



Intellectual Property is the new black: relevant changes introduced in Italy by the reform of the Intellectual Property Code.

The debate over Intellectual Property has been particularly heated over the past year: as of this summer, Italy has also seen significant changes in this area. On August 23, 2023, the law amending the Intellectual Property Code came into force, representing the culmination of the strategic lines of action on Intellectual Property planned by the Italian government for the three-year period 2021-2023.

The reform

This legislative reform represents a milestone in the national mission for the digitalization, innovation, and competitiveness of the national production system, and has been fully elaborated in the drafting process by the Italian Patent and Trademark Office. Specifically, the planned amendments aim at: *(i)* strengthening the protection of IP rights from a pro-competitive perspective; *(ii)* simplifying and digitalizing related procedures; and *(iii)* coordinating national legislation internally, and with the discipline of international patent applications.

Inventions made on behalf of universities and research institutions

The previous text of the article in question attributed the patent rights to the researcher. However, it should be noted that the inventor had little interest in exploiting the invention, also taking into account the considerable costs and complexity of the procedure for granting and maintaining the patent. The revision of the national legislation, therefore, sought to remedy this situation, which discouraged the protection and commercial exploitation of inventions.

The new wording of the Industrial Property Code states that if an industrial invention is made in the performance or fulfilment of a contract or employment relationship with a university, even for a fixed term, the rights arising from the invention shall belong to the structure to which the inventor belongs. The new discipline differs from that applicable to other employees. On the one hand, for researchers, there is no requirement that the inventive activity be identified as the subject matter of the contract or relationship and that it be specifically remunerated for that purpose. On the other hand, employing institutions are required to reward inventors, but the law does not specify the criteria for quantification.

Counterfeits exhibited at official or officially recognized trade fairs and the new protection granted to designs

Previously, the Italian Code stipulated that in the case of suspected counterfeit products exhibited at official or officially recognized trade fairs, the authorities could only proceed with the description of the suspected products, without the possibility of civil seizure. This paragraph has been repealed, thus allowing the authorities to immediately seize the products (and enjoin the continuation of the conduct) upon an order of the competent court based on a suspicion of infringement.

In addition, designs exhibited at official or officially recognized trade fairs, held in the territory of the state or in the territory of a foreign state that accords reciprocity of treatment, can now be granted temporary protection, meaning that their legal protection begins on the date of the exhibition. This amendment is intended to prevent the exhibition of a design at a trade fair from causing the design to lose its registrability requirements (novelty and individual character).

Coexistence of European Patents, Unitary Patents and Italian Patents

After the amendment of the Code, if, for the same invention, an Italian Patent and a European Patent valid in Italy or a Unitary Patent with the same filing date or priority date have been granted to the same inventor or his successor in title, the Italian Patent retains its effects and coexists with the European Patent, even if the latter is later annulled or forfeited.

In conclusion

For completeness' sake, it is worth mentioning that other amendments have also been made with regard to geographical indications and denominations of origin, as well as a series of measures aimed at simplifying the procedures for filing patent applications and appeals against decisions of the Italian Patent and Trademark Office. In conclusion, the new amendments to the Italian Intellectual Property Code and the heated debate on the recent regulatory changes in this area confirm the importance of legislative innovations in the IP field. We will hear more about the implementation of the reformed Italian IP Code, and the issues touched upon remain extremely popular. We can say that in Italy, too, Intellectual Property is the new black.

11.10.2023

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