



Ministero dello Sviluppo Economico

DIREZIONE GENERALE PER LA LOTTA ALLA CONTRAFFAZIONE
Ufficio Italiano Brevetti e Marchi

**MADRID AGREEMENT AND PROTOCOL
PROVISIONAL REFUSAL OF PROTECTION**

Rule 17(1)

I.	Office making the notification: MINISTERO DELLO SVILUPPO ECONOMICO Direzione Generale per la Lotta alla Contraffazione - Ufficio Italiano Brevetti e Marchi Via Molise, 19 - 00187 ROMA e-mail : dglcuibm.div02@pec.mise.gov.it
II.	Number of the international registration: 1 273 344 Trademark: Skyworth
III.	Name of the holder: SKYWORTH GROUP CO., LTD. Unit A, 15/F, West, Skyworth Building, Shennan Ave, Nanshan District 518057 Shenzhen, Guangdong (CN)
IV.	<input type="checkbox"/> Provisional refusal based on an <i>ex officio</i> examination <input checked="" type="checkbox"/> Provisional refusal based on an opposition <input type="checkbox"/> Provisional refusal based on both an <i>ex officio</i> examination and an opposition
V.	<input checked="" type="checkbox"/> Provisional refusal for all the goods and/or services <input type="checkbox"/> Provisional refusal for some of the goods/services.
VI.	Grounds for refusal : Identity or similarity between the marks and identity or similarity between the goods/services.
VII.	Opponent rights: 1) Registration number: 6870992 (Community Trademark) i) Filing date: 18/04/2008 ii) Date of registration: 08/08/2012 iii) Name and address of the opponent: Sky International AG

**Stockerhof, Dreikönigstrasse 31a
CH-8002 Zurich Svizzera**

iv) Reproduction of the mark: **SKY**

iv) List of some of the goods:

CL. 07: Machines and machine tools; motors and engines (except for land vehicles); turbines for power generation; control panels for turbines for power generation; parts and fittings for all the aforesaid goods.

CL. 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, radio, television, sound recording, sound reproducing, telecommunications, signalling, checking (supervision) and teaching apparatus and instruments; apparatus for recording television programmes; apparatus for recording, transmission, reproduction or reception of sound, images or audio visual content; electrical and electronic apparatus for use in the reception of satellite, terrestrial or cable broadcasts; televisions; LCD and plasma screens; home cinema systems; amplifiers; speakers; radios; wireless audio and/or audio visual devices; portable wireless audio and/or audio visual devices; remote controls; games controllers; wireless gaming controllers; wireless keypads; television receivers including a decoder; set-top boxes; digital set-top boxes; high definition set top boxes; personal video recorder; set-top boxes for use in decoding and reception of satellite, terrestrial and cable broadcasts; apparatus for decoding encoded signals including set top boxes for television reception; set top box apparatus including a decoder and an interactive viewing guide, set top box apparatus including a decoder and a recorder for recording television and audio programmes; set top box apparatus including a decoder and a recorder programmable to transfer stored recordings to storage and also to delete the older recordings; satellite dishes; low noise blocks; satellite meters; computer software to enable searching of data; encoded programs for computers and for data processing and telecommunications; telephones; mobile telephones; PDAs; telephone and radio modems; television receivers including a decoder; set top boxes for use in decoding and reception of satellite, terrestrial cable and digital subscriber line (DSL), Internet or other electronic broadcasts; apparatus for decoding encoded signals; recorded television and radio programmes; recorded programmes for broadcasting or other transmission on television, radio, mobile telephones, PDAs and on PCs; video recordings; multimedia apparatus and instruments; portable or hand-held computers; DVD players; computers; computer hardware; computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information; computer programs; electronic computer games; electronic interactive computer games; computer software; computer software and telecommunications apparatus to enable connection to databases and the Internet; computer software supplied from the Internet; network termination equipment; wired and/or wireless computer network routers, modems, firewalls and/or bridges; computer software and computer programs for distribution to, and for use by, viewers of a digital television channel for the viewing and purchase of goods and services; computer games software and computer quiz software; computer video games and/or quizzes adapted for use with television receivers and screens or with video monitors or with computer screens; computer programs for interactive television and for interactive games and/or quizzes; electronic apparatus adapted for use with television receivers in playing games; games consoles; interactive video game devices comprised of computer hardware and software and accessories, namely game consoles, game controllers and software for operating game controllers; portable and/or hand-held electronic devices for interactive computer and video games; portable and/or hand-held electronic devices for receiving, playing and transmitting music, sounds, images, text, signals, information and code; electronic publications; computer games; computer video games; video screens; video projectors; tapes, discs and wires, all being magnetic; cassettes and cartridges, all adapted for use with the aforesaid tapes; blank and pre-recorded audio and video cassettes, tapes and cartridges; compact discs; DVD discs; phonographic records; laser readable discs for recording sound or video; Rom cartridges, CD Roms, cards and discs, integrated circuit cards, memory carriers, recording media, all pre-recorded with computer video games and/or quizzes; encoded cards; radio and television signal antennae; music, sounds, videos, images, text and information provided by a telecommunications network, by on-line delivery and by way of the Internet and/or the world-wide web or other communications network; interactive sound and/or audio recordings; music, video, sound and/or audio recordings (downloadable) provided from MP3 Internet

websites; MP3 players, MP3 readers; audio and/or video file recorders and/or players; portable audio and/or video file recorders and/or players; telephone ring tones (downloadable); apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus and instruments for the reception of radio and television broadcasts including the reception of cable, satellite and digital broadcasts; smart cards; credit cards; loyalty cards; acoustic apparatus or instruments; adaptors; aerials; antennae; amplifiers; amusement apparatus and instruments adapted for use with an external display screen or monitor; communication apparatus and instruments; encoded or magnetic banking or credit cards; cinematographic film; cinematographic instruments and apparatus; data carriers; data storage; electrical telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; electronic telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; film reproducing instruments and apparatus; hand held electrical telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; hand held electronic telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; interactive educational or entertainment games for use with television receivers and video apparatus; mobile telephones; motion pictures; telephone apparatus and equipment; parts and fittings for all the aforesaid goods; sunglasses, leather cases for holding mobile phones; e-sell through products, namely downloadable media content, including video and films, television programmes, computer games, music, images and ring tones provided by Internet, telephone line, cable, wireless transmission, satellite or terrestrial broadcast service; cases, containers, protective coverings and parts and fittings therefore, all for use with MP3 players, music storage devices, media storage devices and other consumer electronic devices; electrical, electronic and computer equipment for machinery for use in conservation, generation and efficient use of heat, light and water, including thermostatic controls, solar panels for electricity generation, photovoltaic devices, solar cells, turbines and motion detectors; electrical, electronic and computer equipment for use in the generation of alternative energy including wind power, hydroelectric power, tidal power, geothermal power, solar power, biomass, and biofuels; control and monitoring equipment for use in the generation of alternative energy including wind power, hydroelectric power, tidal power, geothermal power, solar power, biomass, and biofuels; electronic publications [downloadable], including electronic publications, magazines and newsletters regarding environmental protection, energy conservation and ecology, animal welfare and renewable energy projects, including wind power, hydroelectric power, tidal power, geothermal power, solar power, biomass, and biofuels; apparatus and instruments for closed circuit television and surveillance systems; apparatus and instruments for personal security monitoring; apparatus and instruments for home security monitoring and control; home and personal security apparatus; home and personal security devices; home and personal security alarms; electronic protection equipment, including fire detecting and alarm equipment, intruder and burglar alarm equipment and motion detecting equipment; radio, telephonic, television and signalling apparatus and instruments, cameras, sound and video monitoring and recording and sound and video reproducing apparatus and instruments, all for control and telemetry purposes for the home and personal security; closed-circuit television systems (CCTV); monitors; cameras; optical lenses; camera casings; prepackaged cameras; infrared illuminators; videocassette recorders (VCRs), system controlling software; video monitoring apparatus; detectors; access control apparatus; readers; magnetic or encoded access control cards; monitoring apparatus; electronic panels for alarm management and monitoring; alarm panels; glass breakage detectors; smoke detectors; carbon monoxide detectors; digital audio recorders; digital video recorders; digital audio servers; digital video servers; electrical communication equipment; message programming equipment; radio paging equipment; electronic locking systems; life-saving apparatus and equipment; electric alarms; electronic devices for opening doors; electronic devices for protection; intruder alarms and anti-theft equipment; intruder detection apparatus; motion detecting equipment; electronic control apparatus; electronic apparatus for controlling operation of machines; remote apparatus for controlling operation of machines; computer apparatus for controlling operation of machines; electronic network equipment; electronic communication equipment; message programming devices; electronic locking apparatus; apparatus for controlling temperature; apparatus for controlling water supply; apparatus for controlling lighting; all the aforesaid including remote and computer apparatus and instruments; parts and fittings for all the aforesaid goods.

CL. 11: Apparatus for controlling temperature for central heating installations; apparatus for controlling water supply; apparatus for energy efficient heating and water supply purposes, in particular, apparatus for water conservation and use minimization, automated control apparatus for local management of heating and water supplies; parts and fittings for all the aforesaid goods.

2) Registration number: 9129909 (Community Trademark)

i) Filing date: **25/05/2010**

ii) Date of registration: **16/03/2013**

iii) Name and address of the opponent: **Sky International AG**
Stockerhof, Dreikönigstrasse 31a
CH-8002 Zurich Svizzera

iv) Reproduction of the mark:

sky

v) List of some of the goods:

CL. 07: Machines and machine tools; motors and engines (except for land vehicles); turbines for power generation; electrical and electronic equipment for use in the generation of alternative energy including wind power, hydroelectric power, tidal power, geothermal power, biomass, and biofuels; parts and fittings for all the aforesaid goods.

CL. 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, radio, television, sound recording, sound reproducing, telecommunications, signalling, checking (supervision) and teaching apparatus and instruments; apparatus for recording television programmes; apparatus for recording, transmission, reproduction or reception of sound, images or audio visual content; electrical and electronic apparatus for use in the reception of satellite, terrestrial or cable broadcasts; televisions; LCD and plasma screens; home cinema systems; amplifiers; speakers; radios; wireless audio and/or audio visual devices; portable wireless audio and/or audio visual devices; remote controls; games controllers; wireless gaming controllers; wireless keypads; television receivers including a decoder; set-top boxes; digital set-top boxes; high definition set top boxes; personal video recorder; set-top boxes for use in decoding and reception of satellite, terrestrial and cable broadcasts; apparatus for decoding encoded signals including set top boxes for television reception; set top box apparatus including a decoder and an interactive viewing guide; set top box apparatus including a decoder and a recorder for recording television and audio programmes; set top box apparatus including a decoder and a recorder programmable to transfer stored recordings to storage and also to delete the older recordings; satellite dishes; low noise blocks; satellite meters; computer software to enable searching of data; encoded programs for computers and for data processing and telecommunications; telephones; mobile telephones; PDAs; telephone and radio modems; television receivers including a decoder; set top boxes for use in decoding and reception of satellite, terrestrial cable and digital subscriber line (DSL), Internet or other electronic broadcasts; apparatus for decoding encoded signals; recorded television and radio programmes; recorded programmes for broadcasting or other transmission on television, radio, mobile telephones, PDAs and on PCs; video recordings; multimedia apparatus and instruments portable or hand-held computers; DVD players; computers; computer hardware; computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information; computer programs; electronic computer games; electronic interactive computer games; computer software; computer software and telecommunications apparatus to enable connection to databases and the Internet; computer software supplied from the internet; network termination equipment; wired and/or wireless computer network routers, modems, firewalls and/or bridges; computer software and computer programs for distribution to, and for use by, viewers of a digital television channel for the viewing and purchase of goods and services; computer games software and computer quiz software; computer video games and/or quizzes adapted for use with television receivers and screens or with video

monitors or with computer screens; computer programs for interactive television and for interactive games and/or quizzes; electronic apparatus adapted for use with television receivers in playing games; games consoles; interactive video game devices comprised of computer hardware and software and accessories, namely game consoles, game controllers and software for operating game controllers; portable and/or handheld electronic devices for interactive computer and video games; portable and/or hand-held electronic devices for receiving, playing and transmitting music, sounds, images, text, signals, information and code; electronic publications; computer game; computer video games; video screens; video projectors; tapes, discs and wires, all being magnetic; cassettes and cartridges, all adapted for use with the aforesaid tapes; blank and pre-recorded audio and video cassettes, tapes and cartridges; compact discs; DVD discs; phonographic records; laser readable discs for recording sound or video; ROM cartridges, CD Roms, cards and discs, integrated circuit cards, memory carriers, recording media, all pre-recorded with computer video games and/or quizzes; encoded cards; radio and television signal antennae; music, sounds, videos, images, text and information provided by a telecommunications network, by on-line delivery and by way of the Internet and/or the world-wide web or other communications network; interactive sound and/or audio recordings; music, video, sound and/or audio recordings (downloadable) provided from MP3 Internet websites; MP3 players, MP3 readers; audio and/or video file recorders and/or players; portable audio and/or video file recorders and/or players; telephone ring tones (downloadable); apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus and instruments for the reception of radio and television broadcasts including the reception of cable, satellite and digital broadcasts; smart cards; credit cards; loyalty cards; acoustic apparatus or instruments; adaptors; aerials; antennae; amplifiers; amusement apparatus and instruments adapted for use with an external display screen or monitor; communication apparatus and instruments; encoded or magnetic banking or credit cards; cinematographic film; cinematographic instruments and apparatus; data carriers; data storage apparatus, equipment and instruments; electrical telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; electronic telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; film reproducing instruments and apparatus; hand held electrical telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; hand held electronic telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; interactive educational or entertainment games for use with television receivers and video apparatus; mobile telephones; motion pictures; telephone apparatus and equipment; parts and fittings for all the aforesaid goods; sunglasses, leather cases for holding mobile phones; e-sell through products, namely downloadable media content, including video and films, television programmes, computer games, music, images and ring tones provided by internet, telephone line, cable, wireless transmission, satellite or terrestrial broadcast service; cases, containers, protective coverings and parts and fittings therefore, all for use with MP3 players, music storage devices, media storage devices and other consumer electronic devices; electrical, electronic and computer equipment for machinery for use in conservation, generation and efficient use of heat, light and water, including thermostatic controls, solar panels for electricity generation, photovoltaic devices, solar cells, motion detectors; electrical, electronic and computer equipment for use in the generation of solar power; control and monitoring equipment for use in the generation of alternative energy including wind power, hydroelectric power, tidal power, geothermal power, solar power, biomass, and biofuels; electronic publications (downloadable), including electronic publications, magazines and newsletters regarding environmental protection, energy conservation and ecology, animal welfare and renewable energy projects, including wind power, hydroelectric power, tidal power, geothermal power, solar power, biomass, and biofuels; apparatus and instruments for closed circuit television and surveillance systems; apparatus and instruments for personal security monitoring; apparatus and instruments for home security monitoring and control; home and personal security apparatus; home and personal security devices; home and personal security alarms; electronic protection equipment, including fire detecting and alarm equipment, intruder and burglar alarm equipment and motion detecting equipment; radio, telephonic, television and signalling apparatus and instruments, cameras, sound and video monitoring and recording and sound and video reproducing apparatus and instruments, all for control and telemetry purposes for the home and personal security; closed-circuit television systems

(CCTV); monitors; cameras; optical lenses; camera casings; prepackaged cameras; videocassette recorders (VCRs); system controlling software; video monitoring apparatus; detectors; access control apparatus; readers; magnetic or encoded access control cards; monitoring apparatus; electronic panels for alarm management and monitoring; alarm panels; glass breakage detectors; smoke detectors; carbon monoxide detectors; digital audio recorders; digital video recorders; digital audio servers; digital video servers; electrical communication equipment; message programming equipment; radio paging equipment; electronic locking systems; life-saving apparatus and equipment; electric alarms; electronic devices for opening doors; electronic devices for protection; intruder alarms and anti-theft equipment; intruder detection apparatus; motion detecting equipment; electronic control apparatus; electronic apparatus for controlling operation of machines; remote apparatus for controlling operation of machines; computer apparatus for controlling operation of machines; electronic network equipment; electronic communication equipment; message programming devices; electronic locking apparatus; computer software, operating system software, devices, and hardware for transmitting, receiving, synchronizing, displaying, backing-up, monitoring, controlling, sharing, coding, decoding, encrypting, accessing, remotely accessing, creating, collecting, storing, securing, removing, transferring, disseminating, locating, organizing or otherwise utilizing data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data, including over a global communications network; computer software, operating system software, devices, and hardware for synchronizing data, files, e-mails, contacts, calendars, task lists, text messages, photos, music, audio, visual, audio visual, video, text, graphics, programs and other information between computers and hand-held or other devices, and vice versa; communications platforms for enabling instantaneous, continuous, scheduled and perpetual synchronization of data between computers and hand-held or other devices, and vice versa; multimedia cards, memory cards, flash memory cards, memory chips, data storage media devices, plugs, plug-in cards, magnetic cards, SIM cards, telephone calling cards, headphones, headsets, portable and/or hand held electronic devices for receiving, storing, playing and transmitting data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data; online dictionaries, encyclopaedias, and reference texts (downloadable); online publications, including newspapers, magazines (periodicals), comics, journals (publications), books, user manuals, instructional and teaching materials (downloadable); online posters, photographs, pictures, articles, vouchers and tickets (downloadable), online electronic dictionaries, encyclopaedias and reference texts; computer software for processing electronic payments and transferring funds to and from others; online and downloadable authentication software; online conversion software and databases, including currency conversion and measurement conversion; computer software for the purpose of monitoring online communications and chat room conversations and alerting third parties to the contents; computer software for monitoring the use of computers and the internet by children; computer software relating to online protection and online security; protective clothing for cycling; locks (electric) for bicycles; parts and fittings for all the aforesaid goods; satellite navigational system for bicycles; global positioning systems for use with bicycles; computers for use with bicycle; ergometers; computer apparatus for remote meter reading; bicycle meters; distance meters; power meters; speed meters; eyewear; sports eyewear; sun visors; protective eyewear; sunglasses; cases for eyewear; cases for sunglasses; frames for eyewear; lenses for eyewear; straps for sunglasses and eyewear; helmets; cyclists helmets; crash helmets; protective sports helmets; sports bags for protective helmets; sporting articles for protective purposes; visors; radios; communicators; aerials for radios; parts for radios; carrying cases for radios; electronic radio apparatus; mobile radios; mounting fittings for radios; radio receivers and transmitters, radio transceivers; radios for vehicles; solar powered radios; power meters for bicycles; protective gloves; control panels for turbines for power generation; apparatus for controlling temperature; apparatus for controlling lighting; automated control apparatus for local management of lighting, heating and water supplies; parts and fittings for all of the above.

CL.11: Apparatus for controlling water supply; all the aforesaid being controlled by themselves or controlled by remote and computer apparatus instruments; apparatus for energy efficient lighting, heating and water supply purposes, in particular, light bulbs, apparatus for water conservation and use minimization; lights for bicycles; fittings for attaching lights to bicycles; reflectors for bicycles; parts and fittings for all the aforesaid goods.

VIII. Corresponding essential provisions of the applicable law [(see text under XII)]:
Art.12 1), d) of the Italian Industrial Property Rights Code.

IX. Information relating to subsequent procedure:

(i) Time limit for requesting review or appeal:

The holder of the registration may, through a representative appointed according to article 201, request copy of the opposition notice within a period of three months from the date on which he received the notification of this provisional refusal by the International Bureau of WIPO. Furthermore, copy of the notification received by WIPO must be attached to the abovementioned request to the Italian Patent and Trademark Office.

(ii) Authority to which such request for review or appeal should be made:

The holder of the registration may, through a representative appointed according to article 201, submit his objections to the present refusal to *Ufficio Italiano Brevetti e Marchi – Divisione II Affari Giuridici e Normativi - Via Molise, 19 – 00187 ROMA - ITALY*.

(iii) Indications concerning the appointment of a representative:

Where the applicant is not established or domiciled in a Member State of the European Union or in the European Economic Area, he may submit his objections through a registered agent in the roll kept for this purpose by the Italian Patent and Trademark Office (see: www.ordine-brevetti.it) or a lawyer registered in the appropriate professional role (see: www.ordineavvocati.it) – (art. 201-203 Code of Industrial Property Rights).

X. Date of the notification of provisional refusal:

Prot. N.:

Ministero dello Sviluppo Economico

AOO_Politiche industriali e Tutela

Struttura: **DGLCUIBM_Div08**

REGISTRO UFFICIALE

Prot. n. **0339664 - 27/10/2016 - USCITA**

XI. Signature or official seal of the Office making the notification:



XII. Corresponding essential provisions of the applicable law:

Extract from the Code of Industrial Property Rights

(Legislative Decree of February 10th 2005, n.30)

Art. 17 - International Registration

1. For the registration of trademarks with the World Intellectual Property Organization (WIPO), the provisions in force pursuant to international conventions shall remain valid.
2. International trademarks registered with the World Intellectual Property Organization (WIPO) of Geneva, based on the Madrid Agreement concerning the International Registration of Marks, Stockholm text of 14 July 1967, ratified by law no.424 of 28 April 1976, and the respective Protocol, adopted in Madrid on 27 June 1989, ratified by law no.169 of 12 March 1996, containing the designation of Italy as the country in which protection is requested, must meet the requirements set for national trademarks by this Code.
3. The Italian Patent and Trademark Office carries out the examination of the international trademarks that designate Italy in compliance with the applicable provisions of the applications for national trademarks.

Art. 7 – Subject Matter of Registration

1. A trademark consist of any sign which capable of being represented graphically, and in particular words, including personal names, designs, letters, numerals, sounds, the shape of a goods or of their packaging, the color combinations or tones, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertaking.

Art. 8 - Portraits of person, names and well known signs

1. Portraits of person shall not be registered as trademarks without the persons' consent, and after their death, without the consent of the spouse and children; if there are no such relatives or after their death, of the parents and other ancestors, and if there are no such ancestors or after their death, of the relatives up and including the fourth degree.
2. The names of persons other than those who apply for registration may be registered as trademarks, provided that their use is not such as to harm the reputation, creditworthiness or dignity of those who have the right to bear those names. The Italian Patents and Trademarks Office shall however have the right to make the registration conditional upon the consent as set forth in paragraph 1. In any event, the registration shall not prevent persons having the right to the name to use in the business chosen by them, if the requirements are met as set forth in Article 21(1).
3. If well known, the following may be registered or used as trademarks only by the qualified person, or with the consent of the same, or of the persons indicated in paragraph 1: names of persons, signs used in the fields of art, literature, science, politics or sports, the designations and abbreviations of events and those of entities and associations without economic purposes, as well as the characteristic emblems of the same.

Art. 9 – Shape trademarks

1. Signs shall not be registered as trademarks if they consist solely of the shape dictated by the nature of the product, the shape of the product necessary to obtain a technical result, or of the shape that gives substantial value to the product.

Art. 10 – Coats of arms

1. Coats of arms and other signs considered in existing international conventions on the subject matter, in the cases and the conditions mentioned therein, as well as the signs containing symbols, emblems and coats of arms which are in the public interest shall not be registered as trademarks, unless the consent of the appropriate authorities to their registration has been given.
2. If a trademark contains words, figures or signs with political meaning or a highly symbolic value, or containing heraldic elements, before registration, the Italian Patents and Trademarks Office shall send the copy of the trademarks and whatever else may be necessary to the relevant or appropriate public agencies, to receive their opinion, in accordance with the provisions of paragraph 4.
3. The Italian Patents and Trademarks Office may act in accordance with provisions of paragraph 2 in all cases where there is a doubt that trademark could be contrary to the law, the public policy or accepted principles of morality.
4. If the relevant or appropriate agency, as per paragraphs 2 and 3, expresses an opinion against the registration of the trademark, the Italian Patents and Trademarks Office shall reject the application.

Art.12 – Novelty

1. Signs shall not be registered as trademarks if as of the date of filing of the application any of the following applies:

- a) (omissis);
- b) (omissis);
- c) They are identical to a trademark already registered by others in the Country or having effect in the Country following an application filed on an earlier date or having effect from an earlier date due to a right of a priority or a valid claim of seniority for identical goods or services;
- d) They are identical or similar to a trademark that has already registered by others in the Country or having effect in the Country following an application filed on an earlier date or having effect as from an earlier date due to a right of priority or a valid claim of seniority for goods and services that are identical or similar, if due to the identity or similarity between the signs and the identity or similarity between the goods or services there exists a likelihood of confusion on the part of the public, than can also consist of a likelihood of association between the two signs; [...]
- e); f); 2. 3. (omissis)

Art. 13 – Distinctive character

1. Signs lacking a distinctive character shall not be registered as trademarks. These include:

- a) those consisting only of signs that have become commonly used in current language or in the common practices of the trade;
 - b) those consisting of general designations of goods or services or descriptive indications that refer to them, such as signs that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the good or of the rendering of the service or other characteristics of the good or service.
2. Notwithstanding paragraph 1, signs that have acquired a distinctive character prior to application for registration, due to the use that has been made of them, may be registered as trademarks.
3. (omissis)
 4. (omissis)

Art. 14 – Lawfulness and third-party rights

1. The following shall not be registered as trademarks:

- a) signs that are contrary to the law, public policy or accepted principles of public morality;
- b) signs that can mislead the public, in particular as to the geographical origin, nature or quality of the goods or services.
- c) (omissis)

Art. 135 – Board of Appeal

1. An appeal may be filed with the Board of Appeal against decisions of the Italian Patent and Trademark Office that totally or partially reject an application or request, refuse registration or prevent the recognition of a right, and in the other cases provided for by this Code, within the mandatory term of 60 days from the date of receipt of the notification of the decision.
(omissis)

Art. 170 – Examination of applications

1. The examination of applications which have been found to meet the formal requirements, is aimed at determining:

- a) for trademarks: if Article 11 may be applied when collective marks are involved; if the word, design or sign can be registered as a trademark pursuant to Articles 7, 8, 9, 10, 13, paragraph 1 and 14, paragraph 1, letters a) and b); if the conditions indicated in Article 3 are met.
- b) (omissis)

Art. 171 – Examination of the International trademarks

1. (omissis)

2. If the Italian Patent and Trademark Office deems that the trademark shall not be registered in full or in part, or if an opposition has been filed by third parties pursuant to Article 176, the Office shall proceed pursuant to Article 5 of the Madrid Agreement for the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law no. 424 of 28 April 1976 or the respective Protocol of 27 June 1989, ratified by Law No. 169 of 12 March 1996, to issue a provisional refusal of the international registration and gives notice to the World Intellectual Property Organization.

3. The provisional refusal under paragraph 2 is issued within one year for international registrations based on the Madrid Agreement for the International Registration of Marks, and within eighteen months for those based on the respective Protocol. The terms start on the dates respectively indicated in the cited International Conventions.

4. In the case of provisional refusal, the protection of the trademark shall be that of a trademark application filed with the Italian Patent and Trademark Office.

5. Within the mandatory term set out by the Italian Patent and Trademark Office, the owner of an international registration, for which a provisional refusal has been communicated to the World Intellectual Property Organization, through an attorney appointed in accordance with Article 201, may submit his own arguments, or request a copy of the opposition paper based on which the provisional refusal was issued. In the latter case, if the owner of the international registration requests a copy within the required period, the Office shall send the notice to the parties as Article 178, paragraph 1, and apply the other rules on the opposition proceeding set forth by Articles 178 et seq.

6. If within the term indicated in paragraph 5, the owner of the international registration does not submit his arguments, or does not request a copy of the opposition paper in accordance with the rules indicated above, the Italian Patent and Trademark Office shall issue the final refusal.

7. The Italian Patent and Trademark Office shall notify the World Intellectual Property Organization of the final decisions relating to international trademarks designating Italy.

Art. 201 – Representation

1. 2. 3. (omissis)

4. The appointment may be granted only to attorneys registered in a specific Register established for that purpose at the Board of the Industrial Property Consultants Institute.

5. (omissis)

6. The appointment may also be granted to a lawyer admitted to the Bar.