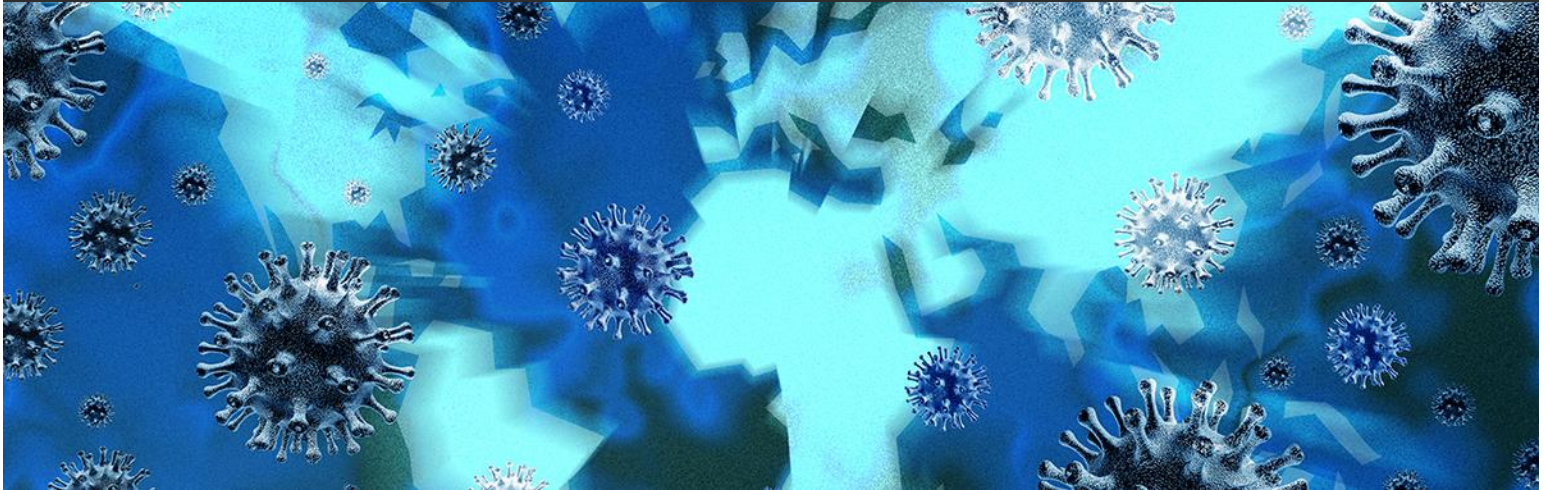


## **Alert** | Health Emergency Preparedness Task Force: Coronavirus Disease 2019 – Focus on Italy



15 April 2020

### **Italian Law and Coronavirus Disease 2019: Update on IP Legislation**

Italy has seen a further suspension of intellectual property (IP)-related administrative and judicial proceedings, as well as an extension of relevant deadlines, due to the ongoing Coronavirus Disease 2019 (COVID-19) pandemic.

#### **1. Extension of Deadlines before UIBM**

The Italian Patent and Trademark Office (“UIBM”) issued a Directorial Decree dated March 11, 2020, providing that official deadlines falling within March 9 and April 3, 2020, were automatically suspended. However, such suspension applied neither to the mandatory deadlines concerning opposition procedures nor to the deadlines related to proceedings before the Board of Appeal.

Subsequently, with two additional new decrees, Italian Law Decree no. 18 dated March 17, 2020 (“*Decreto Cura Italia*”) and Italian Law Decree no. 23 dated April 8, 2020 (“*Decreto Liquidità*”), the Italian Government further extended the above-referenced suspensions. More specifically, pursuant to the combined reading of such Decrees (art. 103 of *Decreto Cura Italia* and art. 37 of *Decreto Liquidità*), all deadlines – including the mandatory ones – related to all administrative proceedings pending before the UIBM for the period between February 23, 2020, and May 15, 2020, have been suspended. As such, the stay currently applies to the mandatory deadlines concerning the opposition procedures, but not to the proceedings before the Board of Appeal. Unless an additional provision of such nature and content is issued, all terms will start to run again after May 15, 2020.

Furthermore, all certificates, permissions and other authorizations expiring between January 31 and May 15, 2020, shall remain valid until June 15, 2020.

## **2. Extension of Deadlines before EPO**

The European Patent Office (EPO) has postponed until further notice all oral proceedings in examination and opposition proceedings scheduled until April 30, 2020 (previously until April 17, 2020), unless those hearings were previously arranged via videoconferencing.

No oral proceedings will be held on the premises of the Boards of Appeal until April 30, 2020.

## **3. Extension of Deadlines before EUIPO**

By means of Decision No. EX-20-3, the European Union Intellectual Property Office (EUIPO) extended all deadlines – that affect parties in proceedings before the Office – expiring between March 9, 2020 and April 30, 2020, to May 1, 2020 (in practice, to May 4, since May 1 is bank holiday, followed by a weekend).

This extension includes all procedural deadlines in relation to trademark and design matters, covering both the time limits set by the Office (in any proceeding before EUIPO, including the Board of Appeal) and the time limits statutory in nature (imposed directly by the Regulations).

EUIPO clarified that the time limits related to proceedings before other Authorities, even if mentioned in the Regulations (such as actions before the General Court against decisions of the Boards of Appeal), are not covered by this extension.

As specified by EUIPO, the suspension applies automatically; accordingly, the affected parties are not required to file an extension request with the Office and will not receive an individual communication about the grant of the extension.

## **4. Extension of Deadlines before WIPO**

The World Intellectual Property Organization (WIPO) has announced that access to postal delivery services and electronic communications may be severely restricted, and that the limitations caused by the health emergency (temporary cessation of business, quarantine, self-isolation) could lead to non-compliance with WIPO deadlines.

In this regard, users of the Madrid system and of The Hague system failing to comply with mandatory deadlines for a communication addressed to the International Bureau of WIPO could remedy the failure by sending a communication within five days of regaining access to postal or delivery services, or to electronic communications, providing evidence that the delay had been due to the pandemic. Such evidence could be an official communication, an official announcement, or a certificate from a licensed medical practitioner.

Documentation necessary to benefit from such remedy (including evidence) must be received by the International Bureau no later than six months after the relevant deadline.

WIPO has also suspended some services until further notice, such as the issuance of certified extracts, the notarization of documents and the accelerated services.

## 5. Extension of Deadlines before Italian Courts

Pursuant to Law Decree no. 18/2020, as amended by Law Decree no. 23/2020, all civil and criminal hearings – therefore, including IP cases - scheduled before Italian Courts between March 9 and May 11, 2020, are postponed *ex officio* to a date after May 11, 2020. For the subsequent period and up to June 30, 2020, judicial authorities may take further measures, such as holding hearings remotely (by means of videoconferencing); substituting the hearings with the filing of additional briefs; postponing the hearings to a date after June 30, 2020.

In addition, the Italian Government has stated that all deadlines related to civil and criminal proceedings shall be suspended. This means that the period between March 9 and May 11, 2020, will not be calculated in the time available for defense, and terms will begin to run again beginning May 12, 2020, unless another Law Decree of similar nature and content provides for a further suspension. The stay of deadlines applies also to the filing of new actions and to appeals.

The suspension does not concern “*any proceedings whose delay may seriously harm the parties*”. In such a case, the Court – upon request of the interested party – will declare the urgency of the proceedings by issuing a decree (on the introductory pleading) or an order (if the proceeding is already pending), which will be considered irrevocable.

\* *This GT Alert is limited to non-U.S. matters and law.*

For more information and updates on the developing COVID-19 situation, visit [GT's Health Emergency Preparedness Task Force: Coronavirus Disease 2019](#).

## Authors

This GT Alert was prepared by:

- [Luigi Fontanesi](#) | + (39) 02.771971 | [luigi.fontanesi@gtlaw.com](mailto:luigi.fontanesi@gtlaw.com)
- [Paola Furiosi](#) | + (39) 02.771971 | [paola.furiosi@gtlaw.com](mailto:paola.furiosi@gtlaw.com)

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