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Infringement proceedings must be stayed in case of pending opposition proceedings, says the Court of Turin

Daniela Ampollini (Trevisan & Cuonzo) · Thursday, January 31st, 2013

By order of 16 October 2012 in *Sperotto v. Bolpagni*, the Court of Turin stated, in line with a few other of its recent decisions, that patent infringement ordinary proceedings (even if including a cross-claim of revocation) must be stayed until the conclusion of EPO opposition proceedings pending on the allegedly infringed patent, in application of Article 120 IP Code.

In fact, Article 120 IP Code literally says something different. In the Italian system, infringement cases can be brought before the grant of the patent, as soon as the patent application has become public or has been served on the alleged infringer. Article 120 IP Code therefore establishes that no ruling in ordinary proceedings can be issued before the grant of the patent and that, therefore, the courts have to stay the proceedings until such a grant. The practical application of this provision has always been that of having the case proceed until the very last steps and, just before the issue of the ruling, allow the grant of the patent by means of a stay (possibly a short one) in order to make sure that the ruling would be issued only on a granted patent. This set of rules appears to be related to how national patents have always been granted Italy, i.e. without prior examination, and without opposition proceedings. In this perspective, the patent will surely be granted, it is just a matter of time, and Article 120 IP Code simply resolves a practical issue.

Now, the Court of Turin seems to be firm in interpreting article 120 IP Code rather broadly, stating that even the pendency of opposition proceedings has the effect determining a stay of the infringement action, considering that the opposition proceedings may lead to the revocation of the patent. My first comment is that there is in fact some difference with the situation referred to in Article 120 IP Code and that of opposition proceedings as, when a patent is opposed, there is a granted and enforceable patent in the first place, and allowing an immediate stay - without even considering whether the opposition is *prima facie* grounded - could be seen as an unreasonable frustration of the rights of the patent holder. Secondly, I am not sure how this interpretation of Article 120 IP Code could reconcile with the established case-law of the Italian Supreme Court according to which a revocation action instigated before an ordinary court does not have the effect of determining the stay of the infringement proceedings pending before another court (e.g. Supreme Court no. 24859/2006).

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This entry was posted on Thursday, January 31st, 2013 at 4:59 pm and is filed under [\(Indirect\) infringement](#), [Italy](#), [Opposition](#), [Procedure](#)
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