
Kluwer Patent Blog

Preliminary Technical Assessments not available to assess the validity of the patent

Daniela Ampollini (Trevisan & Cuonzo) · Monday, January 9th, 2012

As stated already in one my earlier posts ([here](#)), Legislative Decree no. 131/2010 has introduced a new procedural tool in the Italian IP litigation scenario. New Art. 128 of the Italian IP Code now allows the conduction of a Preliminary Technical Assessment (PTA). In practice, as an alternative to commencing ordinary proceedings or preliminary injunction proceedings, the claimant has the option of requesting the court to immediately appoint a court expert to assess the technical matter of the case. Once a reports has been prepared by the court expert, the latter will ask the parties whether, in light of the outcome of the technical assessment, they have the intention to settle the dispute. In case of a settlement, this will be formalized and will acquire the efficacy and enforceability of a ruling. In case no settlement is reached and proper court proceedings are commenced, any of the party may request that the report of the urgent technical assessment be used by the judge in adjudicating the case. In terms of the scope of the new provision and, therefore, the specific cases in which a preliminary technical assessment can be allowed, new Article 128 simply refers to Article 669 bis of the Italian Civil Procedural Code which allows claimants in civil cases to request the court to order a pre-trial assessment by an independent expert on the “existence and extent of credits originating from contractual obligations or infringement of rights”. The case law is now starting to settle. In particular, by decision of 21 July 2011 in the case Novartis v. Crinos, the Court of Rome clearly defined the limits of the tool. In that case, the generic company Crinos had seized the Court of Rome requesting it to appoint a court expert with the task of ascertaining the alleged invalidity of the adversary SPC. The Court however denied the request by clarifying that, based on the language of Article 669 bis of the Italian Procedural Code, PTAs in patent cases may only concern the assessment of possible credits, and these would therefore generally derive from a question of infringement of the patent. PTAs cannot therefore be used to obtain an expert opinion on the validity of the patent.

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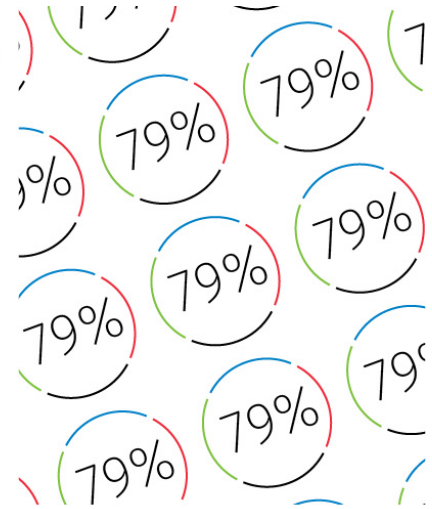
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This entry was posted on Monday, January 9th, 2012 at 7:18 pm and is filed under [\(Indirect\) infringement](#), [Italy](#), [Procedure](#), [Validity](#)

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