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Want to revoke a patent? Call the inventor

Daniela Ampollini (Trevisan & Cuonzo) · Friday, December 12th, 2014

The Italian Supreme Court recently (and surprisingly) said that inventors must be named as co-defendants in revocation actions.

In 2010 I wrote a post concerning the requirement to name inventors as co-defendants in Italian revocation actions. I reported that the Court of Appeal of Milan had established a principle whereby named inventors had to be called in revocation actions and, if they were not, proceedings could not reach the stage of decision. This was based on the then in place provision of Article 122 (4) of the of Italian IP Code, according to which *“Any action aimed at the revocation of an industrial property title shall be brought against all persons listed in the register as right holders”*. The Milan Court stated that inventors as well have *“certain rights on the patent”*, as they should be recognized to have an interest in defending the patent especially in cases the invention was made in the execution of or in compliance with an agreement, including an employment agreement, considering the legislation governing employees’ inventions in Italy, according to which the inventor must always be remunerated for his invention (either in the framework of his ordinary wage or by means of an additional reward). I raised several objections to what above, including the consideration that the fact that an employee inventor obtains a remuneration for a patented invention does not necessarily mean that, according to the law, he has to return the remuneration if the patent is revoked.

We all thought to be over and done with this issue when, in September 2010, an amendment to Article 122 (4) IP Code was introduced, so that the provision now reads *“Any action aimed at the revocation of an industrial property title shall be brought against all persons listed in the register as right holders for being proprietors thereof”*. It seemed to many that, according to this new wording of Article 122(4), revocation actions should only involve current proprietors or co-proprietors of the patent, surely not inventors.

The Supreme Court (decision no. 13915 of 18 June 2014 – *SISVEL v. Italtel*) now stated that the old principle I referred to in my post of 2010 is still valid, notwithstanding the new wording of Article 122(4) IP Code and that, therefore, patent revocation actions must necessarily be served on inventors as well.

According to the Supreme Court *“the action for revocation of an industrial property*

title must be instigated against all of those that are included in the register 'as right holders'. The addition of the phrase 'for being proprietors thereof' (...) does not exclude those who have assigned their rights on the title, as they remain included in the register 'for being proprietors'. The new provision is not limited to 'current' proprietors, but generically refers to 'proprietors' and there is no doubt that this includes the original proprietors of the patent".

Well, I am not sure I agree with this proposition and I do not think there is no doubt that former proprietors are included. Even before that, I am not convinced that one can say an inventor is an original proprietor of the patent under Italian law... In fact, I am not even convinced that one can always say, under Italian law, that the inventor is even the original proprietor of the invention...

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