

Roberto Dini and Paolo Garavelli of Dini, Garavelli & Partners discuss the decisive steps forward made by the recent amendments to the Italian Industrial Property Code

## Patent standards harmonised

A whole series of innovations for patents has recently been introduced by the Italian Legislative Decree no 131 (Statutory Instrument) of August 13 2010. It reforms the Industrial Property Code, which came into force in March 2005 and regulates all IP matters, with the exception of copyrights (a choice which was strongly criticised by many parties).

The effects produced by the Decree are extremely broad. They are meant to take into account, within a single unified legal text, various laws and judicial rulings relating to different IP matters that have been issued in the years following the implementation of the Code.

The declared aim of the Legislative Decree is to correct material errors and coordination defects and flaws of the original Industrial Property Code, to harmonise the Italian provisions with EU and international rules, and to simplify patent filing procedures.

The main changes introduced by the Legislative Decree relate to: the patentability of biotechnologies; claims and scope of protection; European patent limitation; fair reward; preventive expert witness reports; military classification procedures and filing with the Italian Patents and Trademarks Office of European applications under the Patent Cooperation Treaty; and procedural changes.

One of the most significant changes to patent matters brought about by the Legislative Decree concerns the patentability of biotechnologies. The newly introduced Article 81-quater of the Industrial Property Code defines the following matters as patentable, if they are new and involve an inventive step:

- a biological material isolated from its natural environment or produced by means of a technical process, even if it previously occurred in nature;
- a process by means of which biological material is produced, processed or used;
- any new use of biological material or of a process relating to biological material;
- an invention relating to an isolated element of the human body; and
- an invention relating to plants or animals or a plant grouping.

The Legislative Decree also ensures stronger protection for patent holders. Article 52 of the Code, as amended by the Decree, now provides that, in order to assess the scope of the protection conferred by a patent, due account shall be taken not only of the elements of the claims, but also of any element which is equivalent to the latter, thereby harmonising Italian patent law with the European Patent Convention.

In addition, Article 79 of the Code as amended by the Decree grants patent holders the possibility to reformulate the patent claims even during judicial invalidity proceedings. This practice, which has long been adopted in many European countries like Germany, provides the holder of a patent with a defence against any prior art which did not emerge during the prosecution proceedings. Thus, if the examiner has overlooked some documents in his search, the patent holder will not nec-

### Roberto Dini



Roberto Dini began his career with Indesit where he was head of the Patent and Trademark Office. In 1982 Dini founded Sisvel.

In 1987 Dini founded Metroconsult, an IP Consultancy firm based in Turin, with branch offices in Milan and Genoa.

In 2011 a new company – Dini, Garavelli & Partners – was created following the merger between the two IP firms Metroconsult and Abremar.

Since 1981 he has been a member of the Italian Industrial Property Consultants Association, and a registered patent attorney with the European Patent Office. Since 1996 he has been a representative at the European Trademark and Design Office. Dini is the president of LES (Licensing Executives Society) Italy and chairman of the LES Patent Technology Licensing Committee.

Born in 1946, Roberto Dini has a degree in electronic engineering from the Polytechnic of Turin. He is fluent in English, French and has a good knowledge of German. During his experience with industrial companies he invented over 30 patents.

### Paolo Garavelli



Paolo Garavelli began his career in 1983, as production manager and then product manager, with Olivetti SpA, a company specialising in the design and production of computers and other office equipment.

In 1988 he worked as commercial logistic manager for Iveco SpA (FIAT Group), an international manufacturer and supplier of commercial trucks.

He then moved to Interpatent, wherein he gained an extensive expertise in filing, prosecuting and obtaining patents, designs and trade marks in Italy and throughout the world, processing search reports and providing assistance in the enforcement and protection of IP rights.

In 1998 Garavelli founded Abremar Srl, an intellectual property consultancy firm. Following the merging between Abremar Srl and Metroconsult Srl, a new IP company – Dini, Garavelli & Partners SpA – was created in 2011.

Garavelli is a member of the Italian Industrial Property Consultants Association, and a registered patent and trade mark attorney. Born in 1958, Paolo Garavelli has a degree in electro-technical engineering from the Polytechnic of Turin.

essarily see his investments lost, but will still be able to invoke a more specific scope of protection, thereby maintaining protection for what has been legitimately claimed.

Again, in order to adapt Italian law to the EPC, Article 56 of the Industrial Property Code now establishes that, if there is a limitation of the patent at European level, the corresponding Italian portion is likewise limited, provided that a translation of the text of the patent as limited is filed with the Italian Patent and Trademark Office.

The Legislative Decree also brings about changes in the

## Preventive expert evidence procedures are among the most significant changes introduced by the Legislative Decree

matter of an employee's patents reward, establishing that a fair reward is due to the inventor not only when a patent is obtained by the employer, but also when the employer decides instead to avail of the invention under the trade secrets regime. In other words, while, under the former regime, the inventor only had a right to remuneration if the employer filed, and was granted, a patent application, a remuneration is now also due if the company decides not to seek granting of a patent but benefits from the use of the invention under strict secrecy obligations.

Preventive expert evidence procedures are among the most significant changes introduced by the Legislative Decree in the area of civil proceedings rules. Under reformed Article 128 of the Industrial Property Code, it is now possible to apply, prior to instituting ordinary merits proceedings, for appointment by

the competent court of an expert witness to examine and report on validity and infringement or non-infringement of an industrial property right, in the framework of summary proceedings. This innovation responds to the need for an early definition or pre-emption of cases of uncertain judicial outcome, allowing, among other things, the precautionary acquisition of expert evidence on lack of infringement.

A further significant change relates to military classification procedures; indeed, by virtue of the amendments made to Article 198 of the Code, the first filing in Italy rule (or ministerial authorisation to file first abroad) for Italian residents now only applies to patent, utility model or topography patent applications concerning subject matter that might be useful for the defence of the country. According to Article 149, European patent applications can be filed through the Italian Patent and Trademark Office and, in order to ensure compliance with Article 198, they must be accompanied by a summary of the invention in Italian language and a copy of all drawings.

Further main procedural changes relate to the possibility to file patents or utility models applications even without claims, with the claims then having to be filed within the following two months (new Article 160, paragraph 4 of the Code); to file divisional patent applications upon the applicant's own motion, before the granting of the patent (Article 161); to make a declaration of priority after the filing of the application (Article 169); to apply for the so-called prosecution of the procedure (re-establishment of rights) not only in situations which would involve the loss of the industrial property right (Article 192).

DINI, GARAVELLI  
& PARTNERS

You generate ideas. We make them fly.



TORINO · MILANO · GENOVA

WWW.DINIGARAVELLI.COM

However, notwithstanding these additions to the Industrial Property Code, the Italian Legislative Decree no 131 is still lacking something.

We cannot but point out the failure to reform the rules on University inventions (Article 65 of the Code). Unlike other company employees, researchers at universities and public research bodies have the right to file patent applications autonomously, notwithstanding the right of the employer to benefit from any revenues deriving from the use of the relevant patent. This set of rules should have been reformed in order to adapt it to a German-type treatment, with the invention left to the researcher if the employer (the university or the public research body) does not intend to patent it in its own name.

This loophole could create some problems, such as possible constitutionality issues due to different treatment of private and public sector employees, and a possible loss of financial resources for the universities, which only have the right to obtain a percentage (from 30 to 50%) of the revenues or fees deriving from the patenting. These problematic issues will probably require a new revision of the Industrial Property Code.

No substantial changes were introduced by the Legislative Decree to the Italian patent examination procedure, already amended in 2008.

Until 2008, Italian patent legislation did not provide for substantive examination on national patent applications. The

assessment of patentability was deferred to prosecution in foreign countries or to court litigations. This led to a widespread belief that Italian granted patents had a lower presumption of validity compared to other European titles.

From July 1 2008, under an agreement between the Italian Patent and Trademark Office and the European Patent Office (EPO), all Italian patent applications have been subjected to a search report and patentability opinion issued by the EPO.

The search report and opinion, based on an English version of the sole claims, shall be sent to the applicant. A positive

---

## **Notwithstanding these additions to the Industrial Property Code, the Italian Legislative Decree no 131 is still lacking something**

---

report should speed up the prosecution of the application, while a negative or partially negative report will require satisfactory counter-arguments or amendments by the applicant.

This new regime will provide a strong incentive to Italian enterprises to better exploit their patents. The new system will make patent protection for technical innovations more attractive, offering a higher presumption of validity than in the past. It will also encourage companies to pursue an extension in foreign countries. If they already know they have a good chance of success, Italian companies will be encouraged to protect their inventions worldwide.