

The **i**NTERPATENT newsletter



APRIL 2025

LET'S MEET IN SAN DIEGO!

We are delighted to announce that **Manuela Bruscolini and Maria Cristina Goicoechea will represent INTERPATENT at the upcoming Annual Meeting of INTA in San Diego from 17 to 21 May 2025.**

As we all know, the INTA Annual Meeting is a unique opportunity to connect with the most influential brand professionals and industries from across the globe.

This 147th Annual Meeting will be held in sunny San Diego, California, and it is expecting to see the participation of more than 10,000 colleagues from around the world, by far the largest gathering in the IP sector.

The theme of this year's Annual Meeting is "The Business of IP," which highlights the pivotal role that intellectual property plays in driving innovation and business success.

On the course of the week **Manuela and Maria Cristina will each moderate a table topic** at lunchtime.

Manuela will speak about slogans, namely:

- IMPOSSIBLE IS NOTHING®, JUST DO IT®, but is it

really so when it comes to trademark registration? How to efficiently protect slogans as trademarks in the EU and in non-EU jurisdictions

- Date: Sunday, 18 May: Lunch
- Time: 1:00 pm to 3:00 pm (PST)

Maria Cristina's table topic will be wine and IP:

- Let's talk about wines and IP: some of the most interesting cases in the last years all over the world
- Date: Monday, 19 May: Lunch
- Time: 1:00 pm to 3:00 pm (PST)

They will be happy to discuss these and other most recent developments in Intellectual Property in Italy and in Europe as well as explore ways to build or consolidate cooperation with colleagues and associates from all over the world and very much look forward to connecting with old and new IP friends.

For a possible meeting please contact Manuela at m.bruscolini@interpatent.com and Maria Cristina at c.goicoechea@interpatent.com.

In the meantime, safe travels to you all!

ITALY CELEBRATED ITS SECOND NATIONAL 'MADE IN ITALY DAY' ON 15 APRIL, HONORING LEONARDO DA VINCI



On 15 April, Italy marked the second edition of the National **Made in Italy Day**, an initiative dedicated to celebrating and promoting the country's world-renowned craftsmanship, products, and cultural heritage.

The date was deliberately chosen to coincide with the birth anniversary of **Leonardo da Vinci**, born on 15 April 1452 - a symbol of Italian creativity and excellence.

The celebration is part of a broader framework established by the **Made in Italy Framework Law**, which came into effect in January 2024. The legislation is designed to strengthen and promote Italian excellence on both national and international stages, offering economic incentives and policy support for businesses - Italian and foreign - that invest in Italy's strategic sectors.

Support for Strategic Industries and Innovation

One of the cornerstones of the new law is the creation of the **National Made in Italy Fund**, aimed at supporting the growth and revitalization of key national industries such as food, craftsmanship, textiles, fashion, nautical production, and ceramics. It also targets specific supply chains like furniture-grade wood, virgin olive oil, and natural textile fibers, starting from raw material procurement.

The law also introduces targeted initiatives for **female entrepreneurship**, alongside new programs in education and culture, to nurture future generations of Italian innovators and artisans.

Intellectual Property Takes Center Stage

A significant focus of the new law is the **protection of intellectual property (IP)** - an area seen as vital to defending Italy's creative and commercial identity. The law lays out a series of initiatives to encourage the **registration and safeguarding of trademarks, patents, domain names, and geographical indications**:

- **Trademarks:**

- Promotion and protection of trademarks considered of special national interest and value

One of the most notable measures focuses on trademarks deemed to have **"special national interest and value"**. Italian companies that own or have continuously used a trademark for at least 50 years must notify the Ministry of Enterprises and Made in Italy if they plan to cease operations permanently.

To preserve trademarks historically tied to Italy's productive identity, the Ministry may acquire ownership of such trademarks free of charge, unless they have already been sold.

The Ministry may also apply to register trademarks that have been inactive for at least five years and make them available to Italian or foreign companies willing to invest in Italy, including those relocating their production activities to the country.

- Encouragement for cultural institutions to register their trademarks

Cultural institutions and heritage sites are now allowed to register their trademarks under Article 19(3) of the Italian Industrial Property Code and may license them to third parties for a fee. The proceeds will go to the state to support cultural heritage preservation.

- **Patents:**

- Introduction of **"3I Vouchers"** (Investigation of Industrial Innovation) to support patent consultancy services

- **Domain Names:**

- Measures to enhance protection of **".it" domain names** associated with cultural institutions and heritage sites

- **Geographical Indications (GIs) and Traditional Food Products:**
 - Establishment of a dedicated fund to **protect Italian GIs abroad**

The newly created **Foreign Protection Fund for Italian Geographical Indications** is specifically aimed at safeguarding agricultural products, food, wine, and spirits registered under EU Regulations (Nos. 1151/2012, 1308/2013, and 2019/787), and produced by businesses with headquarters and operations in Italy.

The fund supports activities related to industrial property rights, including:

- **Registration of GIs abroad**, or trademarks where GI protections are not recognized, covering both new filings and renewals, as well as applicable local fees;
- **Opposition procedures** against IP filings abroad that may infringe Italian GIs, especially when filed by entities other than authorized consortia;
- **Registration and reassignment of domain names** associated with Italian GIs, particularly those that have been abusively registered or used.

Strengthened Anti-Counterfeiting Measures

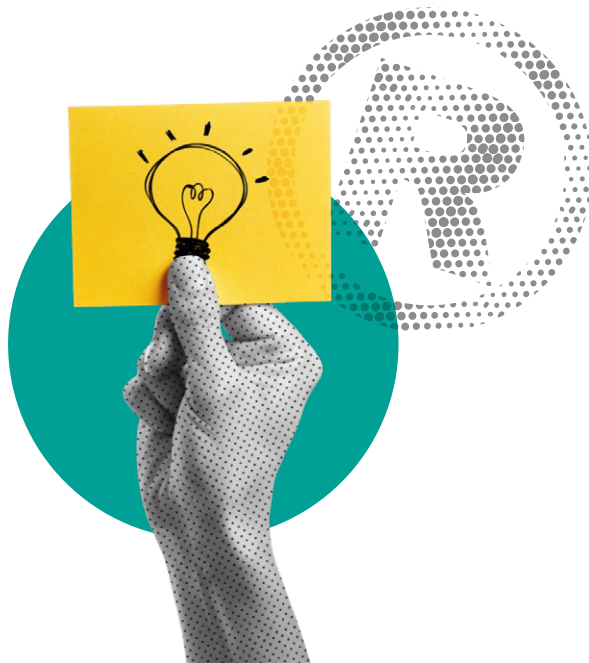
The new legislation revises and strengthens Italy's anti-counterfeiting framework by:

- Increasing administrative penalties for the purchase or import of counterfeit goods;
- Expanding criminal sanctions for the sale of industrial products bearing false trademarks;
- Enhancing rules for the destruction of seized counterfeit items;
- Providing specialized training for judges and court personnel on intellectual property violations.

As global interest in Made in Italy products continues to rise, navigating the legal and regulatory frameworks - especially regarding intellectual property - has never been more important.

Businesses and institutions are strongly encouraged to consult with specialized intellectual property advisors in Italy to ensure their innovations, brands, and heritage are fully protected and strategically positioned for long-term success.

GRACE PERIOD IN DESIGN RIGHTS: THE GENERAL COURT OF THE EUROPEAN UNION CLARIFIES THE ISSUE



The **grace period** in design law is a fundamental principle that allows designers to test their products on the market before proceeding to official registration. Recently, the General Court of the European Union provided important clarifications on the application of this principle, in particular with regard to the relationship between the disclosed design and the subsequently registered one.

The Regulatory Framework

Article 7(2) of [Regulation \(EC\) No. 6/2002](#) stipulates that the disclosure of a design by its creator or successors in title during the 12 months preceding the application for registration shall not affect the assessment of novelty and individual character of the design.

This mechanism allows design creators to verify the commercial success of their designs before investing in registration thereof.

The Court's Decision and Its Implications

In Case **T-66/24**, the General Court dealt with a registered community design owned by Liquidleds Lighting Corp. (defendant) for **LED light bulbs**, which was challenged for lack of novelty and individual character by Lidl Vertriebs GmbH & Co. KG (appellant). The appellant maintained that the earlier design, disclosed prior to its registration, should be taken into account when assessing the validity of the registered design.

The Court clarified that:

- **absolute identity** between the disclosed design and the registered design **is not required** for the grace period to apply;
- **changes made to the design** during the grace period are lawful as long as the final design retains the **same overall impression** as the initially disclosed design;
- the grace period protects innovation by allowing designers to adapt their products according to market feedback without losing legal protection.

Allocation of the Burden of Proof

Another relevant aspect of the judgment concerns the allocation of the burden of proof. In this regard, the Court ruled that:

- the design owner must prove that the

disclosure falls within the grace period (i.e., that the exception set forth in the aforementioned Article 7(2) of Regulation (EC) No. 6/2002 applies);

- the invalidity claimant may contest the application of the above provision, but does not have the burden to rebut such application.

Conclusions

This decision represents a significant step in the protection of designers' rights, confirming that **the grace period is not limited to identical designs, but also extends to designs that undergo modifications as long as they maintain the same overall impression**. Furthermore, the ruling strengthens the possibility for designers to test their products on the market without compromising legal protection.

The Court's approach strikes a balance between the need to protect innovation and transparency in the Community design system, offering greater legal certainty to professionals in the design sector.

It is also noted that the Court's interpretation is entirely in line with the forthcoming new EU Design Regulation (**2024/2822**) - part of which will enter into force on 1 May 2025 - which explicitly addresses the self-disclosure of the earlier design that 'is identical or does not differ in its overall impression from the design for which protection is claimed under a registered EU design'. This regulatory consistency helps to ensure a stable and uniform legal framework, which will remain relevant even when the new regulation comes into force.

TRANSFORMING A EUROPEAN PATENT INTO A UTILITY MODEL APPLICATION IN ITALY: A SOMETIMES NEGLECTED BUT USEFUL POSSIBILITY

Article 58(2) of the Italian IP Code provides for the possibility for European patent applications that have been rejected, withdrawn or deemed to be withdrawn or revoked European patents to be **transformed** into corresponding Italian utility

model applications before the Italian Patent and Trademark Office.

This is an option not to be overlooked, as it allows owners of European applications and patents to

safeguard their industrial property rights in Italy even in the event of difficulties in the European patent process.

On this topic, we draw your attention to the **recent judgement** No. 31995 of 11/12/2024 **by the Italian Court of Cassation**, which was originally called upon to rule on the legitimacy of an appeal judgment concerning the **validity and infringement of a European patent validated in Italy**.

In the course of the proceedings, however, the European patent was **revoked** by the European Patent Office and **converted into a utility model in Italy**.

In view of this change in the legal context, the Court ruled that the **validity and infringement of the utility model** did not form part of the subject

matter of the pending proceedings, but had **to be assessed in separate proceedings**, and therefore repealed the appeal judgement without remand to the Court of Appeal.

This ruling represents an important case law precedent, with **possible consequences on industrial property protection strategies** in Italy and Europe.



UNWORKED PATENTS: POSSIBLE STRATEGIES TO CAPITALISE THEM

Intellectual Property indisputably is a key to business success.

In the specific case of patents, a company with a patent portfolio will be able to exploit it to exclusively implement their patented technologies, thus preventing competitors from manufacturing products or using processes covered thereby.

Although the need to preserve their competitive advantage is often the main reason why companies seek patent protection, they should bear in mind that **the value of patents is not limited to the mere exclusion of competitors**.

What happens where a company – perhaps because of a change of strategy or the difficulty in finding the necessary resources – does not make use of a technology for which they own a patent?

How else can a company valorise their own patents and profit therefrom without risking wasting the investment incurred to obtain them?

There are **several alternative strategies to turn a patent - even if unworked - into a profitable asset** that can actively contribute to company growth and competitiveness: from licensing to third parties, which allows to monetise the innovation without

having to develop it directly, to the assignment of the patent itself, up to the use of exclusive rights as leverage for strategic negotiations or to attract investors interested in promising technologies.

Patent Licensing

Licensing a patent is an effective strategy to obtain an economic return without having to develop the patented technology directly. This approach makes it possible to broaden the dissemination of innovation, build strategic partnerships and generate a continuous revenue stream without having to deal directly with production or commercialisation.

When drafting a license agreement, special attention must be paid to the following aspects:

- royalties and corresponding modes of payment,
- territory to which the licence to use the patent is limited,
- period of validity of the licence,
- exclusivity/non-exclusivity of the licence,
- licensee's obligations (e.g. production and quality standards),
- burden of defending the patent (i.e. who is responsible for defending the patent in case of litigation over possible patent infringements).

Patent Selling

If a company decides not to develop the patented technology, selling the patent is an option to monetise the initial investment. By selling the rights of ownership to another company or investor, an immediate gain can be obtained and resources can be freed up for new ventures. The sale can be advantageous especially when the patent is particularly innovative or in demand on the market, attracting companies interested in achieving a competitive advantage.

Leverage for Strategic Negotiations

A patent can be used as an instrument in business negotiations. Companies can use it to obtain favourable terms in collaboration agreements, joint ventures or mergers, exploiting the value of technological exclusivity. A strong patent can become a strategic asset that increases negotiating power, allowing access to new opportunities for growth or consolidation in the relevant sector.

Attracting Investors

Investors are often interested in innovative technologies with market potential. A patent can be a pivotal element in attracting funding and partnerships. Indeed, intellectual property is an intangible asset that increases the value of the company, gives it credibility and reduces the perceived risk for investors, making the company more attractive to venture capitalists, investment funds and large corporations looking for new investment opportunities or technology solutions to develop.

Last but not least, a patent portfolio also acts as an attractor for qualified and talented employees, as it demonstrates a company's strong commitment to innovation and long-term growth, and the presence

of qualified employees in turn encourages the development of new ideas and solutions, triggering a virtuous circle that benefits the company's competitiveness.

How Can We Help?

For individuals and companies whose IP portfolio includes unworked patents, our firm can provide support to try to seize the opportunities outlined above through a targeted and structured path.

First, we can take care of the **search for potentially interested parties**, identifying companies, investors or strategic partners that could benefit from using or purchasing the patented technology. Using our tools for analysing the patent landscape, we identify qualified interlocutors. Moreover, we can also assist clients in preparing an effective contact plan.

Once we have identified potential licensees or purchasers, we can support clients in **drafting a clear and persuasive presentation letter** aimed at presenting the company and communicating the value of the patent and the opportunities it may offer. This document is designed to generate interest and initiate concrete negotiations, highlighting the technical, commercial and strategic aspects of the patented technology.

As a result of the interest shown by the parties, we can assist in **drafting assignment or licence agreements**, ensuring that the terms are advantageous and comply with the applicable national or international regulations. We precisely define key elements such as fees, territories of application, duration of the contract and protection clauses, ensuring clients a solid and beneficial agreement.

For any information or assistance, please contact us at email@interpatent.com.

The aim of this newsletter is to keep our Clients and Associates updated about developments in the sector of Intellectual Property in general and our firm in particular. In this way, we wish to provide a broader view of the tools that the field of trade marks, domain names, patents, designs and related rights offers to entrepreneurs to enhance and protect their efforts in researching and developing new solutions and ideas.



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