

# Italy



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## 1. What are the most effective ways for a European patent holder whose rights cover your jurisdiction to enforce its rights in your jurisdiction?

In urgent cases the following preliminary remedies are available to the patent owner:

- Seizure – an order to seize products, tools and production plants, books of account and invoices and advertising materials.
- Description – an order to inspect products, production plants, books of account, advertising and any associated documents in order to collect documentary evidence of the infringement and the extent thereof.
- Injunction – an order to cease the manufacture, trade and use of the infringing items or to remove the infringing items from the marketplace.

In order to seek compensation for damages caused by the infringement, the patent owner should start a proceeding on the merits.

## 2. What level of expertise can a patent owner expect from the courts in your jurisdiction?

A patent owner can expect a high level of expertise from the Italian IP courts. In Italy, IP civil litigation is handled by 12 specialised IP courts (Bari, Bologna, Catania, Florence, Genoa, Milan, Naples, Palermo, Rome, Turin, Trieste and Venice). Although the judges do not have specific technical backgrounds, during the trial the judge may appoint an expert to deal with technical issues. In addition, each party may appoint a technical expert, who can exchange both oral and

written opinions with the judge's expert.

## 3. How do your country's courts deal with validity and infringement? Are they handled together or separately?

Patent validity and infringement issues can be, and usually are, handled together in the same proceeding before the same court. In both infringement and invalidity proceedings technical issues are dealt with by the court-appointed expert.

## 4. To what extent is cross-examination of witnesses permitted during proceedings?

In Italy, patent cases are largely based on written evidence. Witness examination is permitted at the request of the interested party and is authorised by the judge on a case-by-case basis. Witnesses can be heard only in relation to specific queries previously submitted and approved by the court, subject to evaluation of the relevance and admissibility of those queries. Although witnesses are not cross-examined, in addition to the submitted queries the court may ask them to provide further clarification in respect of the circumstances on which the relevant queries are based.

## 5. What role can and do expert witnesses play in proceedings?

Expert opinions are frequently filed by the parties to support their technical arguments. There are no restrictions regarding the use of expert evidence. In patent cases the experts appointed by the parties participate actively by filing the relevant technical briefs and documents with the court-appointed expert.

## 6. Is pre-trial discovery permitted? If so, to what extent?

Pre-trial discovery is not permitted. The Italian legal system does not provide for discovery in the common law sense. Pursuant to Article 129 of the IP Code, the patent holder can ask for description as a pre-trial measure. This allows the patent holder access to the infringer's premises, production facilities, warehouses and/or accounts in order to describe the infringing items, as well as the means used to manufacture them, evidence as to the alleged violation and the extent thereof. If summoning the infringer before the court may prejudice enforcement of the order, the measure may be granted *ex parte*. When description is granted before the start of the case on the merits, the judge's order shall also fix a mandatory time limit (no longer than 20 working days, or 31 calendar days should these represent a longer time period) for commencement of the case on the merits. The order becomes ineffective if it is not enforced within 30 days or if the case on the merits is not filed within the fixed deadline. Usually the court authorises the applicant to participate in the enforcement activities and appoint its own technical expert.

#### **7. Do the courts in your jurisdiction apply a doctrine of equivalents?**

Even before the recent introduction of Article 52(3bis) of the IP Code (pursuant to which equivalents must be taken into consideration in order to determine a patent's scope of protection), the doctrine of equivalents was commonly applied in infringement actions. According to some court decisions, infringement occurs when the main inventive idea underlying the invention is found in the alleged counterfeited goods. The Supreme Court, in line with the courts of other EU member states, has held that in order to find that a product infringes a patent, it is necessary first to consider the problem that the invention seeks to solve, and then to decide whether the way in which the alleged infringing product solves the same problem either belongs to the prior art or is patentable in itself. If so, the product does not infringe the patent; if not, then it constitutes infringement.

#### **8. Are certain patent rights (eg, those relating to business methods, software and**

#### **biotechnology) more difficult to enforce than others?**

Business methods, software and biotechnology patents could be more difficult to enforce, particularly in interim measures cases. Due to the complexity of the underlying technical scientific issues, the judge usually requests an expert witness to draft technical advice in order to grant such measure. Accordingly, the proceedings can often take more time than patent cases in other technical fields.

#### **9. How far are the courts bound by previous decisions in cases that have covered similar issues?**

The Italian courts are not bound by decisions rendered in previous similar cases, but they can certainly consider them. Precedents set by the most important courts (Milan, Turin, Rome and Naples) have some influence on the other IP courts. However, at the same time the various IP courts can take divergent positions on complex technical issues, particularly in infringement cases, creating conflicting lines of reasoning that a patent holder must take into account when choosing the venue.

#### **10. Are there any restrictions on who parties can select to represent them in a dispute?**

Only lawyers admitted to practise and enrolled in the Italian Bar Association can represent parties in an Italian dispute. The parties must grant a written power of attorney. In general, in patent litigation the parties designate a lawyer and, if the judge appoints an expert witness, also an expert specialised in the relevant technical field to liaise with the official expert.

#### **11. Are the courts willing to consider the reasoning of courts in other jurisdictions that have dealt with similar cases?**

In general, the reasoning and decisions of courts in other jurisdictions have little influence in Italy; the Italian courts tend to be independent. Nevertheless, mostly with regard to interim measures, if the European Patent Office or a foreign court repeals the patent (or a corresponding foreign patent), the Italian court will take the relevant decision into consideration when assessing the applicant's likelihood of success on the merits.

## 12. How easy is it for defendants to delay proceedings and how can plaintiffs prevent them from doing so?

A defendant may delay proceedings each time it files a new request with its defence briefs (eg, by claiming invalidity of the plaintiff's patent within an infringement action). However, if it is proven that the defence is groundless, the judge will take this into account. In particular, should the losing party stay in proceedings in bad faith or with gross negligence, it will have to bear all relevant costs and can be ordered by the judge to pay damages to the other party pursuant to Article 96 of the Code of Civil Procedure.

## 13. Is it possible to obtain preliminary injunctions? If so, under what circumstances?

The IP Code provides a wide range of interim remedies:

- an injunction to cease the infringing activities;
- a penalty for non-compliance with the injunction;
- seizure of the infringing products and the means of manufacturing them, as well as evidence of infringement; and
- publication of the interim decision in one or more newspapers or trade magazines.

The prerequisites of any interim remedy are the existence of a danger in delay and a *prima facie* case. The danger in delay requirement means that the claimant must prove that the activity of the alleged infringer will cause irreparable harm before the issuing of a first instance decision. The *prima facie* case requirement means that the claimant must prove that it is allowed to enforce its alleged rights and that there are good reasons to believe that such rights are being infringed by the defendant. Interim measures are usually granted after the court has heard both parties, but may also be granted *ex parte* where the claimant can prove that the defendant's knowledge of the application or any delay in ruling may seriously affect the enforceability and effectiveness of the interim measure.

## 14. How much should a litigant plan to pay to take a case through to a decision at first instance?

The overall cost of patent litigation is significantly influenced by the complexity of the case and of the issues involved. On average, the costs of interim proceedings may vary from €25,000 to €35,000, and the costs of proceedings on the merits from €75,000 to €100,000, up to a first instance decision.

## 15. Is it possible for the successful party in a case to obtain costs from the losing party?

The winning party is usually entitled to recover part of the costs incurred from the losing party. Recoverable costs include court costs, lawyer fees and expert fees. Recoverable costs usually amount to around 30% of the total costs incurred.

## 16. What are the typical remedies granted to a successful plaintiff by the courts?

The typical remedies granted to a successful plaintiff in a patent infringement action are:

- a permanent injunction to cease the manufacture and sale of the infringing products;
- an order to withdraw the infringing products from the market or to deliver them to the patent holder – a penalty used in case the infringer does not comply promptly with any measure ordered by the court;
- compensation for damages; and
- publication of an abstract of the decision in one or more newspapers or trade magazines.

## 17. How are damages awards calculated? Is it possible to obtain punitive damages?

The criteria to determine damages for patent infringement are set out in Article 125 of the IP Code as follows:

- an amount equal to the lost profits of the patent owner; and
- the royalties that the infringer should have paid under a licence agreement.

In any event, the patent owner can claim the restitution of the profits earned by the infringer as an alternative to compensation for lost profits or in the amount that they exceed such compensation.

Punitive damages are not allowed under Italian IP law.

**18. How common is it for courts to grant permanent injunctions to successful plaintiffs and under what circumstances will they do this?**

It is quite common for courts to grant permanent injunctions in IP rights infringement proceedings. An injunction can also be ordered against any intermediate that had a part in the proceedings. When issuing a permanent injunction, the judge may also fix a fine for each subsequent violation of the order, as well as for any delay in compliance. There are no specific provisions requiring conditions for granting permanent injunctions.

However, unlike preliminary injunctions, permanent injunctions cannot be granted if the patent application is still pending. Moreover, courts tend to be reluctant to grant this measure when a patent is near to expiry.

**19. How long does it take to obtain a decision at first instance and is it possible to expedite this process?**

First instance proceedings on the merits may last as long as three to four years, depending on the complexity of the case at hand. If the relevant conditions are met, an application for interim measures before and during the pending proceedings on the merits may expedite the process.

**20. Under what circumstances will the losing party in a first instance case be granted the right to appeal? How long does an appeal typically take?**

A first instance decision in patent proceedings can usually be appealed by the losing party before the IP Division of the Court of Appeal within one month of notification of the judgment (or six months if the judgment has not been served). However, the Court of Appeal carries out a preliminary evaluation as to the admissibility of the appeal and may reject it if it is deemed inadmissible or apparently ungrounded. The appeal proceedings usually take between two and three years. Occasionally the Court of Appeal reconsiders the technical issues that were examined during the first instance proceedings and orders a supplementary expert; in such case, the duration of the proceedings may be significantly longer.

**21. Are parties obliged to undertake any type of mediation/arbitration prior to bringing a case before the courts? Is alternative dispute resolution a realistic alternative to litigation?**

The parties are not obliged to undertake mediation or arbitration before bringing a case before the courts. However, mediation is available as a possible alternative to litigation.

**22. In broad terms, how pro-patentee are the courts in your jurisdiction?**

The Italian courts are motivated to assess and uphold the rights of patent owners. This has been particularly so in recent years, with the creation of 12 IP courts with highly qualified judges and the issue of the new IP Code.

**23. Has your jurisdiction signed up to the London Agreement on Translations? If not, how likely is it to do so?**

The Italian government has not signed the London Agreement and has made no announcements regarding its position on this matter.

**24. Are there any other issues relating to the enforcement system in your country that you would like to raise?**

The limited number of specialised IP courts allows for a fairly homogeneous and predictable ruling pattern, with only limited jurisprudential differences among the various IP judges. It is usually possible to choose a specific competent court in which to start an IP action. The selected court can be in either the place where the defendant is located or one of the places where the infringement took place. For example, if the infringed item is sold across the whole Italian market, the plaintiff can in principle choose any of the relevant IP courts.

Furthermore, one of the most relevant issues in the Italian IP system is the possibility to apply for interim measures and commence proceedings on the merits on the basis of a patent application. **iam**

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Giuseppe Mercurio, nuclear engineer and European and Italian patent attorney, joined Rapisardi Intellectual Property in 2002. Highly skilled in patent drafting, filing and prosecution, and with extensive experience in all IP-related matters, he provides assistance in litigation and all extrajudicial procedures for patents, designs and utility models, including oppositions, assignments and licensing. A member of the International Association for the Protection of Intellectual Property, he is also a technical expert before the Court of Milan. His particular area of technical expertise is mechanics. He is fluent in Italian, English and French.