



# Italy: Future changes to patent laws

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Simone Milli

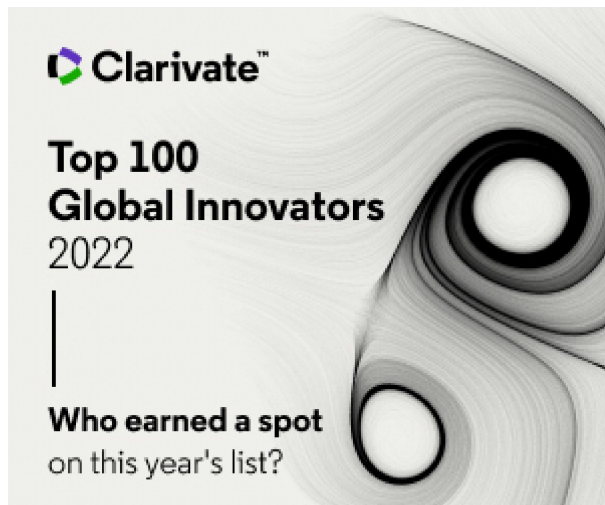


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The proposed new rules will bring the country into line with other European jurisdictions, explains Simone Milli of Bugnion.

On April 6, 2022, the Italian government presented a design of law (DDL) for changing the Italian Patent Code (CPI) which, once definitively approved by the Italian parliament, could change some aspects of the Italian patent attorney's profession, aligning for some further aspects the Italian Patent Code with the European Patent Convention.

Going into detail, we will briefly discuss the proposed changes we may see in the coming months once the law is finally approved.



The first change concerns article 148 CPI, which will be amended such that a patent application could obtain a filing date even without paying the filing fee at the time of filing, giving the applicant the opportunity to pay the filing fee within one month, as is possible for a European patent application.


This opportunity could be of interest to applicants in the obtaining of a so-called “provisional protection” by filing a first application (ie provisional application), for which the filing fees were not paid, and which could be later followed, within one month, by the filing of a second patent application claiming the priority of the first application.

Furthermore, article 198 CPI will be modified in the period for the extension abroad without an authorisation (for reasons of military interest). Such a period shall be shortened from 90 days to 60 days.

This change will give competitive strength to Italian companies in case they need to shorten the period to extend the patent abroad.

Regarding designs, a main change will concern the presentation of a product in an exhibition: article 34 will be modified such that temporary protection in the exhibition could be asked and the priority exhibition could be invoked for a later filing within six months.

Such change will be quite significant for the design law, since it will allow protection for the product in an exhibition and later a design application, as currently happens in some jurisdictions.

This will overcome the rejection of a design application for lack of novelty, following the exhibition in some countries (eg China). The cla  1 f the priority of exhibition will, in fact, adjust any validity legal issues in such countries.

An important change will concern the ownership of the patent application if the inventor is a university researcher or professor. This will reverse the “professor’s privilege” by establishing the ownership directly to the university and not to the researcher or professor. In this way, Italian patent law will fit the patent law of other European countries, wherein the patent right belongs to the university.

According to some IP experts, this could give value to the universities, which could acquire the patent rights and exploit them. In any case, the right to be named as the inventor of the patent application will be guaranteed to the university researcher or professor.

A new article 65bis will be added to the Italian Patent Code (CPI), which will regulate the possibility for the university to activate a knowledge transfer office for managing the IP assets.

Another important change concerns article 129 CPI, which will extend the right for the patentee to also seize goods in infringement of a patent during an exhibition. According to the current patent law, it is only possible to execute a judicial description during an exhibition—unless it is in a special case which relates to criminal acts. With this new provision, the patentee could easily enforce the patent during an exhibition, thus blocking any competitor offering products in infringement.

The Disegno di Legge [design of law] (DDL) further aims to protect the “made in Italy” logo, by modifying article 14 CPI forbidding the registration of trademarks which imitate protected geographical indications. Therefore, a further bar to trademark registration will be added.

Some further simplifications will be introduced concerning the patent proceedings before the Italian Patent and Trademark Office and the communication exchange with other Patent Offices. According to these simplifications, the process will be more digital, following a digital transformation.

*Simone Milli is a partner at Bugnion. He can be contacted at: [simone.milli@bugnion.eu](mailto:simone.milli@bugnion.eu)*

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