

QUESTIONNAIRE ON REPLACEMENT

CONTRACTING PARTY

ITALY

I. APPLICABLE LEGISLATION

1. Are there provisions in your national¹ trademark legislation to implement Article 4*bis*(1) of the Madrid Agreement and/or of the Protocol?

- YES
- NO, because the Agreement/Protocol is of direct application
- NO, there are no such provisions, although the Agreement/Protocol is not of direct application

2. Are there provisions in your national trademark legislation to implement Article 4*bis*(2) of the Madrid Agreement and/or of the Protocol?

- YES
- NO, because the Agreement/Protocol is of direct application
- NO, there are no such provisions, although the Agreement/Protocol is not of direct application
- NO, but there is a procedure

If NO, but there is a procedure, this procedure:

- Consists of Office practice
- Is prescribed by Administrative Guidelines of Office
- Other

If Other, please specify:

¹ Please note that the reference to “national” is intended to include also, where relevant, “regional”.

3. If your Office does have in place a procedure for 'taking note' of an international registration in accordance with Article 4*bis*(2) of the Madrid Agreement and/or of the Protocol, do you require:

- Use of a specific form
- Payment of a fee
- Extract of the International Register
- Other

If Other, please specify:

The Italian Office requires only that the application by the holders, or his representative, includes a revenue stamp. No other fee has to be paid.

4. Are there provisions in your national trademark legislation to implement Rule 21 of the Common Regulations?

- YES
- NO, because the Regulations are of direct application
- NO, there are no such provisions, although the Regulations are not of direct application
- NO, but there is a procedure

If NO, but there is a procedure, this procedure:

- Consists of Office practice
- Is prescribed by Administrative Guidelines of Office
- Other

If Other, please specify:

II. EXPERIENCE OF THE OFFICE

1. Has your Office, in fact, had occasion, on request, to take note of an international registration in accordance with Article 4*bis*(2) of the Madrid Agreement and/or of the Protocol?

- NO
- YES, but no more than 5 such requests
- YES, between 5 and 20 such requests
- YES, between 21 and 100 such requests
- YES, more than 100 such requests

2. Does your Office operate an *ex officio* procedure for ‘taking note’ of an international registration – i.e., irrespective of the filing of a request to take note?

- NO
- YES

If YES, how many cases have there been?

- None, so far
- No more than 5
- Between 5 and 20
- Between 21 and 100
- More than 100

III. OFFICE PRACTICE OR ASSUMED OFFICE PRACTICE

1. Assuming that your Office is presented with a request to take note of an international registration, on which criteria does it, or would it, carry out an examination to assess whether replacement should take place?

- The protection resulting from the international registration extends to the territory of your country/region
- The national and international marks are in the name of the same holder
- All the goods and services listed in the national registration are also listed in the international registration, in respect of the territory of your country/region
- The extension of the international registration to the territory of your country/region takes effect after the date of the national registration
- Other

If Other, please specify:

- There would be no examination

2. If it occurs that the goods and services listed in the national registration are *not* all listed in the international registration, i.e., the list of goods and services in the international registration is narrower than the list recorded nationally, does, or would, your Office nevertheless consider that a partial replacement takes place in respect of the specification that is common to both the national and international registrations?

- NO, replacement would not take place
- YES, with the remainder of the specification remaining unaffected in the national register
- YES, but the Office would *ex officio* cancel the remainder of the specification in the national register
- YES, but the holder would be required to request cancellation of the remainder of the specification in the national register

3. At what time does, or would, your Office consider that replacement takes place?

- On the date of international registration or subsequent designation
- On the date of expiry of the refusal period
- In the event that your Office issues statements of grant of protection, on the date of issuing of statement of grant of protection
- Other

If Other, please specify:

4. If your Office considers, or would, consider that replacement takes place either on the date of expiry of the refusal period, or of issuing of a statement of grant of protection, is the effect of replacement considered to be retroactive to the date of the international registration or subsequent designation in question?

- YES
- NO

5. When does, or would, your Office accept the filing of a request to take note under Article 4*bis*(2)?

- After the date of notification by the International Bureau of the international registration or subsequent designation in question
- Only from the date of expiry of the refusal period
- In the event that your Office issues statements of grant of protection, only after the date of issuing of statement of grant of protection
- Other

If Other, please specify:

6. (redrafted on June 23, 2008)

(a) In case it has been requested to take note, under Article 4*bis*(2), of the international registration, does your Office permit the coexistence of the national registration and the international registration that has replaced it?

YES

YES, but only for the remainder of the current term of protection of the national registration (i.e., the national registration may not be renewed)

NO, the Office *ex officio* cancels the national registration

NO, the holder needs to renounce the national registration

(b) In case your Office has not been requested to take note, under Article 4*bis*(2), of the international registration, but is nevertheless aware that the conditions under Article 4*bis*(1) are met, does it permit the coexistence of the national registration and the international registration that has replaced it?

YES

YES, but only for the remainder of the current term of protection of the national registration (i.e., the national registration may not be renewed)

NO, the Office *ex officio* cancels the national registration

NO, the holder needs to renounce the national registration

7. If your Office does not, or would not, permit coexistence of a national registration and the international registration that has replaced it, does, or would, your Office nevertheless permit reinstatement of the national registration should the international registration cease to have effect within the five-year dependency period (Article 6 of the Agreement and/or the Protocol)?

YES

NO

8. **(For Offices of Members of the Protocol)** Article 4*bis* of the Agreement and of the Protocol provides that an international registration is deemed to replace a national registration without prejudice to any rights acquired by virtue of the latter. Thus, for example, replacement may include the benefit of a priority claim attached to the national registration.

Assume that replacement, under Article 4*bis*(1) of the Protocol, has taken place and has included certain such rights acquired by virtue of the national registration, but subsequently there has been recorded a ceasing of effect due to failure of the basic mark within the five-year dependency period in accordance with Article 6 of the Protocol. Assume also that in such case, the holder wishes to exercise his rights, under Article 9*quinquies* of the Protocol, to transform the international registration into national application.

In your Office, does, or would, such transformation carry the benefit of those earlier national rights, such as, for example, a priority date?

YES

NO

IV. MISCELLANEOUS

1. (redrafted on June 23, 2008)

Where the conditions under Article 4*bis*(1) are met and, in addition, the national mark has lapsed, is reliance on any rights acquired by virtue of the national registration permitted in legal and administrative proceedings?

YES, even if the international registration has not been noted in the national register

YES, but only if the international registration has been noted in the national register

NO

Do not know

2. The International Bureau has made available model provisions with regard to the replacement procedure (see www.wipo.int/madrid/en/contracting_parties). Have you found the model provisions to be of assistance?

YES

NO

Do not know