

Italy

Administrative procedure

Opposition

No formal pre- or post-grant opposition procedure is available. Third parties may only submit petitions during the examination process, pointing out the existence of prior patents; however, the observations will not have any further legal impact.

Appeal

An appeal against the refusal of the application must be filed within 60 days after notification by the Italian Patent and Trademark Office (hereinafter the “Patent Office”). The Board of Appeal will hear the interested parties or their agents and a Patent Office representative. The Board of Appeal is considered a judicial instance, as declared by the Constitutional Court. Any appeal from a decision of the Board of Appeal will therefore not go to an administrative court but to the Supreme Court.

Civil procedure

Legislative Decree 1/2012, converted into Law 27/2012, has established 21 Courts for enterprises (district courts and appellate courts), with a Court of Appeal in each region, apart from Aosta. Each of these has jurisdiction for cases in corporate, competition and intellectual property law and public procurement. In Rome and Milan the Court for enterprises is composed of two sections, one dealing with company and public procurement law cases, the other with IP, competition and public procurement law as well. Only professional and experienced judges are appointed to the specialised sections. Where a foreign party is involved in the proceedings (as claimant or defendant), according to the Decree n° 145 of 23 December 2013, only 11 courts will be competent to decide.

Infringement

Civil and criminal actions are available. A civil action may be brought by a patentee, a patent applicant or the licensee (in



the latter case, depending on the terms of the licensing contract) (Art. 120 IPA, modified by D. lgs. 131/2010).

An action will be heard by the courts for enterprises. During the investigative phase, and even in urgent cases, an expert appointed by the Court can be required to give an expert opinion on the existence of the infringement or the validity of the patent during the court proceedings. The judge is not bound by the evidence of the technical expert. The judge will evaluate it and may challenge it. However, if the judge does not agree with the expert, he has a duty to justify why he has rejected the expert’s evidence.

The expert can also be appointed to calculate damages caused by the infringement.

A panel consisting of three judges will take the decision.

The criterion for jurisdiction is based on the Brussels Regulation: the *forum commissi delicti* (the place where the infringing activity is carried out) or where damages have been incurred (Supreme Court decision 95/1996: where the initial damage occurred). If a nullity action is pending before a different court, staying of the proceedings is not compulsory. Invalidation will be decided in the same section of the proceedings, and the burden of proof is on the defendant.

Infringement may also be punished with a fine or imprisonment in criminal proceedings.

Nullity/counterclaim for revocation

A nullity action may be brought by any interested party or a public prosecutor (Art. 76 et. seq. IPA).

Nullity actions are judged by the same courts as infringement actions.

If the action is withdrawn, the proceedings may be continued.

Partial nullification is available; nullification has retroactive effect (*ex tunc*) (Art. 77 IPA).

The burden of proof lies with the person contesting the patent.

Post-grant patent claim amendment (limitation) is allowable even during nullity actions at every stage and level of the judicial proceedings (Art. 79 IPA).

Depending on the expert's opinion and the party's motion, the judge may also order the conversion of a null patent into another valid title (e.g. utility model), provided that the scope of protection is not extended (Art. 76 IPA).

Remedies

Urgent measures: description and/or seizure of products; prohibition of manufacture, trade and use of products; recall of products from trade; civil penalties for non-compliance with or delay in execution of court orders; order to provide information, including third parties acting on a commercial scale, on the origin and distribution networks of the goods or on the provision of services (discovery implementing the Enforcement Directive). Publication of the provisional order may also be granted and not only in newspapers but also on the homepage of the defendant's web site.

Final measures: definitive prohibition of manufacture, trade and/or use of the products; recall of products from trade; seizure of infringing products. With regard to machinery and products: removal or destruction; assignment in property to the right holder; seizure until the expiration date of the IP right; award of product to the right holder on payment of a price; publication of the decision, or destruction of infringing articles; civil penalties for non-compliance with or delay in execution of court orders. Publication of the decision, compensation for damages (calculated according to three alternative criteria: costs and loss of profits incurred by the IPR owner, disgorgement of the profits earned by the infringer, amount of negotiated or reasonable licence fees).

Other actions

Declaratory judgment on non-infringement is available, also as an urgent measure (Art. 76 et seq. IPA).

Appeal

Questions of both law and fact can be appealed to the territorially competent Court of Appeal (see "Civil procedure" above).

A collegiate body of three judges will review the decisions rendered by the Court of First Instance.

Further appeal: the Supreme Court (*Corte di Cassazione*) may review the decisions rendered by the lower courts exclusively on matters of law.

Access to the Supreme Court is also allowed with a view to enforcing "defects of reasoning", except in cases of "double conformity" (when an appeal decision is based on the same established facts as the first-instance decision). No specialist section has been established in the Supreme Court.

Parallel proceedings

When there are parallel proceedings (e.g. in case of EPO oppositions and/or appeals) between national courts and the EPO, the court may stay national proceedings or proceed to decide the case regardless of the outcome of the EPO proceedings (Art. 56 and 120 IPA): staying the national proceedings is not mandatory, because EPO divisions and the Boards of Appeal do not represent a "jurisdiction" and there is no relationship of a preliminary nature with them.

Arbitration/mediation

Arbitration may be resorted to. A judicial statement during the trial procedure is provided for, but it is not compulsory and is seldom successful.

As the decisions concerning liability and the calculation of damages may be separate, the parties often settle once liability has been decided on and before damages are calculated.

No specific arbitration or mediation authority is competent to deal with IPR disputes.

However, a patent can never be revoked by way of a settlement or a private resolution: only the judge is authorised to declare the invalidity of the patent with *erga omnes* effect.

Enforcement

Bailiffs at local courts of appeal are responsible for enforcing an order during the procedure (e.g. preliminary injunctions, orders for preserving evidence, freezing orders) and after termination or final decision of the court (e.g. orders for award of damages).

Compulsory licence

Compulsory licences may be granted by the Patent Office in cases of non-working and dependent patents. Inability to obtain a contractual licence must be proven. The owner and those who have the right to the patent may start opposition proceedings. If reconciliation between the parties on granting of a compulsory licence is unsuccessful, the Ministry of Economic Development will take a decision (Art. 70-73 IPA).

Relevant national law

Industrial Property Code - Codice della proprietà industriale, 2005 [cited as: IPA]; D. lgs. 10 February 2005, No. 30;

Legislative Decree of 27 June 2003, No. 168 – Institution of Specialized Courts for Industrial and Intellectual Property located at the Courts of Appeal and Tribunals according to Art. 16 of the Law of 12 December 2002, No. 273, as modified by Decree No. 1/2012, converted (with amendments) in Law No. 27/2012 (D.L. 24 January 2012, No. 1, supplemented by D.L. 24 March 2012, No. 29, and converted, with amendments, into Law 24 March 2012, No. 27, in force from 25 March 2012;

Legislative Decree of 19 February 2019, No. 18 – Implementation of enhanced cooperation in the area of the creation of unitary patent protection and implementation of the Agreement on the Unified Patent Court.

Competent authorities or courts



