

IP RIGHTS

Amendments to the Italian Code of Industrial Property

Legislative Decree no. 131/2010, which will come into force on September 2nd 2010, updates the provisions of the Italian Code of Industrial Property (ICIP).

The amendments concern, *inter alia*, the registration procedures for the validity of IP rights, as well as their enforcement against counterfeiting practices (in particular the enforcement mechanism through interim measures is strengthened), and can be summarized as follows:

⇒ **Protection of trademarks and patents:**

i. interim measures against counterfeiting become more accessible with the unification of jurisdictional protection (articles 129 and 130 ICIP): it is now possible to request to **the same judge, description, seizure and injunction orders** (while previously the description had to follow a different procedural path);

ii. the right to obtain **interim measures ex parte** (*i.e.* without advance notice of the other party) is strengthened, as now the Code expressly provides such possibility not only when convening the other party could jeopardize the implementation of the interim measures, but also “*in case of particular urgency, and in particular where any delay could*

cause irreparable harm to the rights holder” (art. 129 ICIP);

iii. the judge is now expressly entitled to request **ex officio technical advice** also in interim measures proceedings whenever he deems it advisable (art. 132 ICIP);

iv. Possibility to obtain in urgent cases a **declaration of non-infringement** through interim proceedings (art. 120 ICIP);

v. The amendments expressly introduce the option of seeking **prior technical assessment**(art. 128 ICIP) for IP rights by reference to proceedings already set forth by the Italian Code of Civil Procedure in article 696-*bis* (“*Prior technical assessment aimed to reach a settlement*”); hence the IP right holder has the possibility to achieve in Court a rapid technical assessment on validity and infringement of an industrial property right, and then decide whether to opt for a settlement or to start legal action;

vi. the ordinary proceedings for the obtainment of the declaration of nullity of a patent are simplified: it is now **sufficient to sue the right holder**; the inventors who have sold or

licensed the right need not be sued any more (art. 122 ICIP).

- ⇒ **Industrial design**: Copyright now applies also to design products which are not protected as industrial design due to the lapse of the registration period, even if such products are marketed by the same parties who lawfully produced them before April 19, 2001 (date of introduction of the applicability of copyright protection to design products in Italy) (art. 239 ICIP).
- ⇒ **Know how**: in case an invention devised by an employee relates to the activity of the employer, the employee is entitled to receive a consideration for the invention, not only if the employer patents the invention, **but also if the invention is exploited as secret know-how** without being patented (art. 64 ICIP).
- ⇒ **Biotechnology**: the provisions of Legislative Decree no. 3/2006 have

been introduced in the ICIP without substantial amendments (articles 81-*bis* and following). The non patentability of the following is confirmed:

- the human body;
- inventions contrary to human dignity;
- processes for cloning human beings; for modifying the germ-line genetic identity of human beings; for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

RUCELLAI & RAFFAELLI

Enrico Adriano Raffaelli / Michele Franzosi

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