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Italy: an update on post grant limitations and infringement

Daniela Ampollini (Trevisan & Cuonzo) · Monday, October 28th, 2019

In another post ([here](#)) I have discussed the procedure for seeking post grant limitation in the framework of Italian court proceedings, and the closing line of that post mentioned that another interesting point of discussion would be when such post-grant limitation should take effect vis-à-vis infringers. In fact, a few decisions have touched this issue recently, and they deserve a brief comment.

First, by decision no. 21402 of 14 August 2019, the Italian Supreme Court has eventually clarified that post-grant limitation shall be treated as producing effects *ex-tunc*. This may seem to be an obvious conclusion, considering that the case concerned the Italian designation of a European patent and that Article 69(2) EPC clearly states that “*the European patent as granted or as amended in opposition, limitation or revocation proceedings shall determine retroactively the protection conferred by the application, in so far as such protection is not thereby extended*”. However, such a confirmation by the Supreme Court is indeed useful, in light of the fact that certain past court decisions had in fact created some confusion on the temporal effects of post-grant limitation, by reference to the language of Article 56 (1) of the Italian Industrial Property Code (IPC) which (by implementing the provision of Article 105-ter(3) EPC), establishes that “*the decision*” which limits the patent becomes effective on the day of the decision’s publication. In other words, the Supreme Court finally caused the cessation of any discussion on a potential divergence between the provisions of Article 69(2) EPC, on the one hand, and of Article 56(1) IPC (and Article 105-ter(3) EPC) on the other, by clarifying that it is the “*decision*” to become effective upon publication, whereas the effects of limitation shall be retroactive.

Second, the Court of Milan has eventually started marking some distance from certain precedents of a few years ago which seemed to have established a principle that, in case of post grant limitation, damages could not be claimed retroactively but only from the time of the filing of the request of limitation. It would be unfair, said those precedents, to request third parties to respect a scope of protection which had not been put in place yet, in a situation in which what third parties faced was a patent which, as granted, was to be considered invalid. For instance, in *Imar v. Wiessmann*, ruling of 29 April 2015, the Court of Milan limited the scope of the award of damages to the period following the request of limitation that the patent holder had submitted to the Court under Article 79(3) IPC, by arguing that, provided that under Italian law damages can only be awarded if the subject who caused them acted wilfully or with negligence, in the case at issue it was impossible to presume the minimum level of required negligence in view of the fact that, prior to the filing of the request of limitation, the infringer could not really determine the scope with which the patent would have survived a revocation claim thanks to limitation. It seems that in that

case the limitation involved a rather extensive rewording of the claims. Furthermore, it seems that the patentee had had to go through several (six, in fact) successive limitations before finding a wording that could be considered such to overcome the invalidity challenges brought by the infringer. As extreme as the case could seem, however, this decision remained a precedent and a potential source for debate as to whether any practical meaning could in fact be attached to the retroactivity of limitations established by Article 69(2) EPC. A more recent decision of the Court of Milan (*Saima v. Plexa*, ruling of 5 October 2018) now seems to have clarified, however, that limitations, even if carried out by way of a true rewording and not just by a combination of claims, have to remain, in fact, limitations. Therefore, in principle the requirement of negligence or wilfulness, which is mandated by the general provisions of Italian civil law as far as damages compensation is concerned, may well be met if one thinks that a limitation can be admitted if the scope of protection is not broadened and, in fact, the reworded claims refer to a subject matter which was already disclosed and which finds support in the patent description. Which in substance means that third parties had to be able to already recognize the (limited) invention, event before the limitation was carried out in practice. An additional note on this point could be that, besides damages compensation, Italian law allows the patent holder to seek so called disgorgement of profits, and such a disgorgement does not fit into to the same systematic framework as damages compensation, so much so that, for instance, recent precedents confirm that disgorgement can be ordered irrespective of any negligent or wilful conduct on the part of the infringer. A topic for yet another post.

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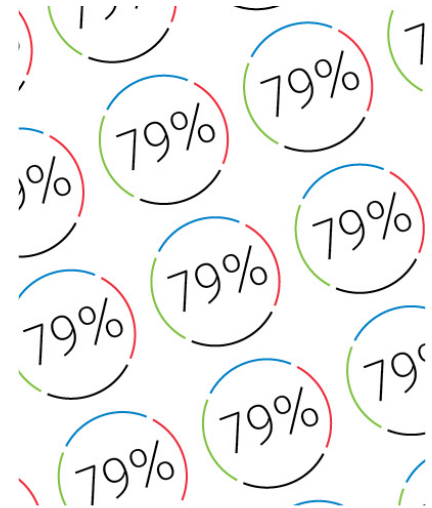
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