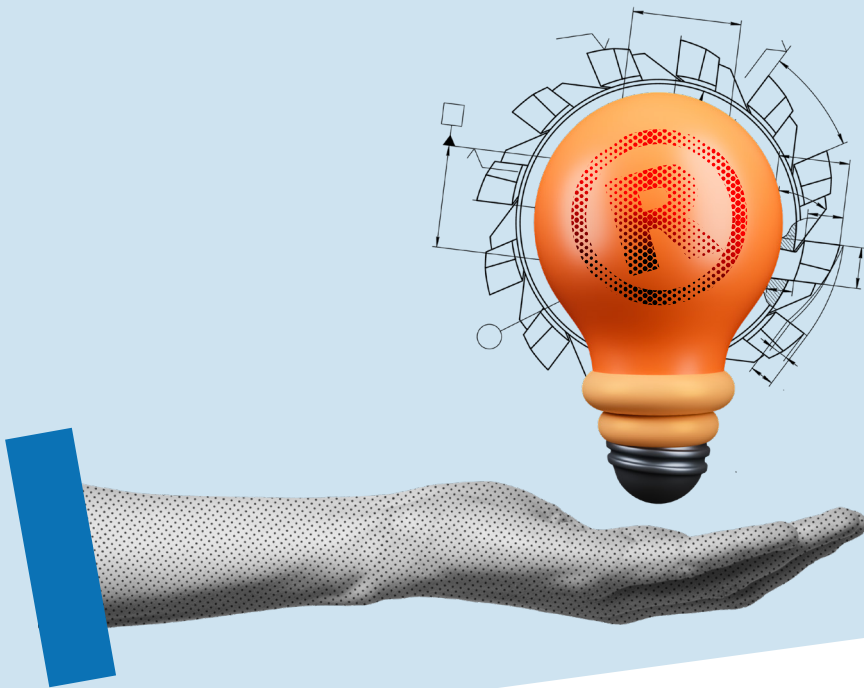


The **i**NTERPATENT newsletter



NOVEMBER 2024

THE EU DESIGN REFORM HAS NOW BEEN PUBLISHED

In our April 2024 issue we reported the formal adoption of the EU Design Reform by the EU Parliament and briefly discussed the most relevant changes introduced by this reform.

Now, both the [Regulation \(EU\) 2024/2822 amending Council Regulation No 6/2002 on Community designs and repealing Commission Regulation No 2246/2002](#) (the Amending Regulation) and [Directive \(EU\) 2024/2823 on the legal protection of designs](#) (the Recast Directive) were published in the Official Journal of the European Union on 18 November 2024 and will become effective 20 days after publication.

The Recast Directive provides for a period of 36 months, ending 9 December 2027, within which EU Member States will have to transpose the rules contained in the Directive into their own national laws.

The **Amending Regulation**, instead, provides for a two-phase implementation, i.e. most amendments, including terminology and structural changes as well as substantive changes, will become effective in **Phase I starting 1 May 2025**, i.e. on the first day of the month following 4 months after the date of entry into force of the Amending Regulation, whereas **Phase II will begin 1 July 2026**, i.e. on the first day of the month following 18 months after the date of entry into force of the Amending Regulation, and will cover other amendments for which further development through secondary legislation (Implementing and Delegated Regulations) is required.

We will be sharing with you the main novelties of the reform close to their coming into effect.

PROTECTING AUTHENTICITY: CUSTOMS INTERVENTION AS MEANS AVAILABLE TO FIGHT COUNTERFEITING

As recently stated by the Italian Ministry of Business and Made in Italy (MIMIT) "given the serious impact of counterfeiting on the macroeconomic level and microeconomic level,

anti-counterfeiting policies represent a central element of industrial policies and contribute to supporting the competitiveness of the national production system".

The last few years have, therefore, been characterised by a legislative imprint increasingly oriented towards the protection of the Italian territory and Made in Italy and - at the same time - towards the fight against the ever-expanding phenomenon of counterfeiting.

The Growth Decree (L. 58/2019) introduced measures such as precautionary seizure and administrative seizure of counterfeit goods (as well as their destruction) and established the **National Council for the Fight against Counterfeiting and Italian Sounding (CNALCIS)**, consisting of government representatives.

The Council has the function of promoting, directing and coordinating institutional initiatives as well as raising awareness about the risks and damages of the counterfeit market both in the real and virtual world, and one of its key focuses is counteracting the so-called '**Italian Sounding**', i.e. counterfeiters making profit by labelling their products with misleading Italian names or words.

The so-called **Made in Italy Law** was also adopted (Law No. 206 of 27 December 2023), which came into force on 11 January 2024. The law aims to enhance, promote and protect, in Italy and abroad, Italian excellence, as factors of identity and growth of the economy, introducing measures aimed at stimulating the development of national strategic supply chains, battling counterfeiting and training new personnel related to Made in Italy.

Since this law came into force in January 2024, there have been **over 2,300 concrete cases of application of the new anti-counterfeiting regulatory provisions**, including the destruction of seized counterfeit goods and the application of new pecuniary sanctions.

The numbers of enforcement actions are also appalling, with over 2,700 interventions carried out by the Italian Finance Police and over 4,000 by the **Italian Customs and Monopolies Agency (ADM)**.

In particular, in the period between 1 January and 30 June 2024, ADM carried out 4,120 seizures of counterfeit goods at Italian customs offices, corresponding to a total of 4,940,669 seized items, the largest quantities of seized goods concerning clothing and accessories, toys, personal accessories and mobile phones.

ADM therefore plays a fundamental role in fighting counterfeiting.

In order to oppose the circulation of goods that imitate or usurp IP rights, ADM can intervene in two ways: upon request of a party, through the so-called "**application for action**" (AFA), or *ex officio*.

Application for Action (AFA)

The holder of an intellectual property right that is valid in one or more member states of the European Union may request the intervention of the customs authority. The **application for action (AFA) – as from next 21 December** – must be submitted electronically through the new portal developed by the European Union Intellectual Property Office (EUIPO), namely the **IP Enforcement Portal (IPEP)**, which replaces the Italian national system "FALSTAFF".

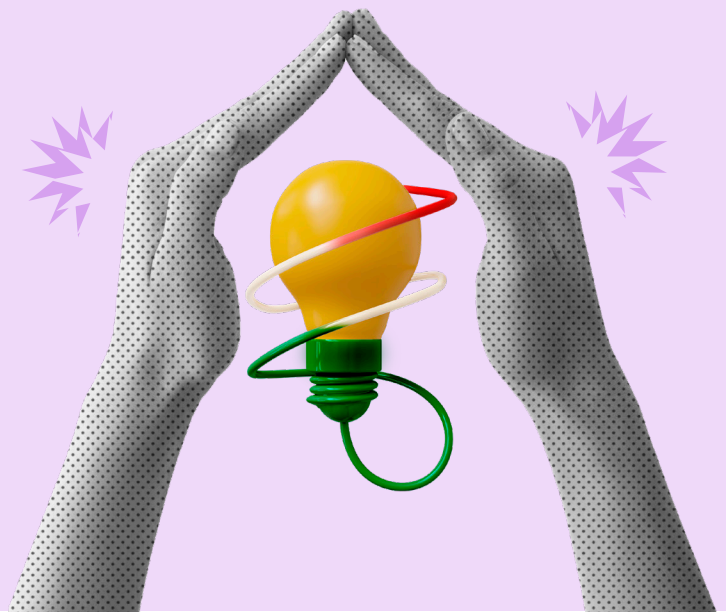
The customs intervention can be requested in respect of trademarks, patents, designs (registered or unregistered), copyrights, supplementary protection certificates, plant variety rights, designations of origin, geographical indications and commercial names, provided that they are protected as exclusive intellectual property rights under national or EU legislation.

The application for action – which is valid for one year (with the possibility of renewal and/or updating) – can be:

- a **National application**, when addressed to the customs authority of the Member State, with a request for intervention in that Member State;
- a **Union application**, when presented in a Member State, with a request to the customs authorities of that Member State and of one or more other Member States to take action in their respective territories.

The application for intervention must be accompanied by all the information necessary to differentiate the counterfeit goods from the originals.

When a customs office suspects that imported goods may infringe intellectual property rights for which the holder has submitted an application for action, it shall **suspend release of the goods and detain them**. The right holder will then be informed and invited to inspect the suspect goods.



The suspension period is 10 working days (3 days in the case of perishable goods) and may be extended by a maximum of 10 additional working days, if necessary. Within these terms, the right holder ascertains, and notifies the customs authorities in writing, that the goods subject to the procedure infringe the right in question. In the absence of such written notification, the customs office may proceed with the release of the suspect goods.

Within 10 working days from the start of the suspension (3 working days in the case of perishable goods) the right holder must initiate **legal proceedings** aimed at obtaining confirmation by a court of the seizure of the counterfeit goods. The Italian customs office, upon receiving the written communication in which the right holder confirms the existence of the infringement, communicates the crime to the Public Prosecutor's Office, which automatically initiates a criminal proceeding.

Ex officio procedure

Even if no application for action has been submitted, if the customs authority has sufficient reason to suspect that goods infringe an intellectual property right, it

may suspend the release of the goods or detain them through an **ex officio procedure**. This measure is communicated to the IP right owners (or their representatives) within one working day, so that they can confirm or deny the suspicion. They must then submit the application for action to the competent customs service within four working days, if the goods are indeed counterfeit.

The advantages of filing an application for action are numerous: IP right owners have the possibility of monitoring in a certain way the circulation of their products; the fact that there is a single portal allows the sharing of information and direct communication with all the EU enforcement authorities involved in the fight against counterfeiting; and the competent authorities are able to detect counterfeiting situations more effortlessly.

Our professionals are available to evaluate with you the possibility of filing applications for customs intervention based on IP rights. Do not hesitate to contact us!

DEEP TECH FINDER: EMPOWERING CONNECTIONS AMONG UNIVERSITIES/STARTUPS AND PROSPECTIVE INVESTORS



The European Patent Office (EPO) has recently upgraded its Deep Tech Finder.

Deep Tech Finder is the digital platform established by the EPO to promote exchanges between the university and startup world and business realities

by making available a comprehensive collection of university-filed and startup-filed European patent applications.

A study conducted by the EPO shows that the **contribution of academic researchers** to European patent applications has steadily increased over the past decades, **now exceeding 10 per cent of all patents filed by European applicants at the EPO**. However, this study also highlights that the transfer of academic knowledge to the market often remains a challenge for universities.

Deep Tech Finder is therefore particularly useful in that, by allowing free access to its extensive information, it enables companies, researchers and prospective investors to have a far-reaching overview of innovations in scientific and technological fields where universities, university spin-outs and startups now play a leading role.

To offer reliable results, when establishing Deep Tech Finder, data from the global platform

The **I**NTERPATENT newsletter

Dealroom about startups and data from the European Higher Education Sector Observatory about universities were matched with the EPO's Register and further reviewed by national patent offices of EPO member states.

With its **new coverage** of almost 900 universities and over 1500 spin-outs, Deep Tech Finder allows users to set various filters to better target their search.

Once the university/spin-out/startup of interest has been spotted, their growth stage and financial position can be viewed along with their EP applications and related status (pending,

refused/withdrawn/EP granted and/or unitary effect).

Also, the search results can easily be exported with a single download to a CSV file for further use.

Deep Tech Finder is a useful tool for companies not only for monitoring the state of research in the most advanced sectors of technology and science, but also for identifying new investment opportunities.

For more information about this topic, please contact our patent attorneys.

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.



Members of FICPI and AIPPI

INTERPATENT Studio Tecnico Brevettuale S.R.L. - Registered Office Via Caboto, 35 - 10129 TORINO - Share Capital € 50000
Company Register of Torino 08327040013 - Fiscal Code and VAT Registration Number 08327040013
REA (Economic and Administrative Index) Number 963838

email@interpatent.com - www.interpatent.com