

Trademark Licence Agreement

It is advisable to conclude a licence agreement in writing. It is possible to license unregistered trademarks but the limited protection afforded by Italian Law to unregistered trademarks makes such licences only enforceable against third parties when the unregistered trademark has acquired the status of a 'well-known' trademark. According to relevant provisions of Italian Law a trademark can be licensed in respect to all or some of the goods/services for which it has been registered and with respect to the whole or part of Italy. In the event that a trademark, through the use by a licensee, becomes misleading as to the nature, quality or origin of the goods or services for which it is used, its registration may lapse or be cancelled. The sale of a registered trademark does not automatically terminate a licence agreement, unless otherwise agreed upon between the parties.

Recordal

There are statutory provisions for voluntary recordal of a licensee with the Italian Patent and Trademark Office (UIBM), but the licence becomes enforceable against third parties only upon recordal. There is no time frame for a recordal. A simple declaration, executed by the licensor and the licensee, which includes full details of the trademark application and/or registration, is sufficient. Such declaration must be registered with the competent fiscal authorities (the Italian Registry Office) before the recordal of the licence is applied for with the UIBM.

Effectiveness

The licence is enforceable against third parties as of the date of recordal in the UIBM's registry, which will coincide with the date on which the application for recordal is filed not with its publication date.

Infringement Proceedings

There is an evidentiary presumption that use by a licensee, whether recorded or not, is permitted use. According to Italian case law, the licensor and the exclusive licensee are allowed to institute infringement proceedings in their own names, unless the licence agreement precludes the licensee from doing so. The exclusive licensee may file an opposition in its own name before the UIBM, unless this is prevented by the licence agreement. If the licence agreement specifically entitles him to do so, the non-exclusive licensee may file infringement proceedings in addition to joining the trademark holder in infringement proceedings. The registered user will not be able to institute proceedings in his own name if the licence agreement does not allow him to do so or if the trademark owner refuses his request to do so. He may however sue the licensor for damages resulting from the licensor's failure to institute infringement proceedings.