

Royal Decree No. 1127 of June 29, 1939, on Patents for Inventions *

(as last amended by Legislative Decree No. 198 of March 19, 1996)

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Title 1 Patent Rights

* *Italian title:* Regio Decreto 29 giugno 1939, N. 1127 (Testo aggiornato delle disposizioni legislative in materia di brevetti per invenzioni industriali).

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** This Table of Contents, as well as the Article titles, were added by the Italian authorities: they do not form part of the Law.

(Definition)

Art. 1. The rights inherent in a patent for an industrial invention consist of the exclusive right to work the invention and to profit from it in the territory of Italy, within the limits and under the conditions provided for by this decree.

This exclusive right shall extend also to trade in the product covered by the invention, but shall be exhausted after that product has been put on the market in the territory of Italy by the proprietor of the patent, or with his consent.

The exclusive right conferred by the patent right shall, regardless of the subject matter of the invention, not extend to:

- (a) acts done privately and for non-commercial purposes, or for experimental purposes;
- (b) the extemporaneous preparation for individual cases in a pharmacy of medicines in accordance with a medical prescription and to the medicines so prepared.

Art. Ibis. In particular, a patent shall confer the following exclusive rights on its owner:

- (a) where the subject matter of the patent is a product, the right to prohibit third parties who do not have his consent from making or using that product, placing it on the market, selling it or importing it for those purposes;
- (b) where the subject matter of the patent is a process, the right to prohibit third parties who do not have his consent from using that process and from using, placing on the market or selling the product obtained directly by that process, or importing it for those purposes.

Art. 2.—1. In the case of process patents, any product identical to that produced by the patented process shall be deemed, in the absence of proof to the contrary, to have been obtained by the patented process alternatively:

- (a) if the product obtained by the process is new;
- (b) if there is a genuine probability that the identical product was produced by the process and the owner of the patent has been unable, in spite of reasonable effort, to determine what process was actually used.

2. For the purposes of proving the contrary, due regard shall be had to the legitimate interest of the person accused of infringement in the protection of his manufacturing and business secrets.

(Authorization to Use)

Art. 3. When the proprietor of a patent covering a new industrial method or process supplies other persons with the means unequivocally intended to carry out the subject matter of the patent, he is presumed also to have granted such persons an authorization to use such method or process, provided that no agreements to the contrary have been entered into.

(Effects and Duration of the Patent; Availability to the Public)

Art. 4. The exclusive rights referred to in this decree shall be conferred by the grant of the patent.

The effects of the patent shall commence on the date on which the application accompanied by the specification and possible drawings is made available to the public. After a period of 18 months from the date of filing of the application, or from the date of priority, or after 90 days from the date of filing of the application, if the applicant declared in his application that he wished to make it immediately available to the public, the Italian Patent and Trademark Office shall lay the application, with the aforesaid attachments, open to the public.

With regard to persons whom the applicant notified of his application, with the specification and possible drawings, the effects of the patent shall commence on the date of such notification.

The patent shall have a term of 20 years as from the date of filing of the application and it may not be renewed, nor may its term be extended.

Art. 4bis.—(1) Proprietors of an industrial patent having effect in Italy and of which the subject matter is a medicine, a substance entering into the composition of a medicine, a use of a product as a medicine or a process for manufacturing a medicine may obtain a supplementary protection certificate once they have obtained registration for the purpose of marketing the medicine itself in accordance with Article 162 of the single text of the health provisions approved by Royal Decree No. 1265 of July 27, 1934, as replaced by Article 4 of Law No. 422 of May 1, 1941.

(2) Requests for a supplementary protection certificate must be filed by the proprietor of the patent with the Italian Patent and Trademark Office within 180 days of the date of the Ministerial Order issuing the initial marketing authorization referred to in paragraph (1) and, in any event, at least 180 days prior to expiry of the patent. If the initial marketing authorization referred to in paragraph (1) was issued prior to grant of the relevant patent, the request for a supplementary protection certificate must be filed within six months of the date of grant of the patent. The request must be filed directly with the Italian Patent and Trademark Office and must contain the particulars and documents required by Royal Decree No. 244 of February 5, 1940, as subsequently amended and supplemented.

(3) The Italian Patent and Trademark Office shall check that the request and the documents attached thereto are in order and shall be required to issue the supplementary protection certificate, or state its grounds for refusal, prior to expiry of the patent. In the event of refusal, an appeal shall lie to the Board referred to in Article 71. The Italian Patent and Trademark Office shall publish, in a monthly bulletin, a notification of the medicines for which supplementary protection certificates have been requested or issued and also of the relevant patents to which the requests for obtaining such certificates refer. The bulletin shall be made available to the public within the month following that during which the requests have been filed and the certificates issued.

(4) The legal arrangements governing patents and patent applications shall apply, with the same exclusive rights and obligations, to supplementary protection certificates to

requests therefor. A supplementary protection certificate shall have the same effects as the patent to which it refers, with regard to the part or parts thereof that concern the medicine that is the subject of the marketing authorization.

(5) Supplementary protection certificates shall take effect as from expiry of the statutory term of the patent for a term equal to the period of time that has elapsed between the filing date of the patent application and the date of the order issuing the initial authorization to market the medicine. The term of a supplementary protection certificate may in no case be more than 18 years as from the date of expiry of the statutory term of the patent. Where the request for a supplementary protection certificate has been filed within the prescribed time limits and has been published in the monthly bulletin and the supplementary protection certificate has still not been issued on expiry of the patent, the request shall be deemed provisionally to have the same effects as a supplementary protection certificate. The exclusive rights referred to in paragraph (4) shall be afforded on issue of the supplementary protection certificate.

(Authorization of Working)

Art. 5. The patent for an industrial invention, the working of which involves the working of inventions protected by prior, still valid patents for industrial inventions, may not be worked or used without the consent of the proprietors of such prior patents.

(Prior Use)

Art. 6. Any person who used an invention in his business in the 12 months preceding the date of filing of the patent application, or the date of priority, may continue to use it within the limits of such prior use.

This right may be transferred only together with the business in which the invention is being used. The burden of proving the prior use and its extent shall rest with the prior user.

Art. 6bis.—1. Without prejudice to the provisions of Article 2598, No. 3, of the Civil Code, the disclosure to third parties of business information, including commercial information lawfully within a competitor's control, or the acquisition or use of such information by third parties in a manner contrary to proper professional practice, shall constitute an act of unfair competition where the said information:

- (a) is secret in the sense that it is not, as a whole or in the precise configuration and arrangement of its elements, generally known or readily accessible to experts and operators in that sector;
- (b) has commercial value because it is secret;
- (c) is the subject of steps to be considered reasonably adequate to keep it secret, taken by the persons lawfully in control of it.

2. The disclosure to third parties, or the acquisition or use by third parties in a manner contrary to proper professional practice, of test data or other secret data the production of which has involved considerable effort and the submission of which is a condition of market approval for chemical, pharmaceutical or agricultural products that

make use of new chemical compounds shall be likewise considered an act of unfair competition.

(Rights of the Inventor)

Art. 7. All rights deriving from industrial inventions may be assigned and transferred, except the right to be recognized as the author thereof.

The right to be recognized as the author of an invention may, after the death of the inventor, be claimed by the person designated by the inventor for this purpose; in the absence of such designation, or after the death of the person so designated, the aforesaid right may be claimed by the spouse or by descendants to the second degree; in the absence, or after the death, of such persons, it may be claimed by the parents and other ascendants, and in their absence, or after their death, by relatives to and including the fourth degree.

Art. 8. [Repealed.]

Art. 9. [Repealed.]

Inventions of Interest for National Defense

(Examination of the Inventions)

Art. 10. When exhibitions are to be held in the territory of Italy, the Ministry of Defense shall have authority through its employees or officers to perform a detailed examination of the articles and inventions delivered for exhibition which may be considered useful for the military defense of the country; moreover, it shall have authority to gather information and request clarification regarding such articles and inventions.

The organizers of exhibitions must make available to the said employees or officers complete lists of any articles to be exhibited which relate to industrial inventions not protected under this decree.

The aforesaid employees and officers shall be entitled to prohibit the organizers from exhibiting any articles which they consider useful for the military defense of the country.

(Prohibition against Exhibition; Expropriation)

Art. 10bis. The Ministry of Defense shall give notice of such prohibition to the executive committee of the exhibition and other interested persons by means of a registered letter, with return receipt requested, warning them to comply with the obligation to secrecy. The executive committee of the exhibition shall keep the articles referred to in the last paragraph of the preceding Article and shall observe secrecy about their nature.

If the prohibition against the exhibition of articles is issued after such articles have been exhibited, they shall be withdrawn forthwith, without, however, imposing the obligation to secrecy.

For articles relating to inventions found useful for the military defense of Italy, the Ministry of Defense shall in any case have authority to expropriate the rights deriving from the invention in accordance with the provisions on expropriation set forth in this decree.

(Sanctions)

Art. 11. Failure to comply with the prohibition against the exhibition of the articles specified in Articles 10 and 10bis hereof shall render the persons responsible for the illegitimate exhibition liable to payment of a fine of from 10,000 lire to 5,000,000 lire.

Title II Subject Matter and Proprietor of the Patent

Chapter I: Subject Matter of the Patent

(Inventive Step and Industrial Application; Exclusions)

Art. 12. Any new invention involving an inventive step and susceptible of industrial application may form the subject matter of a patent.

The following in particular shall not be regarded as inventions within the meaning of the preceding paragraph:

- (a) discoveries, scientific theories and mathematical methods;
- (b) schemes, rules and methods for performing mental acts, playing games or doing business and programs for computers;
- (c) presentations of information.

The provisions of the preceding paragraph shall exclude patentability of the subject matter referred to therein only to the extent to which the patent application or the patent relates to discoveries, theories, schemes, rules, methods, and programs as such.

Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body shall not be regarded as inventions within the meaning of the first paragraph. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

(Public Order; Morality; Animal Varieties; Biological Processes)

Art. 13. Inventions the working of which would be contrary to public order or morality may not form the subject matter of a patent; the working of an invention shall not be deemed contrary to public order or morality merely because it is prohibited by law or regulation.

Nor may animal varieties and essentially biological processes for their production form the subject matter of a patent; this provision shall not apply to microbiological processes and the products thereof.

(Novelty; State of the Art)

Art. 14. An invention shall be considered to be new if it does not form part of the state of the art.

The state of the art shall be held to comprise everything made available to the public in the territory of Italy or abroad by means of written or oral description, by use or in any other way before the date of filing of the patent application.

Additionally, the content of Italian patent applications, or of European or international patent applications designating Italy, as filed, of which the dates of filing are prior to the date referred to in the preceding paragraph and which were published or made available to the public on or after that date, shall be considered as comprised in the state of the art.

The provisions of the preceding paragraphs shall not exclude the patentability of any substance or composition comprised in the state of the art, provided that it is intended for a new form of use.

(Prior Disclosure; Priority)

Art. 15. For the application of Article 14, a disclosure of the invention shall not be taken into consideration if it occurred in the six months preceding the filing of the patent application and if it was due to, or in consequence of, an evident abuse to the prejudice of the applicant or his legal predecessor.

The fact that the disclosure occurred at official or officially recognized exhibitions falling within the terms of the Convention on International Exhibitions signed at Paris on November 22, 1928, and its later revisions, also shall not be taken into consideration.

With respect to inventions for which priority is claimed under international conventions, the existence of the novelty requirement provided for under Article 14 must be evaluated with reference to the starting date of the priority.

(Inventive Step)

Art. 16. An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art includes documents within the meaning of Article 14, paragraph 3, these documents are not to be considered in evaluating inventive step.

(Industrial Application)

Art. 17. An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

Chapter II: Proprietor of the Patent

(Author of the Invention)

Art. 18. The right to a patent shall belong to the author of the invention and his successors in title, except as provided for in Articles 23, 24 and 26 hereof.

(Designation)

Art. 19. The applicant for a patent for an industrial invention may designate in his application one or more persons on whom he confers the rights in the patent, specifying the nature of such rights.

Such designations shall be entered in the Patent Register and the letters patent, provided that notice of the acceptance by the person so designated reaches the Italian Patent and Trademark Office prior to the grant of the patent.

(Several Inventors)

Art. 20. If an industrial invention has been developed by several persons, the rights deriving from the patent shall, unless otherwise agreed upon, be regulated by the provisions of the Civil Code on joint ownership.

Except for agreements to the contrary, the assignment of patent rights shall impose on the assignee the obligation to pay the fees due; if rights are assigned to several persons, either jointly or proportionally, all of them shall be jointly liable to the payment of such fees.

(National Treatment)

Art. 21. Foreigners may obtain patent rights for an industrial invention on the same terms and conditions as those fixed for Italian citizens.

Any benefits which foreigners presently enjoy, have enjoyed or will enjoy in the territory of Italy under international conventions with regard to patents on industrial inventions shall be extended to Italian citizens.

(Employees of the Italian Patent and Trademark Office)

Art. 22. Employees of the Italian Patent and Trademark Office may not, either directly or indirectly, apply for patents for industrial inventions, or become assignees thereof, until two years after the date of termination of their employment at the Office.

(Employee Inventors)

Art. 23. When an industrial invention is developed in the course of the performance or fulfillment of an employment contract or relationship in which the inventive activity forms the purpose of the contract or relationship, and the activity is compensated accordingly, the rights deriving from the invention shall belong to the employer, without prejudice to the right of the inventor to be recognized as such.

If no compensation is stipulated and fixed for the inventive activity and the invention has been developed in the course of the performance or fulfillment of an employment contract or relationship, the rights deriving from the invention shall belong to the employer, but the inventor shall, in addition to his right to be recognized as such, be entitled to fair compensation, the amount of which shall be commensurate with the value of the invention.

(Right of Preemption of the Employer)

Art. 24. If the conditions provided for in the preceding Article do not exist, but the industrial invention falls within the field of activity of the private enterprise or the public administration in which the inventor is employed, the employer shall have a right of preemption with regard to the exclusive or non-exclusive use of the invention or to the acquisition of the patent as well as the right to apply for or acquire patents for the same invention in foreign countries, against payment of a royalty or price to be fixed after deduction of an amount equivalent to the value of such assistance as the inventor may have received from the employer in the development of the invention.

The employer may exercise the right of preemption within three months from receipt of the notice informing him of the grant of the patent.

The relationship ensuing from the exercise of the right of preemption provided for in this Article shall terminate *de jure* if the fixed compensation is not paid in full by the date on which it is due.

(Arbitration)

Art. 25. If, in the cases provided for by the preceding Articles, no agreement can be reached on the compensation, royalty or price, or on the terms and conditions relative thereto, a decision thereon shall be taken by a Board of Arbitration consisting of three members, one to be appointed by each of the parties and the third by the first two, or, in case of disagreement, by the President of the court of the place where the employee ordinarily performs his duties.¹

If the inventor is a government employee, the compensation, royalty or price, and the terms relative thereto, shall be determined, instead of by a Board of Arbitration, by the Minister heading the respective administration, from whose decision no appeal may be taken.

(Inventions Made in the Framework of an Employment Contract)

Art. 26. For the purposes of the preceding Articles, an industrial invention shall be considered as developed during the performance of an employment contract or relationship, when a patent for the invention has been applied for within one year from the date on which the inventor left the service of the private enterprise or public administration in whose field of activity the invention falls.

Title III Application for Examination and Grant of the Patent

(Filing of the Application)

Art. 27. A patent application may be filed by any person entitled thereto under this decree.

¹ The first paragraph of Article 25 has been declared unconstitutional by the Italian Constitutional Court insofar as the inventor or the employer is not entitled to bring legal proceedings before the ordinary courts (Decision No. 127 of July 1977) (*Editor's note*).

In the proceedings before the Italian Patent and Trademark Office, the applicant shall be deemed to own the right to the patent and to be entitled to exercise it.

(Rights Belonging to a Person Other than the Applicant)

Art. 27bis. If by a final decision it is adjudged that the right to the patent belongs to a person other than the applicant, that person may, provided that the patent has not yet been granted and within three months after the decision has become final, at his discretion:

- (a) prosecute the patent application in his own name, assuming for all purposes the quality of the applicant;
- (b) file a new patent application, which, to the extent to which its contents do not go beyond those of the first application, shall be effective as of the filing date, or the priority date, of the original application, which shall in any case cease to produce effects;
- (c) cause the application to be refused.

If the patent has already been granted to a person other than the one entitled to it, the latter may, at his discretion:

- (a) cause the patent to be transferred to his name by a decision having retroactive effect;
- (b) claim nullity of the patent granted to a person not entitled to it.

If two years have elapsed from the date of publication provided for by Article 38, paragraph 1, and the person entitled to the patent has failed to exercise any of the rights provided for in the preceding paragraph, any interested person may claim nullity of the patent granted to a person not entitled to it.

(Filing with Industrial Property Offices of Foreign States)

Art. 27ter. If the persons referred to in the preceding Article are residing in the territory of Italy, they may not, without authorization from the Ministry of Industry, Commerce and Handicrafts, file their patent applications exclusively with the offices of foreign countries, or file such applications with such offices earlier than 90 days from the filing date in Italy, or the filing date of a petition for the aforesaid authorization.

The aforesaid Ministry shall decide the petitions for the grant of the authorization after obtaining an opinion thereon from the Ministry of Defense. If no denial is issued within a period of 90 days, the authorization shall be deemed to be granted.

Any violation of the provisions contained in the first paragraph of this Article shall, unless it constitutes a heavier offense, be penalized with a fine of not less than 30,000 lire, or with imprisonment.

If the violation was committed after denial of the authorization, imprisonment for not less than one year shall be imposed.

(Disclosure of the Invention; Microbiological Inventions; Documents to be Submitted)

Art. 28. Patent applications for industrial inventions shall be accompanied by a specification and the drawings required for their understanding.

The invention must be disclosed in a manner sufficiently clear and complete for it to be carried out by any person skilled in the art and must bear a title corresponding to its subject matter.

If an invention concerns a microbiological process or the product thereof and involves use of a microorganism which is not available to the public and which cannot be disclosed in such a manner as to enable a person skilled in the art to carry out the invention, the patent application must, with regard to the specification, comply with the rules established in the regulations hereto.

If priority is claimed on the grounds of an earlier application, the applicant shall submit to the Italian Patent and Trademark Office the documents and data proving the existence of such priority.

(Unity of Invention)

Art. 29. Each application shall relate to one invention only.

If an application relates to several inventions, the Italian Patent and Trademark Office shall request the applicant to limit his application to one of the inventions within a fixed deadline; the applicant shall have the right to file, for the remaining inventions, as many applications as necessary, which shall be effective as of the filing date of the original application.

Appeals to the Board of Appeals provided for by this decree shall suspend the deadline fixed by the Italian Patent and Trademark Office.

Art. 30. [Repealed.]

(Examination of the Application)

Art. 31. The examination of the application, the formal correctness of which has been recognized and the title of which has been found to correspond with the subject matter of the invention, shall be aimed at ascertaining whether the invention meets the provisions of Article 12 and is not in conflict with those of Article 13 hereof.

The examination shall not concern itself with the technical or economic value of the invention.

If the aforesaid conditions are found not to have been met, the Italian Patent and Trademark Office shall reject the application.

Art. 32. [Repealed.]

(Notice Concerning Working)

Art. 33. All patents issued by the Italian Patent and Trademark Office shall bear a notice to the effect that the inventions which are the subject matter thereof may be worked only in compliance with the laws and regulations concerning the production of and trade in the products covered by the inventions.

Art. 34. [Repealed.]

(Notice of Total or Partial Rejection of the Patent Application)

Art. 35. Notice of the decision in which the Italian Patent and Trademark Office rejects the application, or grants it only in part, shall be given to the applicant, who shall have the right to file an appeal against the same within a period of 30 days from the date of such notice.

The inventor, whose request for the entry of his name in the Patent Register and the letters patent has been rejected by the Italian Patent and Trademark Office, shall have the right to appeal within the same period of time.

(Appeals)

Art. 36. Appeals shall be decided by the Board of Appeals provided for in Article 71 of this decree, which Board shall render its decisions after hearing the interested parties, or their appointees or representatives, and considering their written arguments.

The appeal provided for by the second paragraph of the preceding Article shall not interrupt the prosecution of the procedure for the grant of the patent, without prejudice to the right of the inventor to have his name entered in the Patent Register and the letters patent.

(Legal Actions Concerning the Validity of the Patent)

Art. 37. The grant of the patent shall not prevent the institution of legal actions concerning the validity of the patent and the rights deriving from the invention.

(Publication and Notification)

Art. 38. The Italian Patent and Trademark Office shall publish a notice of all patents granted in the Patent Bulletin provided for in Article 97 hereof.

After the grant of the patent, the specification and drawings laid open to the public shall be printed.

The printed copy and the publication of the Bulletin shall include the name of the inventor.

(Designation of the Inventor)

Art. 39. The Italian Patent and Trademark Office shall not verify whether the designation of the inventor is correct.

An incomplete or incorrect designation of the inventor may be rectified only upon request, accompanied by a declaration of consent of the person previously designated and, in the event of the request not being filed by the applicant or the proprietor of the patent, also by a declaration of consent of the latter.

In the event of a third party filing with the Italian Patent and Trademark Office a final decision whereby the applicant for, or proprietor of, a patent is required to designate

him as the inventor, the Italian Patent and Trademark Office shall enter his name in the Patent Register and publish a notice thereof in the Bulletin.

The provisions of Articles 35 and 36 shall be valid in the cases referred to in the preceding paragraphs, to the extent to which they are applicable.

Art. 40. [Repealed.]

(Postponement of the Grant of the Patent)

Art. 40bis. At the request of foreign States which grant reciprocal treatment to Italy, the Ministry of Defense may request the postponement, for a period which may also exceed three years, of the grant of the patent and of any publication relating to the invention for patent applications already filed in foreign countries where they are subject to compliance with the obligation to secrecy.

Possible indemnities shall be paid by the foreign State which made the request.

(Obligation to Secrecy Concerning the Patent of Which the Grant is Postponed)

Art. 41. The invention shall be kept secret after notice is given of the request for postponement and for the entire duration of the postponement, as well as during the expropriation procedure and after the decree relating thereto is issued, if it provides for an obligation to secrecy.

The invention must also be kept secret under the conditions provided for by the preceding Article 10, paragraph 2, after service of notice on the interested person of the decision ordering to proceed with expropriation under an obligation to secrecy.

The obligation to observe secrecy shall be lifted, however, if the competent Ministry so permits.

Any violation of secrecy shall be punished in accordance with Article 262 of the Penal Code.

Art. 42. The aforementioned Ministries and the establishments subordinate thereto may request that the patent applications for industrial inventions filed by them be kept secret.

Art. 43. If, for an invention of interest to the military defense of Italy, the competent Ministry requests or, in case of postponement as provided for by Article 40,² consents to its grant, the procedure relative thereto shall, at the request of the Ministry, be conducted in secret. In such case, no publication shall take place, and the public inspection referred to in this decree shall not be allowed.

Title IV Patent Fees

(Kinds of Fees)

² This Article has been repealed; see, however, Article 6 of Decree of the President of the Republic No. 540 (see *Industrial Property Laws and Treaties*, ITALY — Text 1-004) (*Editor's note*).

Art. 44. Patents for industrial inventions shall be subject to payment of the following fees:

- (1) an application fee;
- (2) an annual fee to be paid to maintain the validity of the patent;
- (3) a fee for the printed publication of the specification and drawings.

Art. 45. [Repealed.]

(Rejection and Withdrawal of the Application; Refund of Fees)

Art. 46. The application fee, the annual fee for the first three-year period and the printing fee shall be paid prior to the filing of the application.

If the application is rejected or withdrawn before the patent is granted, the amounts paid shall be refunded, except the application fee.

(Subsequent Annual Fees)

Art. 47. The annual fees due after payment of the first three-year fee shall be paid in advance within the same month as the one in which the application was filed. After expiration of this term, payment shall be allowed within the following six months, with imposition of an additional fee.

Any number of annual fees may be paid in advance.

(Due Dates)

Art. 48. Within four months following the date on which the patent was granted, any annual fee possibly due, or falling due, within such period may be paid without imposition of the additional fee.

After expiration of this term, payment shall be allowed within the following six months with imposition of the additional fee.

(Excusable Mistake; Belated Regularization)

Art. 49. If the incomplete or otherwise irregular payment of an annual fee is due to an obvious mistake or another excusable reason, the Italian Patent and Trademark Office may, at the request of the interested person, permit a belated payment, or regularization of the payment.

If the Italian Patent and Trademark Office rejects such request, the interested party may appeal to the Board of Appeals within 30 days from the date on which he was given notice of the rejection.

(Offer of Non-Exclusive Licenses; Effects; Compensation)

Art. 50. If no exclusive license is recorded, the applicant for, or the proprietor of, a patent may, in his application or in a written statement addressed to the Italian Patent and Trademark Office, offer the public a license for the non-exclusive use of the invention.

Such license shall take effect from the date on which the proprietor is notified that his offer has been accepted, even if the compensation has not been accepted. In this case, its amount and the terms of payment shall be determined by a Board of Arbitration, consisting of three members, one to be appointed by each of the parties and the third by the first two or, in case of disagreement, by the President of the Board of Appeals. The Board of Arbitration shall base its award on a fair evaluation. If its award is clearly unfair or wrong or if one of the parties refuses to appoint its arbitrator, the matter shall be decided by a judge.

If circumstances have arisen or become known which render the compensation already determined obviously inappropriate, the compensation may be reviewed in the same manner as provided for the original compensation.

The applicant for, or the proprietor of, a patent who offered the public a license under his patent shall be entitled to a 50% reduction of the annual fees. Such reduction shall be granted by the Italian Patent and Trademark Office. The statement of the offer shall be entered in the Patent Register and published in the Bulletin, and its effects shall last for as long as the offer is not withdrawn.

(Indigent Inventor)

Art. 51. The Ministry of Industry, Commerce and Handicrafts may exempt an inventor who proves that he is indigent from payment of the printing fee and may authorize him to suspend payment of annual fees for the first five years. If, upon the expiration of the fifth year, the inventor wishes the patent to remain in force, he shall be required to pay not only the annual fee for the sixth year, but also all the arrears; failure to make such payments shall entail forfeiture of the patent, whereafter the inventor shall not be obligated to pay the fees for the years already elapsed.

Title V Working, Forfeiture, Waiver and Nullity of the Patent

(Working of the Invention)

Art. 52. The industrial invention which forms the subject matter of a patent must be worked in the territory of Italy to an extent not seriously disproportionate to the needs of the country.

Inventions concerning objects which appear for the first time at an official, or officially recognized, exhibition held in the territory of Italy, shall be deemed to be worked from the date they were introduced into the exhibition until its closing date, provided that they have been exhibited for not less than 10 days, or, in case the duration of the exhibition is shorter, for its entire duration.

Art. 53. The introduction or sale on the territory of the State of goods produced in States other than Member States of the European Union or of the World Trade Organization shall not constitute working of an invention.

Art. 54.—1. Where, after three years have elapsed from the date of grant of a patent, or four years from the filing date of the application if the latter period expires after the former, the owner of the patent or his successor in title has not worked the patented

invention, either directly or through one or more licensees, by producing in the territory of the State or importing goods produced in a Member State of the European Union or of the World Trade Organization, or else has worked the said invention to an extent that is seriously disproportionate to the needs of the country, a compulsory license for the non-exclusive use of the invention may be granted to any person applying therefor.

2. A compulsory license under paragraph 1 may also be granted:

- (a) where the working of the invention has for more than three years been suspended or so reduced that it is seriously disproportionate to the needs of the country;
- (b) where the patented invention cannot be worked without prejudicing the rights in a patent granted on an earlier application. In that case a license may be granted to the owner of the later patent to the extent necessary for the exploitation of the corresponding invention, provided that the latter represents important technical progress of considerable economic significance in relation to the invention claimed in the earlier patent. Without prejudice to the provisions of paragraph 5 of Article 54bis, the license so obtained shall be non-assignable unless the patent relating to the subsequent invention is assigned with it. The owner of the patent relating to the first invention shall be entitled, in his turn, to a compulsory license on reasonable terms for the use of the patent relating to the subsequent invention.

3. Any person who applies for a compulsory license under the foregoing paragraphs shall prove that he has first approached the owner of the patent and failed to obtain a contractual license from him on reasonable terms and conditions.

4. The provisions of this Article shall not apply to patented inventions belonging to the Military Administration or to those kept secret under Article 41 of this Decree.

(Refusal of the Compulsory License; Equitable Compensation; Counterfeits; Legal Proceedings)

Art. 54bis. A compulsory license shall not be granted if the failure to work the patented invention, or to work it adequately, is due to causes beyond the control of the proprietor of the patent or his successor in title. Such causes shall not include the lack of financial means, and, if the product is widely circulated in foreign countries, the lack of demand on the domestic market for the patented product, or the product obtained by the patented process.

A compulsory license may be granted only against payment of fair compensation by the licensee to the proprietor of the patent or his successor in title, and on condition that the person applying for the license gives the necessary guarantees that the invention shall be worked satisfactorily in accordance with the terms laid down in the license.

A compulsory license may be granted where the working of an invention is intended mainly to supply the domestic market.

A compulsory license may not be granted to a counterfeiter of an invention.

Compulsory licenses may be granted for a period not exceeding the remaining duration of the patent, and, except with the consent of the proprietor of the patent or his successor in title, may be transferred only together with the licensee's business, or with the particular branch of the business in which the license is used.

The grant of a compulsory license shall not prevent the institution of legal proceedings concerning the validity of the patent or the rights deriving therefrom, including actions instituted by the licensee.

(Obligation to Work the Invention; Lapse of the Patent)

Art. 54ter. The grant of a compulsory license shall not exempt the proprietor of the patent or his successor in title from the obligation to work the invention.

The patent shall lapse if the invention is not worked within two years from the grant of the first compulsory license or has been worked on an extent seriously disproportionate to the needs of the country.

Art. 54quater.—1. The decree granting the license shall specify the scope, duration and manner of the exploitation, the guarantees and other conditions to which the grant is subject in relation to its purpose, the amount of the remuneration and the conditions of payment. In the event of opposition, the amount of remuneration and the conditions of payment shall be determined by paragraph 2 of Article 50.

2. The license conditions may, by decree of the Minister of Industry, Commerce and Handicraft, be changed at the request of any of the parties concerned where there are reasonable grounds for doing so.

3. Paragraph 3 of Article 50 shall apply to changes in the remuneration payable.

4. A license shall be revoked by decree of the Minister of Industry, Commerce and Handicraft whenever the conditions governing the working of the invention are not complied with or the licensee has not paid the remuneration in the specified amount and manner. If the owner of the patent in respect of which a compulsory license has been granted, or his successor in title, has authorized third parties to use that patent on conditions more favorable than those of the compulsory license, those more favorable conditions shall be extended to the compulsory license at the request of the licensee.

5. The communication of adopted measures to the parties concerned shall be the responsibility of the Italian Patent and Trademark Office.

6. The decree granting the license, that concerning any changes in the licensing conditions and that revoking the license, and the fixing of or any change in the remuneration payable shall be published in the *Patent Bulletin* and entered in the Patent Register.

Art. 54quinquies.—1. A compulsory license shall also be revoked by decree of the Minister of Industry, Commerce and Handicraft, if and when the circumstances that gave rise to the grant thereof no longer obtain and are unlikely to recur.

2. The patent owner may seek revocation by applying to the Italian Patent and Trademark Office, which shall promptly communicate it, by registered letter with advice of receipt, to the holder of the compulsory license. The latter may, within 60 days of

receiving the registered letter, lodge a reasoned objection to such revocation with the Italian Patent and Trademark Office. Articles 4 and 5 of Presidential Decree No. 360 of April 18, 1994, shall apply.

3. In the event of revocation, the person who had previously been granted the license may work the invention on the same conditions within the limits of the prior use or within those determined by genuine and effective preparations.

Art. 54sexies. [Repealed.]

(Lapse of the Patent)

Art. 55. The patent shall lapse for failure to pay the annual fees within six months from the date on which they are due as provided for in the following Articles.

(Procedure for Lapse)

Art. 56. If, after termination of the month in which the annual fee was due and of the succeeding six months referred to in Article 47 and, in general, of the term within which payment of the fees is required, the annual fee is not paid, the Italian Patent and Trademark Office shall notify the interested person by registered mail that the payment of the fee due does not appear to have been effected in time.

Thirty days after the date of such notice, the Italian Patent and Trademark Office shall enter in the Patent Register the lapse of the patent due to non-payment of the annual fee and thereafter publish notice of such lapse in the Patent Bulletin.

(Appeal Against Lapse)

Art. 57. If the proprietor of the patent is in a position to prove that he made the payment in time, he may, within six months from the publication in the Bulletin, appeal to the Board of Appeals for cancellation of the aforesaid entry of lapse and for correction of the publication. The Board shall render its decision after hearing the interested person or his agents, and considering any written arguments which they may have filed.

Both the filing of the appeal and the decree of the decision shall be entered in the Patent Register and notice thereof shall be published in the Bulletin.

(Presumption of Lapse)

Art. 58. After the publication referred to in Article 56 and upon termination of six months following its date, or after rejection of the appeal, the patent shall be deemed to have lapsed as of the end of the last year for which the fee was paid in time.

(Grounds of Nullity of the Patent)

Art. 59. A patent shall be null and void if:

- (1) the invention is not patentable within the terms of Articles 12, 13, 14, 16 and 17;
- (2) the invention is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

- (3) the subject matter of the patent extends beyond the content of the application as originally filed;
- (4) the proprietor of the patent was not entitled to obtain the patent and the inventor has failed to exercise the rights provided for in Article 27bis.

If the aforesaid grounds of nullity affect the patent only partially, the decision declaring such partial nullity shall involve a corresponding limitation of the patent.

A patent which is null and void may have the effects of a different patent whose conditions of validity it fulfills and which the applicant would have wished to obtain if he had been aware of its nullity. The decision stating the conditions of validity for the different patent shall provide for the conversion of the patent which is null and void.

If the conversion entails an extension of the original duration of the patent which is null and void, the licensees and the persons who, with a view to the forthcoming expiry, had made serious and effective investments in order to use the subject matter of the patent, shall have the right to obtain, free of charge, a non-exclusive compulsory license for the extended duration.

(Effects of a Declaration of Nullity)

Art. 59bis. Decisions pronouncing the nullity of a patent shall be retroactive, but shall not affect:

- (a) any acts already performed enforcing any decision on infringement which has acquired the authority of a final decision;
- (b) any contracts concerning the invention which were concluded prior to the date on which the decision pronouncing the nullity has become final, insofar as such contract has been performed before that decision. However, in such case, repayment to an extent justified by the circumstances, of sums paid under the relevant contract, may be granted by the court on the grounds of equity.

(Effects of the Surrender of the Patent)

Art. 59ter. The proprietor of the patent may surrender his patent by means of an instrument received by the Italian Patent and Trademark Office for entry in the Patent Register.

If, in respect of the patent, acts or decisions are recorded which establish or ascertain third-party *in rem* rights inherent in the patent, or the institution of legal proceedings is recorded in which the establishment or acknowledgment of such rights is claimed, the surrender shall be effective only if it is accompanied by the written agreement of such third parties.

(Limitation of the Patent)

Art. 59quater. The patent may be limited at the request of the proprietor who shall attach an amended specification and drawings to his request.

If the Italian Patent and Trademark Office grants the request, the petitioner shall again pay the fee provided for under Article 44(3), if the patent originally granted has already been printed.

The petition for limitation of a patent cannot be granted if a legal action for nullity of the patent is pending, and for as long as a decision on such action has not become final. Nor can it be granted if the persons referred to in Article 59ter, paragraph 2, have failed to give their consent.

The Italian Patent and Trademark Office shall publish a notice of the limitation of patents in the Patent Bulletin.

Title VI Expropriation

(Military and Public Interest)

Art. 60. Patent rights, inclusive of rights deriving from pending applications, may be expropriated by the State in the interest of the military defense of the country or for other reasons of public interest.

Expropriation may be limited to the right to use the invention in the interest of the State, without prejudice to the provisions of Article 54quater and such subsequent Articles as may be compatible.

When expropriation takes place in the interest of the military defense and concerns patents owned by Italian citizens, it shall transfer to the expropriating administration also the right to apply for patents in foreign countries, unless the administration surrenders or limits this right.

(Expropriation Decree)

Art. 61. Expropriation shall be carried out by decree of the President of the Republic, upon the proposal of the competent Minister, with the agreement of the Ministry of Industry, Commerce and Handicrafts and the Minister of Finance, and, if the measure concerns the military defense of the country, after consultation with the Council of Ministers or, in all other cases, with the Board of Appeals.

If the decree ordering expropriation in the interest of the military defense of the country is issued prior to the printing provided for in Article 38, it may impose secrecy regarding the subject matter of the invention and fix the duration of this obligation.

Any violations of secrecy shall be penalized as provided for in Article 262 of the Penal Code.

(Compensation for Expropriation)

Art. 62. The decree ordering expropriation for reasons of public interest shall also determine the compensation to which the proprietor of the patent shall be entitled, after consultation with the Board of Appeals; if expropriation is carried out in the interest of the military defense of the country, the compensation may, on the contrary, be fixed subsequently.

(Arbitration to Determine Compensation)

Art. 63. The compensation for expropriation carried out in the interest of military defense shall, if not agreed upon by the parties, be fixed by an arbitrator named by them. If the parties cannot reach an agreement on the arbitrator to be chosen, the compensation shall be fixed by a board of arbitration consisting of three members, one chosen by the person whose patent rights are being expropriated, one by the Ministry which proposed the expropriation and the third, who shall function as chairman, by the other two arbitrators or, in case of disagreement, by the Minister of Industry, Commerce and Handicrafts. The arbitrators, except the arbitrator named by the expropriating administrative department, shall be selected from among those persons figuring in the professional registers. The rules governing the arbitration procedure and payment of the costs shall be fixed by regulation.

(Award; Deposit; Delay and Equitable Indemnity)

Art. 64. The award shall be deposited with the Ministry of Industry, Commerce and Handicrafts within three months from the date of the arbitrator's acceptance of his nomination, or of the formation of the board of arbitration. A single extension of not more than three months shall be allowed. The award shall be kept secret if so requested by the expropriating Ministry, and no appeal may be taken from it. At the request of an interested person, the Ministry of Industry, Commerce and Handicrafts shall issue a certificate of deposit of the award stating the amount to be paid and the name of the payee.

An equitable indemnity shall be paid to the inventor able to prove loss of priority rights abroad due to the Ministry's delay in deciding against the expropriation, after compliance with the provisions of this and the preceding Articles.

(Appeal Against Expropriation; Exclusion; Notations)

Art. 65. Appeals may be taken to the Council of State from expropriation decrees based on reasons of public interest, except in controversies involving the amount of compensation, which shall come within the competence of the judicial authority.

No appeal may be taken, however, from expropriations ordered in the interest of military defense.

The Patent Office shall enter notations of all expropriation decrees in the Patent Register.

Title VII Recordings

(List of Acts to be Recorded)

Art. 66. The following documents shall be made public by means of being recorded in the Italian Patent and Trademark Office:

- (1) *inter vivos* deeds, with or without consideration, which cover assignments, in whole or in part, of rights in Italian patents on industrial inventions;

- (2) *inter vivos* deeds, with or without consideration, which establish, modify or transfer rights of enjoyment, *in personam* or *in rem*, or rights of security established in the aforesaid patents in accordance with Article 69 hereof;
- (3) deeds of division, corporate documents, settlements and surrenders, relative to the rights referred to at the two preceding numerals;
- (4) bills of attachment;
- (5) official reports on awards following forced sales;
- (6) official reports on suspensions of sales of portions of attached patents which are to be returned to the debtor in accordance with the Code of Civil Procedure;
- (7) expropriation decrees based on the public interest;
- (8) court decisions which declare the existence of the documents listed under (1), (2) and (3), when such deeds have not been recorded already.

All court decisions pronouncing the nullity, invalidation, termination, rescission, or revocation of a recorded document shall be entered in the margin of the record of the document to which such decisions refer.

Petitions addressed to the court in order to obtain the decisions provided for in this Article may also be recorded. In this case the recording of the decision shall take effect from the date on which the petition was recorded;

- (9) last wills and testaments and any documents which prove legitimate succession as well as any court decisions relative thereto;
- (10) the court decisions referred to in Article 27bis and any petitions filed in court in connection therewith;
- (11) the decisions referred to in Article 59, third paragraph, and the relevant demands filed with the courts.

(Recording Procedure; Refusal; Appeals)

Art. 67. Recordings shall be subject to payment of the prescribed fee.

To obtain a recording, the person requesting it shall file an application accompanied by an authenticated copy of the public document or by the original or an authenticated copy of the authenticated private document. Where authentication is not possible, the Italian Patent and Trademark Office may authorize the recording of an unauthenticated private document.

After examining the formal regularity of the documents, the Italian Patent and Trademark Office shall promptly proceed with the recording under the date on which the application was filed.

If the Italian Patent and Trademark Office rejects the application, the applicant may, within 30 days, appeal to the Board of Appeals, which shall decide the matter in a fully substantiated decision after hearing the applicant, or his agent, and taking into account any written arguments which may have been submitted.

Recordings shall be effected in the chronological order in which applications are filed.

Omissions or inaccuracies shall not affect the validity of a recording, provided that they do not create total uncertainty about the document to be recorded, or about the patent referred to in it.

(Effects of the Recording)

Art. 68. The documents and court decisions referred to in Article 66, except last wills and testaments and the documents and court decisions referred to under items (4), (9) and (10), shall, as long as they have not been recorded, not be effective against third parties who have in any way acquired and lawfully maintained rights in the patent.

Where several persons acquired the same right from the same patentee, the person who first recorded his title of acquisition shall enjoy priority.

Recordings of bills of attachment shall, as long as the attachment is in force, suspend the effects of later recordings of the aforesaid documents and court decisions; the effects of such recordings shall become void after the award has been recorded, provided that such recordings take place within three months from the date of the award.

Last wills and testaments and the documents which prove legitimate succession as well as the court decisions relative thereto shall be recorded only in order to ensure the continuity of transfers.

(Rights of Security in Patents; Cancellation of Recording)

Art. 69. Rights of security in patents for industrial inventions must be established through cash credits. Any amounts of such credits not expressed in Italian currency shall, at the time of recording, be converted into the equivalent amount in lire.

Where more than one right of security exists, their rank shall be determined by the order in which such rights were recorded.

Recordings of rights of security shall be canceled upon filing the deed of consent issued by the creditor, whose signature must be authenticated, or when the cancellation was ordered in a court decision which has become final, or after satisfaction of the rights of security as provided for by Article 87 hereof.

For cancellation, the same fee shall be due as the fee provided for recordings.

Title VIII Administrative and Jurisdictional Provisions

(Competence of the Italian Patent and Trademark Office; Organization and Operation)

Art. 70. The services concerned with the matters regulated by this decree shall be rendered by the Italian Patent and Trademark Office for Inventions, Models and Trademarks at the Ministry of Industry, Commerce and Handicrafts.

The rules concerning the organization and operation of the Italian Patent and Trademark Office shall be issued by Decrees of the President of the Republic upon proposal by the Minister of Industry, Commerce and Handicrafts with the agreement of the Minister of Finance, as provided for in Article 1 of Law No. 100 of January 31, 1926.

(Board of Appeals; Composition)

Art. 71. Decisions on appeals from acts of the Italian Patent and Trademark Office provided for by this decree shall be rendered by a Board of Appeals consisting of a chairman and four members chosen, after consultation with the Ministry of Justice, among magistrates with a rank of not less than appellate judge, or from among professors of law at universities or high government institutions. The members of the Board of Appeals, and its Chairman, shall be appointed by decree of the Minister of Industry, Commerce and Handicrafts for a term of two years and shall be eligible for reappointment. Experts chosen by the Chairman among professors at universities or high government institutions may be attached to the Board of Appeals to examine specific questions submitted to the Board. Such experts shall not be entitled to a deliberative vote.

The Director of the Italian Patent and Trademark Office shall be a member of the Board of Appeals, but shall not be entitled to a deliberative vote.

The Board of Appeals shall also function in an advisory capacity at the Ministry of Industry, Commerce and Handicrafts on questions concerning patents of invention.

The compensation of the members of the Board, of the members of the secretariat of the Board and of the experts attached to the Board who present reports on specific questions shall be determined every two years by decree of the Minister of Industry, Commerce and Handicrafts in consultation with the Minister of the Treasury.

(Functioning of the Board of Appeals)

Art. 72. In its decisions and orders, the Board of Appeals shall comply with the provisions of the Code of Civil Procedure regarding pronouncements and forms of decisions and orders, insofar as such provisions are applicable.

The procedural rules to be followed by the Board of Appeals shall be established in the regulations implementing the present decree.

(Appeal Fee)

Art. 73. Appeals shall be filed together with proof of payment of the prescribed fee; the fee shall not be refunded if the appeal is denied.

(Nature of Actions Involving Patents)

Art. 74. Legal actions involving patents for industrial inventions shall have the nature of actions concerning commercial property.

(Competence of the Judicial Authority)

Art. 75. Legal actions involving industrial inventions shall be instituted before the judicial authority of the State, regardless of the nationality, domicile or residence of the parties.

Such actions shall be instituted before the judicial authority of the defendant's domicile; if the defendant has no residence, address or elected domicile in the territory of the State, such actions shall be instituted before the judicial authority of the plaintiff's place of domicile or residence; if neither the plaintiff nor the defendant has a real or elected domicile in the territory of the State, the judicial authority of Rome shall have jurisdiction.

To determine jurisdiction, and for the service of administrative or judicial notice, the domicile recorded in the Patent Register shall be considered as the elected domicile.

Art. 76. If legal actions are based on facts presumed to infringe the right of the plaintiff, they may be brought also before the judicial authority within whose jurisdiction the facts have been committed.

Art. 77.—1. The burden of proving the invalidity or forfeiture of a patent for an industrial invention shall in all cases be on the person challenging the patent, and the burden of proving infringement shall be on the patent owner.

2. Where a party has provided genuine evidence of the validity of his claims and has identified documents, data or information in the possession of the opposing party in support of that evidence, that party may request the court to order that the said evidence be produced or that the information be acquired by interrogation of the opposing party. He may further request the court to order that such data be provided as are necessary for identifying the individuals involved in the production and distribution of the goods or services constituting the infringement.

3. When adopting the above measures, the court shall take such measures as are appropriate to ensure the protection of confidential information, after having heard the opposing party.

4. In matters concerning the subject of this Decree, the technical expert appointed *ex officio* may be provided with documents relating to questions raised by the court even where such documents have not yet been produced in evidence. Each party may appoint more than one expert.

(Competence of the Public Prosecutor)

Art. 78. Actions aimed at obtaining a declaration of nullity or forfeiture of a patent for an industrial invention may also be instituted *ex officio* by the Public Prosecutor.

The action referred to in the preceding paragraph shall be taken against all persons entered in the Patent Register as owning rights in the patent.

(Effect of Judicial Decisions and Recording)

Art. 79. The nullity or forfeiture of a patent, even if only partial, shall be effective towards any third party when it has been declared in a court decision which has become final.

The Italian Patent and Trademark Office shall enter such decisions in the Patent Register.

(Communications to the Italian Patent and Trademark Office; Brief Introducing an Action)

Art. 80. Any person who institutes a civil action involving a patent for an industrial invention must give notice thereof to the Italian Patent and Trademark Office by sending a copy of the brief introducing such action.

In case of non-compliance with the aforesaid provision, the judicial authority shall, at any stage of the proceeding, and before deciding the issue of the case, order such notice to be given.

The clerk of the court shall transmit to the Italian Patent and Trademark Office copies of all decisions which declare the nullity or forfeiture of patents.

Art. 81. The owner of the rights in a patent for an industrial invention may seek an order for the description or seizure of all or some of the goods produced in violation of those rights, of any means used in producing the said goods and of the evidence concerning the reported infringement. In the latter case such measures shall be adopted as are appropriate to ensure the protection of confidential information.

Art. 82. —1. Except where otherwise provided in the following paragraphs, proceedings under Article 81 shall be governed by the provisions of the Code of Civil Procedure on the provisional measures of investigation and seizure, as the case may be.

2. Description and seizure shall be performed by a court official, who may be assisted by one or more experts where necessary, and may make use of technical, including photographic, means of verification.

3. The parties concerned may be authorized to attend the above operations, either in person or through their representatives, and to be accompanied by technical assistants of their choice.

4. Paragraphs 2 and 3 of Article 693 of the Code of Civil Procedure shall not apply to description. For the purposes of Article 697 of the Code of Civil Procedure, the condition of exceptional urgency must be considered equivalent to the need not to jeopardize enforcement of the remedy. The provisions of Articles 669*octies*, 669*novies*, 669*undecies* and 675 of the Code of Civil Procedure shall apply also to description.

5. After the period provided for in Article 675 of the Code of Civil Procedure has elapsed, description and seizure operations already begun may be completed, but no such operations may be initiated by virtue of the same order; the foregoing shall be without prejudice to the possibility of applying to the court for further measures of description or seizure in the course of the procedure on the merits.

6. Description and seizure may likewise concern goods belonging to individuals not specified in the complaint, provided that those goods have been produced, offered, imported, or placed on the market by the party against whom the said measures were ordered and are not intended for personal use. The record of the seizure and description performed, together with the complaint and the court order, shall be served on the third

party to whom the goods affected by the seizure or description belong within 15 days of the completion of the aforesaid operations, on pain of nullity.

Art. 83.—1. The owner of the rights in a patent for an industrial invention may apply to the court for an injunction prohibiting the manufacture, marketing and use of anything that constitutes an infringement of the patent in accordance with the provisions of the Code of Civil Procedure on precautionary measures.

2. On pronouncing the injunction the court may specify a sum payable for any violation or non-compliance or for any delay in compliance.

Art. 83bis. The measures provided for in Articles 81, 82, and 83 may be requested either from the time at which the application is made accessible to the public or against persons to whom the application has been notified under Article 4.

(Prohibition of Seizure)

Art. 84. As an exception to the provisions contained in the preceding Articles, and without prejudice to the requirements of criminal law, no seizure may be performed of articles suspected of infringing a patent which appear within the enclosures of an official or officially recognized exhibition held in the territory of Italy, or are in transit to or from such exhibition. It shall be possible, however, to obtain a description of such articles.

(Publication of Decisions; Assignment of Seized Articles)

Art. 85. The judicial authority may order that the court decision concerning an infringement of patent rights, in whole or in summary form, or the decree of such decision, be published in one or several newspapers named by it, at the expense of the losing party.

The decision establishing the infringement of patent rights may order that the articles manufactured, imported or sold in violation of the said rights, and the specific means used in their manufacture or in carrying out the patented method or process, be awarded to the owner of the patent, without prejudice to the latter's right to compensation for damages.

The judge may also, at the request of the proprietor of the articles or means of production referred to in the preceding paragraph, and considering the remaining terms of the patent or the particular circumstances of the case, order the seizure of the articles and means of production up to the date of expiration of the patent, at the expense of the perpetrator of the violation.

In this last case, the patentee may request that the seized articles be assigned to him at a price which, if no agreement can be reached by the parties, shall be fixed in accordance with the last paragraph of the following Article, with the advice of an expert, if necessary.

(Payment of Damages; Removal or Destruction of Articles)

Art. 86. The decision ordering payment of damages may, at the request of one of the parties, provide for a lump sum payment to be based on the records of the case and on the assumptions deriving therefrom. It may also fix an amount due for each violation, or

each case of non-compliance that may be found in the future, and for any delay in the execution of the orders contained in the decision.

Articles which constitute an infringement of rights in a patent for an industrial invention may not be ordered to be removed or destroyed, nor may their use be prohibited, if they belong to a person who is using them in good faith for personal or domestic purposes.

Any controversies arising out of the enforcement of the measures described in this and in the preceding Articles shall, after hearing the parties and summarily investigating the matter, be decided by the President of the court, or the magistrate who issued the decision providing for such measures, in an order from which no appeal may be taken.

(Forced Execution of Patrimonial Rights in the Patent)

Art. 87. Patrimonial rights in patents for industrial inventions may be subject to forced execution.

The rules on executions on personal property laid down in the Code of Civil Procedure shall be applicable to such executions.

The regulations implementing this decree may establish special rules for such executions and may also lay down the terms and conditions for the satisfaction of rights of security in patents and the extinction of such security.

(Sanctions for Fraudulent Acts)

Art. 88. Any person who, without using deceptive means of authentication, certification or recognition, fraudulently and in violation of a valid patent for an industrial invention manufactures, sells, exhibits, uses industrially, or introduces into the country articles covered by the said patent shall, upon a complaint by the interested party, be penalized with a fine of up to 400,000 lire.

Art. 89. Any person who affixes to an article untruthful words or statements intended to create the impression that the article so marked is protected by a patent shall be penalized with a fine of from 20,000 lire to 200,000 lire.

(Non-Observation of Time Limits; All Due Care Requirement; Appeals)

Art. 90. The applicant for or proprietor of a patent who, despite all due care required having been taken, was unable to observe a time limit vis-à-vis the Italian Patent and Trademark Office or the Board of Appeals shall have his rights re-established if the non-observance in question has the direct consequence of causing the refusal of the patent application or of a request relative thereto or the lapse of the patent or the loss of any other right or means of appeal.

The omitted act must be completed and the application for re-establishment must be filed within two months from the removal of the cause of non-compliance, stating the facts and grounds on which the application is based and submitting the suitable documentation. The application shall only be admissible within the year following the expiry of the unobserved time limit. In the case of non-payment of an annual fee, this

one-year period shall run as of the date of expiration of the due date provided for by Article 47 for payment of the annuity without imposition of the additional fee.

In case of failure to pay a fee for maintenance of a patent, a certificate must also be attached proving payment of the fee due, inclusive of the additional fee provided for by Article 47.

Where the Italian Patent and Trademark Office rejects an application for re-establishment, an appeal from its decision may be taken to the Board of Appeals within 30 days from the date of the notice relative to the rejection. The Board of Appeals shall be competent to decide on applications for re-establishment of the right to take an appeal.

The provisions of this Article shall not be applicable: to the time limits indicated in the preceding paragraph of this Article, to the time limit within which priority rights may be claimed, to the time limits the observance of which is a prerequisite for applicability of Article 4, paragraph 3, of Decree of the President of the Republic No. 540 of June 30, 1972, to the time limit granted in accordance with Article 29 for the division of patent applications and the filing of a divisional application.

(Serious and Effective Preparations for Using the Invention)

Art. 90bis. Any person who has made serious and effective preparations for using an invention or has begun using it in the course of the period between the loss of the exclusive rights or of the right to acquire exclusivity and the re-establishment provided for under the preceding Article 90 may without payment carry out the invention within the limits of his prior use or those resulting from the preparations.

Title IX General and Transitional Provisions

Chapter I: General Provisions

(Use of the Italian Language)

Art. 91. All applications provided for by this Decree shall be addressed to the Italian Patent and Trademark Office.

Applications, and the documents attached to them, must be written in Italian. Any documents written in a language other than Italian must be accompanied by an Italian translation.

Art. 92. [Repealed.]

(Domicile of Applicant or Representative)

Art. 93. The applicant, or his representative, if any, shall in each application indicate or elect an Italian domicile for any communications or notices to be sent to him under this decree.

The Italian Patent and Trademark Office shall be informed of any changes in domicile, which shall be recorded in the Patent Register.

When no Italian domicile has been indicated or elected, or if the Italian Patent and Trademark Office is informed of the discontinuance of the domicile elected in accordance with the preceding paragraphs, communications and notices shall, for as long as the Italian Patent and Trademark Office has not been informed of the election of a new Italian domicile, be effected by posting a copy of the document or notice of its contents on the bulletin board of the Italian Patent and Trademark Office.

The Italian Patent and Trademark Office shall also be notified of changes in the name of the patentee, which shall be entered in the Patent Register; such notices shall be accompanied by documents proving the changes.

(Right to Appoint a Representative; Power of Attorney)

Art. 94. No person shall be compelled to be represented by a professional representative in proceedings before the Italian Patent and Trademark Office; natural or legal persons may be represented by an employee who need not be a professional representative.

If the appointment of one or several representatives has not been made in a separate, authentic or authenticated act, it may be made in a special power of attorney subject to payment of the prescribed fee.

The power conferred by the power of attorney shall be valid only for the subject matter specified in it and shall be limited to relations with the Italian Patent and Trademark Office.

The power may be conferred only on representatives whose names appear on a list maintained for this purpose by the Italian Patent and Trademark Office.

The power may also be conferred upon a lawyer or an attorney-at-law whose name appears in the respective professional roll.

(Non-Acceptance of an Application for Lack of Payment of the Fee)

Art. 95. Applications aimed at obtaining a measure for which payment of a fee is prescribed shall be admitted only if they are accompanied by a document proving the payment of such fee.

Payments may also be made by persons other than the owner of the patent.

The amount of the prescribed fees is indicated in Table A annexed to this decree.³

Acts and documents subject to the payment of tax stamps, other than those provided for in Law No. 3268 of December 30, 1923, and the amendments thereto, are indicated in the annexed Table B.⁴

(Availability to the Public of Registers of Patent Applications and Patents)

Art. 96. The Register of Patent Applications, the Register of Patents, the applications and any documents pertaining to them shall be open to public inspection.

³ Not reproduced here (*Editor's note*).

⁴ Not reproduced here (*Editor's note*).

Without prejudice to the provisions contained in Articles 38, 40⁵ and 61 hereof, any person shall have the right to inspect the registrations, recordings and entries contained in the Registers and to obtain certified copies or abstracts thereof, as well as copies of the applications and documents relating thereto.

Certified copies or extracts, as well as authentications of copies of acts and documents, shall be subject to payment of the prescribed fees.

(Publication)

Art. 97. All publications provided for by this decree shall appear in the Bulletin of Patents, edited by the Italian Patent and Trademark Office.

Chapter II: Transitional Provisions of Decree of the President of the Republic No. 338 of June 22, 1979

(Applicability of the Present Law: Patent Applications and Requests for Recording Filed Before Entry into Force; Exceptions; Right of Priority)

Art. 98. (Article 81⁶) Applications for patents for industrial inventions ... and applications for recordings of any documents relative thereto shall, even if they were filed prior to the entry into force of this decree, be processed in accordance with the provisions contained herein, except for their formal regularity and the designation of the inventor, which shall be subject to the previous provisions.

The priority rights referred to in repealed Articles 9 and 17 of Royal Decree No. 1127 of June 29, 1939, shall be maintained, provided that the disclosure has taken place prior to the entry into force of the present decree.

(Applications for Patents of Addition and Patents of Addition Still in Force)

Art. 99. (Article 82) Applications for patents of addition and patents of addition which are still valid shall be subject to the ordinary provisions; Article 98(81) hereof shall be applicable thereto. The annual fees shall be paid which shall become due after expiration of the term of one year after the entry into force of the present decree.

(Applicability of Former Law: Grounds and Declarations of Nullity for Granted Patents for Inventions)

Art. 100. (Article 83) Patents for industrial inventions ... already issued at the time of entry into force of this decree shall, with regard to the causes of nullity, be subject to the rules of the previous Law and, with regard to the effects of the declaration of nullity, to the provisions contained in Article 59bis of Royal Decree No. 1127 of June 29, 1939.

(Non-Expired Patents for Invention; Exceptions)

⁵ See note 2, above (*Editor's note*).

⁶ The numbers in parentheses correspond to the original Article numbers of Decree of the President of the Republic No. 338 of June 22, 1979 (*Editor's note*).

Art. 101. (Article 84) Article 4, last paragraph, of Royal Decree No. 1127 of June 29, 1939, shall apply to patents for industrial inventions which have not expired by the date of entry into force of the present decree. However, licensees and any persons who, in view of the approaching expiration of such a patent, made serious and effective investments in order to use the invention shall be entitled to obtain a non-exclusive royalty-free license for the remaining period of duration of the patent. This right shall not apply to infringers of patents not yet expired.

(Regulations)

Art. 102. (Article 85) Regulations to be issued within one year from the entry into force of this decree by the Minister of Industry, Commerce and Handicrafts, with the agreement of the Minister of Justice, shall lay down the rules relative to the formation of the list of the professional representatives and shall provide for the examination of the integrity and competence of such representatives, the exercise of the disciplinary powers and any other aspect of their professional activity.

Pending the formation of the list of professional representatives, a power of attorney may be conferred upon any person.

(Amendments to Ministerial Decree of February 22, 1973)

Art. 103. (Article 86) Within six months from the entry into force of this decree, the Minister of Industry, Commerce and Handicrafts shall issue a decree providing for the amendments to be made to the Ministerial Decree of February 22, 1973, concerning the implementing regulations to Decree of the President of the Republic No. 540 of June 30, 1972.⁷

(This text replaces the one previously published under the same code number.)

⁷ See *Industrial Property Laws and Treaties*, ITALY — Text 1-005 (*Editor's note*).