten years. If the culprit has acted for the purpose of political or military espionage, in the case provided for by the first part of this article, imprisonment of not less than 15 years shall apply; and, in the cases provided for in the first paragraph, the death penalty. The penalties laid down in the previous provisions also apply to those who obtain the news. If the act is committed by fault, the penalty is imprisonment of six months to two years, in the case provided for by the first part of this article, and from three to fifteen years if one of the circumstances referred to in the first paragraph applies.'

⁵⁸ *Paragraph repealed by Article 60 of Legislative Decree No 206 of 9 November 2007*

⁵⁹ **Note to Article 203:**

— The wording of Article 6(2) of Legislative Decree No 115 of 27 January 1992 on 'Implementation of Directive 89/48/EEC on a general system for the recognition of higher education diplomas sanctioning vocational training of a minimum duration of three years', published in the Official Gazette No 40 of 18 February 1992, is as follows: 2. Recognition shall be subject to passing an aptitude test if it concerns the professions of legal prosecutor, lawyer, accountant and industrial property consultant.'

⁶⁰ **Note to Article 206:**

— The wording of Article 200 of the Code of Criminal Procedure is as follows: 'Art. 200 (Professional Secretariat). — 1. They cannot be obliged to report on what they have known by reason of their ministry, office or profession, except in cases where they are obliged to report to the judicial authority: a) ministers of religious confessions, whose statutes do not conflict with the Italian legal system; lawyers, authorised private investigators, technical advisors and notaries; doctors and surgeons, pharmacists, midwives and any other health profession; D) the operators of other offices or professions to which the law recognises the right to abstain from depositing determined by professional secrecy. 2. If the court has reason to doubt that the statement made by those persons in order to refrain from giving evidence is unfounded, it shall make the necessary assessments. If it is unfounded, order the witness to testify. 3. The provisions laid down in paragraphs 1 and 2 shall apply to professional journalists registered in the professional register in respect of the names of the persons from whom they have had information of a fiduciary nature in the exercise of their profession. However, if the news is indispensable for the purpose of proving the crime for which it is proceeding and its veracity can only be ascertained by identifying the source of the news, the judge shall order the journalist to indicate the source of his information.'

⁶¹ **Note to Article 224:**

— For Law No 260 of 25 May 1973, see the footnote to Article 54.

⁶² **Note to Article 225:**

— For Law No 169 of 12 March 1996, see the footnote to Article 156.

⁶³ **Note to Article 231:**

— Legislative Decree No 480 of 4 December 1992 concerning 'Implementation of Council Directive 89/104/EEC of 21 December 1988 on the approximation of the laws of the Member States relating to trade marks' is published in Official Gazette No 295 of 16 December 1992, Ordinary Supplement.

⁶⁴ **Note to Article 232:**

— For Legislative Decree No 480 of 4 December 1992, see the footnote to Article 231.

⁶⁵ **Notes to Article 233:**

- For Legislative Decree No 480 of 4 December 1992, see the footnote to Article 231.

- Article 48 of Royal Decree No 929 of 21 June 1942, 'Text of Legislative Provisions on Registered Trade Marks', published in the Official Gazette No 203 of 29 August 1942, is as follows: 'Art. 48. — 1. The proprietor of an earlier trade mark within the meaning of Article 17(1)(d), (e), (g) and (h) and the proprietor of a pre-use right which amounts to a reputation which is not purely local, who have, for five consecutive years, tolerated, being aware of it, the use of an equal or similar later registered mark, shall not apply for the declaration of invalidity of the later mark or oppose the use of the later mark for goods or services in respect of which that mark was used on the basis of its earlier trade mark or its foreclosure, unless the later mark has been applied for in bad faith. The proprietor of the later mark may not oppose the use of the earlier mark or the continuation of the pre-use. 2. The foreclosure of the nullity action referred to in paragraph 1 shall also extend to third parties. 3. The provisions of paragraph 1 shall also apply to the case of a trade mark registered in breach of Article 18(1)(f) and Article 21.'

⁶⁶ **Note to Article 234:**

- For Legislative Decree No 480 of 4 December 1992, see the footnote to Article 231.

⁶⁷ **Note to Article 235:**

— For Legislative Decree No 480 of 4 December 1992, see the footnote to Article 231.

⁶⁸ **Note to Article 236:**

— For Legislative Decree No 480 of 4 December 1992, see the footnote to Article 231.

⁶⁹ **Note to Article 237:**

— Legislative Decree No 95 of 2 February 2001 concerning 'Implementation of Directive 98/71/EC on the legal protection of designs' is published in Official Gazette No 79 of 4 April 2001, Ordinary Supplement.

⁷⁰ **Notes to Article 238:**

- For Legislative Decree No 95 of 2 February 2001, see the footnote to Article 237.

- Decree No 641 of the President of the Republic of 26 October 1972 laying down the 'Regulation on Taxes on Government

Grants' is published in the Official Gazette No 292 of 11 November 1972, Ordinary Supplement No 3.

⁷¹ *Already amended by Article 19(6) of Law No 99 of 23 July 2009.*

⁷² **Note to Article 240:**

— For Legislative Decree No 95 of 2 February 2001, see the footnote to Article 237.

⁷³ **Note to Article 241:**

— Directive No 71 of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs is published in the Official Journal of the European Community of 28 October 1998 No L 189.

⁷⁴ **Notes to Article 242:**

- Decree No 974 of the President of the Republic of 12 August 1975 on 'Rules for the Protection of New Plant Varieties, implementing the delegation referred to in Law No 722 of 16 July 1974' is published in Official Gazette No 109 of 26 April 1976.

- Legislative Decree No 455 of 3 November 1998 laying down 'Rules for adapting to the requirements of the 1991 Act of Review of the International Convention for the Protection of New Plants' is published in Official Gazette No 303 of 30 December 1998.

⁷⁵ **Notes to Article 243:**

- The wording of Article 24-bis of Royal Decree No 1127 of 29 June 1939, 'Text of Legislative Provisions on Patents for Industrial Inventions', published in Official Gazette No 189 of 14 August 1939, is as follows: Article 24-bis. — 1. By way of derogation from Article 23 of this Decree and Article 34 of the Consolidated Text of the Provisions concerning the Statute of Civil Employees of the State of 10 January 1957, paragraph 3, where the employment relationship exists with a university or a public administration having among its institutional purposes research purposes, the researcher is the sole holder of the rights deriving from the patentable invention of which he is the author. In the case of several authors, employees of universities, public administrations or other public administrations, the rights deriving from the invention belong to all in equal parts, unless otherwise agreed. The inventor shall submit the patent application and notify the administration thereof. 2. Universities and public administrations, within the framework of their autonomy, shall determine the maximum amount of the fee, relating to licences to third parties for the use of the invention, payable to the same university or public administration, or to private research funders, as well as any further aspect of mutual relations. 3. In any case, the inventor is entitled to no less than 50 % of the proceeds or canons of exploitation of the invention. In the event that universities or public administrations do not make the determinations referred to in paragraph 2, they shall be responsible for 30 % of the proceeds or fees. 4. Five years after the date of issue of the patent, where the inventor or his successors have not commenced industrial exploitation, unless this arises from causes beyond their control, the public administration of which the inventor was employed at the time of the invention automatically acquires a free, non-exclusive right to exploit the invention and the related property rights, or to have them exploited by third parties, except for the right of the inventor to be recognised as an author.'

- Law No 383 of 18 October 2001 on 'First interventions to relaunch the economy' is published in the Official Gazette No 248 of 24 October 2001.

⁷⁶ **Notes to Article 245:**

- For Chapters I and IV of Title II and Title III of Legislative Decree No 5 of 17 January 2003, see the notes to Article 134.

- For the text of Articles 35 and 36 of Title V of Legislative Decree No 5 of 17 January 2003, see the footnote to Article 134.

⁷⁷ *Amended by Article 19(7)(a) of Law No 99 of 23 July 2009.*

⁷⁸ *Amended by Article 19(7)(b) of Law No 99 of 23 July 2009.*

⁷⁹ **Notes to Article 246:**

- The text of Article 3 of Decree-Law No 63 of 15 April 2002 (urgent financial and tax provisions on the collection, rationalisation of the system for the formation of the cost of pharmaceutical products, Community obligations and adjustments, securitisation, valorisation of assets and financing of infrastructure), converted into law, with amendments, by Article 1, Law No 112 of 15 June 2002, as amended by this Legislative Decree: Article 3 (Rationalisation of the cost system of pharmaceutical products). — 1. The selling price of medicinal products referred to in point (a) of Article 8(10) of Law No 537 of 24 December 1993, including those provided for in Ministerial Decree of 4 December 2001 of the Minister for Health published in Official Gazette No 33 of 8 February 2002, is reduced by 5 % excluding VAT until 31 December 2002. 2. The price reduction referred to in paragraph 1 shall not include extractive and recombinant blood-derived medicinal products as well as recombinant DNA medicinal products included in Annex 2 to the Ministerial Decree of 22 December 2000 of the Minister for Health published in the Ordinary Supplement to Official Gazette No 7 of 10 January 2001, and medicinal products whose selling price to the public is less than EUR five. 3. Pharmaceutical companies holding the marketing authorisation of medicinal products are allowed to organise or contribute to the realisation of conferences, conferences or meetings within the meaning of Article 12 of Legislative Decree No 541 of 30 December 1992, up to 50 % of those notified to the Ministry of Health in 2001 or authorised pursuant to paragraph 7 of Article 12 of Legislative Decree No 541 of 30 December 1992 for the years 2002 and 2003. 4. The expenditure of pharmaceutical companies for the organisation, participation and indirect financing of conferences, congresses, seminars or meetings referred to in paragraph 3 for 2002 and 2003 may not exceed fifty percent of the expenditure incurred and documented for the same purpose in 2001. 5. However, for newly established pharmaceutical companies the same expenses may not exceed 8 % of the annual turnover. 6. The percentage ratio between the total turnover of 2002 and the difference between the expenditure incurred by the individual pharmaceutical undertaking for the organisation, participation and financing, even indirectly, of conferences, congresses, seminars or meetings referred to in paragraph 3 for 2002 and the same expenditure relating to the year 2001, shall, as from 1 January 2003, result in the equal percentage reduction in the selling price of the medicinal products referred to in paragraph 1. 7. The organisation and participation in congresses, conferences or meetings exceeding the percentage referred to in paragraph 3 shall be excluded, except those already duly notified or authorised by the Minister of Health on the date of entry into force of this Decree. 8. (Repealed). 8-bis. (Repealed). 8-ter. (Repealed). 8-quaer. (Repealed). 9. With effect from 1 January 2003, the packaging of medicinal products, with the exception of those referred to in Article 3(1) of Legislative Decree No 539 of 30 December 1992, must include on the packaging and instructions and in the permitted forms of advertising, after the indication of the mark, the international classification symbol corresponding to the international common name 'anatomic-therapeutic-chemical' (ATC), followed by the corresponding chemical name of the product. The trade name — if any — must be printed

below the initials and of the chemical name in body equal to that of the chemical name; until stocks are exhausted, packaging bearing the only trade name may be sold only if packaged before 1 November 2002. 9-bis. The board of trade unions of healthcare companies and hospitals periodically informs the general manager of the company, the president of the region and the Ministry of Economy and Finance of any deviations in the expenditure made from the levels planned in the current accounting documents of public finance. The general manager of the company shall communicate the measures taken to ensure compliance with the planned expenditure limits. 9-ter.

- Law No 350 of 24 December 2003 (Provisions for the establishment of the State's annual and multiannual budget — Finance Law 2004), published in the Official Gazette No 299 of 27 December 2003, Ordinary Supplement.