



CAMERA DI
COMMERCIO
MILANO
MONZABRIANZA
LODI

Intellectual Property

«Where? What? How to file an IP right in Italy?»

Milano, 7th February 2019

Office of the Chamber of Commerce of Milano Monza Brianza Lodi.
Paola Callegari, Front Office Monza.

• Which IP rights you can file:

- Trademarks: National (UIBM), European (EUIPO) and International (WIPO).
- Design and models: National (UIBM), European (EUIPO) and International (WIPO).
- Patents: National (UIBM), European (EPO) and International (WIPO).

• What the Intellectual Property Office of the Chamber of Commerce manages:

- National and International trademarks.
- National design and models.
- National and International patents.
- European patents' translations
- Instances, transcriptions, annotations
- Certificates of registration of national trademarks and patents.

The Chamber of Commerce accepts registration applications only in **paper form**.

• How you can file IP rights:

Focus on National Trademark

WHAT:

All signs - graphically representable - suitable for distinguishing the products or services of a company from those of others, may constitute **company trademarks**: words (including personal names), designs, letters, digits, sounds, shape of the product or of its packaging, combinations or chromatic tones. The law requires that a sign can be validly registered as trademark in the case it is provided with: novelty, distinctive character, lawfulness.

• How you can file IP rights:

Focus on National Trademark

WHO:

Art. 19 of IPC states that "registration of company trademark can be obtained by those using it or propose to use it in manufacturing or trade of products or in the performance of services of own company or controlled companies or that use it with its consent".

It can either be a **natural person** or a **legal person**.

• How you can file IP rights:

Focus on National Trademark

HOW:

The registration application for a trademark must be made on **form** and filed at any Chamber of Commerce in **paper form**. Alternatively, the application can be filed online on the Italian Patent and Trademark Office's website (Ufficio Italiano Brevetti e Marchi - UIBM).

- **Costs:**

The costs for registering a trademark (first filing) depends on the number of identified classes:

1. Payments / Government licence taxes

Revenue stamp to be applied on the original form of registration application € 16.00

Payment to the Agenzia delle Entrate only through the use of the F24 form

In the case of individual trademark:

€ 101.00 registration fee inclusive of a class

€ 34.00 for each added class

2. Administration fees

Payment to the Chamber of Commerce where the filing is made € 40.00 or € 43.00 + one revenue stamp of € 16.00 (if a certified copy of the filing report is requested)

3. Letter of appointment (only if the registration application is made through an appointee) valid for filing one or more applications by a single applicant

Sheet of stamped paper € 16.00 or application on plain paper with revenue stamp of € 16.00

Government concession fee for letter of appointment € 34.00.

• What can you do after you filed a trademark:

Modifying it: before the UIBM grants the licence, the owner or their representative can correct in the **non-substantive aspects** the originally filed application.

Renew it: the TM can be **indefinitely** renewed every **10 years** by its owner or their representative.

Taking advantage of it: in the case of a **licensed TM**, the owner retains its property, but allows its use by other companies against payment of royalties.

Make trascriptions and annotations: transcription request in the case of changes in the ownership of IP rights and annotation request in the case of master data changes and waiver/limits.

- **What causes the extinction of a trademark:**

A trademark is extinguished for

- **missed renewal**
- **forfeiture** (due to external factors or non-compliance with legal provisions)
- **total waiver** (by explicit expression of the owner's will)

• What you need to know when you file a national trademark in the Chamber of Commerce:

- ☐ A national trademark grants protection **only** in that specific State's territory.
- ☐ It can be filed online (UIBM's website) or in the Chamber of Commerce.
- ☐ **Before** you register your trademark, you must:
 1. Classify your trademark: international classification system of trademarks (Nizza system for the classification of trademarks).
 2. Perform a priority search: check if it is not identical or similar to previously registered trademarks.

• Nizza system for the classification of trademarks:

- ☐ The registration of a national trademark is required and granted according to specific classes of the products/services of the **Nizza Classification**.
- ☐ **TMClass**: it is an online and free tool useful to help people to **identify the proper classes of products and services** for their trademarks.
- ☐ N.B. Identifying the class or classes for the registration of a trademark is a **complicated issue**. If you have any doubts, it is highly recommended to ask to a **consultant** enrolled in the Ordine dei Consulenti in Proprietà Industriale or a **lawyer** specialised in IP.

- **Priority searches:**

Before registering a trademark/patent, it is **always** better to verify:

For trademarks:

- If an identical or similar trademark has not been already registered.

For patents:

- The novelty of the invention, monitoring the state of the arts in that particular technological field.

• **How to conduct a priority search:**

- Public databases freely available online
- Private databases available online for a fee

 **The Intellectual Property Office is a PatLib Point, authorized to conduct priority searches only for:**

- Companies enrolled in the Chamber Of Commerce of Milano – Monza Brianza - Lodi
- Citizens living in the Provinces of the Chamber of Commerce of Milano – Monza Brianza - Lodi

• How you can file IP rights:

Focus on EU Trademark

- ☐ It is a trademark registered with **EUIPO** (European Union Intellectual Property Office), in compliance with the conditions established in the regulations on EUTMs.
- ☐ It is valid throughout the **EU territory** and in the case of enlargement of the EU it is automatically extended to the new member states.
- ☐ It must also meet **certain requirements** (art. 7 of EU Regulation no. 2015/2424) and it is provided with a **simplified registration procedure**.
- ☐ It is valid for **ten years** and can be **renewed indefinitely** for a further ten years.
- ☐ The registration application must be filed **online** (EUIPO) without the involvement of the Chamber of Commerce.
- ☐ All information necessary for the registration of a EUTM is available at the following address:
www.euipo.europa.eu

• How you can file IP rights:

Focus on International Trademark

- ☐ It allows to register the **same trademark** in one or more of the countries belonging to the **Madrid Union** (Madrid Agreement and Madrid Protocol).
- ☐ The protection of TMs in **states outside the Madrid Union** can be obtained through a **series of national registration applications in the states of interest** (according to their filing procedure, their language and their fees).
- ☐ The registration application for International TMs is managed by the **World Intellectual Property Organisation (WIPO)**.
- ☐ Before filing an International TM, it is essential to have **already registered an identical national trademark or EUTM**.
- ☐ The main advantage consists of the presentation of a **single international application**, in a **single language**, through the **payment of a single series of fees** and according to a **single series of deadlines**.
- ☐ If one or more states refuse its registration, this remains effective in the other designated states where there were no objections.
- ☐ The international registration is obtained by filing the TM on paper form **at the Chamber of Commerce** or online on the WIPO website.
- ☐ All information necessary for the registration of an International TM is available at the following address: <https://www.wipo.int/trademarks/en/>

• What priority means:

- ❑ Within **6 months** from the registration date of a trademark in one of the member states of the Paris Convention, the owner has the right to file the same registration application in one or more member states of the mentioned Convention **moving the date of the following filing back to the date of the first filing**. After that date, the trademark's extension is always possible but the priority cannot be claimed anymore.

DOMANDA DI REGISTRAZIONE PER MARCHIO D'IMPRESA

UIBM

Al Ministero dello Sviluppo Economico
DGLC-UIBM

N° _____

MARCA DA BOLLO

1. DATI IDENTIFICATIVI DELLA DOMANDA

1.1 TIPOLOGIA DEPOSITO Ordinaria, Divisionale, Comunitaria (O/D/C)* ☐Per tipologia Divisionale: N. domanda di riferimento divisione delle classi divisione di prodotti/servizi Per tipologia Comunitaria: N. domanda comunitaria Data domanda comunitaria 1.2 TIPO DI MARCHIO Individuale/Collettivo (I/C)* ☐1.3 NATURA DEL MARCHIO Denominativo (D)/Figurativo (F)* ☐1.4 RIFERIMENTO DEPOSITANTE 1.5 DENOMINAZIONE 1.6 DESCRIZIONE 1.7 COLORI RIVENDICATI Descrizione/Codice (D/C) ☐Descrizione Codice (Pantone/HREX/RAL/RGB) 1.8 NOTE

2. CLASSIFICAZIONE

CLASSE*	ELENCO DEI PRODOTTI O DEI SERVIZI*
<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>
<input type="text"/>	<input type="text"/>

* campi obbligatori. Per la Classificazione è obbligatorio indicare almeno una.

FIRMA DEL RICHIEDENTE

N° _____

3. PRIORITA' (solo se si intende rivendicare la data di deposito di una precedente domanda estera o di una esposizione)

Nazione/Ente	Tipo di priorità	Numero di domanda/Esposizione	Data della priorità

4. RICHIEDENTE**PERSONA FISICA**

Codice fiscale***

Cognome*

Comune e prov. di nascita

Comune e prov. di residenza**

Indirizzo**

Telefono

Email o CECPAC

Partecipazione ai diritti nella misura del % *

Nome*

Nazione di nascita

Nazione di residenza*

Civico**

CAP**

Fax

PEC

Codice fiscale***

Cognome*

Comune e prov. di nascita

Comune e prov. di residenza**

Indirizzo**

Telefono

Email o CECPAC

Partecipazione ai diritti nella misura del % *

Nome*

Nazione di nascita

Nazione di residenza*

Civico**

CAP**

Fax

PEC

PERSONA GIURIDICA

C.F. o P.IVA***

Tipo società*

Denominazione*

Comune e prov. sede/filiale**

Indirizzo**

Telefono

Email o CECPAC

Partecipazione ai diritti nella misura del % *

Nazione sede/filiale*

Civico**

CAP**

Fax

PEC

C.F. o P.IVA***

Tipo società*

Denominazione*

Comune e prov. sede/filiale**

Indirizzo**

Telefono

Email o CECPAC

Partecipazione ai diritti nella misura del % *

Nazione sede/filiale*

Civico**

CAP**

Fax

PEC

* Campi obbligatori.

** Da inserire obbligatoriamente per i richiedenti residenti o con sede legale in uno Stato dell'Unione europea

*** Da inserire obbligatoriamente per i richiedenti in possesso di codice fiscale o partita iva rilasciati da un Ente italiano

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CAMERA DI
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MONZABRIANZA
LODI

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N° _____

5. DOMICILIO ELETTIVO

c/o*			
Indirizzo*			Civico*
Comune e Provincia*			Cap*
Nazione*	Telefono*		Fax
Email o CECPAC*	PEC *		

6. DOCUMENTAZIONE ALLEGATA O CON RISERVA DI PRESENTAZIONE

Esemplare del marchio

Dettaglio specifico del marchio

Rappresentazione del marchio*

Regolamento marchi collettivi

Autorizzazione o atto di cessione

Documenti di priorità con traduzione in italiano

Domanda originaria con traduzione in lingua italiana

Domanda di conversione con traduzione in lingua italiana

Dichiarazione di conformità delle traduzioni al documento originale

N° fogli aggiuntivi per i seguenti paragrafi

1	2	3	4
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Richiesta copie autentiche (Sì/No)

Numero pagine totali

AL/RI/AS (*)	N. esemplari
AL	

(*) AL = Allegato

RI = Riserva

AS = Assente

* Campi obbligatori. Inserire almeno uno dei seguenti: Email, PEC, CECPAC.

FIRMA DEL RICHIEDENTE

VERBALE DI PRESENTAZIONE

Numero di domanda

CCIAA di

Sigla

In data

è stata e me presentata la domanda di cui sopra corredata da N°

fogli aggiuntivi

Annotazioni dell'Ufficiale rogante

Il depositante

Timbro
dell'Ufficio

L'Ufficiale rogante

• How you can file IP rights:

Focus on Patents

- ☐ The following may be subject to patent: **industrial inventions, utility models, new plant varieties.**
- ☐ **Inventions and utility models:** new inventions implying an inventive activity and capable of having an industrial application can be subject to patent. The right to a patent is held by the **author** of the invention/model or of its **assignees**. It is preferable to resort to patent protection as soon as all the information necessary to draft the relative application is available ("**first to file**"). The procedure for obtaining a patent is rather **complex**: it starts with the **priority search** and ends - if successful - with the issue of the **licence**, at the end of a series of verifications and examinations, both formal and substantial.
- ☐ The patent application must be made on the appropriate form and filed with any **Chamber of Commerce** or online on the **UIBM** website.
- ☐ The patents for an invention and for new plant varieties are protected against unauthorised use for a period of **20 years (10 years for utility models)** starting from the date of their filing but only as long as the **maintenance rights are duly paid** and, during this period, no request for invalidity or revocation is accepted.
- ☐ Patents are **territorial rights** and are only protected in those countries and in those regions, meaning the specific set of countries where they have been granted.
- ☐ The date of the first national filing of a patent is called the "**priority date**" and any further filing, forwarded to other countries as long as it is within the next **12 months** (within the "**priority period**"), will benefit from the same priority date with respect to any other filing that has been subsequently forwarded by others for the same invention. The priority claim must be made together with the filing application.
- ☐ The **European Patent**: <http://www.uibm.gov.it/index.php/brevetti/brevettare-all-estero/il-brevetto-europeo>
- ☐ The **International Patent (PCT)**: <http://www.uibm.gov.it/index.php/brevetti/brevettare-all-estero/il-brevetto-internazionale-pct>

• How you can file IP rights:

Focus on Designs and Models

- ❑ The **appearance of the entire product or part thereof** which, in particular, the features of the lines, the contours, the colours, the shape, the surface structure or the materials of the product itself or its ornamentation, may be **subject to registration as designs and models**, as long as they are **new and individual**.
- ❑ The **natural owner** of a design or model is its **creator**. It is, therefore, up to him to request the registration.
- ❑ Fill in the application form, together with the relative documentation, to request the registration of a design or model in Italy. The application can be submitted in **paper form** to any **Chamber of Commerce** or **online** on the UIBM website.
- ❑ The protection period of the design or model lasts **5 years** starting from the date of submission of the application and the owner can obtain the extension for one or more 5-year periods, up to a **maximum of 25 years**.
- ❑ Protection of the design or model has a **territorial nature**, namely it is only valid in the territory of the Country or region where it was made. Therefore, to protect the designs or models in countries in which the items to which they apply are sold, registration of the design or model must be requested in each of these countries.
- ❑ It is important to remember that for a **6-month period** from the date when registration was requested in the first country, it is possible to benefit from the "**right of priority**" to request registration in other countries. When this period expires, it will no longer be possible to request that registration in another country take effect from the date on which the first application was submitted.
- ❑ The **Community Design and Models**: <http://www.uibm.gov.it/index.php/disegni-e-modelli/registrare-all-estero/disegni-e-modelli-comunitari>
- ❑ The **International designs and models**: <http://www.uibm.gov.it/index.php/disegni-e-modelli/registrare-all-estero/disegni-e-modelli-internazionali>

• **The Specialised Assistance Office:**

- **Free guidance about IP rights** and the **most efficient ways to protect them** under several perspectives: national, european and international.
- Provided for companies and would-be entrepreneurs of the Provinces of the Chamber of Commerce of Milano – Monza Brianza – Lodi.
- **Individual** meetings: personalised assistance based on your own needs on IP matters.
- **Group** meetings: the main function is to acquire the basic knowledge about IP issues (trademarks, patents and other IP rights).

- **The Specialised Assistance Office: how it works**

- The user connects to the following Internet page:
<http://www.milomb.camcom.it/assistenza-specialistica-e-patlib>
- The user must choose to sign up to an **individual** meeting or a **group** meeting.
- The user books the **appointment** according to his/her preferences on the date and the location.

• **The Specialised Assistance Office: IP Firms**

- This service is provided by **Professional Firms** and **Consulting Firms** focused on Intellectual Property operating in Milano, Monza Brianza, Lodi.
- At least **5 years** of experience in the IP field on both national and international level.
- Presence of experts and consultants enrolled in the **Albo Consulenti Brevetti** and in the **Albo Consulenti Marchi**.

» **Contacts:**

For general informations

On the **filing** of trademarks and patents, costs and paper form:

- **Contact Center:** 800.22.63.72 (per chiamate da fuori provincia o cellulare: 02.85152000)
- **Front and Back office:**
 1. Via Meravigli 11/b, 20123 Milano from Monday to Friday from 9.00 to 12.00
 2. Piazza Cambiaghi 7, 20900 Monza from Monday to Friday from 9.00 to 12.00

For detailed informations:

info.marchiebrevetti@mi.camcom.it

For priority searches:

ricerca.marchiebrevetti@mi.camcom.it

<http://www.milomb.camcom.it/la-proprieta-intellettuale>