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New rules for post grant amendments in Italy

Daniela Ampollini (Trevisan & Cuonzo) · Thursday, October 21st, 2010

The amendments of the Italian IP Code introduced by Legislative Decree no. 131 of 13 August 2010 are many and I tend to believe that there is no Italian IP lawyer who is sure to have already counted them all. Each time I have to consider a new issue for a client, I find some interesting new provision. Extremely relevant ones are those of Arts. 76 and 79 IP Code on post grant amendments.

In the Italian system, there are two ways to obtain that a patent be limited post grant. According to Art. 79 IP Code, the patentee may file a motion with the Italian Patent Office (IPO) to amend (limit) the scope of protection of the patent as granted. A second possibility is that the limitation be made as a result of court proceedings. There is no formal procedure for the submission of amended claims in the course of court proceedings. The patent holder is allowed to request the amendment of the patent in reply to a revocation action or counterclaim by submitting pleadings indicating – inter alia – that the patent claims should be amended (limited), and to what extent. In principle, although this is rarely done, the patent holder may even immediately request the court to amend the patent when filing an infringement action, in the event that he has reasons to believe that the scope of the patent should be limited from the outset. In either case, the judge would typically ask the court expert reviewing all technical issues involved in the case to also provide an opinion on the request for amendment. The new provisions of Art. 76 and 79 now provide that the limitation (either made through an administrative procedure under Art. 79 IP Code or in the framework of court proceedings) may be carried out through a “re-drafting” which results in “new” claims, as long as these are supported by the patent description. Amendments are therefore no longer restricted to sub-claims as granted. This is a rather relevant innovation as opposed to the past as, prior to Legislative Decree no. 131/2010, Italian courts had generally taken the view that patents could only be limited post grant based on a combination of independent and dependent claims. With the new provisions, patent holders are clearly provided with a potentially enormous freedom to intervene on the patent to save it from a finding of nullity, and I anticipate that the question will be that of defining the limits of such a freedom in order not to compromise the need that the scope of protection of the patent be sufficiently certain vis-à-vis the general public.

This entry was posted on Thursday, October 21st, 2010 at 10:39 am and is filed under G 1/93, OJ 1994, 541) *The 'gold standard'* of the European Patent Office's Board of Appeal is that *any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*">Amendments, Italy
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