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Inventions made for hire according to the Court of Appeal of Milan

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In a decision of 9 February 2012, the Court of Appeal of Milan decided a case concerning the ownership of the rights over an invention allegedly made in the framework of a work-made-for-hire relationship. The case is interesting as Italian law does not explicitly regulate the case of inventions made for hire. Articles 64 and 65 of the Italian IP code, in fact, only consider cases in which the inventions are made in the framework of an employment relationship. In the case at issue, Gnutti S.p.A., the holder of a European patent and an Italian utility model concerning collectors to be used in air conditioning appliances, filed patent infringement proceedings against Aermec S.p.A. The latter, after having for a certain period of time sold air conditioning devices supplied by Gnutti and falling within the scope of protection of the Gnutti patents, had started selling identical appliances however produced by a third party, which allegedly resulted in the infringement of the Gnutti patents. While joining in, however, Aermec claimed that the relationship that had incurred with Gnutti was not just a supply agreement, but rather a contract according to which Gnutti developed a certain type of collector explicitly for Aermec, which resulted in an invention made in the framework of work-made-for-hire relationship. Aermec, therefore, not only requested that the claim of infringement be rejected, but also claimed that the patents at issue be assigned to Aermec as the only legitimate owner. Eventually, both the Court of first instance and the Court of Appeal upheld the Aermec case. As said, Italian law does not explicitly contemplate the ownership of inventions made for hire when there is no actual employment contract in place. In this situation, the case law generally stated that the invention automatically belongs to the company “hiring” the inventor’s activity if the “inventive activity” which lead to the invention was the subject matter of the contract. In the case at issue, no specific written contract had been entered into. According to the ruling of the Court of Appeal, however, it seems that the relevant evidence showed that, when requesting Gnutti to supply the collectors in question, Aermec furnished drawings which already embodied the invention and that the activity carried out by Gnutti consisted in a simple engineering activity which did not per se result in an invention. For these reasons, it was concluded that the patents had to be considered as the result of an invention made for hire and assigned to Aermec; in any event no infringement had been carried out by Aermec. In fact, the reasoning of the Court of Appeal is somewhat unsatisfactory: in order to conclude that the case is one of an invention made for hire (as the Court does) one would also have to conclude that an invention was made, although based on Armec’s request, by Gnutti. Stating that the invention already existed in the Aermec’s drawing is, in my view, something else, which may even pose the issue of the prior disclosure of the invention when Aermec provided the drawings to Gnutti.

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