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Do inventors have a right to be called as co-defendants in patent revocation actions in Italy?

Daniela Ampollini (Trevisan & Cuonzo) · Wednesday, June 30th, 2010

The Court of Appeal of Milan established a principle whereby named inventors must be called in revocation actions and, if they are not, proceedings may not reach the stage of decision. This principle, which may sound strange to practitioners of other jurisdictions, is based on Art. 122, paragraph 4, of the Italian IP Code, according to which "Any action for revocation or invalidity of an industrial property title shall be brought against all persons listed in the register as having rights on the patent" and the consideration that inventors as well have "certain rights on the patent". See Inter alia, the Court of Appeal of Milan, 3 March 2000, according to which "(…) the inventor, whose name is noted in the collection of the originals of patents, has an interest which legitimates his intervention and participation in the nullity proceedings for the protection either of his personal right to be acknowledged as the author of the (validly) patented invention, or of the property rights connected to his intellectual performance (which presumably was not made for free) and as the one to which the system attributes the right to patent the invention (…). Accordingly, the inventor (…) has to be qualified as one of the subjects 'who have rights on the patent' and who has therefore to be involved in the action for revocation". Further: "according to the Court, an interest with analogous consequences should also be recognised to the author of the invention when the invention was made in the execution or in compliance with an agreement, including an employment agreement" in light of the legislation governing employees' inventions in Italy, according to which the inventor is always remunerated for his invention (either in the framework of his ordinary wage or by means of an additional reward).

A number of objections could be raised: for instance, 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. Also, the issue of whether a remuneration applies or not in the specific case is often regulated by foreign law, and not Italian law, when the patent holder and the inventors are not Italian citizens or residents. On the other hand, it is true that the mere moral right granted by Italian law to the inventor technically qualify the inventor as a subject having "rights on the patent", within the meaning of Art. 122 IP Code. Based on the above, the Court of Milan has adopted this approach and inventors are practically always called as co-defendants in revocation actions. It is difficult to say whether this approach is adopted by the Court of Milan because the Court is fully convinced on the above mentioned reasoning, or because the Court would like to avoid that cases that reach the appeal stage without inventors having been involved are sent back to the first instance and have to re-start from scratch. Needless to say, it may sometimes be very difficult to involve inventors in revocation actions: their address is often unknown and claimants may not know where to serve proceedings (in this respect – see Court of

Milan, order of 31 July 2008, according to which the proceedings can be served on inventors at the address of the agent who filed the patent). Furthermore, often inventors are a large team and involving them all may cause delay. In any event, I have never seen one case in which the inventor on which proceedings are served based on Art. 122 IP Code eventually joins the proceedings and takes an active part therein.

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