



In or out?

It appears that Italy is out of the new European Patent, but it is not as simple as that according to Valerio Lunati, Lunati & Mazzone S.r.l.

Italy, Europe's third-largest economy, apparently seems to be out of the new European patent with unitary effect. However, analyzing the situation more deeply, this is not the case.

As is well known, the European Parliament recently approved the new European Patent with Unitary Effect and the new European Unified Patent Court. Italy and Spain are notably absent from the former but, as we will see, this absence is easily overcome and in reality only apparent.

The current granting situation

Currently, a European Patent Convention (EPC) is in place, signed in 1973 and updated in 2000. The EPC was agreed prior to, and does not directly depend on, the European Union. There are 40 EPC member countries, in other words all 28 countries belonging to the European Union, (Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Germany, Denmark, Estonia, Spain, Finland, France, United Kingdom, Greece, Croatia, Ireland, Italy, Lithuania, Luxembourg, Latvia, Malta, Netherlands, Poland, Portugal, Romania, Sweden, Slovenia, Slovakia) and also Albania, Switzerland, Hungary, Iceland, Liechtenstein, Monaco, Former Yugoslav Republic of Macedonia, Norway, Serbia, San Marino, Turkey, Bosnia and Herzegovina, Montenegro (the latter two only as extension states, but it makes little difference). These countries manage a central patent office, the European Patent Office (EPO), which follows a unitary procedure for patent examination.

The procedure for examination of European patent applications must be carried out in one of the EPO's

three official languages – English, French or German – although it is possible to file the application and all subsequent documents in an official language of a member country (for example: Dutch, Portuguese, Italian, Spanish, etc.) and subsequently provide a translation.

When the patent has been granted, the proprietor must ensure translation of the claims only into the other two official EPO languages not corresponding to that of the procedure. To summarize, European patents granted today have the description in one of the official languages and the claims in all three languages.

Following granting of the patent, there is a nine-month window for any opposition. That is, a period in which third parties can proactively submit, directly to the EPO, observations and evidences in favor of the total or partial revocation of the European patent granted.

Current procedure after granting

Following the granting of a European patent, the centralized European patent procedure terminates and the patent can be transformed into a series of national patents valid in individual countries adhering to the EPC.

In particular, the proprietor must choose the countries in which the European patent is to be enforced after granting and with each of these chosen countries file, at the local national patent office, a translation of the patent into the local language.

For example, a proprietor who wishes to enforce their European patent only in Sweden and Portugal must, within three months of granting, translate the patent into Swedish and Portuguese and file these translations with the relevant patent offices. These national patent offices are obliged to accept the patent as granted without further examination.

Recently, this latter requirement, following the "London Agreement", has been slackened for some countries for which translation is no longer necessary or it is necessary to file only the translation of the claims, but the situation does not change substantially.

The individual national patents deriving from a European patent then remain mutually independent. For example, one of them may be abandoned or declared void regardless of the others, or sold independently of the others.

Current defense

The individual national patents deriving from a European patent can only be defended in national courts. During national legal proceedings the court can declare void

only the local national portion of the European patent, which remains valid in the other countries. Similarly, infringement of a patent may be declared only for the national part of the patent.

The EPC contains a number of articles to harmonize the reasons for revocation (article 138 EPC) and infringement (article 69 EPC), but each country has its own separate judiciary.

The new situation

The previous European patent had the advantage of not depriving individual countries of their judicial autonomy and centralizing only a portion of the patenting process and patent defense. It is no coincidence that the EPC also had the consent of historically independent countries, such as Norway, Switzerland and Monaco, as well as all major European countries.

Nevertheless, this procedure is too expansive and in contradiction with the creation of a single Union market (with regard to the European Union). Consequently, European countries have attempted to remedy these drawbacks.

The new European Patent with Unitary Effect

Recently, (almost all) the European Union countries, following years of discussion, came to an agreement on the "European Patent with Unitary Effect" regulation.¹ This regulation has been signed by all EU countries, except Italy, Spain and Croatia (the latter however has only recently joined the European Union and presumably will soon sign the regulation) and establishes the creation of a Unitary patent for those countries which remains such even after granting.

In detail the regulation establishes the following.

- The new Unitary patent can be obtained substantially as a nationalization of the traditional European patent, in other words instead of a single country, the proprietor may designate all the Unitary countries together (except for Italy and Spain).
- Such nationalization will be acquired and managed by the EPO itself.
- To obtain nationalization it will be necessary to translate the European patent into English or, if the patent is already in English, another official language of the European Union. Note that the convention does not speak of another language of a country adhering to the Unitary regulation. So this language can also be Italian or Spanish.

¹ See: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:361:0001:0008:EN:PDF>

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The new Unified Patent Court

European Union countries have also signed an Agreement on a Unified Patent Court which gives rise to the Unified Patent Court. The latter is a unified court dealing with the validity and infringement of patents following their granting. This Unified Patent Court, seven years after its implementation, will become the only court able to deal not only with European Patents with Unitary Effect but also current European Patents, completely replacing the national courts.

The Agreement on a Unified Patent Court has been signed by all European Union countries except Spain, Poland and Croatia (which presumably will soon sign the regulation). So Italy has signed this agreement.

The Unified Patent Court will have jurisdiction as regards:

- (a) actions for actual or threatened infringements of patents and supplementary protection certificates and related defenses, including counterclaims concerning licenses;
- (b) actions for declarations of non-infringement of patents and supplementary protection certificates;
- (c) actions for provisional and protective measures and injunctions;
- (d) actions for revocation of patents and for declaration of invalidity of supplementary protection certificates;
- (e) counterclaims for revocation of patents and for declaration of invalidity of supplementary protection certificates;
- (f) actions for damages or compensation derived from the provisional protection conferred by a published European patent application;
- (g) actions relating to the use of the invention prior to the granting of the patent or to the right based on prior use of the invention;
- (h) actions for compensation for licenses on the basis of Article 8 of Regulation (EU) No 1257/2012; and
- (i) actions concerning decisions of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012.

These powers extend to both the Patent with Unitary Effect as well as European Patents.

Bringing in Italy

To obtain a Patent with Unitary Effect which also designates Italy, in addition to the 25 signatory countries of the regulation, it will be necessary, in addition to carrying out the operations indicated above to obtain a Patent with Unitary Effect, to also translate the patent into Italian and file it with the Italian Patent and Trademark Office.

In particular, for the vast majority of European patents which have English as the procedure language, it will be necessary to translate the European patent granted into one of the other official languages of the European Union. Given that Italian is one of the official languages of the European Union, the most economical solution is to choose Italian as the second language of the Patent with Unitary Effect and use the same translation into Italian to file the national validation in Italy.

Subsequently, the Italian Patent will retain its independence from the Patent with Unitary Effect but, nevertheless, it will always be subject to the Unified Patent Court and exclusion from the Patent with Unitary Effect will therefore not make a significant difference.

Moreover, Patents with Unitary Effect, as well as traditional European Patents, can also be defended by Italian Patent Litigators.

Given that Italy has important engineering and law schools and legal office and patent attorney costs are lower than those of the other main European countries (for example, Germany, France and the UK), Italy represents an excellent source of patent and legal offices to initiate defense actions at the Unified Patent Court.

In conclusion, the absence of Italy from the Patent with Unitary Effect can be easily and economically integrated in the current unitary system.

Résumé

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Valerio provides consiliences for enterprises, since 2003, focused in the field of patents and models. In particular he follows European patents, International patents, U.S. and South-East Asia, taking care of the stages of drafting, filing and prosecution, comprising the step of examination, granting and debate with local examiners. He also deals with drawings and models at Community level and internationally. Valerio has also gained experience in the field of patent litigation in both judicial and non-judicial. Areas techniques: Mechanical, industrial processes, industrial chemistry and electrical engineering. Languages: Italian, English, German.

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