Italy (IT)

Trademark Licence Agreement

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 assignment of a registered trademark does not automatically terminate a licence agreement, unless otherwise agreed upon between the parties.

Recordal

License agreements must be recorded with the Italian Patent and Trademark Office, the Ufficio Italiano Brevetti e Marchi, Ministero delle Imprese e del Made in Italy (UIBM) in order to be effective against third parties who in bona fide have lawfully acquired rights over the trademark. There is no deadline for filing 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. In the case of declaration attesting the grant of license, the declaration must indicate if it concerns an exclusive license or a non-exclusive license and if it covers all or only a part of the rights protected by the title licensed.
Such declarations must be registered with the competent fiscal authorities (the Italian Revenue Office) before the license recordal is filed to the UIBM.

Effectiveness

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

Infringement Proceedings

There is an evidentiary presumption that use by a licensee, whether recorded or not, is permitted use. According to new Article 122-bis of the Italian Industrial Property Rights Code, introduced by the new reformation of March 2019, the non-exclusive licensee is entitled to enforce infringement proceedings only with the consent of the owner of the trademark, whereas the exclusive licensee can enforce infringement proceedings also in absence of consent of the TM owner, provided that he has been in default, in case he does not activate himself within appropriate terms to protect the trademarks' rights. These provisions apply even in case the license agreement does not contain specific provisions for the exclusive licensee to be allowed to act for infringement; however, the statements of the license agreement are reserved. The exclusive licensee may file an opposition in its own name before the UIBM, unless this is prevented by the licence agreement. The licensee may however sue the licensor for damages resulting from the licensor's failure to Institute infringement proceedings.

The above-mentioned provisions also apply to the subjects authorized to use collective marks.

Latest update

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Barzano & Zanardo, Milan, Italy

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