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A “new” category of marks: historic

Erica Vaccarello (De Simone & Partners S.P.A.) · Tuesday, September 24th, 2019

The so called “growth decree” (decree-law no. 34/2019, amended by the Italian Parliament as law 58/2019 in June 2019) has introduced a new category of marks in Italy: “historic marks” defined as those marks registered or used continuously for a period of at least 50 years to market products or services “made by an Italian manufacturing company of excellence, which are historically connected to the Italian territory”.

This broad definition leaves itself somewhat open to interpretation, specifically with respect to the concepts of “company of excellence” and “connection” to the Italian territory, as well as a continuous period of 50 years.

Historic marks are entitled to inclusion in the special register of “historic marks of national interest” at the request of either the trademark owner or its exclusive licensee. No indications are provided in the event of disagreement between the two. Moreover, the provisions do not sufficiently make for the possibility to keep checking the conditions for maintaining the registrations or possibly revoking them.

Once a mark has been included in the registry, a special logo (the “logo of historic marks of national interest”) can be applied to products or services concerned for promotional and advertising purposes. This may turn out to be an interesting opportunity for brand owners, at least in theory. Although we’ll have to wait and see the criteria for use of the logo, which has yet to be announced.

Curiously, historic marks carry a major disclosure burden which represents a considerable part of this new regulation. More specifically, a trademark owner intending to close its “original or main production site” (which has to be said is a rather vague concept), due to “the cessation of the activity or delocalisation outside of Italy” (even if it remains within the EU), must notify the Ministry of Economic Development, “without delay”, under penalty of a fine of up to Euro 50,000. At this point, the Ministry would initiate a procedure for participation, “on market terms”, in the risk capital of the company (essentially a nationalisation process), drawing resources from a specially created fund.

The disclosure obligations and related sanctions apply to all marks falling within the definition of “historic marks”, regardless of whether they have been included in the special register.

Trademark law is apparently being used as a possible tool to discourage relocation outside of Italy of manufacturing sites of valuable Italian companies and thus avoid any consequential job losses. The impact of the new provisions has yet to be seen and will also depend on the Ministry's follow-up and its implementation decree.

In the meantime, one cannot help but wonder if trademark law is the appropriate tool for fulfilling this economic goal. Instead of favouring growth, the burdens and possible sanctions arising from the ownership of historic marks could even become a deterrent to the stipulation of transfer/licensing agreements concerning such marks and may even hinder future investment. Perhaps more economic and/or status incentives could have been introduced in favor of ownership of historic marks; for example, the introduction of a presumption of reputation of their brand or a waiver from the necessity to provide evidence of its notoriety.

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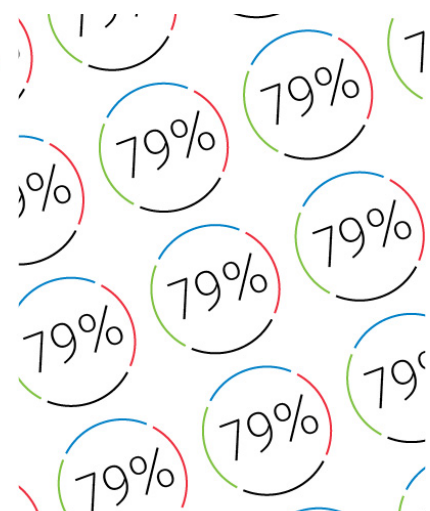
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