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Q244

Inventorship of multinational inventions

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I. Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Inventorship in such situations must be evaluated on a case-by-case basis. The Italian case law in this regard is rather scant.

b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Please comment:

The Italian patent law establishes that the scope of protection is defined by patent claims. However, there is no legal basis allowing to define inventorship on a claim-by-claim basis, nor on any other specific part of the patent/patent application.

2)	Does your law of inventorship depend on the citizenship of the inventor(s)?
	no
	Please comment:
	<i>The Italian Industrial Property Code does not provide a definition of inventorship. Hence, no answer can be given to this question.</i>

3)	Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?
	no
	Please comment:
	<i>As explained above, the Italian Industrial Property Code does not provide a definition of inventorship. Hence, no answer can be given to this question.</i>

4)	Can the inventorship of a patent application be corrected after the filing date in your country?
	yes
	If yes, what are the requirements and time limits for such correction?:
	<i>According to article 119(2) of the Italian Industrial Property Code, an incomplete or erroneous designation may be corrected only by filing a request accompanied by a declaration of consent of the person previously designated, and if the request is not filed by the applicant or the owner of the patent or registration, also by a declaration of consent of that party.</i>
	<i>This article prescribes no time limits.</i>

5)	What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?
	<i>According to article 118(1) of the Italian Industrial Property Code, whoever is entitled to do so under this Code may file an application for registration of a patent application.</i>
	<i>Article 118(2) states that if by a final judgment it is determined that the right to registration of the patent belongs to a person other than the one who filed the application, such person may, if the industrial property title has not yet been issued, and within three months of the judgment becoming final:</i>
	<i>a) take over the application for the patent or registration in his own name, assuming the capacity as the applicant for all purposes;</i>
	<i>b) file a new application for a patent or registration whose starting date, to the extent that its content does not exceed that of the first application or refers to an object that is essentially identical to that of</i>

the first application, dates back to the date of filing or priority of the initial application, which in any case ceases to have effect; in the case of a trademark, file a new application for registration, whose starting date, to the extent that the trademark contained in it is essentially identical to that of the first application, dates back to the date of filing or priority of the initial application, which in any case ceases to have effect;

c) obtain the rejection of the application.

According to Article 118(3), if the patent has been issued or the registration made in the name of a person other than the entitled party, the latter may do one of the following:

a. obtaining the transfer of the patent or certificate of registration to his name by way of a judgment, starting on the date of the filing;

a. claiming the nullity of the patent or registration granted to the person who was not entitled to it.

According to Article 118(4), after two years from the date of publication of the granting of the patent for an invention, utility model, new plant variety, or from the publication of the granting of the registration of a topography of semiconductor products, without the entitled person having made use of one of the rights under paragraph 3, nullity may be claimed by whoever has an interest to do so. This provision does not apply to registrations of trademarks and designs.

A possible intentional error has in principle no influence on the procedure of Article 118.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

If the answer is yes, please answer the following::

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

no

Please comment.:

The area of technology is not relevant in the frame of Article 198 of the Italian Industrial Property Code.

b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

Please comment.:

According to Article 198(1) authorization of the Ministry of Economic Development may be given in the form of a foreign filing license. A petition for a foreign filing license must identify the Applicant and indicate the title of the invention. An abstract of the invention with possible drawings, as well as a power of attorney and a list of the inventors shall be attached to the petition.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

Please comment.:

The Italian Industrial Property Code does not provide any indication in this regard.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

If an inventor of the team or group of inventors is resident in Italy, the first patent application shall be filed with the Italian Patent Office as established by the Article 198(1) of the Italian Industrial Property Code. Alternatively, a foreign filing license shall be requested. The nationality of the patent owner is not relevant.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

no

Please comment.:

The filing of a foreign filing license in another country does not affect the provisions about the national filing of Article 198(1) of the Italian Industrial Property Code.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

Unless the act constitutes a more serious crime, violation of the provisions of Article 198(1) shall be punished with a fine or with detention. If violation is committed when authorization has been denied, detention of not less than one year shall apply.

- 7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

If yes please answer the following questions.:

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

See under question 6(a)

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

See under question 6(b)

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

See answer to question 6(f)

II. Policy considerations and proposals for improvements of the current law

- 8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

As explained above, the Italian Industrial Property Code does not provide a definition of inventorship. Hence, no answer can be given to this question.

- 9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

In our view, the provisions of the Italian patent law are appealing for foreign inventors, because no binding provisions exist for inventors that are not resident in Italy.

- 10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

In our view, the provisions of the Italian patent law are adequate and the request of a foreign filing license is a quick, effective and inexpensive procedure for filing patent applications abroad.

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

In our view, there are no other aspects of the Italian patent law that should be improved.

III. Proposals for harmonisation

- 12) Is harmonisation in this area desirable?

yes

Please comment.:

Harmonization of provisions ruling inventorship of multinational inventions is desirable.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international

standard.

In our view and in line with the approach of the European Patent Convention, a definition of inventorship is not strictly necessary. However, a possible definition of inventorship should consider who conceived the invention and reduced it to practice.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

In our view, the Italian Article 119 of the Italian Industrial Property Code provides a good standard for correction of inventorship after a patent application is filed. See the answer to question 4.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

Provided that the national defence of a country requires that a first filing application be evaluated by the Ministry of Defense of that country, the possibility of obtaining a foreign filing license should be available so as to facilitate and promote the activity of international R&D teams.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

In our view the Article 198(1) of the Italian Industrial Property Code provides a good standard for national first filings, also considering that, according to Articles 149 and 151 of the Italian Industrial Property Code, the same provisions also concern first filings of European and international patent applications.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

In our view, the present Italian procedure for obtaining a foreign filing license provides a good standard. As explained in our answer to question 6, a petition for a foreign filing license should identify the Applicant and indicate the title of the invention. Moreover, as established by Article 149(2) of the Italian Industrial Property Code, an abstract of the invention with possible drawings, as well as a list of the inventors should be attached to the petition. A power of attorney should also be filed if the request is made by a professional representative on behalf of the applicant.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

In our view, the whole provisions Article 118 of the Italian Industrial Property Code provide a good standard. See the answer to question 5.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Summary

The Italian Industrial Property Code does not provide a definition of inventorship.

An inventor has a moral right to the invention and shall be mentioned in the patent application. The Italian Patent Office does not check correctness of the indication of owner and assumes that the indication is correct. Inventorship of a patent application may anyway be corrected after the filing date and reliefs are available to claim entitlement to file an application for registration of a patent application when the owner's rights have been violated.

The Italian patent law provides no legal basis allowing to define inventorship on a claim by claim basis, nor on any other specific part of the patent/patent application.

Persons residing in the territory of the Country may not, without the authorization of the Ministry of Economic Development, file their patent applications only with the offices of foreign Countries or the European Patent Office or the International Office of the World Intellectual Property Organization as the receiving office, if those applications relate to objects that could be useful for the defense of the Country.

Violation of these provisions shall be punished with a fine or with detention.

An authorization of the Ministry of Economic Development may be obtained in a short time in the form of a foreign filing license. The request of a foreign filing license is a quick, effective and inexpensive procedure for filing patent applications abroad.

Harmonization of provisions ruling inventorship of multinational inventions is desirable. In this regard, the provisions of the Italian patent law are appealing for foreign inventors, either alone or working in a, possibly international, team, because no binding provisions exist for inventors that are not resident in Italy.

The possibility of obtaining a foreign filing license should be available so as to facilitate and promote the activity of international R&D teams.

As far as entitlement and correction of inventorship are concerned, the Italian Industrial Property Code provides good standards after a patent application is filed.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.