

Italy jurisdiction report: A new route to protection

29-10-2020

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For international patent applications filed before July 1, 2020, the only way to obtain patent protection in Italy was to pass through a European patent application.

But, after a change in law, applicants can now apply for protection in Italy without going through the European patent system.

Previously, a European patent application could be validated in Italy only after grant or, if with-drawn, converted into an Italian utility model. This meant that an applicant who was interested or Italian market had to undertake a long and expensive procedure.

Since July 1, 2020, pursuant to Decree Law number 34 of April 30, 2019, by amending articles 55 and 160 of the Industrial Property Code, the legislator has introduced the direct route for the Italian national phase before the Italian Patents and Trademarks Office (UIBM) to grant a patent application or utility model.

The decree established that international Patent Cooperation Treaty (PCT) patent applications entitled to follow the direct national route for Italy must be filed after July 1, 2020, and must contain the Italy designation or election regardless of the European Patent Office (EPO) designation or election.

Moreover, entry into the national phase will require the filing, within 30 months from the filing date or the priority date, if claimed, of a request to enter into the national phase together with a full Italian translation of the text.

The translation may be filed within two months after the expiry of the 30-month period and must be declared compliant with the original text by the applicant or his representative.

The applicant of an international PCT application can choose the best solution that suits his business model, opting for the European regional phase where his market is extended to at least two states (having ratified the European Patent Convention) or limiting the effort by directly entering into the Italian national phase, if the market is limited to that jurisdiction only.

With this amendment, Italy aligns itself with Germany, the UK, Spain, Sweden, Switzerland and Turkey, where such an alternative was already available.

Upon entry into the national phase, the applicant can request a patent application or a utility model. In the first case, after the administrative checks, the UIBM will submit the application to a substantive examination based on the search report or an international preliminary examination, to which the applicant has a chance to reply, possibly submitting amendments as per the national application procedure.

Before this amendment, the only alternative was to leave the entire examination phase to the EPO, which would decide whether or not to grant the patent application, whereas in Italy the text was simply formally validated as a patent.



A different procedure

From a procedural point of view, the UIBM has issued guidelines on the correct entry into the Italian national phase.

Filing takes place electronically through the portal of the office, similarly to what happens for the filing of national applications, where one can proceed with a “patent application for industrial invention deriving from international application” or “patent application for utility model deriving from international application”.

The applicant must indicate the PCT filing number, according to the following coding PCT/XX2020/111111, and must also submit the application form filed with the World Intellectual Property Office (form PCT-RO-101), translated into Italian.

Further information about the documents that need to be submitted is enshrined in article 2, paragraphs 2 and 3, of the Ministerial Decree of November 13, 2019.

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As an alternative, the owner may file the application for entry into the national examination phase by hand (in paper form).

After the admissibility of the application has been verified, the applicant or his representative will receive an office action specifying a deadline, not less than two months, to submit any replies to the search report and the patentability opinion, similarly to what happens for national Italian applications.

On the contrary, if the applicant has opted for a utility model application, after administrative checks on the admissibility of the application, the application passes through the merit phase, where it is granted or rejected.

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