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Are auxiliary requests admitted in Italian patent validity proceedings?

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After post grant limitations in court were introduced in Italy by the 2010 reform of the IP Code (IPC), there is hardly a patent validity case in which the patent holder does not play the card of limitation to counter the objections raised by the other party.

Even before the reform of 2010, Italian patent litigation could in fact end up with the court limiting the patent, in application of the provision according to which the court may find for partial invalidity. In practice, however, in most cases this was confined to claims combinations. Furthermore, the patent holder did not need to formally submit a set of limited claims to the court and the possible limitation of the patent could come up in an informal manner as a result of the technical discussion taking place during the proceedings.

Things have radically changed after 2010. First, Article 79 (3) IPC – which was adopted in order to give effect to Article 138 (3) EPC 2000 – expressly allows the patent holder to submit to the court a “*rewording of the claims*”. In other words, the patent holder is now allowed to submit to the court the same type of amendment that is possible via the administrative route, in the patent office: the limitation may not only consist in a claims combination, but may take the form of a rewording which makes use of elements taken from the description or drawings, provided of course that the scope of protection is limited, and not broadened.

The most recent debate, however, revolves around the procedural framework established by Article 79 (3) IPC. In particular, this article provides that “*at any stage or instance of the proceedings*” the patent holder can “*submit*” to the Court a rewording of the claims which remains within the boundaries of the patent application as initially filed and does not extend the scope of protection beyond that of the patent as granted. It may therefore seem that according to this provision the patent holder is allowed to act as it would before the EPO Opposition Division, i.e. to submit auxiliary requests. In particular, it may seem that this provision does not exclude the possibility for the patent holder to insist, in the first place, for the patent to be maintained as granted, and, should this not be upheld by the court, propose different sets of claims.

This is however not the opinion adopted in several recent decisions of the Court of Milan (*ex multis*: Court of Milan, 27 November 2017, *Raimondi v. FIRP*; Court of Milan, 5 July 2017, *Advachem v. Sadean Chimica*). In more detail, these decisions have repeatedly stated that the right of patent limitation in court as conferred by Article 79 (3) IPC is an expression of the *jus poenitendi* of the patent holder, whereby the latter renounces the scope of protection of the patent

as granted, and submits to the court a limited title. According to these precedents, as a result, the patent holder is not allowed to insist for the maintenance of the patent as granted, in the first instance, and propose limited claims, in the second and subordinate instances; even less is the patent holder allowed to submit to the court more than one set of claims by way of auxiliary requests. In these precedents, in substance, patent holders wishing to take advantage of the provision of Article 79 (3) IPC were rather requested to renounce the scope of protection of the patent as granted and confirm just one set of limited claims.

The first consequence of this approach is on case management. Those who are familiar with Italian patent litigation know that in the course of validity proceedings, the Italian court will appoint a court expert and ask her to provide her reasoned opinion on the technical issues underlining validity (and possibly infringement as well). Although it is not binding for the court, the opinion of the court expert is obviously influential and will play an important role in the road to the ruling. In case the patent holder decides to take advantage of Article 79 (3) IPC as above interpreted, i.e. with the patent holder having the possibility to submit just one set of patent claims, the court expert will produce her opinion on that set of patent claims. If she concludes that the patent as limited still suffers, e.g., from lack of novelty, the patent holder will most likely go ahead and submit another set of limited claims. This because Article 79 (3) IPC expressly states that the patent holder can submit reworded claims “*at any stage and instance of proceedings*”, without there being any restriction in the number of possible limitations. Therefore, the court will inevitably reopen the technical discussion and ask the court expert to produce – after an additional exchange of views with the parties – another opinion on the second set of limited claims, and so on and so forth should the second opinion still find the patent invalid notwithstanding the further limitation. This may obviously be a time consuming exercise, to the detriment of the efficiency of proceedings.

The second consequence is that, as the limitation is to be seen as the exercise of so called “*ius poenitendi*”, in second and further limitations the patent holder will not have the possibility to propose a scope broader than that of previous limitations. In other words, later limitations will only be allowed for a scope narrower than that of preceding limitations, as these will have already caused an irreversible partial withdrawal of protection by the patent holder.

It is unclear what the effect would be of the above said exercise of the *ius poenitendi* in case the limitation submitted is found to be inadmissible, e.g. as the resulting scope of protection is considered to be broader than the previous one. One may think that it is overreaching and not in line with the intention of the legislator to conclude for the loss of the patent as a whole, by virtue of the renunciation of the initial scope of protection, on the one hand, and the inadmissibility of the limitation, on the other.

In principle, all these issues may be resolved by eventually accepting a practice of auxiliary requests. In fact, the submission of alternative or subordinate sets of claims on which the court could immediately request the opinion of the court expert would avoid unduly stretching the case. Furthermore, auxiliary requests may eliminate issues of coordination between sets of claims submitted in a successive manner, as well as those concerning the possible outcome of a finding of inadmissibility of a limitation. I am afraid however that the reasons which underline the approach supported to date by the case-law have to do with general principles of procedural law (and in particular the one according to which the parties’ claims cannot be amended during the proceedings) which, according to some commentators, do not co-ordinate very well with the right granted by Article 79 (3) IP Code. I believe therefore that discussions will continue for some more years on how patent limitation in court should be carried out in Italy. For the time being, the advice

is to pay the biggest attention possible to the designing and implications of patent limitations in court, as this is likely to be considered as bringing about irreversible consequences.

Another interesting point is from when such post grant limitation should take effect vis-à-vis infringers, may be a topic for another post.

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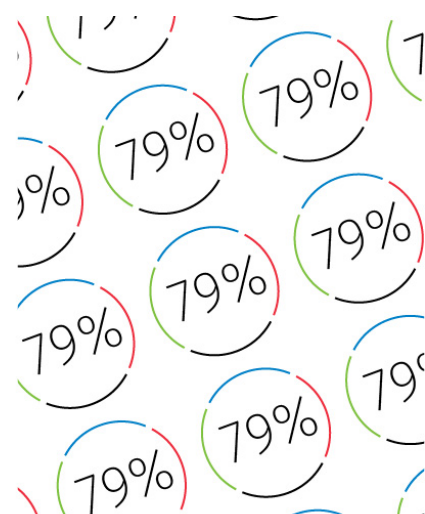
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