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Italian Supreme Court clarifies test for prior disclosure

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By decision no. 9291 of 19 April 2010, the Italian Supreme Court clarified that the sale of a single unit of the patented product is novelty destroying under Art. 46 of the Italian IP Code, which provides that an invention is new if it is not comprised in the state of art and that this is formed by all that was made available to the public before the filing of the patent application by written or oral description, by use, or by any other means.

The Court expressly clarified that this is not in contrast with its preceding case law according to which prior disclosure is novelty destroying if it involves an “indeterminate number of persons”. As long as the unit sold is a functioning one, the purchaser is not bound by a confidentiality agreement with the patent holder and the purchaser is sufficiently experienced to understand the invention and implement it or have it implemented, the disclosure is a relevant one and is such to determine the revocation of the patent.

In the case at issue, the patent holder sought to enforce against an infringer a product patent claiming a device for accumulating and counting paper objects. The defendant cross-claimed the revocation of the patent by producing evidence that a prototype of the product claimed by the patent had been sold by the patent holder to a professional customer before the filing of the patent application. The patent holder however claimed that this would not be novelty destroying as the prototype was the only unit to be sold. Furthermore, it claimed that it was not a properly functioning one and that the purchaser had never used the purchased product in its business, which had de facto blocked its dissemination.

According to the Court, the sale of one unit only was enough. By this sale, the product was placed into the market and brought to the (even if only potential) knowledge of an indeterminate number of persons (thereby placing the subject matter of the patent into the prior art), considering that the purchaser company (including its shareholders, employees, consultants, etc.) was not bound by any obligation of confidentiality towards the seller. Nor was it relevant that the product was never used in the business of the purchaser. Rather, the decision by the purchaser not to use the product in its own business was actually a demonstration of the fact that the purchaser had been able to understand how the product worked and to conclude that it was unsuitable for its own business. The non functioning of the prototype was the only potentially relevant element, as it would have impacted on the possibility by the purchaser (and further people) to understand the invention. However, an expert appointed by the Court clarified that the prototype was in fact a functioning one. The patent was therefore revoked and the claim for infringement dismissed.

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