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Obligatory mediation in Italian patent disputes?

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By Legislative Decree no. 28 of 4 March 2010, the Italian legislator introduced obligatory mediation into the Italian legal system. In particular, Art. 5 provides that, as of 20 March 2011, in a number of listed cases, court proceedings may be instigated only if, prior to that, the parties pursued mediation proceedings using one of the official mediation bodies contemplated by the new law. The list of Art. 5 includes a rather generic definition of the cases for which mediation will become obligatory and Italian IP experts are currently debating on whether industrial property litigation, including patent litigation, is included in the list. The latter, in fact, inter alia contains the expression "diritti reali". This phrase, I believe, is impossible to translate into English. In short – and accepting a certain degree of imperfection in the explanation I am about to give – "diritti reali" is a definition by which we generally oppose "relative rights" to "absolute rights", with "property right" being the "diritto reale" par excellance. Therefore, at least at first sight, there seems to be room for arguing that industrial property rights fall within the general definition of "diritti reali" and that, therefore, after 20 March 2011, patent litigation will only be admissible if prior mediation according to the above mentioned piece of legislation has duly been attempted (and it has failed). Numerous seem to be, however, the arguments to the contrary, mainly based on a historical research of the true meaning of the phrase "diritti reali" and of the scope of the category of IP rights in the Italian legal system, which would seem to play against an interpretation of this phrase which encompasses absolute rights over intangible assets, as opposed to absolute rights over tangible assets. Another argument in this sense is the fact that, in the explanatory report issued at the time of the adoption of Legislative Decree 28/2010, it is stated that the list of Art. 5 refers to issues in which the "relationship between the parties is destined to be prolonged in time" as the relevant cases concern "relationships involving people belonging to the same family, the same social group, the same territorial area", which would again seem to exclude that IP rights are involved. Some commentators even conclude that Legislative Decree no. 28/2010 would be contrary to the Italian Constitution, by reference to Art. 24 on the right of any person to resort to court to assert her rights. I tend to agree with the interpretation which excludes the application of Legislative Decree 28/2010 to IP litigation, but the debate has just commenced. From a practical point of view, should an interpretation be accepted that Art. 5 of Legislative Decree no. 28/2010 encompasses IP litigation, numerous will be the procedural issues to resolve, including how to coordinate the request of urgent measures (which would remain possible even without prior mediation), with the

requirement that a mediation is attempted before commencing merits proceedings (which in general must be commenced within extremely short deadlines from the issue of preliminary measures). For those who speak Italian, I suggest reading the several articles on this topic that are published in the latest issue of the Rivista di Diritto Industriale, and especially those by Prof. Giuseppe Sena and Prof. Adriano Vanzetti (3/2010, I, 163 and 173).

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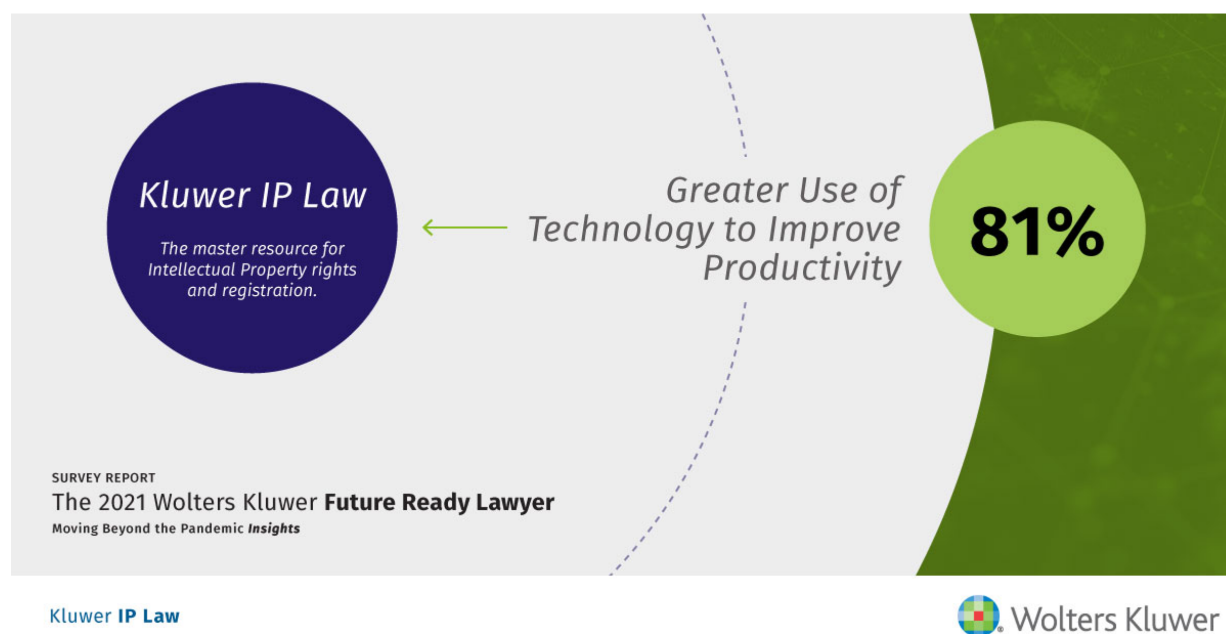

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