

ITALIAN IP
FIRM OF THE YEAR
MIP Awards 2006

Società Italiana Brevetti

*Intellectual and Industrial Property
in Italy and the European Union*

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ITALY - LEGISLATION UPDATE

Patent, Utility Model and Design
Fees Are Back

EUROPEAN UNION
LEGISLATION UPDATE

Patent Enforcement,
News From the European Pipeline

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società italiana brevetti's updates on intellectual and industrial property in Italy and the EU

December 2006 **patents**

ITALY - LEGISLATION UPDATE

PATENT, UTILITY MODEL AND DESIGN FEES ARE BACK

The cancellation of fees is to be reversed by the new government, which plans to reintroduce fees for patents, utility models and designs, as well as maintenance fees, as from early 2007.

Italy's draft Financial Law 2007, awaiting final approval, contains a provision aiming to reintroduce the government fees for patents, utility models and designs which were cancelled as from 1 January 2006 by the previous Financial Law 2006 (see June 2006 issue of this newsletter).

The draft's current version plans to reintroduce government fees for Italian patents, utility models and designs, as well as maintenance fees for Italian patents and European patents validated in Italy (only as from the 5th annuity), and for Italian utility models and designs (only as from the second 5-year period).

Universities and public bodies which include research among their institutional purposes would be exempted from paying government filing fees for patents and utility models.

The cancellation of fees in 2006 did not concern supplementary protection certificates, semiconductor topographies, new plant varieties and trademarks, which are therefore not interested by the changes described above.

The draft Financial Law 2007, which has already been approved by



Quite sure?

Italy's government led by Mr. Prodi (left) intends to reintroduce patent and other fees cancelled by the previous government barely a year ago. The Ministry of Economic Development led by Mr. Bersani (right) will be in charge of determining the new fees.

the lower house of Parliament and is currently being discussed in the Senate, must be approved by 31st

December 2006 at the latest. If the final version maintains the provision on reintroduction of fees, as seems extremely likely, the Ministry of Economic Development will have 30 days from approval to issue a decree establishing the new amounts.

**SIB ITALIAN CONTRIBUTOR TO
EPO-IAM "PATENTS IN EUROPE"**

Società Italiana Brevetti has contributed the chapter "Enforcing Patents in Italy" to the 2006 edition of "Patents in Europe: Helping business compete in the global economy".

The author of "Enforcing Patents in Italy" is Giovanni Antonio Gripiotti, an attorney-at-law with Società Italiana Brevetti's Rome office.

Produced in association with the European Patent Office (EPO) by Intellectual Asset Management (IAM) magazine, "Patents in Europe" is designed to inform companies both European and worldwide of the business case for patenting in Europe, and to provide an overview of how companies can secure effective patents in Europe and enforce their rights.

"Enforcing Patents in Italy" by Giovanni Antonio Gripiotti can be downloaded from our website at

<http://www.sib.com>

EUROPEAN UNION - LEGISLATION UPDATE

PATENT ENFORCEMENT, NEWS FROM THE EUROPEAN PIPELINE

EU Member States fail to agree on a new plan for a single European Patent jurisdiction, while the European Parliament votes to exclude patents from a proposed directive on criminal measures to enforce IP rights.

McCreevy Pessimistic about EU Patent Jurisdiction

Plans to create a single patent jurisdiction for all European Union Member States took a blow on 4 December 2006, making the European Commissioner for the Internal Market Charlie McCreevy wonder out loud whether it is at all worth trying to get Member States to agree on any EU-wide arrangement concerning patents.

The ambitious idea of a single EU-wide patent system known as the Community Patent was abandoned long ago, essentially because of disagreement between EU Member States concerning language regime as well as jurisdiction. Since then, the European Commission has been working on alternative proposals, for the short and longer term, with an initial focus on jurisdictional arrangements only.

Under the current system, any patent granted under the European Patent Convention falls under the jurisdiction of the national courts of countries where the patent is valid, which makes enforcement a long and expensive process. Therefore the first of the Council's proposals to be tabled aimed at obtaining a mandate

from EU Member States to negotiate the EU's entry into the European Patent Litigation Agreement (EPLA), which would establish a single jurisdiction for patents granted under the European Patent Convention.

On 4 December 2006, EU Member States refused the mandate. The Commission will therefore not be able to forward its proposals for an EU patent strategy on jurisdictional arrangements as planned, but will start yet another round of consultation with Member States.

In his speech at the PanEuropean Intellectual Property Summit on 7 December, Mr McCreevy was therefore openly pessimistic about the possibility of achieving a single European patent jurisdiction.

EU Member States, according to Mr McCreevy, seem too eager to forward their own ideas on the subject, and much less interested in building agreement around any existing proposal.

"If there is a will, there is a way" Mr McCreevy said, "but that is precisely the question. Is there a will to find a solution at EU level in the interests of the overall competitiveness of the EU economy?"

No Criminal Measures to Enforce Patents

A proposed European directive aims to make criminal measures applicable to the enforcement of intellectual property rights. The proposal was substantially amended on 27 November 2006, when the European Parliament's Industry Committee voted to have patents removed from the scope of the directive. The Committee explained that if the

purpose of the proposed directive is to tackle counterfeiting and piracy, particularly in the music, luxury goods, clothing industries and related sectors, a distinction must be maintained between patent infringements which may take place in the normal course of commercial activity, such as the legitimate development of products, and deliberate counterfeiting and piracy.

The Committee holds the view that patent infringers should not be equated with criminals such as pirates and counterfeiters, and points out that a company may need to infringe a patent intentionally in order to demonstrate that the patent at issue is not valid, and thus contribute to innovation. In this context, the infringement should remain a civil matter as is currently the case, unless it constitutes a serious threat to public health or safety.



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