

## **Standing Committee on Patents**

### **Questionnaire on the Publication of Patent Applications**

#### **Questions**

Groups are invited to answer the following questions under their national laws:

#### **I. Analysis of current law and case law**

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

*Intellectual property rights in Italy are ruled by the Industrial Property Code (Legislative Decree 10 February 2005 n. 30 – “IPC”).*

*Articles 53(2) and (3) IPC relate to the effects of an Italian patent, which start from the date in which the application with the description, claims and drawings, if any, is made available to the public.*

*Once eighteen months have passed from the date of filing of the application or the date of priority, or after ninety days from the date of filing of the application if the applicant has stated in the application that he wishes to make it immediately available to the public, the Italian Patent and Trademark Office (IPTO) makes the application available to the public together with its annexes.*

*Before the eighteen months or the ninety days, with respect to persons to whom a patent application with the description, claims and any drawings is notified, the effects start on the date of that notification [Article 53(4) IPC].*

*As far as European patent applications are concerned, Art. 54 IPC states that the protection conferred by a European patent application pursuant to Article 67(1) of the European Patent Convention (EPC) starts on the date on which the owner has made available to the public, by way of the IPTO, a translation of the claims into the Italian language or has directly notified such translation to the alleged infringer.*

*As far as International patent applications (PCT) are concerned, Art. 55 IPC states that a PCT application containing the designation or election of Italy, is equivalent to a European patent application wherein Italy has been*

*designated, and produces its effects.*

*According to Art. 186 IPC, the files of industrial property titles and of the applications may be consulted by the public, on authorization from the IPTO upon request.*

*According to Art. 189 IPC, the IPTO shall publish at least monthly an Official Bulletin containing a number of information about patents and utility models, registrations of designs and models and topographies of semiconductor products.*

*According to Art. 190 IPC, the IPTO shall also publish at least monthly an Official Bulletin of applications and complementary protection certificates for medicines and phytosanitary products.*

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

*Yes. 18 months after the filing or priority date as established by Art. 53(3) IPC. See point 1 above.*

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

*If a patent application claims priority from or the benefit of an earlier application, its publication occurs 18 months after the date of priority, as established by Art. 53(3) IPC. See points 1 and 2 above.*

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

*The owner of a patent application may withdraw it, without it being published, by filing an instance according to Art. 172 IPC and to Art. 29 of the IPC Implementing Regulation, up to the publication date indicated on the on-line database of the IPTO.*

5. What parts of a pending patent application are published?

*Art. 53(2) IPC provides that an Italian patent application is published together with its description, claims and drawings, if any.*

*As for European patent applications, Art. 54(4) IPC requests the publication only of the Italian translation of the claims.*

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

*As foreseen by Art. 132(1) IPC, all the interim measures provided by the IPC are available also during a patenting procedure, as long as the application has been made available to the public.*

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

*As foreseen by Art. 132(1) IPC, all the interim measures provided by the IPC are available also with respect to persons to whom notification of the application was given before an application is made available to the public.*

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

*Early publication is allowed in Italy, but the Applicant must declare it upon filing. According to Art. 53(3) IPC, the application is made available to the public after 90 days from the filing date.*

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

*According to the IPC, a patent application must be published pursuant to Art. 53(2) and (3). As an exception, according to Art. 198 IPC, a patent application is not published whenever an invention concerns objects that could be useful for the defense of the Country.*

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

*A lapsed or an abandoned patent application is generally published. Publication may only be avoided by filing a withdrawal instance of the patent application before the publication date.*

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

*In our jurisdiction only divisional applications may be filed, whose legal effect*

*starts from the filing or priority date of the initial application. The same rules apply as far as publication is concerned.*

## **II. Policy considerations and proposals for improvements to your current system**

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

*We agree that there should be a requirement for automatic publication of pending applications by a particular deadline. The IPC already provides for automatic publication after 18 months from the filing of priority date.*

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

*We agree that there should be a right for the patentee to request early publication. The IPC already provides for such a request and its conditions. See point 1 above.*

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

*We believe that all the applications deriving from the same priority application should be subject to the early publication if one of them is published early.*

15. Should there be a right for the patentee to withdraw the application before publication?

*In our opinion there should be a right for the patentee to withdraw the application before publication. The IPC already has such a provision. See point 4 above.*

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

- a. with respect to the patentee's own subsequent patent applications; and
- b. with respect to third party patent applications?

*Following withdrawal of a patent application before its publication date, the state of the art should remain the same as before the filing date of that patent application. Hence, any further patent application filed by either the patentee*

*or third parties should not be affected by the previous filing.*

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

*We agree that the patent office should be required to provide its initial assessment of the validity of the patent, so that the applicant may decide whether to withdraw before publication.*

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:

a. the patent office to provide the results of its initial assessment?

*A patent office should provide the results of its initial assessment well before the priority deadline, e.g. within 9-10 months from filing date as it is presently the case of the IPTO.*

b. the applicant to decide whether to withdraw the application?

*18 months from filing or priority date.*

c. the application to be published?

*18 months from filing or priority date.*

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:

a. on the initiative of the patentee;

b. on the initiative of the patent office; or

c. on the initiative of third parties (such as other governmental agencies)?

*We believe that the only exception to automatic publication should be related to national security as e.g. established by Art. 198 IPC. See point 9 above.*

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

*In line with our answer to question 19, a governmental agency should decide. In our case the Military Section for Patents of the Ministry of Defense.*

21. Should there be different rules for the publication of continuation,

continuation-in-part and divisional applications?

*We believe that there should be no different rules for the publication of continuation, continuation-in-part and divisional applications.*

22. What proposals would you make to improve your current system?

*We believe that our present patent law concerning publication of patent applications is generally satisfactory. Anyhow, electronic publication of patent applications and granted patents should be quickly improved as well as the related search engine.*

### **III. Proposals for harmonization**

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

*We agree that patent offices should be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret. The search results and a preliminary assessment of patentability should be available before the priority deadline, if any.*

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

*In our view, there should be no exception to publication of applications.*

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

*We believe that any exceptional circumstances where a Patent Office delays or suppresses publication should be clearly, well defined and very exceptionally applied.*

26. What is an appropriate period for publication after filing an application or after

the priority date? Is 18 months an appropriate period?

*We believe that 18 month is an appropriate period for publication after filing an application or after the priority date.*

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

*We believe that harmonization concerning the effects of a published patent application is desirable, especially as far as the publication date is concerned and the possibility to obtain preliminary measures before grant of the patent.*