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## OFFICIAL CORRESPONDENT

**Davide Luigi Petraz** of GLP SrL is a qualified lawyer and registered patent and trademark attorney practising before the Italian Patent and Trademark Office, the EPO, the OHIM and the Patent Office of the Republic of San Marino. His practice focuses on handling IP legal issues and he has gained experience in international contracts and mediations. He is experienced also in drafting and prosecuting patents and trademarks, and managing issues related to internet domain names. He is author of a growing number of publications, meetings and conferences, training and master courses.



## Partnership to overhaul patent process

**Davide Luigi Petraz** of GLP SrL reports on an agreement between the EPO and the Italian Patent and Trademark office which will have a major impact on the Italian patent process

**A**s is known, until not long ago the patenting procedure in Italy – relating to applications for patents both for industrial invention and for utility models – did not provide any examination of validity by the Italian Patent and Trademark Office (UIBM).

From this it followed that there was a high probability for Italian patent applications, regardless of their contents, to be granted as patents, and their possible nullity – whether total or partial – had to be discussed, until 2003, before the judge of an Italian ordinary court and, after that date, before one of the 12 Italian courts specialized in industrial property.

Another consequence of that procedure was that Italy was often an extension country, but not a country where to file priority patent applications, if not because of specific and limited needs to acquire the priority date in Italy, for instance for a statutory obligation.

This situation now no longer exists, at least partially, and new patent protection opportunities can be considered.

Since July 1 2008 the patenting procedure without substantive examination has undergone an important change that will have effects both on the

administrative granting procedure of patent rights and on nullity proceedings – whether total or partial – before the Italian specialised judges, and not only.

Thanks to an agreement between the UIBM and the European Patent Office (EPO), patent applications having an Italian priority date will be subject to a prior art search.

The results of that search conducted by the EPO according to the methods typically in use at the EPO, in the form of a search report, are transmitted to the UIBM as soon as they are available and, in its turn, the UIBM transmits them to the applicant.

The results of that prior art search will be available to the applicant within a relatively short period of time, i.e. within the first nine months after the date of first filing of the patent application in Italy.

The search report will be absolutely similar to the one that we are used to receiving in relation to patent applications made on the basis of the European Patent Convention.

At least during the starting stage of the new patenting procedure in Italy, the search report should not be accompanied by any preliminary opinion. In this regard,

in fact, it is necessary to wait for the UIBM to acquire the competence required in terms of substantive examination; in addition to that, it is not yet clear if the contents of said preliminary opinion will have to be considered binding or not.

This important news affects only the new applications for patents for industrial invention and not the new applications for patents for utility models, which continue to be subject to the old procedure. It is remembered that in Italy a patent for a utility model must protect an innovation that improves the use of a machine or tool,

of prior art searches made by the EPO on the contents of Italian priority patent applications are borne by the UIBM, whereby this entails a considerable economic saving for the holders of said patent applications.

In addition to that, the priority filing in Italy, by offering the possibility to evaluate the results of a prior art search conducted by the EPO before the priority deadline, enables to act, prior to extension, on the contents of the patent application, in order to better adapt description and claims to the requirements that thus became apparent. It

**“The fact that the search report is made accessible to the applicant within nine months from the date of first filing will bring advantages to the patent applicants”**

contrary to patents for invention that are intended to protect inventions.

The procedure does not provide the possibility to do without said preliminary search and requires that upon the filing of an application for a patent for invention at least the patent claims be submitted, besides in Italian, also in English. This translation can be provided directly by the patent attorney, without entailing an increase in the filing fees, or it can be requested from the UIBM, whereby in this latter case the filing fees are increased by 200 Euro.

The fact that the search report is made accessible to the applicant within nine months from the date of the first filing will bring undoubted advantages to patent applicants who will choose Italy as the country of first filing. This advantage is available not only to Italian residents, but also to all companies – even if based outside Italy – that want to know in a relatively short time the patent feasibility of a new idea of solution. This advantage will prove particularly useful to all those companies that have Research & Development (R&D) centres located in different geographical areas and that need continuous monitoring of the patent feasibility of their research results.

This first consideration must be followed at least by another one. The costs

further enables to withdraw the application in secrecy, without letting competitors know this. Therefore, these possibilities thus offered entail a considerable saving in patenting procedures.

Besides the advantage offered by said prior art searches in view of the patent feasibility study of a new idea of solution, the prior art search can be used also for purposes other than those for which it was intended, such as, for instance, to evaluate the presence, or not, of an infringement.

The whole issue is then extremely important in Italy, where the judicial system allows the holder of a patent right – whether of a granted patent or of a patent in the application phase – to file legal actions for infringement, either ordinary or precautionary, such as technical judicial descriptions, seizures and injunctions, also *inaudita altera parte*, or else to file actions for negative ascertainment. ☺



Intellectual Property Office

