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Two recent decisions of the Italian Supreme Court on the test for sufficiency

Daniela Ampollini (Trevisan & Cuonzo) · Wednesday, June 2nd, 2010

Two recent decisions of the Italian Supreme Court (no. 21835 of 14 October 2009 and no. 23414 of 4 November 2009) have tackled the issue of sufficiency in a peculiar manner, departing from previous case law. In both decisions, it is stated that “the protection granted by a patent presupposes, besides the requirements of novelty and inventive step, the formal requirement of a clear and sufficient description. Therefore, the lack in the description of the indication of the technical problem of which the invention is a solution, and of the degree of inventiveness or usefulness of the invention as opposed to the prior art, results in a deficiency which cannot be filled in ex-post by the patent holder or the Court Expert in the framework of a revocation action”. In substance, according to the Court, the patent description not only has the task of explaining, to the person skilled in the art, the way in which the invention can be implemented (as provided for by Art. 51 of the Italian IP Code), but also that of explicitly describing the technical problem and the specific reasons why the invention results in an innovation, in respect of the prior art, in the solution of the technical problem. Although the Italian case law on the issue of sufficiency is rather scant, these decisions seem to be in contrast with the preceding case law of the Supreme Court. For instance, in the famous Carbadox case (no. 2168 of 1982) it was stated that: “the element of the description of the patent consists in the definition of the content of the invention (that as far as chemical patents are concerned is the enunciation of the chemical structure of the product) and in the indications necessary to the skilled person to put the invention into practice in connection with its purpose and its attitude to have an industrial application. The analytical and comprehensive indication of all the properties of the products and of all its practical effect and the proof and the relevant documentation of the inventiveness of the invention are irrelevant with respect to the description of the invention for the purpose of its valid patentability”.

The reasoning at the basis of the two recent decisions cannot be explained by reference to Art. 21 of new ministerial decree no. 33/2010 (containing regulations for the implementation of the Industrial Property Code), which establishes the elements that must be contained in patent applications, which include “indicating the state of the art useful to the understanding of the invention” and “illustrating the invention in such a way that the technical problem and the proposed solution can be understood”. These requirements should in fact pertain to the formal assessment of the patent application when filed, but not pose an additional requirement of validity. Hopefully the principle set by these decisions will be corrected, or at least clarified, by the Supreme Court in future cases.

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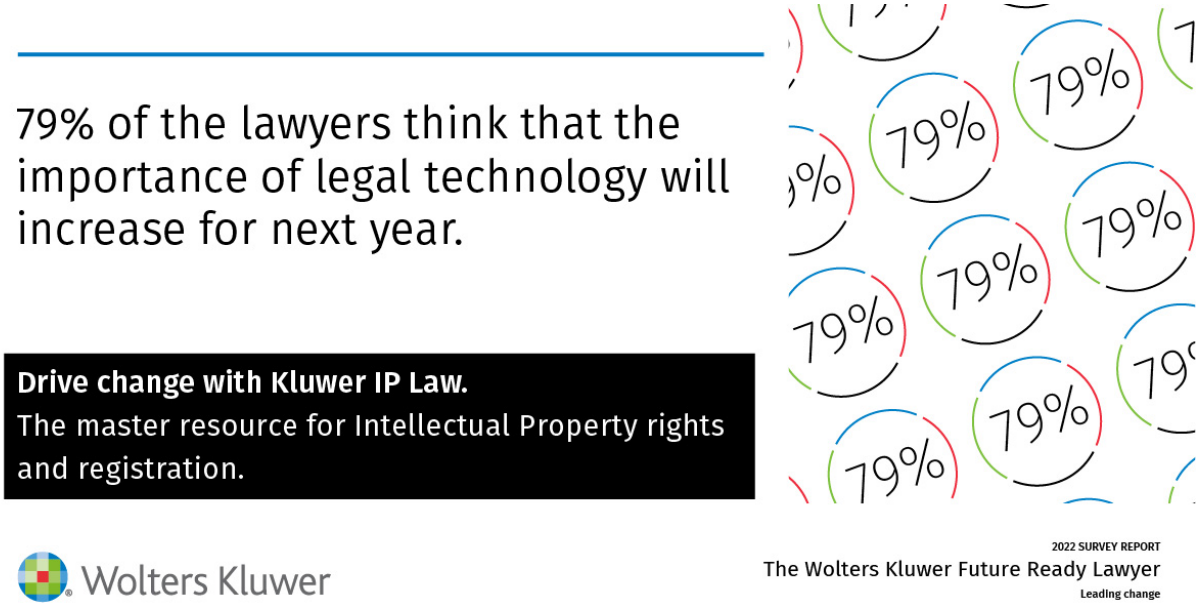

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