

Italy jurisdiction report: Patent rights for self-employed workers

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In 2017, the Italian legislator approved the so-called ‘Jobs Act for Self-Employed Workers’, to shed some light on the ownership of patent rights when an R&D activity is outsourced.

In Italy, patent law is very targeted in order to protect investments. This is clear, first from article 64 of the Italian Industrial Property Code (IPC) which, as an exception to the basic inventor’s ownership of all the rights deriving from the invention, foresees several cases all united by the will to protect company investments.

In general, article 64 dictates that, if the employee has done the act of the invention taking advantage of the knowledge and/or material resources of the company, the company has at least a right of

options to buy the following patent.



More particularly, if said taking advantage can be correlated only to the membership of the employee to the company, without any causal relation between the specific work tasks of the employee and the act of the invention, the company has only the above-mentioned option.

An example of this is when the company is producing a machine for a technical function, the employee is an accountant of the company, and the machine invented by the employee is a machine for the same technical function.

If said taking advantage can be correlated also with the work experience of the employee, and therefore with at least a causal link between the specific work tasks of the employee and the act of the invention, all the rights deriving from the invention belong to the company.

In this latter case, if the act of the invention is explicit in the employment contract, in the sense that the latter literally establishes a general task of obtaining an invention and specifies an additional part of the salary for the same general task of obtaining the invention, separated from the other part of the salary, the company is not required to give any additional compensation for the patented invention.

In the example above, the latter situation occurs for example if the employee is a mechanical designer of the machine and the contract specifies an additional remuneration for the general task of obtaining new and original machines for the same technical function.

However, if the act of the invention cannot be explicitly referred to any part of the employment contract, the employee has a right to receive an additional remuneration for the obtained patent.

In the example above, the latter situation occurs for example if the employee is a worker for the assembly of the machine.

A different situation is when the act of the invention can be referred to a part of a commission contract between the contractor and the person having done the act of the invention. Italian jurisprudence was previously settled on the principle that all the rights deriving from the invention, in this case, belong to the contractor of the invention.

In the new Jobs Act, article 4 specifies that, in the case of a commitment contract with a self-employed person, all the rights deriving from the invention belong to the contractor only if the contract

specifies the inventive activity.

Starting from the fact that the experience and knowledge of the self-employed person can be considered as correlated to the past studies, training and experience in general of the self-employed person, this new law is a further element in favour of protection of investments in general.

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In fact, this new law imposes on the contractor the onus of specifying in the contract, with at least a certain degree of detail, the object of the invention to be obtained by the self-employed person, so as to alleviate at least in part the intellectual efforts which have to be done by the self-employed person for the fulfilment of the contractual obligations.

It is likely that the latter, where the contract is unclear or too general with regard to the object of the invention, has all the rights deriving from the invention. In this way it is more likely that the self-employed person is more conscious of the legal situation before starting the inventive activity.

It can be concluded that the new law helps even more to prevent everyone from parasitically taking advantage of investments of others, whether they are businesses or individuals.

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