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# Patent Litigation 2022

Italy: Law & Practice  
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## Law and Practice

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## 1. INTELLECTUAL PROPERTY RIGHTS AND GRANTING PROCEDURE

### 1.1 Types of Intellectual Property Rights

For the protection of inventions, the Italian legal system contemplates:

- patents;
- utility models; and
- supplementary protection certificates, extending the duration of the protection conferred by patents protecting medicinal product (Regulation 469/2009/EC).

These are based on statutory law.

### 1.2 Grant Procedure

The patent granting procedure has the following stages.

- Filing of the application, online (with the Italian Patent and Trademark Office – IPTO) or on papers (with the local Chamber of Commerce).
- Check of formal requirements by the IPTO.
- No examination, but a “prior search procedure”:
  - (a) there is no proper prior examination system at the IPTO but Italian national patent applications that do not claim priority over other applications undergo a prior search;
  - (b) this search is outsourced to the EPO examiners, based on a contractual agreement between the Italian government and the EPO;
  - (c) the search report is sent to the applicant who is given a deadline to provide comments or amend claims if the search report so requires;
  - (d) this process is generally limited to one single exchange of comments or amendments by the applicant; and
  - (e) at this stage, the applicant may also

change the application into a utility model application.

- Grant/rejection and relative publication.

The utility model and SPC granting procedures differ from the granting procedure of patent applications in that there is no “prior search procedure” step.

### 1.3 Timeline for Grant Procedure

Patent and utility model granting procedures typically last approximately 24 months.

The inventor does not need representation to file an application.

The average costs to grant are:

- EUR50, in the case of an e-filing;
- EUR120–600 in the case of a paper filing and depending on the number of pages.

The prior search procedure costs an additional EUR200 if the applicant did not already provide an English translation of the claims. Each additional claim after the tenth costs EUR45.

An SPC granting procedure typically last approximately four to six months.

### 1.4 Term of Each Intellectual Property Right

Patents last 20 years from the filing of the application.

Utility models last ten years from the filing of the application.

SPCs take effect at the expiry of the basic patent and shall last for a period equal to the period elapsing between the date on which the application for a basic patent was lodged and the date of the first authorisation to place the product on the market in the European Community,

reduced by a period of five years. This notwithstanding, the duration of the certificate may not exceed five years from the date on which it takes effect. An extension of duration of the SPC by six months may be obtained under the provisions of Article 36 of Regulation 1901/2006/EC (“paediatric extension”).

## 1.5 Rights and Obligations of Owners of Intellectual Property Rights

The patent owner gains exclusive rights on the basis of which they may seek various types of remedies, including injunctions and damages.

The patent holder is obliged to pay annual fees.

Patents are published in the IPTO database, which is free to consult. In the pharmaceutical space, the IPTO publishes a list of granted SPCs that can be searched by reference to the name of the medicinal product involved.

## 1.6 Further Protection after Lapse of the Maximum Term

Italian law contemplates SPCs and relative paediatric extensions. See **1.4 Term of Each Intellectual Property Right**.

## 1.7 Third-Party Rights to Participate in Grant Proceedings

There is no true participation by third parties during grant proceedings. In practice, third-party observations may be filed. These will not be forwarded to the applicant. However, the examiner is at liberty to consider them and possibly translate them into its own observations. In this case, the examiner’s observations will be sent to the applicant and the latter will be given a deadline to comment.

## 1.8 Remedies against Refusal to Grant an Intellectual Property Right

A refusal to grant is subject to appeal before the IPTO’s Board of Appeal with a deadline of 60 days.

## 1.9 Consequences of Failure to Pay Annual Fees

The legal consequence of a failure to pay the annual fees is the revocation of the patent.

After six months from the due date for payment, during which payment is allowed subject to a late-payment fee, the IPTO (i) notifies the interested party that it has no record of payment and (ii), after a further 30 days from said communication, publishes the notice of revocation in the IPTO Official Bulletin.

Within six months from the above publication in the Official Bulletin, the patent owner, who proves timely payment of the annual fees, may file an appeal before the IPTO Boards of Appeal requesting cancellation of the notice of revocation. A patent shall be deemed revoked if the appeal has been dismissed or, in any case, after six months from the publication of the notice of revocation.

## 1.10 Post-grant Proceedings Available to Owners of Intellectual Property Rights

Post-grant amendments of patents may be obtained in two ways.

- In court, during a revocation action – the relevant procedure merely consists of a declaration of amendment filed with the judge.
- Through an application filed with the IPTO – the applications undergoes a mere check of formal requirements by the IPTO and the grant of the amendment is generally obtained in approximately two months.

## 2. INITIATING A LAWSUIT

### 2.1 Actions Available against Infringement

Against infringement, a patent owner may bring:

- an infringement action on the merits;
- preliminary injunction proceedings (ante-causam or in the framework of proceedings on the merits); and
- search/seizure proceedings aimed at collecting or preserving the evidence of the infringement.

### 2.2 Third-Party Remedies to Remove the Effects of Intellectual Property

Third parties who wish to remove the effects of the technical intellectual property right may bring one of the following actions.

- Invalidation/revocation action – no particular admissibility requirement applies.
- Declaration of non-infringement action, either as proceedings on the merits or by means of preliminary proceedings – an interest to seek the declaration must be proven, typically the need to clear the way for launching an allegedly infringing product, whether or not based on cease and desist letters sent by the right-holder.

No opposition proceedings or post-grant review proceedings are available.

### 2.3 Courts with Jurisdiction

At first instance, the commercial chambers of 22 courts of first instance sitting throughout the Italian territory have jurisdiction: Ancona, Bari, Bologna, Bolzano, Brescia, Catania, Catanzaro, Campobasso, Cagliari, Florence, Genoa, L'Aquila, Milan, Naples, Palermo, Perugia, Potenza, Rome, Turin, Trento, Trieste and Venice.

At second instance, 22 Courts of Appeal sitting in the same districts as the above-mentioned courts of first instance have jurisdiction.

The Supreme Court sitting in Rome has jurisdiction at third instance.

The territorial jurisdiction of the above mentioned courts is determined by reference to:

- the patent holder's elected domicile in the case of invalidation/revocation actions – this jurisdiction prevails also if the revocation claim is coupled with other claims in the same proceedings;
- the domicile of the defendant or alternatively the locus commissi delicti in declaratory judgment actions or infringement actions.

If the proceedings involve a foreign party, only 11 of the above listed courts have territorial jurisdiction: Bari, Bolzano, Cagliari, Catania, Genova, Milan, Naples, Rome, Trento, Turin and Venice.

### 2.4 Specialised Bodies/Organisations for the Resolution of Disputes

There are no specialised bodies or organisations for the resolution of intellectual property disputes.

Also, although possible in theory, arbitration is practically unknown in the context of patent disputes in the Italian jurisdiction.

### 2.5 Prerequisites to Filing a Lawsuit

There are no prerequisites to filing a lawsuit, such as the recordal of the patent or licence with the patent office, issuing a formal demand letter, warning letters, or engaging in mediation.

### 2.6 Legal Representation

Parties in intellectual property matters need to be represented by a lawyer.

## 2.7 Interim Injunctions

Inter partes and ex parte interim injunctions are available, although courts are quite reluctant to grant ex parte injunctions.

The following requirements must be met for an interim injunction to be granted:

- prima facie case – ie, plausible evidence of patent validity and/or infringement; and
- urgency/irreparable harm – ie, need for the injunction as the delay required to complete proceedings on the merits would produce irreparable effects.

No delay in seeking relief and balance of convenience are also considered by the Italian courts, although not specifically provided for in the law.

## 2.8 Protection for Potential Opponents

A potential opponent cannot protect itself through protective briefs as these are not allowed in Italy.

The law allows Italian courts to request the claimant to post a bond when granting a preliminary measure, however this tool is hardly ever used.

## 2.9 Special Limitation Provisions

The limitation period for claiming damages caused by patent infringement is five years. There is no other relevant limitation period.

## 2.10 Mechanisms to Obtain Evidence and Information

The Italian legal system contemplates search/seizure proceedings.

These are saisie-type proceedings that can be resorted to if the right-holder:

- provides at least initial elements to substantiate a likelihood that its rights are being infringed; and

- proves that the requested measure is needed to obtain evidence which could not be obtained otherwise than by accessing the defendant's premises.

Search orders are typically granted ex parte on the assumption that putting the other party on notice would frustrate the execution of the search as the latter could easily conceal or displace the evidence to be collected.

Once issued, the search order empowers a Court Bailiff, normally accompanied by the claimant's counsels and representatives, to raid the alleged infringer's premises unannounced and "search" the evidence of the infringement within those premises.

Depending on the circumstances, the search order may specify the objects or documents to be searched and may encompass accounting or financial documents for the purposes of proving the existence of the infringement or violation as well as its magnitude. The collection of samples of allegedly infringing products is generally allowed.

Ex parte search orders generally have to be executed in a very short timeframe after issue by the court (typically eight days) and then have to undergo a confirmation phase upon an inter-partes hearing which typically takes place within one or two weeks from the raid.

Once the order is confirmed inter-partes, the right-holder will have to institute merits proceedings within the mandatory deadline of 30 days. Failure to institute merits proceedings within the stated deadline will make the evidence collected during the search unusable.

## 2.11 Initial Pleading Standards

Although Italian proceedings are not strictly front-loaded; ie, the submission of additional

evidence is allowed to some extent after the proceedings have been instituted, the initial pleading must contain a fairly substantial elaboration of the grounds on which the claims rest and provide relevant evidence.

After the case has commenced, general procedural rules provide for a system of fixed “preclusions” by which the parties are allowed to modify their claims and submit new evidence. As far as intellectual property cases are concerned, however, this system is to some extent undermined by the principle that each time the court appoints a court advisor to consider the technical merit of the case, the parties are then free to submit new evidence to that court advisor until they have produced their report. In practice, the Italian courts appoint court advisors in all patent cases, the impact of which is that claimants have ample opportunity to supplement arguments and evidence on validity and/or infringement after the case has been started.

### **2.12 Representative or Collective Action**

The Italian legal system does not permit representative or collective actions (such as class actions) for intellectual property rights proceedings.

### **2.13 Restrictions on Assertion of an Intellectual Property Right**

Depending on the circumstances, competition law and contractual restrictions may be relied on in cases concerning standard-essential patents, where good-faith willing licensees can rely on such restrictions to avoid injunctive relief and/or seek a licence on fair, reasonable and non-discriminatory (FRAND) terms.

Furthermore, according to the most recent case law, the remedies requested by the right-holder must be scrutinised against the general principle of proportionality.

## **3. INFRINGEMENT**

### **3.1 Necessary Parties to an Action for Infringement**

The exclusive licensee is entitled to enforce the patent in its own name seeking an injunction and/or damages.

Non-exclusive licensees are generally entitled to bring action as co-plaintiffs as the courts tend to view infringement claims by non-exclusive licensees as dependent on the primary right of action by the patent holders.

### **3.2 Direct and Indirect Infringement**

As far as direct infringement is concerned, the patent confers on the owner the exclusive rights to prohibit third parties from producing, using, marketing, selling or importing for these purposes the patented product; if the subject matter of the patent is a process, the patent holder may prohibit third parties from applying the process, and from using, marketing, selling or importing for these purposes the product directly obtained by the patented process.

As far as indirect infringement is concerned, the patent holder may prohibit third parties from providing or offering to provide to subjects other than those entitled to use the patented invention, the means relating to an indispensable element of this invention and necessary for its implementation, if the third party is aware of the suitability and destination of said means to implement the invention or should have such awareness through ordinary diligence. If the means are commodities, indirect infringement subsists only in the case of wilful inducement.

The same type of remedies (search/seizure, injunctions and damages) are available in either case.

### 3.3 Process Patents

If the subject matter of the patent is a process, the patent holder may prohibit third parties from applying the process, and from using, marketing, selling or importing for these purposes the product directly obtained by the patented process.

Whether (part of) the process is practiced abroad does not impede infringement as long as the product directly obtained by the patented process is imported/marketed in Italy.

### 3.4 Scope of Protection for an Intellectual Property Right

According to Italian law, the scope of protection of a patent is determined by the patent claims, interpreted in light of the description and the drawings. It is then expressly provided that the scope of the claims must be interpreted so as to ensure both the patentee's right to fair protection and legal certainty for third parties.

The doctrine of equivalents has existed in the Italian system for many years, and was translated into statutes in 2010. The relevant provision states that in determining the scope of protection, account must be taken "of features that might be equivalent to the claimed features". The relevant test most likely to be applied by Italian courts today is the "triple test", according to which an element is considered equivalent to the claimed features if it performs the same function, in the same way, and obtaining the same result.

There is no prosecution history estoppel in the Italian system, and the most recent case law has quite substantially reduced the impact of the declarations made by the applicant during prosecution in determining the scope of protection or the feasibility of a claim of infringement by equivalents.

### 3.5 Defences against Infringement

Typical defences against infringement are non-infringement, invalidity and the application of specific exemptions, the most relevant of which are the experimental exemption and the Bolar exemption.

The prior-user right defence is also available; however, it has rather limited impact as the law stipulates that the prior user may continue to use the patented invention as long as such use remains within the limits of the prior use. According to the case law, this means that the prior user will not have the possibility to expand the use of the invention beyond the specific use they previously made, both from a quantitative and qualitative perspective.

Compulsory licensing is generally not a defence as Italian law expressly indicates that there is no obligation of a compulsory licence in favour of an infringer.

Violation of competition law and/or the contractual promise to offer licences on FRAND terms may be a defence in the case of standard-essential patents, depending on the specific remedy sought. In particular, an Italian court would follow the CJEU case law in determining the circumstances in which an injunction may be granted based on a standard-essential patent.

Patent exhaustion is also available as a defence, when the product claimed by the patent was put into the market by the patent holder or with its consent in the EEA.

### 3.6 Role of Experts

In Italian patent litigation, either in preliminary or merits proceedings, the evaluation of the relevant technical issues relating to validity and infringement is always subject to consideration by an independent advisor appointed by the court. This advisor will generally be chosen

amongst relatively senior Italian patent agents with specific experience in the given technical field.

In practice, a technical discussion will take place before the court advisor through the submission of written briefs and replies to be prepared by the parties through their own counsel and technical consultants. The court advisor may also conduct experiments or inspections which the parties have a right to attend. After the technical discussion is completed, the court advisor will produce a draft report and will ask the parties to comment on the same, after which they will produce a final report to the court. The report of the court advisor is not binding and the court retains the right to overrule it. The technical phase before the court advisor is crucial and must be conducted with the necessary care and deployment of effort by the parties.

### **3.7 Procedure for Construing the Terms of the Patent's Claim**

In Italian patent litigation, there is no separate procedure for construing the terms of the patent's claims. The claims construction is carried out during the phase led by the court advisor, through the exercise of exchanging technical briefs by the parties towards the production of a report by the court advisor (as discussed in **3.6 Role of Experts**).

### **3.8 Procedure for Third-Party Opinions**

In Italian patent litigation there is no system by which the court can seek or receive third-party opinions (amicus briefs).

## **4. REVOCATION / CANCELLATION**

### **4.1 Reasons and Remedies for Revocation/Cancellation**

The reasons for revocation fully reflect the patent grant requirements established by the European Patent Convention.

There are no specific locus standi requirements to bring a patent revocation action in Italy.

### **4.2 Partial Revocation/Cancellation**

Italian law contemplates the possibility that the court establishes that a patent is only partly valid. In this case, the relative limitation of the patent will be produced by operation of the ruling. This typically happens when the court finds for the invalidity of the independent claim, but for the validity of a dependent claim.

### **4.3 Amendments in Revocation/Cancellation Proceedings**

The patent holder is at liberty to amend the patent during a revocation action by means of declaration of amendment submitted to the judge. There are no given time limits to do so. Typically, the patent holder will submit such a declaration of limitation once the court advisor has provided a preliminary conclusion that the patent lacks novelty or any other requirement that may be cured by way of a post-grant amendment. In this case, the court will most likely ask the court advisor to issue a supplemental report on whether the limitation is admissible and whether it has the effect of curing invalidity.

### **4.4 Revocation/Cancellation and Infringement**

Revocation and infringement are heard together in Italy as there is no bifurcation system.

## 5. TRIAL AND SETTLEMENT

### 5.1 Special Procedural Provisions for Intellectual Property Rights

The background legislation governing the procedure of any court proceedings dealing with the validity and infringement of, and entitlement to, intellectual property rights is the Italian Code of Civil Procedure (CPC).

Special provisions apply to IP proceedings, starting with the fact that IP proceedings are heard by IP-specialised courts (see **2.3 Courts with Jurisdiction**). Having specifically reserved judges makes IP proceedings faster than other contentious matters of civil law. The typical timeline for main (revocation and infringement) proceedings is between two and two and a half years. Preliminary proceedings take between three and six months on average. Patent matters can take a little longer due to the involvement of experts, see **3.6 Role of Experts**.

Main proceedings are normally composed of (at least) three case management conferences (CMCs) and at least two hearings. A first CMC serves as the very first in-court meeting between the parties and the judge and is used to address procedural issues or objections and set the calendar of the case. A second CMC is scheduled to discuss the parties' requests to introduce evidence, which the parties will have submitted in writing after the first CMC. A first, proper hearing is scheduled once the evidence has been acquired/formed to discuss the evidence collected (including the court advisor's opinion, which the judge will always want to acquire in patent matters) and whether it is enough to adjudicate the case. If this is judged to be so, a third CMC is then set for the parties to formally confirm their requests to the court, followed by the submission of final written pleadings and, at

the parties' request, a hearing for the delivery of final oral pleadings.

Preliminary injunction proceedings are far more agile. Further to the submission of the parties' introductory motion and defensive briefs, a hearing is set and normally used to "test" the urgency requirement. If the urgency requirement is met, the case proceeds right away with the appointment of a court technical advisor (or CTA). A proper discussion hearing is then held once the CTA is prepared to adjudicate on the case.

Fact witnesses are not too common in patent matters, and are used only to confirm purely factual circumstances (ie, circumstances other than validity and infringement) that are relevant to adjudicate the case, for instance in entitlement proceedings. Expert witnesses are not contemplated. Experts can nevertheless appear as technical counsel for the parties, typically as part of the process that leads up to the delivery of a CTA opinion, and may be questioned directly by the judge. There is no cross-examination by the parties' counsel.

Remedies that do not normally require further assessment once validity and infringement have been determined are normally assigned with the judgment carrying the finding of infringement. These remedies typically include (both preliminary and permanent) injunctions, market recall, astreinte, assignment or, alternatively, destruction of the infringing goods seizures. Financial remedies – ie, damage awards or return of profits – are decided at a later stage and after further activities including the running of accounting/financial evaluations by a court-appointed financial/accounting advisor.

### 5.2 Decision-Makers

Main infringement/revocation proceedings are adjudicated with a majority decision of a panel of three IP-specialised judges at both first instance

and appeal. Preliminary proceedings are adjudicated by a single, IP specialised-judge at first instance. A panel of three judges from the same first instance IP chamber rules on the appeal.

While experienced in patent matters, Italian patent judges have a purely legal, non-technical background, hence the reason why they normally require the guidance of a CTA when assessing a case.

Once a case is filed, the parties have no influence whatsoever in determining which judge or judges will end up deciding their cases. The only influence they can exercise in this respect is before filing a case, when forum shopping for a court perceived as overall better suited than others to hear and adjudicate a certain case.

### **5.3 Settling the Case**

The Italian CPC contemplates settlement conferences, which must be attended by the parties, either in person or through their attorneys, along with their defence counsel. However, these conferences cannot be triggered by one party alone. They are either set on the basis of a joint request from all parties or scheduled by the judge at their own initiative.

### **5.4 Other Court Proceedings**

Following a 2016 landmark judgment of the Italian Supreme Court, main infringement proceedings can be stayed upon request of the defendant where the latter has filed a parallel revocation action before a different court. This situation is possible on account of the combination between the special jurisdiction criterion applicable to patent revocation proceedings – which can be filed where the patentee has elected its domicile upon filing or, in the case of European patents, validated the patent – and the *locus commissi delicti* criterion applicable to infringement proceedings, which in turn may well lead to (a number of) different courts, other

than the one of the place of domicile of the patent, being competent.

There are no further, significant situations where separate court proceedings can influence (ie, lead to a stay of) previously filed infringement or revocation proceedings. Anti-suit injunctions are possible, but yet to be heard of in Italian practice. There is a general scepticism among scholars who see them as interfering with the fundamental right of access to justice and with the principle of mutual trust and co-operation between European courts.

## **6. REMEDIES**

### **6.1 Remedies for the Patentee**

The main remedy is injunctive relief, normally assisted by an *astreinte* order or penalty due for each act in breach of the injunction. This is the case in both preliminary and permanent injunctions.

Damages are awarded in the form of lost profits, which are determined starting from a *de minimis* criterion equal to the reasonable royalty the infringer would have had to pay had it gone out seeking a licence from the patentee up until the profits that the patentee would have made on the infringers' sales. Return of infringer's profits is also an option. They are awarded either alternatively to damages or concurrently with damages, however only for the portion exceeding damages. The Italian system does not contemplate punitive damages.

Further remedies include seizure (available in preliminary proceedings), market withdrawal orders as well as destruction or assignment of the infringing goods and of the means that are unequivocally necessary and functional to the manufacture and production of the infringing

goods (available in main infringement proceedings).

Statutory provisions entrust the judge with discretionary powers to decline requests that infringing goods are destroyed when this would “prejudice the national economy” and convert such requests into damages awards. A further, statutorily entrusted discretionary power is that of ordering that withdrawal of the infringing goods from the market is only temporary, as needed to operate modifications that would make the goods non-infringing and therefore legitimate.

A general clause of the Italian IP Code provides that courts must always ensure proportionality between the remedies awarded and “the intensity of the infringement (ie, the offence) as well as third parties’ interests” has been used to start and progress a debate on whether the judge has discretion to refuse injunctive relief in cases where the latter can negatively affect public interests. The current position, which is reflected in a number of recent judgments, is that injunctive relief can never be denied, but modulated so as to strike a balance with those interests (for instance by means of ordering “phase-out” periods).

## 6.2 Rights of Prevailing Defendants

The right to recover legal costs and attorney’s fees from the losing party applies to all winning parties, including (winning) defendants. Attorney’s fees are awarded based on a flat-rate scheme set forth in a specifically-dedicated piece of legislation. The amounts awarded would normally not cover the actual expenditure.

Defendants are entitled to seek preliminary injunction damages in cases where a granted preliminary injunction is subsequently lifted further to the patent being revoked or found not to be infringed in subsequent main proceedings.

The threshold for this kind of liability is that the patentee must have taken action with gross negligence or bad faith, which is typically quite a high bar to meet. Preliminary injunction damages are, for this reason, very rare.

## 6.3 Types of Remedies

The only remedy that is specifically applicable to invention patents only is the possibility of requesting the court to convert the patent into a utility model patent, if the invention patent is found invalid and provided that the requirements for the protection of utility models are met.

Italian utility models are different from utility models as known in other jurisdictions. They can be granted for mechanical appliances only and only for those new models or configurations that improve on the efficacy or ease of use of known machines, tools or equipment in general.

## 6.4 Injunctions Pending Appeal

Injunctions, whether preliminary or permanent, are effective and binding on the affected party as of publication of the related judgment. No enforcement steps are required.

An appeal does not automatically stay the injunction. A stay must be applied for by the appealing party. In preliminary proceedings, a stay is granted only in view of newly arisen facts or circumstances that were not known at the time of the injunction. In main proceedings, a stay is granted only in the presence of “serious and compelling reasons”, which include the likelihood of the judgment (and the remedies ordered thereto) being reversed on appeal. The threshold is in both cases very high. Having an injunction stayed is normally very difficult.

## 7. APPEAL

### 7.1 Special Provisions for Intellectual Property Proceedings

The most impacting provision on appeal is the ban of any new evidence (whether documentary or from witnesses) that the parties could have introduced during the first instance proceedings. New evidence is only accepted in cases where said evidence could not possibly be introduced during the first instance, for reasons beyond the control of the requesting party. This rule applies before the Appeal Court and in main proceedings only. The filing of additional evidence on appeal in preliminary proceedings is generally permitted.

### 7.2 Type of Review

Appeals imply a full review of the case, the only limit being the recourse to additional evidence in main appeal proceedings, see **7.1 Special Provisions for Intellectual Property Proceedings**.

Appeal judgments can be further appealed before the Supreme Court. As opposed to second instance appeal, supreme court appeals will imply a legal review only and no further assessment on the facts.

## 8. COSTS

### 8.1 Costs before Filing a Lawsuit

Unlike in other law systems and jurisdictions, under Italian law, patent cases can be filed in court without giving prior notice to the defendant. Notice or warning letters may serve a strategic purpose or function depending on the case, but are not mandatory in order to start a case in court. Also, under Italian law, tools such as protective briefs are not admissible.

Besides the costs that are typically requested to run an assessment of and prepare the case

before filing, a significant cost item might be represented by search proceedings, which the patentee may need to file before starting infringement proceedings and with a view to collecting evidence of the infringement, in cases where the latter is available at the infringer's premises only. The costs of search proceedings range between a few thousand euros to six-digit figures, depending on the complexity of the case and the technology at stake.

### 8.2 Calculation of Court Fees

The court fees for commencing proceedings or bringing a counterclaim in already pending proceedings are determined based on the claim's value, regardless of the number of enforced patents or defendants (in main claim or counterclaim). Court fees are negligible compared to those in other jurisdictions. They range between a minimum of EUR86 and a maximum of EUR3,372 for first instance proceedings and a minimum of EUR129 and a maximum of EUR5,058 for appeal proceedings.

### 8.3 Responsibility for Paying the Costs of Litigation

The "loser pays" principle applies in Italy, see **6.2 Rights of Prevailing Defendants**. The costs and attorneys' fees that courts award based on their binding, statutorily applicable flat-rate scheme do not necessarily (and normally do not) cover the winning party's actual expenditure.

Furthermore, upon issuing their decision, judges have a discretionary power to "compensate" costs and attorney's fees (each party bears its own costs) in cases where each of the parties has seen some of its claims dismissed or if the court had to tackle completely new legal issues or reverse existing case law in deciding the case.

## 9. ALTERNATIVE DISPUTE RESOLUTION

### 9.1 Type of Actions for Intellectual Property

Alternative dispute resolution such as arbitration proceedings are possible. However, ADR is not a common way of starting or settling a patent case.

## 10. ASSIGNMENT AND LICENSING

### 10.1 Requirements or Restrictions for Assignment of Intellectual Property Rights

Patents and the exclusive rights stemming from patents are always transferable, except for the moral right to be named as the inventor. The assignment of a patent follows the rules governing the transfer of “registered assets” set forth in the Civil Code. In a nutshell, and while the general rule is that there are no particular formal requirements to meet, any transfer or subsequent assignment should be registered on the Italian Patent Register. A registered assignment can be opposed to parties claiming a prior right to the patent and shifts the burden of proving their better right to them.

### 10.2 Procedure for Assigning an Intellectual Property Right

Assignment per se requires little in the way of formalities and can in principle happen verbally. Written evidence is nevertheless required to prove the existence of an assignment, which makes it advisable to sign a proper assignment

agreement. Registration on the Italian Patent Register requires that either a copy of the actual assignment agreement or a confirmatory declaration signed jointly by both the assignor and assignee is presented and filed with the IPTO.

### 10.3 Requirements or Restrictions to License an Intellectual Property Right

Patent licensing is not subject to specific formalities. There is no requirement to register the licence with the IPTO, nor to give the latter prior notice before issuing the licence.

Licence agreements can nevertheless be registered with the IPTO by filing either a copy of the actual licence agreement or a confirmatory deed signed jointly by licensor and licensee. While registering a licence agreement is not a requirement, this is done often for evidentiary reasons; ie, to prove the licensee’s status of licensee, typically in cases where an exclusive licensee (who has standing to bring an infringement action of its own) wants to institute infringement proceedings and at the same time avoid filing the licence agreement in court.

### 10.4 Procedure for Licensing an Intellectual Property Right

Licensing does not require particular formalities. Written evidence is nevertheless required to prove the existence of a licence, which makes it advisable to sign a proper licence agreement. Registration on the Italian Patent Register requires that either a copy of the actual licence agreement or a confirmatory declaration signed jointly by both licensor and licensee is presented and filed with the IPTO.

**Trevisan & Cuonzo** was established in 1993 and is one of the leading independent Italian law firms working with some of the most technologically advanced and innovative businesses and industry leaders around the globe. The firm has established a commanding reputation both domestically and internationally for its success and in-depth business and industry knowledge in intellectual property, commercial and product liability litigation. Since its establishment, the firm has earned a formidable reputation for its

success in patent litigation, winning landmark cases on behalf of the world's most innovative companies in the electronic, biotech, pharmaceutical, automotive, chemicals and consumer goods sectors. A large number of these cases have been fought on a multi-jurisdictional level, in close co-operation with lawyers and experts from different jurisdictions acting in parallel proceedings. The firm has a network of offices in Milan, Rome, Parma and Bari.

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