

Italian patents: New Search Procedure from July 1st, 2008

The Italian Patent and Trademark Office announced that, from July 1st 2008, any patent application will be subject to a new substantive search procedure run by the European patent Office, following to an agreement between the two Offices of December 12, 2007. The purpose of this reform is transforming the Italian Patent from a non-examined patent into an examined (and hence "strong") patent, suitable for preliminary injunctions against alleged infringers.

Such new procedure should be designed along the lines of the patent examination of France: the European Patent Office will issue a Search Report consisting of a list of prior citations with the indication of the significance of the documents, according to Rule 61 EPC. This report shall be accompanied by a preliminary opinion on patentability according to Rule 62 EPC.

Up to now, it is not clear whether or not such opinion has to be rendered available to the public. As a matter of fact, the Italian patent application are not published in any form and the sole source of information about a patent application is its file wrapper at the Patent Office. Hopefully, also this lackness should be remedied by the Office.

The basis for the drawing up of the Search Report will be the english translation of the set of claims. To this purpose, a new translation fee of Euro 200,00 will become due at the filing. This amount should cover the expenses for an automatic translation of the claims. The fee is not due if an English version of the claims is submitted by the applicant. Further, the application will incur a claim fee for the 11th and each subsequent claim. The amount of the fee is Euro 45, 00 for each claim. Again, it is not clear whether or not such fee is bond to the equivalent claim fee of Rule 45 EPC. In such a case, the amount should be updated to the new Rule 45, in force from April 1st, i.e. € 200,00 for the 16th and each subsequent claim.

After the issue of the Search Report, the applicant continues to have the opportunity to file a petition for the correction of the application, possibly accompanied by arguments responsive to the preliminary opinion. Both the correction and the arguments will be available to the public after the 18th month after the priority date in the application file wrapper.

It is interesting to note that the whole cost of this new procedure, roughly corresponding the the Search fee to be paid to the European Office, will be supported by the Italian Government, as a measure in

favour of the national technology and scientific development. However, such a discount is offered to all the applicants, regardless their nationality. Further, such Italian Search Report could be used for obtaining the refund of the fees to be paid for the searches involved in subsequent European or International patent applications.