

Bird & Bird

Italy

Patent Litigation Q&A

May 2023



Italy – Patent Litigation

Where can patent infringement actions be started? Is there a choice of venue?

Infringement proceedings must be brought before one of the 22 “Specialised Divisions in Company Matters” as these have exclusive jurisdiction over all intellectual property cases sitting in the main Italian Courts.

Infringement actions can be initiated before the Specialised Division of the Court in either, the district where the defendant has its registered office/domicile, or the district where the unlawful act occurred (so called “*forum commissi delicti*”).

Are the judges’ specialists? Do they have technical backgrounds?

Judges do not have technical backgrounds which is why they almost always appoint a Court Technical Expert (“CTE”), i.e., a patent attorney skilled in the field, who is requested to draft a report on the validity and/or infringement of the patent at issue. Judges generally tend to rely on this report, though they are not bound by it.

However, as they belong to a Specialised Division, these judges are generally skilled in dealing with patent matters.

How long does it take from starting proceedings to trial?

Infringement proceedings on the merits generally take around 2 to 3 years to reach the first instance judgment, but the timing also depends on the Court and the appointed Judge.

Can a party be compelled to disclose documents before or during the proceedings?

Being a civil law country there is no disclosure system. However, a party may apply to the court where there is a specific document (confirming their claims) which is in the control of the adverse party. The Judge may order the adverse party to exhibit the document or to provide information about the document(s), subject to the protection of confidential information.

It follows that the patent proprietor could try to obtain information on the infringement that could be impossible to collect otherwise (including, to a certain extent, the accounting documents of the infringer to quantify the compensation for damages).

There is also a tool, “*descrizione*”, which allows the patentee to collect evidence of the infringement which would be very difficult (or impossible) to collect during the proceedings on the merits.

This is a kind of judicial inspection, generally ordered *ex parte* by the Judge, who permits a bailiff and – if needed – a technical expert to access the premises of the alleged infringer and collect evidence of the suspected infringement. Under certain circumstances, they may collect evidence to prove the extent of infringement, such as samples of the infringing products, documents, and account information.

There is then a hearing where the parties discuss the confirmation/revocation/amendment of the order. The patentee must then file for main infringement proceedings to use the evidence gathered during the *descrizione*.

How are arguments and evidence presented at the trial?

Patent proceedings are mainly constituted by written pleadings and different hearings, rather than one trial.

The arguments and evidence are presented within precise deadlines provided both by the governing law and the Judges on the case.

How long does the trial generally last and how long is it before a judgment is made available? Are judgments publicly available?

Judgments are generally issued 2-3 months after the filing of the final pleadings.

The judgments are made available to the public.

Can a defence of patent invalidity be raised? Are infringement and validity issues heard together?

There is not a bifurcated system. If the patentee starts main infringement proceedings, the defendant may file counterclaims for patent invalidity within the same proceedings.

Infringement and invalidity can be heard within the same proceedings, at the same time. It is very common for alleged infringers to defend by counterclaiming invalidity of the patent.

Are infringement proceedings stayed pending resolution of validity in the national patent office (or, if relevant, the EPO) or another court?

In theory, a stay of the infringement proceedings pending EPO opposition/appeal procedure can be requested, but in practice the Courts very rarely grant it. There are a few decisions stating that the Judges have a discretionary power to stay the proceedings if they consider that there are good chances that the patent will be revoked or amended by the EPO.

According to the case law of the Supreme Court, infringement proceedings should instead be stayed if there are separate pending invalidity proceedings.

Are preliminary injunctions available? If they are, can they be obtained *ex parte*? Is a bond necessary? Can a potential defendant file protective letters?

Preliminary injunctions are available.

The patent owner can try to obtain a preliminary injunction (and seizure and recall) *ex parte*. However, in complex patents, most Courts are reluctant to grant *ex parte* preliminary injunctions and in almost all the cases, before taking any decision, they will summon both parties.

In granting precautionary measures (such as preliminary injunctions and seizures) the Judge may order the claimant to post a bond before implementing them, but this is very rare.

Protective letters are not available for potential defendants.

Are final injunctions available as of right? Is a bond necessary?

A final injunction is generally granted upon request of the patentee once the infringement is ascertained, usually along with a penalty due by the infringer in case of non-compliance (or delay in complying) with the injunctive relief.

A bond is not necessary.

What other remedies are usually ordered if a patentee is successful?

Available remedies can include recall from the market and/or the destruction of the infringing products, penalty for any breach of judgment or delay in compliance, publication of the decision in newspapers and/or on the infringer's website, compensation for damages, and destruction of the infringing products.

Would the tribunal consider granting cross-border relief?

The grant of cross-border relief is highly disputed, we are not aware of any recent decisions to grant such relief in patent cases.

Is there a right of appeal from a first instance judgment? How long between judgment at first instance and hearing the appeal?

First instance judgments can always be appealed to the Specialised Division of the Court of Appeal within 30 days of the service of the decision by one party, or in the absence of such service, within 6 months of the publication of the judgment.

The appeal judgment can be further appealed before the Supreme Court, but this is rare in patent matters. The Supreme Court may only decide on jurisdiction, competence, violation of the law or lack/contradiction of the reasoning of the judgment, and not on the fact-finding of the lower courts.

Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

Appeal proceedings imply a further assessment of the facts and rules of law already dealt with before the first instance Court.

No new claims or objections can be raised on appeal. As for new evidence, the general rule is that parties cannot file new documents at the appeal stage, unless the evidence concerns facts which occurred after the first instance judgment, or if it is successfully demonstrated that the evidence could not be submitted during the first instance proceedings due to reasons that were beyond the control of the party.

The Court of Appeal may also order that another CTE phase be carried out.

What is the cost of a typical infringement action to first instance judgment? If the issues of invalidity and infringement are bifurcated, what is the cost of the invalidity action? Can the winner's costs be recovered from the losing party? How much is the cost of an appeal?

The cost would be very dependent on the specific case (such as the subject matter, number of patents, procedural issues, etc) and would be difficult to estimate generally.

Note: The information in this document relates to litigation through the national jurisdiction and not the UPC.

Authors



Giovanni Galimberti

Partner

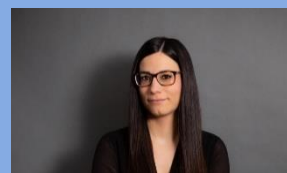
+390230356021
giovanni.galimberti@twobirds.com



Edoardo Barbera

Partner

+390230356046
edoardo.barbera@twobirds.com



Evelina Marchesoni

Senior Associate

+390230356052
evelina.marchesoni@twobirds.com

twobirds.com

Abu Dhabi • Amsterdam • Beijing • Bratislava • Brussels • Budapest • Casablanca • Copenhagen • Dubai
• Dublin • Dusseldorf • Frankfurt • The Hague • Hamburg • Helsinki • Hong Kong • London
• Luxembourg • Lyon • Madrid • Milan • Munich • Paris • Prague • Rome • San Francisco • Shanghai
• Shenzhen • Singapore • Stockholm • Sydney • Warsaw

The information given in this document concerning technical legal or professional subject matter is for guidance only and does not constitute legal or professional advice. Always consult a suitably qualified lawyer on any specific legal problem or matter. Bird & Bird assumes no responsibility for such information contained in this document and disclaims all liability in respect of such information.

This document is confidential. Bird & Bird is, unless otherwise stated, the owner of copyright of this document and its contents. No part of this document may be published, distributed, extracted, re-utilised, or reproduced in any material form.

Bird & Bird is an international legal practice comprising Bird & Bird LLP and its affiliated and associated businesses.

Bird & Bird LLP is a limited liability partnership, registered in England and Wales with registered number OC340318 and is authorised and regulated by the Solicitors Regulation Authority (SRA) with SRA ID497264. Its registered office and principal place of business is at 12 New Fetter Lane, London EC4A 1JP. A list of members of Bird & Bird LLP and of any non-members who are designated as partners, and of their respective professional qualifications, is open to inspection at that address.